by Daniel Sánchez and Víctor Ramírez

Trademark registration system

Trademarks in Mexico are regulated under the Industrial Property Law (IPL) and its regulations. In general, businesses, merchants, or service providers can use trademarks in industry, commerce or in the services they render (Article 87, IPL). The right to their exclusive use is obtained through their registration with the Mexican Institute of Industrial Property (IMPI). Any person or entity is entitled to apply for a trademark registration before the IMPI, and actual use is not required by the IPL.

All visible signs can be protected provided that they are sufficiently distinctive, and are able to identify the products or services to which they are applied, or are intended to be applied, from those in the same class (Article 89, IPL). Under this definition, olfactory and auditory trademarks cannot be protected.

However, three-dimensional signs can be protected as trademarks since these are visible signs. What cannot be protected as a trademark is set out in a rather long article (Article 90, IPL), which contains a list of general prohibitions and the only legal grounds for rejecting a trademark application.

In addition to the general, absolute and relative prohibitions provided in the IPL, in the case of brands related to medicinal products, Mexican trademark examiners have a special rule regarding registrability based on the Mexican Health Law (MHL): if a junior trademark application does not have at least a three-letter difference from a senior trademark registration, and is confusingly similar, the junior one will not be registered.

Even though the MHL is not binding for trademark matters as it is not included in the IPL, Mexican examiners use their discretion to apply it.

As well as this special criterion, when applying for a trademark registration, applicants must bear in mind that medicinal products fall into class 5, which includes many other types of goods that are unrelated, such as baby foods, disinfectants, fungicides and herbicides.

This should not be a problem as long as a junior trademark application is refused only if it is confusingly similar to a senior trademark registration and the goods sought to be protected are the same as, or related to, ones covered by the older trademark registration.

However, as mentioned above, actual use of a trademark in the Mexican market is not a requirement to apply for, or get, trademark protection, so in domestic practice any applicant may request the broadest protection possible— that is, all the products that are covered in a single class.

Therefore, when choosing a trademark in Mexico for a medicinal product, the applicant needs to make a careful and deep search, bearing in mind all the peculiarities of the Mexican system, to evaluate the possibilities of achieving trademark rights.

Obtaining a trademark registration does not, however, automatically mean that trademark owner is able actually to use the trademark on medicinal products. There is yet another process that involves a different authority, and has its own characteristics.

Health authorisation process

According to our legal system, the process to obtain marketing authorisation from the Federal Commission for Protection against Sanitary Risks (COFEPRIS) of the Mexican Health Authority for a medicinal product includes a review and approval for the pharmaceutical or drug name, referred to by our regulatory bodies as a 'distinctive name'. Failure to propose an acceptable name will result in a bar to obtaining marketing authorisation.

The specific requirements and rules regarding distinctive names are provided under the MHL and its regulations. The basic set of rules regarding the pharmaceutical or drug names is as follows:

- The term distinctive name will be understood as the name or trademark assigned by the laboratory or manufacturer to its pharmaceutical products, in order to distinguish it from other similar products, and prior approval of the health authority and registration with the competent authorities is required (Section IV, Article 2 MHL Regulations);

- Medications for use and marketing will be identified by their distinctive and generic names. Generic identification is required (Article 225 MHL);

- The distinctive name must not make clear, or unclear, reference to the composition of the medicinal product or its therapeutic action. No indications are permitted in relation to diseases, syndromes, symptoms, nor anatomical data or physiological phenomena, except for vaccines and biological products (Article 225 MHL);

- A proposed distinctive name can be rejected when it is confusingly similar to a prior authorised drug name, in which case the difference between the proposed and the prior drug name should be at least three letters in each word (Article 23 MHL Regulations);

- A distinctive name will also be rejected if the proposal is identical to a prior distinctive name of another drug with existing health registration (Article 23 MHL Regulations); and

- The same distinctive name should be used only in the case of different pharmaceutical forms or different doses with the same principal active ingredient and registered by the same laboratory (Article 23 MHL Regulations).

Although a legal definition of a distinctive name is provided under Section IV, Article 2 of the MHL Regulations—including that it is subject to the approval of the corresponding authorities— in practice, prior approval and registration with other relevant agencies, such as IMPI, is not required for the application and granting of the distinctive name before COFEPRIS. In fact, having a trademark registration for the distinctive name will not make any difference for the purposes of getting a marketing authorisation with that trademark.

COFEPRIS decisions regarding medicinal products are completely independent from what the IMPI may decide regarding distinctive names, which of course are trademarks according to the IPL.

Unfortunately, there is not yet a clear and specific link between the IPL, the MHL and the MHL regulations (the HLR) regarding conflicts between registered trademarks and marketing authorisations/distinctive names.

As mentioned, IMPI examiners usually take into consideration the 'three letters' rule when analysing the similarity of trademarks for pharmaceutical products, though this rule (provided by the HLR) is not binding for IMPI Examiners.

On the other hand, COFEPRIS is not bound by the HLR to consider senior trademark registrations (for pharmaceutical products) when analysing the similarity of distinctive names by means of their own tool: software developed to apply the three letters rule.

This situation causes undesirable scenarios such as contrary decisions issued by IMPI and COFEPRIS regarding the likelihood of confusion for the same trademarks and distinctive names.

Furthermore, IMPI and COFEPRIS have different databases. The IMPI database comprises all the trademark applications and registrations that have been filed with the agency or its predecessors. The COFEPRIS database contains only all the distinctive names allowed for medicinal products, regardless of whether the distinctive names are currently in use.

Marketing authorisations used to be granted for an unlimited period of time, until amendments in 2008 to the HLR.

Since those amendments came into force, marketing authorisations have been granted for renewable, five-year periods. Marketing authorisations granted before the amendments should have been renewed before February 2010. It is not yet clear whether COFEPRIS will remove the distinctive names for authorisations that have not been renewed. In this scenario, a trademark infringement could be triggered by companies that have a marketing authorisation but cannot achieve trademark rights because of the different criteria and the different databases used by the two agencies.

A third difference is found between IMPI and COFEPRIS when dealing with medicinal trademarks. During IMPI's procedure, the applicant may file arguments and request limitation of third party rights, whereas during the COFEPRIS procedure for marketing authorisation, the applicant will not know why its distinctive name has been rejected.

Due to this lack of clarity, from 2010, COFEPRIS has offered pharmaceutical companies the possibility of obtaining a pre-approval through its website. If a three-letter coincidence is detected, the proposed name will be rejected.

If the distinctive name is approved, the system will grant the user a certificate that will last for 90 days and can be used by the applicant for any marketing authorisation. The COFEPRIS system allows users to have up to 10 valid certificates for distinctive names that can be used by the company at any time while the certificates are valid. Once a certificate expires, the user is allowed to obtain new certificates.

However, these pre-approval certificates are not binding and COFEPRIS may still reject the distinctive name during the marketing authorisation procedure. Although a rejection of this type may be challenged before the courts, this almost never happens.

Mexico needs a trademark linkage system between COFEPRIS and IMPI. Some attempts to do it have been proposed to Congress in the past without success. The idea around these proposals is to require applicants to obtain a trademark registration from IMPI first, leaving COFEPRIS the authority to deny marketing authorisation when the proposed trademark indicates diseases, syndromes, symptoms, anatomical data or physiological phenomena.

In May 2012, the Mexican Senate gave notice that Mexico has joined the Madrid Protocol for trademark registration. The implications of this treaty are yet to be studied, but this change in the Mexican policy on trademarks could provide the momentum to implementing a trademark linkage system.

Source: Life Sciences Intellectual Property Review 2012