
ARGENTINA

NEW REGULATION OF THE LAW ON TRADEMARKS AND DESIGNATIONS

Following the amendments introduced in the trademark law by Decree 27/2018 and the subsequent Law 27,444, on April 3, 2019, the Decree 242/2019 was published in the Official Gazette. This decree regulates the amended Law 22,362 on Trademarks and Designations and it will be in force as of June 3, 2019.

The provisions of said Decree are in line with the standard modernization of the trademark procedures and the incorporation of new procedures for the resolution of oppositions, nullities and cancellation to expedite proceedings. In addition, it clarifies issues related to classification of goods and services and the date in which protection of the trademark begins, establishes procedures, updates the amounts of fines for infringements and incorporates into the trademark law framework some criteria that was applied in practice by the Trademark Office.

The most relevant issues of the regulation are the following:

1. Secondary meaning:

In accordance with the criteria already adopted by the Trademark Office's examiners, the regulation expressly provides that non-registerable signs that have acquired distinctiveness through use, including the form and color for which registration is requested, can be allowed and registered as trademarks. Also forms that are not necessary or common that show distinctiveness can be registered.

2. Geographical indications:

It is clarified that the prohibition of registering national or foreign geographical indications as trademarks refers to the geographical indications expressly recognized by the Argentine Republic.

3. Renewal of trademark registrations:

A novelty introduced by Law 27,444 is the possibility of filing the renewal of a trademark registration within a grace period. The Decree only indicates that the request for renewal must be submitted within the term established by the Government Authority, which may consider the possibility of establishing a grace period. To date, the grace period has not been established, nor any official fee been set for this purpose.

4. Procedures to resolve nullities and cancellation of trademark registrations:

The amended Trademark Law provides that the nullity of trademark registrations granted in breach of the provisions of the law, as well as the cancellation requests, must be dealt through an administrative proceeding. The regulatory decree states that, until the corresponding procedures are regulated, the nullity and cancellation requests will be handled by the Administrative Authority (Industrial Property National Institute - INPI) and the general rules of Law 19,549 of Administrative Procedures will be applied. As from June 3, 2019, the nullity and cancellation requests will have to be filed with the INPI.

5. Statement of Use between the 5th and 6th year:

Another novelty of the amended Trademark Law is the requirement of a statement of use that must be filed between the 5th and 6th year as of the granting date. If this statement is not submitted, the registration will not be cancelled; it will only lead to the presumption that the trademark was not used. This presumption can be refuted with evidence to the contrary.

Besides this, the decree states that the process of renewal will be kept in abeyance until the statement is filed and the corresponding fees are paid.

The official fee for the presentation of this declaration was included in the last update of INPI's official fees: the fee for the presentation of the Statement of use in term is AR\$ 2,250 and for the late filing of the declaration AR\$ 1,500 per year, which is added to the fee for the statement filed in term.

The obligation to submit such statement of use came into force and applies to all trademark registrations that had been granted for over 5 years when the Law 27,444. The regulation does not require proof of use, but rather a declaration. Notwithstanding this, the decree does not indicate how the statement must be filed, nor sets a grace period so that owners of trademarks granted more than 6 years ago can file their statements after June 3, 2019. These matters will have to be clarified in a subsequent provision issued by the INPI.

Although most issues introduced to the amended Trademark Law have already been regulated, there are certain procedures that still need regulation and issues that must be clarified. Therefore, we should expect the INPI to issue new provisions that complete the regulatory framework for the new Trademark Law.

PPH PILOT PROGRAM BETWEEN ARGENTINA AND DENMARK

On March 19, Argentina and Denmark held a Business Conference under the slogan "Alliance for Sustainability". In the context of this meeting, the Argentine National Institute of Industrial Property and the Danish Patent and Trademark Office signed an Agreement for the establishment of a Patent Prosecution Highway (PPH) pilot program for the applications filed in both Offices.

When the Office of earlier examination has determined that one or more claims of a patent application are patentable, the applicant will be able request the accelerated examination of its application in the Office of latter examination, provided certain conditions are met, including the correspondence of claims of the two applications and the search or examination results are available for the Office of latter examination. Each Office will apply its national patent laws and regulations in the examination of the applications filed in that Office.

This program will be in force for three years as of March 19, 2019.

AUTOMATIC EXTENSIONS TO RESPOND TO EXAMINATIONS AND OFFICE ACTIONS

On April 25, 2019, the INPI Resolution 98/2019 was published in the Official Gazette, which establishes that the National Patent Administration will grant three automatic and consecutive extensions of 30 consecutive days in each case, for the answer of the examinations, preliminary technical background examination and report prior to the final resolution.

