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Invalidity of Trademark Registrations Due to Contravention of Law: Demystifying Its Interpretation and Scope

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1. INTRODUCTION

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Background and Introduction

The exclusivity right that a trademark registration confers on its owner is not an absolute right; the legal system regulates various correction mechanisms built into the different stages of registration, ranging from the filing of a trademark application with its opposition system, to petitions for administrative declarations applied once the registration has been granted and during its term. This means that, although trademark rights are enforceable against third parties and owners have the power to exercise defensive actions for their protection, the law also regulates mechanisms allowing an interested party to challenge an already granted registration on the grounds of a failure to comply with principles established in the Federal Law for the Protection of Industrial Property (LFPPI) or in the law in force at the time of registration.

In particular, Mexican industrial property legislation provides, as one of its legality control mechanisms, the petition for an administrative declaration of invalidity of a trademark registration, an administrative proceeding contemplated as one of the four administrative declaration petitions under Article 328 of the LFPPI, within Title Six on Administrative Declaration Proceedings, Chapter I, which provides as follows:

Article 328.- *Petitions for administrative declarations of invalidity, lapse, cancellation, and infringement established by this Law shall be processed and resolved in accordance with the procedure set out in this Chapter and the formalities provided by this Law.*

The petition for an administrative declaration of nullity is a contentious administrative proceeding filed before the Mexican Institute of Industrial Property (IMPI), the purpose of which is to “eliminate the flawed right that, for various reasons, has defied the hypothesis for the formation of the right¹,” according to Mauricio Jalife Daher. In other words, the validity of a trademark registration is challenged on the grounds of an original defect that made its granting improper from the outset. For that reason, the authority, either on its own initiative or at the request of an interested party², must analyze the arguments raised and determine

¹Jalife Daher, Mauricio, *La nueva Ley Federal de Protección a la Propiedad Industrial*, 1st ed., Mexico, Tirant lo Blanch, 2020, p. 197.

²Art. 329, Federal Law for the Protection of Industrial Property. https://portalhcd.diputados.gob.mx/LeyesBiblio/pdf/LFPPI_010720.pdf (accessed: August 12, 2026).

whether, at the time it was granted, the registration complied with the regulatory framework then in force. Unlike non-use cancellation actions, which operates towards the future and penalizes non-use³, infringement, which examines conduct that violates industrial property rights⁴, or cancellation, which occurs when an owner allows its trademark to lose distinctiveness, nullity looks to the past, questioning the original legality of the grant.

Thus, if IMPI determines that it is appropriate to declare a trademark registration invalid, one of the main consequences will be that the challenged registration title will cease to have effect retroactively to its date of grant, that is, as if it had never been granted or entered into the legal world^{5,6}, because the defect predates the grant and constitutes an illegality that the authority failed to notice when examining the application.

The LFPPI does not provide for a single ground of nullity in its Article 258; rather, it sets out a catalog of six sections, each adapted to particular circumstances that may give rise to the nullity of a registration. Some refer to the existence of previously recognized third-party rights, others to false statements made by the applicant itself, and others, like the one discussed in this article, to a generic contravention of the applicable legal framework. Of all of them, Section I is the broadest and, for that reason, the most susceptible to differing interpretations, since it does not provide a *numerus clausus* list of applicable legal rules.

Background: Article 151 of the Industrial Property Law

Article 151, Section I, of the Industrial Property Law (LPI), provided as follows:

Article 151.- The registration of a trademark shall be invalid when:

³Art. 235, Federal Law for the Protection of Industrial Property.

https://portalhcd.diputados.gob.mx/LeyesBiblio/pdf/LFPPI_010720.pdf (accessed: August 12, 2026).

⁴Art. 386, Federal Law for the Protection of Industrial Property.

https://portalhcd.diputados.gob.mx/LeyesBiblio/pdf/LFPPI_010720.pdf (accessed: August 12, 2026).

⁵Art. 263, Federal Law for the Protection of Industrial Property.

https://portalhcd.diputados.gob.mx/LeyesBiblio/pdf/LFPPI_010720.pdf (accessed: August 12, 2026).

⁶Otero Muñoz, Ignacio and Ortiz Bahena, Miguel Ángel, *Propiedad Intelectual. Simetrías y Asimetrías entre el Derecho de Autor y la Propiedad Industrial. El Caso de México*, Mexico, Porrúa, 2011, p. 547.

I.- It was granted in contravention of the provisions of this Law or of the law in force at the time of its registration. Notwithstanding the provisions of this section, the nullity action may not be based on a challenge to the legal representation of the applicant for the trademark registration

[...]

The remaining five sections regulate invalidity for prior use, for false statements in the declaration of use, for being confusingly similar or identical to a prior, validly registered trademark, for registration made by an agent or distributor, and for bad faith. Section I, by contrast, is built on an open-ended hypothesis that, unlike the other sections, is not self-actualizing but is necessarily tied to the occurrence of, or non-compliance with, another legal provision. The only limitation established by Article 151 was that the ground for nullity could not be based on matters relating to the applicant's legal representation; outside that scenario, it could be interpreted that the invalidity of a registration could be sought on the basis of any provision of the Industrial Property Law.

