

Mexico

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1. Legal framework

National

The national legislation governing trademarks is the Industrial Property Law, which is itself governed by the Industrial Property Regulations. These statutes' principal objects are:

- to establish the registration process and procedures for industrial property rights;
- to protect Mexican industrial property by regulating and granting, among other things, trademarks, commercial slogans, trade names and patents; and
- to prevent acts that violate industrial property rights by establishing sanctions and penalties against those acts.

International

Trademarks in Mexico are also protected under the following international agreements and conventions:

- the Paris Convention for the Protection of Industrial Property;
- the Hague Convention;
- the Vienna Agreement;
- the Nice Agreement;
- the North America Free Trade Agreement; and
- the Agreement on Trade-Related Aspects of Intellectual Property Rights.

2. Unregistered marks

Under applicable law, the registration of a mark shall not be effective against a third party which in good faith uses the same or a confusingly similar mark for the same or similar products or services, provided that the third party had begun to make uninterrupted use of the mark prior to the filing date of, or date of first use declared in, the application.

Moreover, the party that has been using an unregistered mark can challenge a trademark registration through a cancellation action based on prior use. Such party should apply for registration of the mark within three years of the day on which the registration was published; that party shall also previously apply for and obtain a declaration of cancellation of the said registration.

3. Registered marks

Anyone, whether an individual or an enterprise, may apply to register a trademark.

A trademark registration grants its holder the right to use the mark exclusively; such right runs from the time when the Mexican Trademark Office grants the registration, unless a date of first use has been claimed, in which case the exclusive right over a trademark will be considered since the date of first use claimed.

Moreover, under Mexican legislation the following documents are required in order to file a new trademark application:

- labels (if applicable), in electronic format;
- a certified copy of the priority document (if applicable); however, this document can be filed up to three months after the new application has been filed; and
- the rules governing the use, licence, transfer of rights, voluntary cancellation and voluntary limitation of goods or services, if the registration of a trademark is requested by two or more persons.

Powers of attorney are no longer compulsory for filing. However, such documents need to be executed since the Trademark Office (or another relevant authority) has the liberty to request at any point that a legal representative prove its credentials. There are two types of power of attorney:

- a simplified power of attorney, which has been executed in the presence of two witnesses and will serve to conclude the registration proceeding; and
- a formal power of attorney, which is duly certified and legalised and will serve to file any contentious action before the Trademark Office.

Further, Mexican legislation establishes which distinctive signs can be protected. They include word marks, device marks, composite marks, three-dimensional marks, commercial slogans, trade names and collective marks.

Marks that cannot be protected include:

- trademarks, figures or three-dimensional animated or changing forms that are depicted in motion, even when these forms

are all visible (this excludes, by definition, holograms, which contain both visible and invisible shapes, depending on the angle from which the hologram is seen);

- the technical or commonly used names of products or services for which protection is sought, as well as those words that everyday language or business practice has made into the usual or generic designations of the said products or services;
- three-dimensional shapes that are of public property or have come into common use, those that lack the originality that readily distinguishes them, and the usual and everyday shapes of products or those determined by their nature or industrial function;
- three-dimensional names, figures, shapes or words that, when their characteristics are considered as a whole, are descriptive of the products or services to which they are intended to afford trademark protection. The above shall include descriptive or indicative words that, in trade, serve to identify the kind, quality, quantity, composition, purpose, value or place of origin of the products, or the time of their production;
- isolated letters, digits or colours, except when they are combined with, or accompanied by, elements such as signs, designs or names that give them distinctive character;
- the translation into other languages, the arbitrarily changed spelling or the artificial construction of words not eligible for registration;
- signs that reproduce or imitate, without authorisation, the coats of arms, flags or emblems of any country, state, municipality or equivalent political division and the full or abbreviated names, symbols or emblems of governmental or non-governmental international organisations, or of any other officially recognised organisation, including the verbal designation thereof;
- signs that reproduce or imitate official signs or seals of control and warranty adopted by a state, without the authorisation of the competent authority, or coins, banknotes, commemorative coins or any domestic or foreign legal tender;
- signs that reproduce or imitate the names or graphical representations of decorations, medals or other prizes awarded at officially recognised exhibitions, fairs, congresses, or cultural or sporting events;
- proper or common geographical names and maps, as well as adjectives, names and nouns when they indicate the origin of the products or services and can cause confusion or error regarding such origin;
- the names of towns or places known for the manufacture of certain products, to protect those products, except the names of places in private ownership when they are special and not liable to be confused and when the consent of the owner has been obtained;
- the names, pseudonyms, signatures and portraits of persons, without the consent of the persons concerned or, if they are deceased, of their surviving spouse, blood relations in direct line or by adoption, as well as relations on either side, both down to the fourth level of relationship;
- the title of intellectual or artistic works and the titles of periodicals and other distributed publications, the names of fictional or symbolic characters or real personages portrayed, stage names and the names of performing groups, except where the owner of the corresponding rights has expressly authorised such registration;
- three-dimensional names, figures or shapes liable to deceive or mislead the public, understood as being those that constitute false indications as to the nature, components or qualities of the products or services that they claim to protect;
- three-dimensional names, figures or shapes identical or similar to a mark that the Trademark Office (or other relevant authority) considers well known in Mexico, to be applied to any product or service;
- a mark that is identical or confusingly similar to another in respect of which an application has been filed earlier and is awaiting registration, or to another that is already registered and in force, and is applied to the same or similar products or services, provided that a mark identical to one previously registered may be

registered if the application is made by the same owner for use in connection with similar products or services; and

