

CHECKLIST OF ISSUES ON ENFORCEMENT¹

Replies by Argentina

Civil and administrative procedures and remedies

(a) Civil judicial procedures and remedies

1. Specify the courts which have jurisdiction over IPR infringement cases.

The federal courts have jurisdiction for intellectual property rights.

In the case of infringements of copyright and related rights, jurisdiction lies with the Ordinary Civil or Commercial Courts, depending on the infringement.

2. Which persons have standing to assert IPRs? How may they be represented? Are there requirements for mandatory personal appearances before the court by the right holder?

The persons with standing to assert IPRs in the case of civil actions are the right holders or licensees or authorized third parties. They may act on their own behalf, with a representative, or through an attorney. Article 404 of the Civil and Commercial Code of Procedure establishes that the parties must make a personal appearance for the purposes of setting out their priorities.

In the case of an infringement of copyright or related rights, the persons with standing are the original holders (natural persons) and related holders (legal persons). Any of them may also be represented by a collective management society.

3. What authority do the judicial authorities have to order, at the request of an opposing party, a party to a proceeding to produce evidence which lies within its control?

In civil proceedings, the court is entitled to require the party to submit documents in its possession within the period specified by the court. Similarly, any party may request the court to order the opposing party to present such documents.

Where by other evidentiary means the existence and contents of such documents is manifest, a refusal to submit them constitutes a presumption against the party required to produce them (Civil and Commercial Code of Procedure, Articles 387 to 389).

In the case of patents and trademarks, the person in possession of the infringing goods is obliged to inform the court of the commercial channel and present invoices or receipts for the goods in question (Patents Law, Article 85; Trademarks Law, Article 39).

¹ Document IP/C/5.

4. What means exist to identify and protect confidential information brought forward as evidence?

In civil cases the court may, ex officio or at the request of the interested party, order the documents in the proceedings to be kept in the court's safe for the purposes of preventing disclosure of any confidential information that the evidence may contain.

In a criminal case, the initial enquiry shall remain secret until after charges have been brought (Supreme Court of Justice, Regulations for National Justice, Articles 64 and 65, 17 December 1952).

5. Describe the remedies that may be ordered by the judicial authorities and criteria, legislative or jurisprudential, for their use:

- **injunctions;**
- **damages, including recovery of profits, and expenses, including attorney's fees;**
- **destruction or other disposal of infringing goods and materials/instruments for their production;**
- **any other remedies.**

The civil judicial authorities may, at the request of the plaintiff, order cessation of acts constituting the infringement of intellectual property rights.

The judicial authority in deciding on an infringement of intellectual property rights, may order destruction of the infringing goods and the adoption of all requisite measures to prevent the continuation or repetition of the infringement as well as publication of the judgement and notification thereof to the persons concerned, at the expense of the infringer.

The criteria that the judicial authority may apply in determining the amount of damages in an action for infringement of intellectual property rights relates to compensation both for consequential damage and for loss of income sustained by the victim and seen from evidence produced in the proceedings.

6. In what circumstances, if any, do judicial authorities have the authority to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the goods or services found to be infringing and of their channels of distribution?

The courts are entitled in themselves and by law to order the defendant to provide information in response to questions from the plaintiff (Code of Civil and Commercial Procedure, Articles 378 to 389).

Article 85 of the Patents Law establishes that, where the infringing goods have not been manufactured by the person who is the subject of the interlocutory order, the order must give full particulars of the name, quantity, value and time at which the goods started to be sold; otherwise the person shall be deemed an accomplice of the infringer.

Article 39 of the Trademarks Law establishes that the person in possession of the infringing goods must give the name and address of the person who sold or obtained them and the date,

producing an invoice or receipt, together with the quantity of units manufactured or sold and the identity of the persons to whom the infringing goods were sold or delivered.

Article 24 of Decree Law 6673/63 stipulates that the holder of the goods shall provide explanations as to their origin, where relevant, to enable the right holder of the model or design to prosecute the manufacturer.

In connection with phonograms, Article 72 of Law 11723 authorizes the court to require the person storing or displaying them to present the relevant invoice linking him commercially with the producer.

7. Describe provisions relating to the indemnification of defendants wrongfully enjoined. To what extent are public authorities and/or officials liable in such a situation and what "remedial measures" are applicable to them?

Everyone is required to compensate injury sustained by another person on account of his fault or negligence (Civil Code, Article 1109). The same obligation applies with regard to acts and omissions by public officials that signify failure to fulfil their obligations (Civil Code, Article 1112).

