

PRESIDENCY OF THE REPUBLIC OF PARAGUAY MINISTRY OF INDUSTRY AND COMMERCE

Decree No. 22,365

THAT REGULATES TRADEMARK LAW No. 1,294/98

Asunción, August 14, 1998

REGARDING:

Trademark Law No. 1,294/98; and

CONSIDERING:

That Article 238, paragraph (3), of the National Constitution and Article 120 of the above mentioned Trademark Law No. 1,294/98, authorizes the Executive Power to regulate said law;

THEREFORE:

THE PRESIDENT OF THE REPUBLIC OF PARAGUAY

DECREES:

Article 1. Trademark Law No. 1,294, dated August 6, 1998, hereinafter referred to as “the Law”, is hereby regulated, in the following Chapters:

CHAPTER I APPLICATION ORGANS—POWERS

Article 2. The Office of Industrial Property [Dirección de la Propiedad Industrial], a department of the Ministry of Industry and Commerce, in accordance with the Law’s provisions, is the application organ charged with directing, organizing, executing and interpreting the provisions of said Law, within the administrative jurisdiction.

Article 3. In its capacity as a competent entity established by the Law, the Office of Industrial Property is empowered to dictate the necessary administrative Resolutions which shall facilitate the application of the Law and this Decree.

Article 4. The Office of the Legal Counsel of the Ministry of Industry and Commerce shall represent the Office of Industrial Property in litigious administrative-court cases.

CHAPTER II

Article 5. The text of the international classification of products and services for trademark registration, in accordance with the Agreement of Nice, which took effect on January 1, 1997, is hereby adopted.

CHAPTER III FRONTIER MEASURES

Article 6. The Office of Industrial Property, as the Law's application organ, in coordination with the National Council for the Protection of Intellectual Property Rights, may take action before the Republic's Customs Offices regarding the importation and exportation clearance of merchandise whose trademark is suspect of having been adulterated or falsified. Customs authorities shall allow access to the warehouses and documents related to merchandise alleged to have infringed the Law in order that they be verified. In addition, action before the pertinent courts of law may be brought if necessary.

CHAPTER IV PRESENTATIONS, FORMS

Article 7. The Office of Industrial Property shall make available a Book of Records, which may be electronic and in which shall be recorded all the applications filed to said Office. The Office of Industrial Property shall issue the respective receipts, which shall identify the issuing Section, in addition to, as a minimum, the number, date and time of the presentation. Said receipt may be issued by electronic means and in all cases shall be signed by the person in charge of the corresponding registration desk.

Article 8. Applications for registration of a trademark shall be in written form and shall include the information detailed in [Article 5](#) of the Law; to this effect, the respective forms shall be made available; the content, characteristics and requirements for their validity shall be established by the Office of Industrial Property via a Resolution.

Article 9. Trademark renewal applications shall fulfill the same requirements and formalities as the trademark application for registration application established in the present Decree, unless otherwise established by the Law.

Article 10. Any assignment, licensing, change of domicile, change of name, merger, and any other change in juridical form or modification or correction affecting the owner of a trademark shall be recorded in the corresponding Book of Records; upon request by an interested party, the Chief of the respective Section shall issue an appropriate certification.

Article 11. Any application for modification, reduction, limitation, or correction regarding the list of products or services, shall be presented in writing by the owner of a trademark to the Office of Industrial Property. Said Office shall order the recording of the application in the appropriate Book of Records.

Article 12. An application for registration of a license to use a trademark shall be presented in writing; the Office of Industrial Property shall make available the appropriate forms, whose content, characteristics and requirements for their validity shall be established by said Office via a Resolution.

Article 13. An application for registration of the assignment or transfer of a trademark, opposition to the registration of a trademark, registration of a collective trademark, and certification trademark, shall also be presented in writing, in forms made available by the Office of Industrial Property,

whose content, characteristics and requirements for their validity shall be established by said Office via a Resolution.

CHAPTER V PROCEDURES

Article 14. Any presentation to the Office of Industrial Property shall be received and note shall be taken of the order number, date and time or same. Regarding applications for registration and renewal, the requirements included in [Article 11](#) of the Law shall be fulfilled. In cases where the presentation does not fulfill the requirements mentioned in the Law, the Office of Industrial Property, through the competent Section, shall not accept incomplete applications until said requirements are fulfilled.

Article 15. Once the filing requirements have been fulfilled, the documents shall be sent to the Trademark Section, in order that they be examined for completeness. Once the documents have been approved, the application shall be published.

Article 16. After said publication and once the terms for the presentation of oppositions have expired without their being any oppositions, the Trademark Section shall examine the application regarding its content. This examination shall consist of a search for antecedents, after which written opinion about the feasibility of the registration requested shall be given. If there are no antecedents, the Director of the Office of Industrial Property shall grant the registration by means of a Resolution and the corresponding certificate shall be issued.

Article 17. If there exists a trademark which is identical or very similar to the one whose registration has been applied for, the Trademark Section may refuse to grant said registration by means of a resolution containing an explanation for said refusal, and a notification to the applicant, or it may submit an office action to the applicant before resolving the case. In cases where opposition to the registration has been filed within the term established in the Law, the Trademark Section shall send the files to the Litigious Matters Section in order that this Section take appropriate steps.

Article 18. The Office of Industrial Property shall make available a Records Book of Trademarks Granted, where the Resolutions regarding the granting of trademarks shall be recorded. The following data shall be included, as a minimum: order number; date of filing of the application and date of registration; name and domicile of the trademark owner; name of the trademark and description of same; and a list of products and services for which the trademark registration has been granted, together with an indication of its class. Said Records Book shall be signed by the Director General of the Office of Industrial Property and by the Secretary or other officials so assigned.