The operability of Section I of Article 151 depended on a reference to the provisions establishing the substantive requirements and prohibitions for registration, in accordance with various precedents issued by the Supreme Court of Justice of the Nation (SCJN). First, Article 4 of the LPI, which prohibited granting any right regulated by the law when it contravened public policy or any legal provision; and Article 90, which set out a list of more than twenty absolute prohibitions on registration - such as registering a term in common use - and relative ones - a trademark confusingly similar to another already registered.

In that regard, Professor Efraín Olmedo Velázquez notes that “this section [...] makes it possible to correct acts that, under an analysis confined solely to trademark legislation, appeared viable or lawful, but whose validity may be called into question when examined in light of other rights within the Mexican legal, constitutional, or treaty-based system, allowing for the interaction and contrast of trademark rights with other rights and, with that, much more complex balancing than mere likelihood of confusion.”⁷

⁷Ortiz Bahena, Miguel Ángel and Estrada González, Itzel (coords.), *Ley Federal de Protección a la Propiedad Industrial comentada por AMPPI*, Mexico City, AMPPI-Tirant lo Blanch, 2022, p. 560.

The ground for nullity enshrined in Section I of Article 151 had a clear purpose compared to the other sections: it sought to regulate a control mechanism allowing for the invalidity of a registration on grounds raised in a rule that, at the time, should have prevented the grant of the registration, but that IMPI nevertheless failed to notice.

Current regulatory framework

Later, the entry into force of the LFPPI on November 5, 2020, did not alter the spirit of the provision transcribed above. However, the legislature introduced a textual change that, although it may seem insignificant at first glance, has generated enormous debate in its interpretation, since it entirely calls into question the scope of the exception to the provision, as can be seen below:

Article 258.- *The invalidity of a trademark registration shall be declared when:*

I.- It was granted in contravention of the provisions of this Law or of the law in force at the time of its registration.

Notwithstanding the provisions of this section, the invalidity action may not be based on a challenge to the legal representation of the person applying for the trademark registration, nor on procedures relating to its granting or validity;

As can be seen, Article 258, Section I, reproduces the prior ground almost verbatim, and Articles 12 and 173 replaced Articles 4 and 90 of the LPI, likewise with minimal modifications, retaining their function of setting out the relative and absolute prohibitions on trademark registrations.

The relevant difference lies in the last part of the second paragraph of the section. Previously, Article 151 excluded only the challenge to the applicant's legal representation; Article 258, Section I, adds a second exclusion: the action also excludes procedures relating to its granting or validity. This is a brief textual addition, but one with significant interpretive consequences, since it establishes an additional limitation that, not having been defined or clarified by the legislature, is highly ambiguous.

Now, in this particular reform, a later regulatory provision was also added seeking to clarify the scope of Section I, in Article 126 of the Regulations to the LFPPI, providing that “contravention of the provisions of this law” includes only the scenarios set out in Articles 12 and 173, Sections I through XVII and XIX through XXII, of the LFPPI itself. Thus, although the LFPPI proposes a broad provision regarding the application of the scenario in Section I, it is in the Regulations themselves that a limitation on its scope can be found.

Statement of the problem

From the foregoing, two questions arise that will be developed throughout this article. The first concerns the material scope of the expression “contravention of the provisions of this Law”: whether the SCJN precedents on the scope of Article 151 of the LPI apply to the current Article 258 of the LFPPI, and whether Article 126 of the Regulations merely implements the legal ground or, exceeding its function, restricts it in violation of the principles of legal reserve and normative hierarchy.

The second question concerns the exclusion added by the 2020 legislature regarding “procedures relating to its granting or validity.” It must be clarified whether this expression constitutes a simple broadening of the exclusion relating to the applicant's legal representation, or whether it refers to a different object - the acts and stages of the trademark application procedure itself - whose challenge would be expressly barred as a basis for the nullity action. Both questions, as will be shown in the sections that follow, directly affect the determination of the scope of effective protection that the Mexican legal system grants to trademark registrations against a nullity action.

The SCJN's criteria on the ground of invalidity for contravention of law: are they still applicable to Section I of Article 258 of the LFPPI?

In light of Article 258, Section I, of the Federal Law for the Protection of Industrial Property, the ground is set out for seeking the invalidity of registrations granted in contravention of the applicable provisions of the law itself, or of the law applicable at the time of the grant.⁸

⁸Article 258, Section I, Federal Law for the Protection of Industrial Property. <https://www.diputados.gob.mx/LeyesBiblio/pdf/LFPPI.pdf> (accessed: August 10, 2026).

It is of It is of interest to examine the scope of the criteria issued by the Supreme Court of Justice of the Nation with respect to Article 151, Section I, of the repealed Industrial Property Law, a provision that constitutes the immediate precedent of this study's subject, Article 258, Section I, of the LFPPI.

In particular, through the isolated precedent 1a. CCXLVIII/2016 (10a.), titled "INDUSTRIAL PROPERTY. ARTICLE 151, SECTION I, OF THE RELEVANT LAW, DOES NOT VIOLATE THE PRINCIPLES OF LEGALITY AND LEGAL CERTAINTY,"⁹, the First Chamber of the SCJN held that the ground for invalidity at issue could rest on non-compliance with obligations set out not only in the statute itself, the Industrial Property Law, but also in regulatory provisions or other administrative rules linked to it, provided there is a logical and reasonable connection between those provisions and that their content provides a sufficient degree of legal certainty.

