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# Protecting product packaging and trade dress in China: insights from the "Dandie Mint" case

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# New trademark rules under Mexico's Federal Law for the Protection of Industrial Property

Mariana Patiño of OLIVARES examines the new regulations implementing the Federal Law for the Protection of Industrial Property, highlighting how they provide greater clarity on filings, evidence, use requirements, coexistence agreements, and digital proceedings before IMPI.

Mariana Patiño

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The long-awaited Regulation of the Federal Law for the Protection of Industrial Property was published in the Official Gazette on April 28, 2026, only six years after the Federal Law for the Protection of Industrial Property ("LFPPI") entered into force. The Regulation develops several provisions already contemplated by the LFPPI and provides the procedural framework necessary for their implementation before the Mexican Institute of Industrial Property ("IMPI"). The Regulation entered into force on July 22, 2026, and introduces relevant guidelines on trademark prosecution, enforcement, portfolio management, and evidentiary standards in Mexico.

## Non-traditional and three-dimensional trademarks

One area in which the Regulation provides an important degree of certainty concerns the protection of non-traditional trademarks. The LFPPI has recognized a broad range of registrable signs, including sound, scent, motion, holographic, multimedia, and trade dress-type marks. Applicants and practitioners lacked specific guidance on how such signs should be represented and examined.

The Regulation now establishes a framework governing the representation of these trademarks. Applicants must provide a sufficiently clear and precise description of the sign together with any material or electronic media necessary for IMPI to identify the claimed subject

matter. Depending upon the nature of the mark, this may include sound recordings, audiovisual files, photographs, visual graphic representations, or any other medium capable of accurately depicting the sign.

Significantly, the Regulation expressly authorizes IMPI to require supplementary materials where the original representation is incomplete or insufficient to determine the scope of the sought protection. Likewise, where submitted electronic files are damaged, inaccessible, or password-protected, the Institute may require their replacement.

The Regulation further confirms that three-dimensional trademarks may consist of packaging, containers, wrappers, product shapes, or presentations, provided that the claimed configuration can function as a distinctive source identifier.

These provisions represent an important step toward the practical implementation of the expanded trademark categories introduced by the LFPPI and provide applicants with greater certainty regarding filing requirements and examination standards.

## Acquired distinctiveness (secondary meaning)

The Regulation also develops the evidentiary framework applicable to trademarks seeking protection based on acquired distinctiveness, commonly referred to as secondary meaning.

It provides that applicants must demonstrate that the relevant public recognizes the sign as identifying a particular commercial source as a result of prolonged and exclusive use in the marketplace. This recognition ought to be sufficient to overcome any lack of inherent distinctiveness.

The Regulation identifies several categories of evidence that may be submitted in support of such claims, including advertising and promotional materials, consumer surveys, market studies, sales records, market share information, digital presence, ranking on electronic platforms with indexed results, and other documentation capable of demonstrating public recognition of the trademark.

Special attention should be given to the requirement of exclusive use. Although the Regulation does not define the exact parameters of exclusivity, applicants will likely need to demonstrate that the consumers associate the sign with a single commercial origin. This requirement may present significant challenges in cases involving descriptive or highly diluted terms that multiple market participants may use.

The Regulation demands the quality and reliability of the evidence submitted. The Institute may require the applicant to provide any information deemed necessary to demonstrate that the trademark subject to the application has acquired distinctiveness in Mexico.

There is no doubt that acquired distinctiveness will likely remain one of the most evidence-intensive mechanisms available under trademark practice.

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## Letters of consent and coexistence agreements

For many years, coexistence agreements have constituted mechanisms for overcoming relative grounds of refusal and resolving disputes between trademark owners. However, neither the former law nor the LFPPI provided detailed criteria regarding the information that should be included in such agreements.

The Regulation now introduces a series of elements that IMPI may consider when evaluating coexistence agreements and letters of consent.

Among others, such agreements may address the commercial origin associated with each mark, restrictions concerning particular goods or services, limitations relating to specific markets or consumer sectors, and any additional measures intended to reduce the likelihood of consumer confusion or erroneous association.

While these provisions seek to provide a clearer framework for assessing coexistence arrangements, they have also generated debate among trademark practitioners and academics. It has been questioned whether IMPI's review of the coexistence measures proposed by the parties extends beyond its traditional role in cases involving letters of consent and coexistence agreements.

Letters of consent and coexistence agreements are, by nature, private arrangements through which the parties assume responsibility for managing any potential risk of confusion. Accordingly, it has been argued that IMPI should limit its review to verifying the existence and formal validity of the agreement, rather than assessing the practical effectiveness or commercial feasibility of the coexistence measures adopted by the parties.

Notably, the Regulation provides that the consent granted may only be invalidated through a court resolution. Whether IMPI adopts an interventionist or deferential approach remains to be seen. Future examination criteria and judicial review will determine the practical scope and impact of these new provisions.

## Expanded definition of economic group

The Regulation broadens the circumstances under which entities may be deemed to belong to the same economic group. In addition to direct ownership relationships, the Regulation recognizes situations involving direct or indirect control, including the ability to influence strategic, financial, operational, or administrative decisions, whether directly or through third parties.

The Regulation further establishes presumptions of control where a person or entity possesses a majority interest or a significant participation lacking countervailing influence, exercises management authority, or has the ability to appoint members of the board of directors or senior executives.