The Framework Law Regulating the Civil Service, Law 25,164, stipulates suspension, dismissal or exoneration for an official who fails to perform his duties (Articles 23, 31, 32 and 33). Again, Financial Administration Law 24,156 stipulates that an official is liable for financial harm caused through his fault or negligence (Articles 130 and 131).

8. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.

The length and cost of judicial proceedings vary, depending on the complexity of the issue and the evidence invoked.

(b) Administrative procedures and remedies

9. Reply to the above questions in relation to any administrative procedures on the merits and remedies that may result from these procedures.

Law 25,163 provides for the remedy of opposition to the registration of geographical indications. Any natural or legal person declaring a legitimate interest may submit such opposition.

The implementing authority in that case gives authorization to the applicant, who may submit the relevant information for the authority to decide whether or not it is appropriate to grant protection to the geographical indication applied for.

Applications for remedies may also be submitted by any natural or legal person forming part of the geographical indications system.

The implementing authority is entitled to impose penalties on natural or legal persons in the system when any fault or infringement is ascertained:

- A fine of up to fifty (50) times the market value of the infringing good;
- forfeiture of the infringing goods;
- temporary suspension of use of the indication of origin or source in question;

- definitive cancellation of the use of the indication of origin or source, which shall be published in a newspaper with nationwide circulation and in the Official Bulletin for one (1) day.

In the event of a further offence or where the goods are intended for export, fines may be increased up to twice the amount stipulated in the first subparagraph above.

In the course of the administrative procedure, preventive seizure of the infringing goods may be ordered, for which purpose relevant judicial authorization will be required.

The implementing authority may also impose penalties on natural or legal persons not in the protection system established by law in the event of:

- Improper use of an indication of origin or source;
- the use of trade names, expressions, signs, abbreviations or emblems which, because of their identity or graphic or phonetic similarity with protected indications, or with registered signs or emblems, may be misleading as to the nature or origin of agricultural and food products;
- the improper use of protected geographical names on labels or tags, trade documents or product advertising, even though accompanied by the terms "kind", "type", "style", "method", "imitation" or a similar expression that may mislead the consumer as an indication of origin or source.

In all cases of alleged infringements of this law or its regulations on indications of origin, or decisions by councils, a preliminary enquiry shall be initiated and shall guarantee the alleged infringer's right to a defence.

Where the enquiry reveals alleged infringements for which the body making the enquiry is not competent to judge, that body shall in due course inform the appropriate organization and/or court.

Decisions by the implementing authority imposing penalties shall be actionable before the relevant federal court. An appeal does not suspend execution of the act. It is not essential to exhaust administrative channels before bringing court actions.

Provisional measures

- (a) Judicial measures

10. Describe the types of provisional measures that the judicial authorities may order and the legal basis for such authority.

General framework

With reference to patents, see WT/DS173/3, WT/DS196/4, IP/D/18/Add.1 and IP/D/22/Add.1, dated 19 June 2002, question 6.

In the case of an infringement of the Trademarks Law, the owner of a registered trademark who learns of the existence of goods with an infringing trademark may apply to the competent court for: seizure, an inventory and description and/or confiscation of some of the infringing goods. The court may require surety from the applicant (Trademarks Law, Article 38), where it deems that the

applicant does not have financial resources and is liable when he has requested seizure without any right whatsoever.

In civil actions to obtain cessation of the use of the trademark, the plaintiff may demand real-property security from the defendant if the defendant does not halt the use in question. If the security is not furnished, the plaintiff may demand suspension of use and a seizure (Trademarks Law, Article 35).

As for copyright, precautionary measures are provided for in Article 79 of Law 11723, which specifies that the courts may, after a bond is posted by the parties concerned, preventively order suspension of a theatre, cinema, philharmonic or similar performance, seizure of the works in the complaint, together with seizure of the proceeds thereof, and any measure for effective protection of the rights protected by the Law.

11. In what circumstances may such measures be ordered *inaudita altera parte*?

See WT/DS173/3, WT/DS196/4, IP/D/18/Add.1 and IP/D/22/Add.1, dated 19 June 2002, question 6.

12. Describe the main procedures for the initiation, ordering and maintenance in force of provisional measures, in particular relevant time-limits and safeguards to protect the legitimate interests of the defendant.

