

Comments from the National Trademark Office of the National Institute of Industrial Property (INPI) on the different areas of convergence identified in document SCT/35/4

#### a) Introduction

The Law on Trademarks and Designations (Law No. 22.362) permits the registration as a mark of geographical names with the exception of the following: “1) National or foreign appellations of origin; 2) Letters, words, names or badges used by foreign countries and international organizations recognized by the Government of Argentina; and 3) Marks that may mislead as to the nature, properties, merit, quality, processing techniques, function, origin, value or other characteristics of the goods or services to be distinguished.”

Thus, our legislation permits the registration as a mark of geographical names except where one of the circumstances mentioned in the previous paragraph applies, in which case the Argentine office rejects the application to register the mark.

#### b) Notion of country name

Article 3(g) of Law No. 22.362 prohibits the registration as a mark of “letters, words, names or badges used by foreign countries and international organizations recognized by the Government of Argentina”.

For this exclusion to apply, in principle the sign must meet two conditions:

- i) it must be the official name adopted by the foreign government; and
- ii) that country must be recognized by the Government of Argentina.

The exclusion applies not only to the foreign country’s “official” name, but also to all “names or badges” used by that country.

The reason for the exclusion is twofold: first, in line with a tradition of international cooperation, to prevent any potential harm through acts of trademark piracy; and second, to protect consumers who, on seeing such

marks, may think that they are endorsed by the countries apparently represented.

#### c) Use of a country name as a description of goods or services

Article 2(a) of the aforementioned Argentine Law stipulates that “names, words and signs” that describe the “nature, function, qualities or other characteristics” of a mark may not be registered.

This exclusion applies to country names indicative of a place of manufacture where that place is recognized as the origin of such goods by different manufacturers.

Otherwise, country names, unless misleading or appellations of origin, may be registered.

#### d) Invalidation and opposition procedures

Article 4 of the above Law stipulates that in order to “exercise the right to oppose” the registration or use of a trademark, the applicant or opponent “must have a legitimate interest”.

Thus, “any person” with a legitimate interest can oppose a trademark application provided, of course, they can prove the existence of a de facto situation worthy of legal protection.

Oppositions can be based on any legal cause establishing grounds for the non-granting of the mark in question.

Under Article 24(a) of the aforementioned Argentine Law, registrations made “in breach of the provisions” of said Law shall be null and void.

This refers to marks that, for one reason or another, should not have been registered but were nonetheless granted by the respective office.

Requests to annul registrations are not handled by the trademark office: they must be referred to the Federal Civil and Commercial Court.

e) Use of a country name as a mark

Under Article 4 of the above Argentine Law, any person may oppose the use of a mark. This is the basis for any civil injunction to prohibit the use of a mark.

Thus, any applicant with a "legitimate interest" has the necessary means to prevent the use of a country name where such use is misleading as to the nature, quality or geographical origin of goods or services.

This principle is well founded: it is enshrined in legislation to protect the interests of both trademark holders and consumers and to foster good business practice, thereby enabling the free, harmonious and honest development of trade.

Lastly, Article 10bis of the Paris Convention, ratified in our country by Law No. 17.011, constitutes a directly applicable standard and provides that:

"1) the countries of the Union are bound to assure to nationals of such countries effective protection against unfair competition;

3) the following in particular shall be prohibited:

iii) indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods."

f) Other grounds for refusal to register - section 19

Registration, as marks consisting of or containing country names, can be refused for other grounds under the Argentine Law on Trademarks

(Article 3(a), (b) and (e)).

Registration can be refused where country names prove identical or similar to marks "already registered or applied for in order to distinguish the same goods or services".

Mark registrations can also be refused where, in an application, the claimed country name, or combination of elements containing that name, is configured in such a way as to be outwardly offensive, insulting or defamatory towards a particular country.