The expanded definition of economic group provides greater legal certainty when determining whether goods have been lawfully introduced into commerce by the trademark owner or a related entity. By recognizing modern forms of corporate control beyond direct ownership, the Regulation facilitates the identification of entities whose commercialization activities may be attributed to the trademark owner for purposes of applying the exhaustion of trademark rights. This clarification is particularly relevant for multinational corporate groups that distribute products through subsidiaries, affiliates, or other controlled entities.

## Classification of goods and services and the principle of specialty

The Regulation reaffirms the principle of specialty that underlies trademark protection.

Under this principle, trademark rights are limited to the goods and services covered by the registration, except in circumstances involving famous marks.

The Nice Classification remains the basis for classification in Mexico. However, the Regulation expressly recognizes IMPI's authority to issue administrative criteria governing the interpretation and application of the applicable edition of the International Classification.

As a practical matter, applicants should continue exercising caution when drafting specifications of goods and services. Broad descriptions that do not accurately reflect commercial reality may create enforcement difficulties and could ultimately diminish the strategic value of maintaining the registration.

> "Merely sporadic or apparent use would be insufficient to preserve trademark rights."

## Market studies and consumer surveys

The Regulation also introduces specific requirements applicable to market studies and consumer surveys submitted before IMPI.

Article 100 establishes minimum methodological standards for market studies and consumer surveys submitted before IMPI. Such studies must identify their objective, describe the methodology employed, define the characteristics of the sample population, present statistically meaningful results, and identify the individual or entity responsible for the study.

The Regulation also authorizes IMPI to require supporting statistical data and underlying documentation whenever it considers additional verification necessary.

These requirements are particularly relevant because survey evidence frequently plays a decisive role in proceedings involving well-known and famous trademarks. The new framework reflects a growing emphasis on evidentiary reliability and methodological transparency.

## Well-known trademarks

Article 101 clarifies that a declaration recognizing a trademark as well-known may be limited to specific classes. Accordingly, the corresponding resolution issued by IMPI must expressly identify the classes in which well-known status has been recognized.

From an evidentiary standpoint, trademark owners seeking recognition of well-known status should carefully evaluate whether the available evidence supports recognition in the specific classes and markets for which protection is sought.

## Definition and evidence of trademark use

Among the most practical changes introduced by the Regulation are those related to trademark use. Article 121 clarifies that trademark use must be genuine, effective, and consistent with ordinary commercial practices. Consequently, merely sporadic or apparent use would be insufficient to preserve trademark rights.

The Regulation recognizes various forms of admissible evidence to demonstrate trademark use, including sales records followed by a significant number of commercial transactions, consistent with the nature of the relevant goods or services; distribution documentation; storage inventory records intended for commercialization; marketing; and other materials capable of evidencing actual marketplace exploitation. It also expressly recognizes export-oriented commercial activity as a valid form of trademark use.

These clarifications are expected to have relevance in non-use cancellation proceedings, where the sufficiency of evidence often becomes the central issue in dispute. Accordingly, trademark owners should continue maintaining comprehensive documentation and records regarding the commercialization and distribution of their goods and services in Mexico.

## Digitalization, procedural flexibility, and alternative dispute resolution

The Regulation introduces several measures aimed at modernizing and streamlining industrial property proceedings before IMPI.

On the trademark prosecution side, applicants using elements associated with Indigenous or Afro-Mexican cultural heritage must submit the original certificate issued by the respective community authorities in accordance with the relevant legislation.

The Regulation also permits applicants without a physical establishment to designate a website as their legal establishment, provided they make the corresponding declaration under oath.

The Regulation further strengthens the digitalization efforts already contemplated under the LFPPI by establishing detailed rules for online administrative infringement proceedings. Articles 184 to 189 regulate electronic case files, the use of advanced electronic signatures, electronic filing of pleadings and evidence, notifications, all of which produce the same legal effects.

Another significant innovation is the introduction of a comprehensive framework for alternative dispute resolution mechanisms in administrative infringement proceedings. The new framework allows conciliation proceedings to be conducted either in person or through digital platforms, establishes governing principles such as voluntariness, confidentiality, good faith and party autonomy, and confirms that settlement agreements ratified by IMPI are binding on the parties and may acquire the effect of administrative res judicata once ratified by the competent authority. Together, these measures promote procedural efficiency, legal certainty and greater flexibility in the administration of industrial property rights.

## Remarks

The Regulation represents a significant milestone in implementing the trademark provisions introduced by the LFPPI. While it does not fundamentally alter the substantive principles governing trademark protection in Mexico, it provides the procedural and evidentiary framework necessary for the effective operation of concepts that have formed part of Mexican trademark law.

Its practical impact is therefore likely to extend well beyond trademark prosecution, influencing enforcement strategies, dispute resolution practices, and portfolio management for years to come.

> "Applicants using elements associated with Indigenous or Afro-Mexican cultural heritage must submit the original certificate issued by the respective community authorities in accordance with the relevant legislation."

RÉSUMÉ

**Mariana Patiño** joined OLIVARES in 2017 and is a member of the Trademarks team, advising clients in Mexico and abroad on trademark prosecution and industrial property matters. Her practice includes trademark clearance, registration, licensing, coexistence agreements, and international protection strategies for clients across the digital media, entertainment, hospitality, and consumer goods industries.

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