

Mexico: Summary of recent amendments regarding trademark applications.

Since the recently enacted amendments to the Mexican Industrial Property Law (IPL)¹, there have been some discussions related to the applicability of some of its provisions. This is basically due to the fact that the Rules of Implementation have not been approved yet.

By virtue of the present communication, we would like to clarify some of the main amendments and their impact in your applications and registered trademarks.

Declarations of Real Use:

Probably the most controversial amendment included in the new IPL is the Use Requirement. As of August 10th, 2018, a declaration of real use is now required to be made within three months from the third anniversary of the trademark registration date. Otherwise, the trademark will be cancelled.

Pending final approval of the Rules of Implementation, a publication of the Institute of Industrial Property² states that this new provision only applies to trademarks / signs granted as of August 10th, 2018. Hence, it may be concluded that trademarks granted before August 10th, 2018 do not have to submit the declaration of real use on the third anniversary.

Obviously, trademarks filed after August 10th, 2018, are subject to this use requirement.

Specific Use Declaration at the time of Renewal:

Related to the use requirement, it is to be noted that as of August 10th when renewing any trademark, it is necessary for the trademark owner to clearly specify the particular goods / services for which the trademark is under current use. The generic use statement which was being required is no longer acceptable. Protection only to those goods/services on which the real used has been declared will remain.

It is important to mention that this declaration should be submitted by the holder's authorized representative with a local address or by a legal representative in Mexico. The local address is required for purposes of notification according to the Mexican IPL.

Trademark protection:

Holograms and non-visible signs are now eligible to obtain trademark protection. Regarding sounds and smells, they should be described in the application and a sample of the product can be voluntarily submitted by the applicant at the time of filing or during the prosecution if so requested by the Mexican Registry.

Also, a new definition of trademark is introduced including all signs perceptible by the senses and capable of being represented to clearly determine the object of the protection.

Certification trademarks:

This trademark is an indicator of quality of the products or services in question, whose owner is under the obligation to control its use and the obligation to impose sanctions in case this use is not in accordance with the provisions of its rules of use. This trademark can contain the name of a geographic area, when a given quality, is attributable to its geographical origin.

¹ http://dof.gob.mx/nota_detalle.php?codigo=5523102&fecha=18/05/2018

² <https://www.gob.mx/imp/ articulos/si-ya-iniciaste-un-tramite-o-estas-interesado-en-el-registro-de-una-marca-debes-saber-esto?idiom=es>. "Only trademark, collective trademark, commercial notification or trade name publication registrations granted as of August 10, 2018, must present the declaration of use."

Trade dress:

Having precedent on a 2015 thesis, this concept is now included in the Law and recognized as a sign subject to trademark registration.

Secondary meaning:

Those signs which originally could not be registered for being descriptive or of common use can obtain now trademark protection, provided they have acquired distinctiveness.

Consent and Co-Existence Agreements:

Letters of consent are now officially recognized under the amendments, thus giving an option to the parties to negotiate coexistence agreements too. Hence, it may be the case that closely similar trademarks in the name of different owners will now coexist by virtue of such inter partes agreements, although the possibility for a trademark owner to assign part of its trademark portfolio including a number of identical or closely similar trademarks to others not being the subject of the assignment, remains closed. Moreover, use of name, image or voice of a person can only be used with an expressed letter of consent.

Bad faith:

This concept is now included not only as a ground of post registration invalidation, but also as a ground of opposition.

Binding opposition:

A third party will have one month after the publication in the Gazette of the trademark application to file an opposition including the necessary evidence. The applicant could also submit any arguments and evidence he may consider appropriate against the opposition in a period of one month. Contrary to what occurred up to now, the Examiner must decide on the merits of the opposition as a parallel administrative procedure to the Trademark application and would not be considered as prejudged matter to the merits of the case (Article 120 BIS-3)³.

Notoriety and Well-known Trademarks:

The reputation of a trademark will be recognized considering the marketing activities whether in Mexico or abroad.

³ Article 120 BIS-3. Opposition to the registration or publication of an application will not suspend the process, nor will it prejudice the outcome of the substantive examination carried out by the Institute on the application. Article added DOF 18-05-2018.