Likewise, it was considered constitutional for the legislature to resort to a broad regulatory clause. In the Court's view, this legislative technique allows the authority a margin of discretion that favors effective protection of industrial property rights, provided that the exercise of its powers is subject to the requirements of competence and adequate legal grounds and reasoning.

From this criterion it follows that the Supreme Court recognized the constitutionality of a ground for invalidity formulated in broad terms, acknowledging that the contravention could derive both from provisions contained in the statute and from regulatory or administrative rules that develop, complement, or make operative industrial property rules.

Based on the First Chamber's criterion (thesis 1a. CCXLVIII/2016), when reference is made to "regulations derived from those laws or other administrative rules rationally linked to the legal regime of industrial property," we highlight the relevance of provisions such as international treaties on industrial property, the Regulations to the Federal Law for the Protection of Industrial Property, administrative agreements issued by the IMPI that develop procedural aspects expressly provided for in the law or the Regulations, as well as the supplementary application of the Federal Administrative Procedure Law.

⁹Thesis 1a. CCXLVIII/2016, INDUSTRIAL PROPERTY. ARTICLE 151, SECTION I, OF THE RELEVANT LAW, DOES NOT VIOLATE THE PRINCIPLES OF LEGALITY AND LEGAL CERTAINTY, *Semanario Judicial de la Federación*, Tenth Era, November 2016, <https://sjf2.scjn.gob.mx/detalle/tesis/2012975> (accessed: August 4, 2026).

Years later, the Second Chamber of the SCJN addressed the constitutionality of Article 151, Section I, of the Industrial Property Law again in isolated precedent 2a. VII/2021 (10a.), titled “TRADEMARKS. ARTICLE 151, SECTION I, IN RELATION TO THE LAST PARAGRAPH, OF THE INDUSTRIAL PROPERTY LAW (TEXT IN FORCE PRIOR TO THE REFORM OF MAY 18, 2018), BY PROVIDING THAT THE NULLITY ACTION MAY BE EXERCISED AT ANY TIME WHEN IT INVOLVES A TRADEMARK REGISTRATION GRANTED IN CONTRAVENTION OF THE PROVISIONS OF THAT LAW OR OF THE LAW IN FORCE AT THE TIME OF ITS REGISTRATION, VIOLATES THE PRINCIPLE OF LEGAL CERTAINTY.”¹⁰

This precedent emphasized that the fact that the action does not lapse, with respect to any contravention of the law, violated the principle of legal certainty set out in Article 16 of the Mexican Constitution.

It was likewise held that owners of trademark registrations would lack legal certainty regarding the stability of their rights, since those rights would remain indefinitely exposed to any third party bringing a nullity action based on an alleged legal contravention. This would create a permanent state of uncertainty over granted registrations, contrary to the legislature's intent to improve the industrial property system.

It should be noted that this second criterion did not question the constitutional validity of the ground for nullity based on contravention of law, but only the possibility that the action could be brought without any time limitation. Consequently, the discussion of the concept of “contravention of law” remained unaddressed.

From the criteria mentioned above, questions arise regarding the interpretation and scope of the current Article 258, Section I, of the LFPPI. It is necessary to determine whether the reasoning developed by the Supreme Court with respect to Article 151, Section I, of the repealed Industrial Property Law continues to apply to the current Article 258, Section I, of the LFPPI.

¹⁰Thesis 2a. VII/2021, TRADEMARKS. ARTICLE 151, SECTION I, IN RELATION TO THE LAST PARAGRAPH, OF THE INDUSTRIAL PROPERTY LAW (TEXT IN FORCE PRIOR TO THE REFORM OF MAY 18, 2018), BY PROVIDING THAT THE NULLITY ACTION MAY BE EXERCISED AT ANY TIME, WHEN IT INVOLVES A TRADEMARK REGISTRATION GRANTED IN CONTRAVENTION OF THE PROVISIONS OF THAT LAW OR OF THE LAW IN FORCE AT THE TIME OF ITS REGISTRATION, VIOLATES THE PRINCIPLE OF LEGAL CERTAINTY, *Semanario Judicial de la Federación*, Eleventh Era, May 2021, <https://sjf2.scjn.gob.mx/detalle/tesis/2023145> (accessed: August 4, 2026).

In this regard, the review Amparo 962/2021¹¹ provides greater clarity regarding the criteria the responsible authority should take into account when analyzing the viability of a nullity action for contravention of legal provisions, as well as its constitutionality.

The criterion holds that the examination is limited to assessing the legal and conceptual elements of the trademark sign and its use in commerce, which limits the authority's discretionary power, since it must confine itself to analyzing the substantive aspects of the registration procedure, that is, the requirements and conditions for registration related to Articles 12 and 173 of the Federal Law for the Protection of Industrial Property, analogous to former Articles 4 and 90 of the Industrial Property Law.

In this sense, we can observe that both the repealed rule and the current one retain essential elements for the grant of a trademark registration. Thus, the provisions contained in Article 4 of the repealed LPI and Article 12 of the LFPPI are matters of public interest, since they establish a limitation on the grant of the legal figures and institutions provided for when their content or form is contrary to public policy or violates any legal provision.