- a mark that is identical or confusingly similar to a trade name applied to a firm or industrial, commercial or service establishment whose principal business is the manufacture or sale of the products or the provision of the services that the mark is intended to protect, provided that the trade name has been used prior to the filing date of the application for registration of the mark or the date of the declared use thereof; the foregoing shall not be applicable when the application for a mark is filed by the owner of the trade name, if no identical trade name exists that has been published.

4. Procedures

Examination, registration and opposition

The Mexican Trademark Office examines the inherent registrability of a trademark. Such examination comprises:

- a formal examination during which the Trademark Office considers, on one hand, whether the application complies with all the requirements established by the applicable law, and, on the other hand, whether the description of products and services is acceptable, and such goods and services were duly classified under the Nice Protocol; and
- a novelty examination during which the Trademark Office assesses whether the trademark requested for registration is prohibited by Mexican legislation – for example, the Trademark Office considers whether the sign subject to registration is descriptive of the products or services sought to be covered by the same, and whether the trademark sought to be registered is confusingly similar to a prior trademark registration or application.

While Mexican law does not provide for opposition procedures, any third party is authorised to file a writ opposing the registration of a trademark. However, the Trademark Office is not obliged to take into

account the statements asserted by the third party in the writ of opposition when making a decision concerning the registrability of a trademark application.

Timeframe: The Trademark Office takes between two and four months to issue any official action in a registration procedure (if applicable). If an official action is issued, the Trademark Office takes between four and six months from the date of filing of a response to such action to issue its final resolution. If no official action is issued, the Trademark Office takes between four and six months to issue a final resolution.

The Trademark Office takes between two and four months to issue any official action relating to any type of recordal procedure (ie, renewal, assignment, licence, merger, change of name, change of address). If an official action is issued the Trademark Office takes between four and six months from the date of filing of a response to such action to issue its final resolution. If no official action is issued, the Trademark Office takes between four and six months to issue a final resolution.

Removal from register

Nullity action: A nullity petition can be filed in the following circumstances:

- When a mark was granted in violation of the provisions of the law or that which was in force at the time of registration;
- When a mark is identical or confusingly similar to another that has been used in the country or abroad prior to the filing date of the application in respect of the registered mark, and that has been applied to the same or similar products or services;
- When a trademark registration was granted on the basis of particulars contained in the application that were false;
- When a trademark registration was granted in error, by mistake or owing to a difference of judgement, there being another registration in force that is considered infringed because it is identical or confusingly similar to the mark applied for and used for identical or similar services or products; and
- When the agent, representative, licensee or distributor of the owner of a mark registered abroad applies for and secures

the registration of the said mark or of a confusingly similar mark in its own name without the express consent of the owner of the foreign mark, in which case the registration shall be regarded as having been made in bad faith.

A nullity action takes between two and four years.

Lapsed registration/cancellation for non-use: A registration shall lapse in the following cases:

- When it is not renewed. Any trademark registration can be renewed six months before and six months after its expiration date; and
- Following a cancellation action for non-use. Such action may be started if the mark has not been used during the three years immediately prior to the request for a non-use cancellation action, except where there exist reasons for the non-use that are justified in the opinion of the Trademark Office. A cancellation action for non-use takes between two and four years.

A mark must be used in the national territory in the form in which it was registered or with only modifications that do not alter its distinctive character. Declarations of use are no longer compulsory. Nonetheless, such declarations should be filed every three years so that:

- any third party wishing to file a cancellation action for non-use may be persuaded that the mark is effectively in use, which would save the mark owner the time and cost involved in contesting such a cancellation action; and
- the mark owner be familiar with the concept of use in Mexico.

Cancellation: A registration may also be cancelled:

- *ex officio* by the Trademark Office or at the request of an interested party when an owner has caused or condoned the transformation of a registered mark into a generic name denoting one or more of the products or services for which it was registered in such a way that, in the

commercial circles and in the course of its generalised use by the public, the mark has lost its distinctive character as a means of distinguishing the product or service to which it is applied; and

- when the owner of the registered mark itself requests in writing, at any time, the cancellation of the registration.

Trademark searches

The following searches are available in Mexico:

- identical trademark searches;
- similar trademark searches;
- searches in particular classes;
- searches including slogans; and
- owner searches.

All of the aforesaid searches can be conducted through an IP agent or through the Trademark Office's website at marcanet.impi.gob.mx. The costs depend on the fees charged by the IP agent.