With regard to patents, see WT/DS173/3, WT/DS196/4, IP/D/18/Add.1 and IP/D/22/Add.1, dated 19 June 2002, question 6.

Article 39 of the Trademarks Law stipulates that a record must be made out when provisional measures are adopted. As in the case of patents, if the applicant does not bring the corresponding action within 15 days of the precautionary measures, such measures lapse (Article 40).

With regard to industrial designs, Article 24 of Decree 6673/63 stipulates that the court shall appoint a court official to proceed to the place in question, seize a specimen of the infringing goods, after making an inventory.

With reference to copyright and related rights, Article 79 of Law 11723 requires the interested parties to post a bond for the measures to be adopted. Article 72 *bis* waives the bond for authors' or producers' societies recognized as being legally representative and the time-frame is extended to 15 days from seizure of the copies.

13. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.

The cost and duration of the proceedings vary, depending on the complexity of the proceedings.

(b) Administrative measures

14. Reply to the above questions in relation to any administrative provisional measures.

With reference to intellectual property, there are no administrative-type measures.

With a reference to new plant varieties, Law 20,247 authorizes the Ministry of Agriculture, Livestock, Fisheries and Food to halt the sale and movement of the allegedly infringing goods for a period not exceeding thirty days (Article 45).

Special requirements related to border measures

15. Indicate for which goods it is possible for the suspension by the customs authorities of the release into free circulation, in particular whether these procedures are available also in respect of goods which involve infringements of intellectual property rights other than counterfeit trademark or pirated copyright goods as defined in the TRIPS Agreement (footnote to Article 51). Specify, together with relevant criteria, any imports excluded from the application of such procedures (such as goods from another member of a customs union, goods in transit or de minimis imports). Do the procedures apply to imports of goods put on the market in another country by or with the consent of the right holder and to goods destined for exportation?

Article 38 of the Trademarks Law establishes the possibility of applying for provisional measures consisting of seizure, an inventory and description of the goods and confiscation of one of the infringing goods. Under Article 34 of the Trademarks Law, the injured party may also request forfeiture and destruction of the goods.

With reference to industrial designs, Article 24 of Decree 6673/63 allows for the possibility of seizure of a specimen of the infringing goods.

With reference to copyright and related rights, Article 79 of Law 11,7123 allows the court, after a bond has been posted by the interested parties, to distrain on the works in question.

16. Provide a description of the main elements of the procedures relating to the suspension of the release of goods by customs authorities, in particular the competent authorities (Article 51), the requirements for an application (Article 52) and various requirements related to the duration of suspension (Article 55). How have Articles 53 (security or equivalent assurance), 56 (indemnification of the importer and of the owner of the goods) and 57 (right of inspection and information) been implemented?

In the Argentine legal system, suspension of the release of goods is a provisional measure further to a special decision and, consequently, must fulfil the same requirements as provisional measures.

17. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost. How long is the validity of decisions by the competent authorities for the suspension of the release of goods into free circulation?

There are no data available. The duration and cost depend on the type of action brought and the complexity of each particular case.

18. Are competent authorities required to act upon their own initiative and, if so, in what circumstances? Are there any special provisions applicable to ex officio action?

There is no provision of any kind establishing ex officio action. Actions must be initiated by the right holder or his licensee.

19. Describe the remedies that the competent authorities have the authority to order and any criteria regulating their use.

See the replies to questions 12 and 15 above.

Criminal procedures

20. Specify the courts which have jurisdiction over criminal acts of infringement of IPRs.

The competent authorities for cases of criminal acts of infringement of intellectual property rights are the federal (criminal) courts.

21. In respect of which infringements of which intellectual property rights are criminal procedures and penalties available?

Under Article 75 of the Patents and Utility Models Law, fraud concerning inventors' rights is deemed to be counterfeiting. Article 76 extends this offence to anyone who:

- Produces or orders the production of one or more articles in breach of the rights of the holder of the patent or utility model;
- imports, sells, places on sale or markets or displays or introduces into the territory of the Argentine Republic one or more articles in breach of the rights of the holder of the patent or utility model.

Under Article 77, the following are liable to the offence of disclosure and usurpation of an invention which has not yet been protected:

- Any partner, agent, adviser, employee or workman of the inventor or his assignees who he usurps or discloses an invention which is not yet protected;
- anyone who bribes the partner, agent, adviser, employee or workman of the inventor or his assignees to obtain disclosure of the secret;
- anyone who breaches the confidentiality imposed by law.