For its part, Article 90 of the LPI and its analog, Article 173 of the LFPPI, set out the catalog of specific prohibitions applicable to trademark registration. Together, these provisions make up the framework of impediments to granting the right to exclusive use of a trademark.

Regarding the constitutionality of the fact that the action does not lapse, the SCJN concluded that this has valid justification, since the illegality in granting a registration is not cured by the passage of time.

It was likewise held that the provision does not become unconstitutional despite not specifically identifying the contraventions of law on the basis of which the authority could declare nullity. This is because the discretion granted to the authority, together with the dynamism of trademark law, are essential elements for addressing situations that the legislature cannot foresee with absolute precision.

¹¹Amparo under Review 962/2021, Plenary of the Supreme Court of Justice of the Nation, January 29, 2024. https://www2.scjn.gob.mx/juridica/engroses/3/2021/10/3_280828_6724_firmado.pdf (accessed: August 8, 2026).

This circumstance takes on special significance when we consider that distinctive signs develop in a constantly evolving commercial environment, which requires an assessment of the particularities of each specific case. For that reason, it is not reasonable to demand an exhaustive list of all the legal contraventions that could give rise to the nullity of a trademark registration under Section I, since it is not possible to anticipate every future situation or all the regulatory provisions that might apply.

At this point, the reader might wonder whether the recently enacted Regulations to the LFPPI contain any provision clarifying the scope of this ground. In this regard, Article 126 clarifies that contravention of the Law occurs when the registration falls under one of the impediments provided for in Articles 12 and 173, Sections I through XVII and XIX through XXII, of the LFPPI, or in the equivalent provisions of the legislation applicable at the time it was granted. It is worth examining the concept of the regulatory function as a source of law.

Under Mexican administrative doctrine, regulations are intended to ensure the exact observance of laws, that is, to facilitate their proper compliance; they are therefore an integral part of the legislative provisions they regulate.

It has been held that, in the absence of an administrative law, there is no room for a regulatory function. The regulation is subordinate to the law and, under no circumstances, may it prevail over the law itself.¹²

The foregoing reflects both the principle of normative hierarchy and that of legal reserve. The former requires that every regulatory provision remain subordinate to the law and may not contradict it or prevail over it. The latter, legal reservation, means that it is for the legislature to define the essential elements of legal institutions and the scenarios that give rise to rights, obligations, or legal consequences, such that the regulation may only develop and implement the legal provisions necessary for their execution. Consequently, the regulation power finds its limit in the law itself: it may not create new law, nor expand, restrict, or modify the scope established by the legislature.¹³

¹²Serra Rojas, Andrés, "Derecho Administrativo. Doctrina, Legislación y Jurisprudencia," vol. I, 8th ed., Editorial Porrúa, Mexico, chap. V, "La Facultad Reglamentaria," p. 187.

¹³Thesis P./J. 30/2007, REGULATORY POWER. ITS LIMITS. Semanario Judicial de la Federación, Ninth Era, May 2007. <https://sjf2.scjn.gob.mx/detalle/tesis/172521> (accessed: August 12, 2026).

Constitutionality of Article 126 of the Regulations to the LFPPI

The real debate is just beginning. The inevitable question is whether the Regulations simply interpret and clarify the scope of the ground, or whether, on the contrary, they end up restricting it to an extent not intended by the legislature. This question is especially relevant because it places us within one of the classic topics of administrative law: the limits of regulatory power in relation to the content of the law. It is precisely on this point that the debate over the constitutionality of Article 126 arises.

In this regard, opinions are not uniform. One view would hold that Article 126 of the Regulations constitutes a valid regulatory clarification of the ground for nullity provided for in the Law. Another view would hold that this provision improperly narrows the scope of a legal scenario deliberately drafted in broad terms. After all, the Law already refers generally to registrations granted in contravention of its provisions, or of the legislation in force at the time of the grant, whereas the Regulations appear to limit that scenario to a specific catalog of impediments. The constitutionality of this limitation ultimately depends on determining whether the Regulations merely develop the content of the Law or introduce a restriction that exceeds the regulatory power.

Thus, in order to objectively determine whether Article 126 of the Regulation contains a limiting provision, contrary to the principles of statutory reservation and hierarchical subordination, it is first necessary to analyze the scope of the articles to which it refers, particularly Article 12, which establishes the following:

Article 12.- *No patent, registration, or authorization shall be granted, nor shall publication in the Official Gazette be made, for any of the legal figures or institutions regulated by this Law, when their content or form is contrary to public order or contravenes any legal provision.*¹⁴

From the transcribed norm, it follows that Article 12 of the law provides a considerably broad framework by establishing that any registration may be denied when its "content or form contravenes any legal provision," in contrast to Article 173, which provides specific grounds - of both an absolute and relative nature - by which a prohibition on registration is triggered.