Searches for device marks must be requested at the Trademark Office. They cost \$10 in government fees, plus the fees charged by the IP agent to produce the corresponding report.

5. Enforcement

The main objectives of Mexican legislation concerning the violation of IP rights are to discontinue any infringing activity and to collect damages.

In order to enforce its rights, a trademark holder must be heard before the following authorities, in this order: the Trademark Office, the Federal Tribunal of Tax and Administrative Justice and the Federal Circuit Court.

All infringement actions are ruled by an administrative authority specialised in industrial property (ie, the Trademark Office) and the applicant can then request the payment of losses and damages before a civil court; these are quantified as at least 40% of the earnings generated by the infringer as a consequence of the infringement.

If a person uses the same or a confusingly similar registered trademark in good faith, the registration of such trademark shall not be enforceable against such person. Indeed, that

person has the right to apply for the registration of its mark within three years of the day on which the registration of the other mark was published, in which case that person shall previously apply for the cancellation of the said registration.

Conversely, if a person registers the same or a confusingly similar trademark in bad faith, the actual and legitimate owner of the IP right can request the cancellation of such registration in order for the registration to be considered as invalid. A cancellation action against a trademark registered in bad faith can be filed at any time.

Moreover, an IP rights holder can also file a lawsuit before a Prosecutor's Office (criminal) against a third party which has committed either of the following acts, both of which are classified as crimes:

- repeating an infringement action (ie, second offence); and
- counterfeiting trademarks.

The Trademark Office takes between four and five years to issue a final resolution in a trademark infringement procedure.

6. Ownership changes and rights transfers

All changes made concerning trademark registrations and/or applications must be registered before the Trademark Office to be effective against third parties.

The request for recordal of ownership changes and rights transfers may be filed by any interested party.

Applications shall be filed with the Trademark Office and comply with the following requirements:

- The applications must be duly signed;
- The application must be filed using the official printed forms approved by the Trademark Office, in the duly prescribed number of copies and annexes;
- Annexes shall be included, and they shall be legible and typewritten or printed;
- An address within the national territory shall be given for hearing and receiving notifications;
- The number of the application, registration, publication, statement or

record and the date of receipt referred to shall be mentioned;

- Proof of payment shall be included;
- The appropriate Spanish translation of documents written in other languages shall be included;
- Documents from abroad shall be authenticated where appropriate; and
- The application shall be accompanied by a certified and legalised copy of the document to be recorded or with the original document.

With regard to licence agreements, the request, in addition to meeting the above-mentioned requirements, shall specify:

- the names, designations or business styles, nationalities and addresses of the licensor and the licensee;
- the term of the agreement;
- whether the agreement accords the licensor or authorised user the right to bring legal action for the protection of the industrial property rights to which it relates; and
- the goods or services for which the licence is granted.

In addition, the application shall be accompanied by a copy, either certified or with handwritten signatures, of the agreement evidencing the licence or authorisation of use.

7. Related rights

The following figures may enjoy overlapping protection in Mexico:

- trademarks and reservation of rights (under copyright law);
- trademarks and industrial designs; and
- the titles of intellectual or artistic works and the titles of periodicals and other distributed publications, the names of fictional or symbolic characters or real personages portrayed, stage names and the names of performing groups, which can be registered as long as the owner of the corresponding copyright has expressly authorised such registration.

8. Online issues

The unauthorised use on the Internet of a registered trademark can be challenged through an administrative infringement action filed before the Trademark Office.

If a third party is using a registered trademark as its domain name without the mark owner's authorisation, an interested party can initiate a dispute procedure against such third party.

Mexico has set up a dispute resolution policy for the '.mx' country-code top-level domain. The policy, called the Local Dispute Resolution Policy, is a variation of the Uniform Domain Name Dispute Resolution Policy for generic top-level domains, but it features some particularities. The domain name disputes involving '.mx' domain names are ruled on by the Arbitration and Mediation Centre of the World Intellectual Property Organisation.

Unregistered rights Protection for unregistered rights?	✓
Specific/increased protection for well-known marks?	✓
Examination/registration Representative requires a power of attorney when filing? Legalised/notarised?	Not obligatory ✗
Examination for relative grounds for refusal based on earlier rights?	✓
Registrable unconventional marks	✗
Opposition Opposition procedure available? Term from publication?	✗
Removal from register Can a registration be removed for non-use? Term and start date?	3 years' non-use immediately prior to request for cancellation ✗
Are proceedings available to remove a mark that has become generic?	✓
Are proceedings available to remove a mark that was incorrectly registered?	✓
Enforcement Specialist IP/trademark court?	✓
Punitive damages available?	✓
Interim injunctions available? Time limit?	No time limit ✓
Ownership changes Is registration mandatory for assignment/licensing documents?	✓
Online issues National anti-cybersquatting provisions?	✓
National alternative dispute resolution policy for local ccTLD available?	LDRP ✓