Under Article 78 anyone is liable to punishment if, without being the holder of a patent or utility model, whether or does not enjoy the rights conferred thereby, uses those products or, in his advertising, names likely to mislead the public as to the existence thereof.

Under Article 31 of the Trademarks Law, anyone is liable to punishment if:

- He counterfeits or fraudulently imitates a registered trademark or name;
- uses a registered trademark or name that is counterfeit or, fraudulently imitated or belongs to third party, without his authorization;
- places on sale or sells a registered trademark or name that is counterfeit or fraudulently imitated or belongs to a third party, without his authorization;
- places on sale, sells or markets products or services with a counterfeit or fraudulently imitated registered trademark.

Under Article 38, anyone in possession of counterfeit goods is required to report the name and address of the person who sold them and the date on which they were acquired, the invoice, the

quantity of counterfeit units sold and to whom sold or he will otherwise be presumed to be an accomplice in the counterfeiting or fraudulent imitation.

Under Article 21 of Decree 6673/63 anyone is liable to punishment if:

- He manufactures or orders the manufacture of industrial goods with the characteristics protected by the registration of a model or design or copies thereof;
- knowing that it is unlawful, sells, places on sale, displays, imports, exports or in any other way markets the goods referred to above;
- with malice aforethought holds such goods or conceals the names of the manufacturers;
- with malice aforethought invokes a model or design, without registering it;
- sells as belonging to him plans for designs protected by registration by another person.

Under Articles 71 et seq. of Law 11,723, the following are offences:

- Publishing, selling or reproducing an unpublished or published work without the consent of the author or right holder;
- falsifying intellectual works;
- plagiarism;
- failure to observe the contract clause specifying the number of issues to be printed.

In addition, with regard to phonograms:

- The storage or display of unlawful copies and the importation of unlawful copies for distribution to the public.

Under Law 20,247 it is an offence to identify and sell seeds of cultivars where multiplication and marketing thereof have not been authorized by the owner of the cultivar.

22. Which public authorities are responsible for initiating criminal proceedings? Are they required to do this on their own initiative and/or in response to complaints?

With reference to patents and trademarks, criminal proceedings are a public matter and are initiated by the Department of Public Prosecutions.

With reference to industrial designs, criminal proceedings are brought by private individuals (Decree 6673/63, Article 23).

Court cases for breaches of copyright may be initiated ex officio or by complaint by the party concerned.

The Ministry of Agriculture, Livestock, Fisheries and Food (Seeds) is entitled and obliged to conduct investigations ex officio and on receipt of complaints and is the authority for applying penalties.

In addition, the Directorate General of Fair Trade is also competent to act ex officio in cases of infringements.

23. Do private persons have standing to initiate criminal proceedings and, if so, who?

The right holder.

24. Specify, by category of IPR and type of infringement where necessary, the penalties and other remedies that may be imposed:

- **Imprisonment;**
- **monetary fines;**
- **seizure, forfeiture and destruction of infringing goods and materials and implements for their production;**
- **other.**

In the case of patents, fraud is penalized with six months to three years' imprisonment and a fine (Patents Law, Article 75). Unlawful manufacture and marketing entail the same penalty (Article 76). Disclosure and usurpation of inventions that are not yet protected entails the same penalty increased by one third (Article 77).

Acts of usurpation under Article 78 entail a fine.

In the case of the Trademarks Law, offences under Article 31 entail three months to two years' imprisonment, in addition to a fine.

Similarly, Article 34 of Trademarks Law, establishes that the injured party, regardless of the legal channel chosen, may request:

- Forfeiture and sale of goods and other elements with an infringing trademark;
- destruction of the infringing trademarks and names and all elements bearing them if they cannot be separated.

As for industrial designs, offences under Article 21 of Decree 6673/63 entail a fine.

The penalties for infringements indicated in response to question 21 are:

- One month to six years' imprisonment;
- monetary fines (Law 11,723, Article 73 and 74);
- with respect to phonograms, confiscation, forfeiture (Law 11,723, Article 72 *bis*).

Orders may be issued for monetary fines, forfeiture of the goods or suspension of inclusion in the National Register of Commerce and Seeds Inspection.

25. Describe the provisions governing the length and any cost of proceedings. Provide any available data on the actual duration of proceedings and their cost, if any.

There are no provisions or data in this connection. The duration and cost of the case depend on the complexity of the evidence and the amount claimed.