¹⁴Art. 12, Federal Law for the Protection of Industrial Property (<https://www.diputados.gob.mx/LeyesBiblio/pdf/LFPPI>) (Date accessed: August 12, 2026)

Therefore, it can be concluded that the Regulation does not actually represent a limitation on the scope of Section I of Article 258; rather, by incorporating a formula as broad as "any legal provision," the Regulation itself ends up clarifying the question of which regulatory provisions are capable of giving rise to trademark nullity due to contravention of law. Thus, far from imposing a limitation on the cause of action, Article 126 recognizes the breadth of Article 12 in order to incorporate it as one of the grounds for nullity due to contravention of law, without unconstitutionally contradicting the legal framework already established by the legislator.

Now then, it is important to note that the determination that Article 126 of the RLFPPI respects the principles of hierarchical superiority and statutory reservation rests purely on the fact that Article 12 is extremely broad. However, if the legislator or the Higher Courts were ever to limit the scope of the phrase "any legal provision," or even define what the phrase "content or form" means, then the unconstitutionality of the article in question could indeed be triggered, since we would then have a regulatory provision that, instead of detailing or explaining the operation of a law, establishes restrictions that were not originally established by the Congress of the Union, thereby violating the principles of statutory reservation, normative hierarchy, and legality.

Unless and until the foregoing occurs, it is reasonable to conclude that the breadth of the provision in question was drafted precisely in such a way as to allow for a broad and flexible interpretive margin; therefore, as long as no express limits are placed on that scope, the provision must be understood according to the breadth with which it was originally framed. In other words, where the law does not distinguish, there is no reason to distinguish.

Scenarios of Contravention to the Law Other Than Those Provided for in Articles 12 and 173 of the LFPPI

Based on the foregoing, it is worth assessing whether there can be scenarios of invalidity based on contravention of law other than the impediments provided for in Articles 12 and 173 of the LFPPI. It is worth analyzing whether a registration could have been granted in contravention of other provisions outside the defined perimeter of those articles. It is precisely within these possible scenarios that it can be seen most clearly whether the regulatory text merely interprets and develops the ground provided for in the Law or, on the contrary, ends up reducing its scope.

An interesting example is found in the specificity principle applicable to the description of the goods or services covered by a trademark application. In this regard, Article 176 of the LFPPI requires that trademarks be registered with respect to specific goods or services determined in accordance with the classification and rules established by the Regulations.

Article 94 of the Regulations establishes that only descriptions that specifically identify goods or services will be acceptable, including descriptions contained in class headings, provided the terms used are those set out in the International (Nice) Classification or in the supplementary lists published by the Institute.

Suppose, then, that a trademark registration was granted for a broad or generic description, in apparent non-compliance with the specificity requirement set out in Article 176 of the LFPPI. At first glance, one might assume that the scenarios contemplated in Article 126 of the Regulations limit the possibility of bringing a nullity action for contravention of law.

However, a careful reading shows that this provision refers not only to the impediments set out in Article 173 of the Law, but also to Article 12, which prohibits the granting of any registration whose content or form is contrary to public policy or contravenes any legal provision.

It is precisely this reference to Article 12 that allows us to sustain a broad interpretation of the expression “contravene any legal provision.” If that provision is interpreted in its natural, broad sense, it could be argued that a failure to comply with Article 176 also falls within the ground for nullity under Section I, even though that article is not expressly mentioned either in the Law or in Article 126 of the Regulations. Under this view, the reference to Article 12 would make it possible to encompass not only registration-prohibition impediments, but other legal provisions as well.

The discussion is not entirely settled: is the limitation in the regulatory text merely cosmetic, or a real restriction? While a broad interpretation would lead to admitting the propriety of nullity for any non-compliance related to the content or form of the registration under Article 12 of the Law, a more restrictive interpretation could hold that the Regulations intended to narrow a ground that was deliberately formulated in broad terms.

Now, it should be noted that, on this particular point, through an isolated thesis, the Ninth Era of the Federal Courts of Administrative Affairs determined that the nullity of a registration does not apply when it is alleged that the examiner of the Mexican Institute of Industrial Property granted a trademark registration despite the description of goods or services not being sufficiently specific, on the grounds that this constitutes "a mere interpretive discrepancy unrelated to the legal grounds for nullity, to the detriment of the legal certainty of the registration holder."¹⁵

Another example can arise during the registration procedure, where IMPI fails to properly notify an opposition that a third party filed within the deadline and in compliance with the legal requirements. As a result of that omission, a registration ends up being granted that, had the opposition been processed as it should have been, should not have been granted, because the trademark was confusingly similar to another already registered mark. In this situation, under the criterion IMPI currently applies, it would not be possible to resort to the nullity ground under Section I of Article 258, since it would consider this a matter of "procedures relating to the granting" of the registration. However, excluding this type of case from the merits analysis of nullity, solely because the problem arose "during processing," would run counter to the text of that ground.

Analysis of Section I of Article 258 with Respect to the Phrase "Procedures Relating to Its Granting or Validity"

Under the repealed Industrial Property Law, Article 151, Section I, established as a ground for nullity of a trademark registration that it had been granted in contravention of the provisions of the Law or of the law in force at the time of registration, specifying only that the nullity action could not be based on a challenge to the applicant's legal representation. The literal text was as follows:

Article 151.- *The registration of a trademark shall be null when: I.- It was granted in contravention of the provisions of this Law or of the law in force at the time of its registration. Notwithstanding the provisions of this section, the nullity action may not be based on a challenge to the legal representation of the applicant for the trademark registration.*¹⁶

¹⁵Thesis: IX-CASE-PI-17, NULLITY OF TRADEMARK REGISTRATION. IT DOES NOT ARISE WHEN THE ALLEGED DEFECT STEMS FROM AN ASSESSMENT BY THE REGISTRATION AUTHORITY AND NOT FROM A CONTRAVENTION OF LAW, R.T.F.J.A., Ninth Era, year V, no. 50, April 2026, p. 274.