Article 19. A trademark registration certificate issued by the office of Industrial Property shall include the following information, as a minimum: number of registration; date of granting; date of expiry; mention of trademark; name of owner, together with his/her domicile; and class of products and services it protects. The Office of Industrial Property shall, via a Resolution, order the inclusion of other data or the attachment of a description and design of the trademark.

Article 20. Use of a trademark by a third party, with the consent of the owner of said trademark, or use by any person authorized by the owner to use a registered trademark, shall be construed as use by the owner.

Article 21. When a person files with the Office of Industrial Property a counterclaim requesting cancellation a trademark based on non-use of same, the petitioner shall have fifteen (15) business days to file a cancellation action in a court of law in accordance with the rules of the code of civil procedures. The Office of Industrial Property shall comply with the provisions of [Article 52](#) of the Law, within a term of twenty (20) business days. Once the files have been sent to a court of law in order that said cancellation action be judged, the Office of Industrial Property shall continue processing the case, using an attested copy of said files, which the Office of Industrial Property shall have retained for this purpose; said processing shall be carried out in accordance with provisions contained in the Law until the case is ready to be resolved, though the Office may not dictate a Resolution regarding the above mentioned request for cancellation until a final and definitive sentence of a court of law has been handed down.

Article 22. If the interested party has not filed a court action requesting cancellation within the term established in the preceding article, the Office of Industrial Property shall nullify the counterclaim regarding the non-use of the registered trademark and shall, upon request by the interested party, continue with the respective administrative procedure.

Article 23. The use of a trademark in any country shall be sufficient to comply with the provisions of [Chapter V](#) of the Trademark Law.

Article 24. The annual registration maintenance fee equivalent to five (5) minimum daily wages established in [Article 118](#) of the Law shall be paid only once and for only one year at the time the renewal of a registration of a trademark is granted.

Article 25. The five-year period mentioned in [Article 27](#) of the Law regarding Trademark registrations, granted under the Law previously in effect, shall be calculated beginning on the date the new Law is in force.

CHAPTER VI PRIORITY

Article 26. The right of priority may be invoked within the term of six (6) months established in the Paris Convention or in any other agreement or treaty that Paraguay should ratify. Said priority shall be invoked in the same application or in a subsequent statement, provided that said statement be presented within said term; it shall include the date and the country where it is presented.

Article 27. Within a term of three (3) months after the priority is invoked, the applicant shall file at the Director of the Office of Industrial Property a copy of the receipt of the application, certified by a pertinent administrative authority of the country where said application was filed.

Article 28. If the receipt mentioned in the preceding Article is not filed, the applicant shall lose his/her right of priority, and when an order of priority is in effect, said right shall be conveyed to the next applicant on the priority list.

CHAPTER VII PUBLICATIONS

Article 29. The Office of Industrial Property, whenever possible, shall publish an Official Gazette. The Office of Industrial Property is hereby empowered to determine the cost of said publication as well as the cost of each issue.

Article 30. All notices ordered by the Law shall be published in any of the periodicals of the capital of Paraguay that have an appropriate circulation or in specialized periodicals that attract the interest of professionals.

Article 31. A notice referring to a trademark request shall be published for a term of three consecutive days and shall include the name of the trademark and a design of same, if there is one; the number under which the application was recorded, and the date and time of same; the name and address of the applicant; the class or classes under which the trademark is being applied for; and an indication whether the application is for a trademark registration or for a renewal. The renewal application shall be published for one day only and the respective notice shall include the same information mentioned above in this same paragraph.

Article 32. Publications to a license to use a trademark shall be made for one day only and shall contain, as a minimum, the following information: identification of the licensor and licensee; their respective domiciles; the object of the license contract, with specific reference to a trademark licensed; an indication of whether the right to use the trademark is exclusive or not; the term of validity of the license to use; the quality control measures established; and the date of presentation and the number under which it has been recorded.

Article 33. Publications to the assignment or transfer of a trademark registration shall be made only for one day and the following information, as a minimum, shall be included: identification of the assignor and assignee; their respective domiciles; identification of the trademark and its respective registration number, respective date of same, class, date of presentation and number under which same was recorded.

CHAPTER VIII ABANDONMENT

Article 34. Regarding the calculation of terms in cases of abandonment of applications, the last act by an interested party shall be construed as such when it is an act performed to expedite a court action.

CHAPTER IX INDUSTRIAL PROPERTY AGENTS

Article 35. An Industrial Property Agent shall annually renew his/her registration before the Office of Industrial Property by March 31 and pay the legally established fees.

CHAPTER X TRANSITORY PROVISIONS

Article 36. Applications for registration or renewal of trademarks that are currently being processed shall comply with the procedural provisions contained in the previous Law, but said registration or renewal shall be granted in accordance with provisions of the Law now in force.

Article 37. The Minister of Industry and Commerce shall resolve, in accordance with the previous law: the cases that are at the Legal Counsel's Office awaiting an opinion or at said Minister's office awaiting a decision; the cases that have been appealed; and the Resolutions of the Office of Industrial Property dictated before Law No. 1,294 was sanctioned.

Article 38. The cases that were processed before the present Law was in force and reached the resolution stage, shall be sent from the Office of Industrial Property to the Litigious Matters Section in order that they be resolved.

Article 39. Litigious cases filed before the Law was in force and whose proceedings had been initiated, shall be continued until ready for sentencing, in accordance with the procedure established in the previous law. They shall subsequently be sent to the Litigious Cases Section for their final resolution.

Article 40. The present Decree shall be countersigned by the Minister of Industry and Commerce.

Article 41. May the present Decree be communicated, published and filed in the Official Registry.