At the moment of answering the hearing, a fee must be paid according to the number of extensions used. If this fee is not paid, the hearing will be considered as unanswered and, as the case may be, abandoned or withdrawn.

The resolution will enter into force on May 2 and will apply to the views that are issued as of that date.

Although the regime of three automatic and consecutive extensions of the previous system is maintained, after the modifications introduced in the procedures of patents and utility models through Law 27,444, it was necessary to review the provisions and resolutions related to these procedures. In this sense, the granting of extensions for the answers to hearings before the National Patent Administration is confirmed.



The link to access the publication of this standard is the following:

<https://www.boletinoficial.gob.ar/detalleAviso/primera/206106/20190424?fbclid=IwAR1IsaSizLLUyCu2jPjxDxVcFxcWlaPfk9KqkMuAPmclltomrhFJoeFFLaw>

MEXICO



SETBACK TO GUIDELINES OF SANITARY CONTROL OF CANNABIS PRODUCTS AND ITS DERIVATIVES

As previously reported, the Federal Commission against Sanitary Risks (COFEPRIS¹) published on October 30, 2018, under regulation of the previous administration, the guidelines on health control of cannabis and its derivatives, which specified criteria of evaluation of applications of marketing authorization, exportation and importation of products related to cannabis and its derivatives in concentrations of less than 1% of tetrahydrocannabinol (THC).

However, on March 27, COFEPRIS¹ revoked these guidelines on the grounds that said guidelines contravene the General Health Law amended in 2017, and exceeds its purpose when authorizing the commercialization of diverse products with

cannabis derivative (THC) in uses other than medical and scientific.

It is apparent in the official COFEPRIS¹ release, that the purpose of this revocation is to harmonize the current legal framework, not implying a total cessation of the developments achieved on the medicinal and therapeutic use of cannabis.

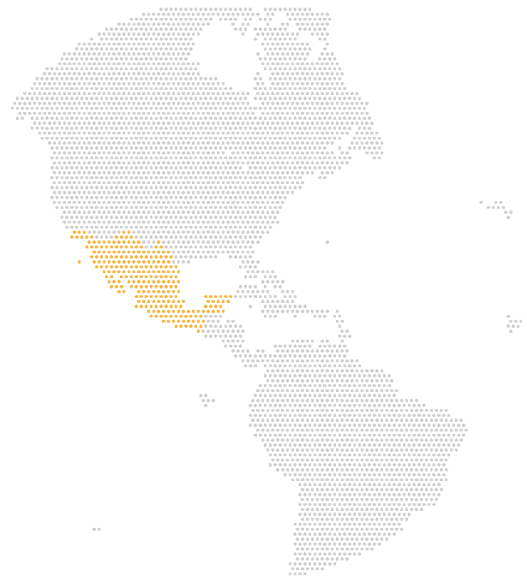
Regarding the sanitary authorization of products containing cannabis, resolved under the recently revoked guidelines, COFEPRIS¹ has not determined what the general procedure will be. It is only stated that the cases will be reviewed to determine their validity and then take the relevant actions.

NEW NOTIFICATION SYSTEM

As a consequence of the reforms to the Industrial Property Law (Art. 183 IPL) issued on May 2018, the Mexican Institute of Industrial Property (IMPI) carries out the notification through the Industrial Property Gazette of resolutions, requirements and other procedures related to trademarks, patents, designs and utility models applications.

In the operational implementation, these Gazette notifications are working for official actions of substantive examination, resolutions, namely; letters patent, rejections, abandonment and dismissals, recordings related to the maintenance of rights and renewals. Consequently, no hard-copies of the Letters Patent will be delivered, only a digital version.

On the other hand, official actions related to formal examination and notifications of formal requirements' fulfilment are maintained until further notice, by traditional desk or post notification.



NOTE 1: https://www.gob.mx/cms/uploads/attachment/file/448553/Digitalizacio_n_2019_03_27_17_51_23_668.pdf

BRAZIL



PARLIAMENT APPROVES THE GOVERNMENT'S PROPOSAL TO ADHERE TO MADRID PROTOCOL

The Brazilian Parliament approved on April 4, 2019, in plenary session, the government's proposal to adhere to the Madrid Protocol. The project must be examined by the Senate but it is, without a doubt, an important step in relation to an adherence that has been discussed for many years. We attach a link to the publication of the news on the website of the INPI - office of patents and trademarks of Brazil.

<http://www.inpi.gov.br/noticias/camara-dos-deputados-aprova-adesao-brasileira-ao-protocolo-de-madri>

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