¹⁶Art. 151, Industrial Property Law (accessed: August 12, 2026).

With the entry into force of the Federal Law for the Protection of Industrial Property (LFPPI), that ground was relocated to Article 258, Section I, essentially retaining its content but incorporating an additional phrase at the end of the second paragraph. The text currently in force provides:

Article 258.- The nullity of a trademark registration shall be declared when:

I.- It was granted in contravention of the provisions of this Law or of the law in force at the time of its registration. Notwithstanding the provisions of this section, the nullity action may not be based on a challenge to the legal representation of the person applying for the trademark registration, nor on procedures relating to its granting or validity.¹⁷

As can be seen by comparing both texts, the reform did not modify the main legal premise, contravention of the Law as a ground for nullity, but rather specified, or at least intended to specify, the exception applicable to that ground. The question to be resolved, then, is not whether an additional exception exists, but what object that exception refers to: the power of attorney or legal representation, or the trademark registration itself.

To properly understand the scope of Section I of Article 258, it is essential to turn to Article 12 of the Law itself, which constitutes the substantive standard to which Article 126 of its Regulations refers. That provision states:

Article 12.- *No patent, registration, or authorization shall be granted, nor shall publication be made in the Gazette, for any of the legal figures or institutions regulated by this Law, when their content or form is contrary to public policy or contravenes any legal provision.*¹⁸

Article 126.- *For purposes of the provisions of Section I of Article 258 of the Law, a registration shall be understood to have been granted in contravention of the provisions of this Law, or of the law in force at the time of registration, when it falls under one of the impediments provided for in Articles 12 and 173, Sections I through XVII and XIX through XXII, of the referenced Law, or their equivalent under the law in force at the time it was granted.*¹⁹

¹⁷Art. 258, Federal Law for the Protection of Industrial Property (accessed: August 12, 2026).

¹⁸Art. 12, Federal Law for the Protection of Industrial Property (accessed: August 12, 2026).

¹⁹Art. 126, Regulations to the Federal Law for the Protection of Industrial Property (accessed: August 12, 2026).

Reading these provisions reveals an express normative distinction between two elements that can render a legal figure unlawful: its content (that is, subject matter, object, or purpose of the act) and its form (that is, the procedure through which that act is externalized and perfected).

The legislature did not distinguish between the two for purposes of their legal consequences; therefore, both content and form are equally capable of giving rise to a legal contravention sufficient to nullify a registration.

In this regard, the second paragraph of Section I of Article 258 literally states that “the nullity action may not be based on a challenge to the legal representation of the person applying for the trademark registration, nor on procedures relating to its granting or validity.”

Under this reading, the exception provided in the second paragraph must be understood to mean that the invalidity action may not be based on a challenge to: (i) the legal representation of the registration's applicant or owner, and (ii) the procedures relating to the granting or validity of that legal representation (that is, of the power of attorney), such as its legalization, apostille, formalization before a notary, or recording.

Under this interpretation, the legislature at no point referred to procedures relating to the granting or validity of the trademark registration itself.

Otherwise, if the LFPPI provided as an exception to the ground for invalidity that the claim be based on matters relating to the registration-granting procedure, including controversies going to the merits of the matter, such as oppositions or prior-right citations, that ground would become meaningless in practice. This is because trademark nullity penalizes defects that exist during the registration procedure and that predate the grant of a trademark, such as the existence of a prior trademark registration that is confusingly similar and covers identical or similar goods or services, as regulated in Section IV of Article 258. Therefore, interpreting the phrase “nor on procedures relating to its granting or validity” broadly, as if it covered any controversy arising during the registration procedure, whether procedural or substantive, would strip the ground for nullity of content, contradicting its original purpose.

In addition to the foregoing, it is likewise senseless to adopt a broad interpretation of the exception under analysis with respect to the portion referring to procedures relating to its validity, since **validity** is a matter unrelated to the nullity of a trademark registration.

First, it must be clarified that trademark “validity” may refer to two things: (i) the renewal of a trademark registration, or (ii) the filing of the declaration of use for registrations granted after August 10, 2018. Given this, it follows that the validity of a trademark registration is in no way related to the petition for an administrative declaration of nullity, since, if a trademark is not renewed or the declaration of use is not filed, it will automatically cease to have effect by operation of law, without any need for a third party to challenge the registration's validity through an invalidity action. Therefore, when the legislature referred to procedures relating to “validity,” it clearly was not referring to the validity of a trademark registration, but to the validity of the legal representation of the party filing the trademark application.

It is thus quite evident that this reading is the only one compatible with the historically recognized ratio legis of the provision, whose direct antecedent (Article 151, Section I, of the repealed Industrial Property Law) had the sole purpose of preventing third parties from seeking to invalidate a trademark registration through the late or abusive challenge of formal defects in the power of attorney granted by the applicant, a situation that has nothing to do with the substantive legality of the registration granted.

