

ARGENTINA: Court Rejects Rebranding Registration of a Mark Containing a Geographical Indication

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On April 4, 2017, Argentina's Supreme Court of Justice dismissed an appeal, thus making the Court of Appeals' April 2016 decision final, in the case of *Ovinto S.A. v. Instituto Nacional de la Propiedad Industrial y Otro* (docket No. 12.279/2007). The case involved the National Institute of Industrial Property's (Instituto Nacional de la Propiedad Industrial—INPI) resolution rejecting a registration in connection with the rebranding of a registered mark composed of a geographical indication (GI). This was the first decision issued in such a matter.

Registered TM



New TM application



The Court of First Instance admitted the complaint and declared the INPI decision invalid. The court said that the applicant already owned a trademark registration for TUNUYAN (and design) in the same class before the TRIPS and GI law had come into effect. It further mentioned that it was logical for a trademark owner to rebrand a sign—in this case from a graphic and not an ideological perspective.

The Court of Appeals on April 5, 2016, reversed the first instance decision on the grounds that there existed differences between the new application and the registered trademark. The court pointed to the differences in typography of the words and the design of the lines supporting the letters between the two marks, and noted that the original mark included the phrase “marca registrada” (registered trademark). Also, while the scope of protection for the registered trademark excluded “cider,” the new application covered the whole class.

The Court of Appeals acknowledged that a trademark already registered in good faith prior to being protected as a GI would remain valid. However, in this case, the court said that, due to the differences between the marks, the application counted as a new trademark rather than a renewal, which was applied for after the TRIPS Agreement had become effective (2000) and also after the date on which TUNUYAN was recognized as a GI (2002).

The plaintiff filed an Extraordinary Appeal against this decision, which was deemed inadmissible by the Court of Appeals on May 31, 2016. Finally, on April 4, 2017, the Supreme Court dismissed the direct appeal filed by Ovinto S.A. against the latter decision. Therefore, the Court of Appeals decision has now become final.

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