The addition of the phrase “nor on procedures relating to its granting or validity” was not intended to create a new exception regarding the registration, but to reinforce and clarify the already-existing exception regarding the power of attorney, closing off its application to scenarios or arguments that, without directly challenging the legal representation itself, sought to do so indirectly through defects in the procedures used to prove that power.

Current IMPI Criteria on Its Interpretation

Under the criterion IMPI has been applying in practice, the propriety of the ground for invalidity provided for in Section I of Article 258 is conditioned on the alleged contravention not arising from acts, omissions, or administrative determinations proper to the registration-processing procedure, but exclusively from the nature, content, or legal effects of the registration already granted. Under this reasoning, IMPI considers itself legally barred from analyzing grounds for nullity based on a challenge to the applicant's legal representation, including defects, insufficiencies, or objections regarding powers of attorney, the authorized representative's powers, or the formal validity of powers of attorney and their proof during processing (which is correct), but also, in addition, with respect to procedures relating to the granting or validity of the registration, including notifications made by the authority, calculation of deadlines, timely or untimely responses to requirements, determinations regarding the abandonment of applications, and, in general, any administrative action taken during the processing of the file (all of which is entirely incorrect).

If accepted, the interpretation IMPI maintains, under which the phrase “its granting or validity” refers to the trademark registration, would lead to the interpretive absurdity that Section I of Article 258 would exclude from nullity precisely all the irregularities that occurred during the registration procedure, which is the only avenue through which a legal contravention can materialize at the time the registration is granted.

Such is the case in file P.C. 2396/2024(N-633)27452, in which, as background, it was alleged that the trademark applicant failed to respond to an office action citing a prior right within the four-month legal deadline, resulting in the automatic abandonment of the application. Despite this, the legal representative filed an untimely response months later, concealing the true notification date and presenting a manipulated acknowledgment of receipt bearing the file number of a different case, in order to make it appear that the response had been timely. IMPI, deceived by this maneuver, “revived” the already-abandoned file and granted the trademark registration.

A petition for an administrative declaration of invalidity was filed against that registration, seeking, among other things, the invalidity of the registration for contravention of law, since the registration had been granted to a trademark whose application had already been abandoned, having failed to file a response within the legal deadline. However, despite the existence of a clear defect that occurred prior to the grant of the challenged registration, IMPI ruled that, because it was a matter relating to the processing of the registration's grant, the trademark registration could not be nullified, on the theory that the exception in the second paragraph of Section I of Article 258 applied.

As another example, if during the registration procedure IMPI failed to properly notify an opposition timely and properly filed by a third party, and that resulted in the grant of a registration that, had the opposition been properly processed, would not have been granted because the sign was confusingly similar to a previously registered trademark, in that case, under the Institute's current criterion, the path to nullity under Section I of Article 258 would be closed, on the theory that this involves "procedures relating to the granting" of the registration. In other words, excluding this scenario from the merits analysis of nullity, solely because it occurred "during processing," is entirely contrary to the text and spirit of the law.

Conclusions

Under a correct legal interpretation, exception rules, that is, those that restrict or except the application of a general rule, must be interpreted strictly and narrowly, and never expansively or by analogy, to the detriment of the party seeking to exercise the right recognized by the general rule.

In the matter at hand, the general rule is the propriety of invalidity for contravention of the Law (first paragraph of Section I); the exception is the impropriety of nullity based on a challenge to legal representation (second paragraph).

IMPI, by extending that exception to the entire universe of administrative actions taken in the registration procedure, is not interpreting the rule: it is rewriting it, expanding its scope beyond what the legislature established, in violation of the pro actione principle, as well as the guarantees of legal certainty and access to justice.

The Regulations to the Federal Law for the Protection of Industrial Property themselves confirm that the ground for invalidity under Section I must be linked to the substantive impediments to registrability. Consider the following:

Article 126.- *For purposes of the provisions of Section I of Article 258 of the Law, a registration shall be understood to have been granted in contravention of the provisions of this Law, or of the law in force at the time of registration, when it falls under one of the impediments provided for in Articles 12 and 173, Sections I through XVII and XIX through XXII, of the referenced Law, or their equivalent under the law in force at the time it was granted.*²⁰

First, it expressly refers to Article 12 of the Law, which distinguishes between content and form as elements equally capable of giving rise to a legal contravention, without excluding the form of the registration procedure. Second, by limiting the ground to the impediments in Articles 12 and 173, the Regulations themselves demonstrate that the object of control is the legality of the registration granted (in both its substantive and procedural aspects), and not merely its substantive content in isolation from the procedure that gave rise to it.

Article 16 of the Mexican Constitution requires that every act of authority be duly and sufficiently grounded and reasoned, meaning there must be a precise correspondence between the reasons cited by the authority and the rules it invokes as applicable, such that, in the specific case, the corresponding legal hypothesis is actually satisfied.

In turn, the case law of the Federal Judiciary has distinguished between a lack of legal grounds and reasoning (a formal defect) and improper legal grounds and reasoning (a substantive defect), holding that the latter occurs when the authority invokes a legal provision that is inapplicable to the specific situation, or when the reasons given do not match the content of the rule being applied.^{21,22}

²⁰Art. 126, Regulations to the Federal Law for the Protection of Industrial Property (accessed: August 12, 2026).

²¹Thesis I.3o.C. J/47, GROUNDS AND REASONING. THE DIFFERENCE BETWEEN THE LACK AND THE IMPROPER SATISFACTION OF BOTH CONSTITUTIONAL REQUIREMENTS AFFECTS THE ORDER IN WHICH THE GROUNDS FOR CHALLENGE MUST BE EXAMINED AND THE EFFECTS OF A FAVORABLE RULING. *Semanario Judicial de la Federación*, Ninth Era, <https://sjf2.scjn.gob.mx/detalle/tesis/170307> (accessed: August 12, 2026).

²²Thesis 260. GROUNDS AND REASONING. *Semanario Judicial de la Federación*, Seventh Era, <https://sjf2.scjn.gob.mx/detalle/tesis/394216> (accessed: August 12, 2026).

Applying this standard to IMPI's criterion, it is clear that the Institute incurs precisely in a substantive defect, since it invokes the second paragraph of Section I of Article 258 as grounds to summarily dismiss grounds for nullity based on procedural irregularities, when that provision (properly applied) does not contemplate such a ground for dismissal. There is, accordingly, a lack of correspondence between the rule invoked and the situation to which it is applied, and therefore improper reasoning.

Additionally, IMPI's criterion also violates the principle of legal certainty, since it introduces an exception not provided for in the legal hypothesis. In this regard, legal certainty requires that individuals clearly know the scenarios in which they may exercise their rights and what the limits of those rights are. When IMPI discretionarily extends the scope of an exception provided for by law, the certainty as to how the rule will be applied is undermined, leaving individuals exposed to interpretations that do not follow from its text, and consequently leaving them defenseless.²³

Moreover, by foreclosing the possibility of examining, on the merits, grounds for nullity based on irregularities in the registration procedure that resulted in a legal contravention, IMPI's criterion also affects the right to effective judicial protection and the principle of legality.

In this regard, the amendments to the Regulations to the LFPPI concerning Article 126 are especially illustrative, as they narrow and clarify the scenarios in which the ground under Section I applies. By linking this ground for nullity to Articles 12 and 173 of the Law, it is clear that it is not enough to review the registration in isolation, since the procedure through which it was granted must also be taken into account.

²³Thesis 2a./J. 106/2017 (10a.). FUNDAMENTAL RIGHTS OF LEGALITY AND LEGAL CERTAINTY. THEIR VIOLATION CANNOT ARISE FROM THE DIFFERENT REGULATION OF TWO ESSENTIALLY DIFFERENT LEGAL SCENARIOS. *Semanario Judicial de la Federación*, Tenth Era, <https://sjf2.scjn.gob.mx/detalle/tesis/2014864> (accessed: August 12, 2026).

In summary, we can draw two conclusions of considerable importance:

First, that the second paragraph of Section I of Article 258 of the LFPPI, correctly interpreted in light of the provision's legislative background, excludes from the nullity action only a challenge to the applicant's legal representation and to the procedures relating to the granting or validity of that representation (the power of attorney), but NOT to procedures relating to the granting or validity of the trademark registration itself; a contrary interpretation could be unconstitutional. IMPI's current criterion, by extending that exception to every irregularity occurring during the registration procedure, engages in an expansive interpretation of an exception rule and contravenes both Article 126 of the Regulations to the LFPPI and Article 12 of the Law itself, which expressly recognize that both the content and the form of a legal institution may give rise to its nullity for contravention of law.

The application of IMPI's criterion violates the guarantees of proper legal grounds and reasoning, legal certainty, effective access to justice, effective judicial protection, and the principle of legality, by introducing grounds for dismissal not provided for by the legislature. If this criterion continues to be applied, the ground for nullity provided for in Section I of Article 258 would, in practice, be left without any possible scenarios for application, and would therefore be rendered entirely meaningless.

Second, that although the Regulations to the LFPPI “limits,” in a certain sense, the scope of the contravention-of-law scenario provided for in Section I of Article 258, that limitation is not unconstitutional for violating the principles of legal reservation or normative hierarchy, since Article 12 of the LFPPI itself, to which the Regulations' article refers, contains a sufficiently broad clause to allow for the application of multiple regulatory provisions within the framework it refers to, establishing “any legal provision.” To that extent, Article 126 does not introduce a restriction foreign to the legislature's intent, nor does it limit interested parties from filing a trademark nullity action based on Section I, since its application is not limited solely to the scenarios in Article 173, but operates within the scope the Law itself had already established.

It could only be argued that there is an unconstitutionality with respect to the provision of the Regulation if Article 12 itself, to which it refers, established significant limits on which provisions are actually applicable or what should be understood by "content or form." However, as long as that clause maintains a broad scope, Article 126 merely reflects the breadth of Section I of Article 258, without restricting it, and therefore it cannot validly be maintained that the Regulation exceeds the limits of the regulatory authority.

In summary, it is proposed that IMPI's criterion be reviewed and reconsidered in order to restore to the ground for nullity provided for in Section I of Article 258 of the Federal Law for the Protection of Industrial Property its true scope as a mechanism for controlling the formal and substantive legality of trademark registrations.

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