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THE DEFINITION OF 'TRADEMARK' IN MEXICAN LAW IS RESTRICTED TO SIGNS THAT CAN BE PERCEIVED VISUALLY. IN PRACTICE, THE TRADEMARK OFFICE NARROWS THIS DEFINITION FURTHER – FOR INSTANCE, BY NOT GRANTING REGISTRATION TO COLOURS UNLESS THEY ARE COMBINED WITH OTHER DISTINCTIVE ELEMENTS

Words, letters and numbers have long been registered as trademarks around the world. In contrast, the registrability of sounds, colours, shapes, textures or smells is still debated in a number of jurisdictions. The discussion often hinges on whether such signs can distinguish the products or services of one company from those of others.

From a doctrinal point of view, a trademark represents something else (ie, an indication of origin) and, consequently, there is no doubt that sounds, colours, shapes, textures or smells, which are perceived by various senses – most of them other than sight – can be distinctive. To hold otherwise would imply that the public is incapable of distinguishing one product or service from another by using senses other than sight.

However, not all products are capable of being identified through non-visual senses. It may be possible to prove that certain products have a distinctive smell or taste, but what happens if these products are not in perfect condition and their smell or taste has deteriorated, or if their smell or flavour cannot be directly appreciated because doing so would require the product to be unwrapped?

These and other practical considerations, such as the graphical representation of such marks, are the main obstacles to recognition of many non-traditional signs as trademarks in various countries.

BACKGROUND

Article 88 of the Mexican Law of Industrial Property provides that “a trademark is any visible sign capable of distinguishing products or services from others of the same type or category on the market”.

Article 89 narrows this definition by providing that only visible words, names and designs, as well as three-dimensional forms, can constitute trademarks in Mexico and, consequently, can be registered. Does this mean that non-traditional trademarks are not protectable in Mexico?

To answer this question, we must first define ‘non-traditional trademarks’.

These are:

- colours or combination of colours applied to products or to the packaging in which they are sold (for services, colours applied to the visual appearance, external or internal, of a store or restaurant);
- three-dimensional shapes of products, their container, a label or a tag;
- motion marks (ie, a series of images);
- sounds, such as jingles or pieces of music;
- smells;
- tastes; and
- textures.

From this list, only signs that are distinctive and can be perceived visually can be protected through a registration granted by the Mexican Trademark Office (TO).

COLOURS

Under Mexican law, single colours are not registrable, “unless they are combined or accompanied by elements such as symbols, designs or denominations that give them a distinctive character”. This means that, theoretically, a combination of two or more colours can be subject to trademark protection and registration, regardless of the form or surface to which they are applied.

However, the TO practice has been not to grant protection to a combination of colours if it is not part of a design or logo – which is contrary to Supreme Court case law.

THREE-DIMENSIONAL SHAPES

Article 89 of the Law of Industrial Property expressly mentions three-dimensional signs as elements that can constitute trademarks and be registered with the TO. However, the provision also imposes the following limitations:

- The three-dimensional signs may not be in the public domain.
- The three-dimensional signs may not have fallen into common use.
- The three-dimensional signs may not lack sufficient originality to be easily distinguished.
- The three-dimensional signs may not consist of the shape of products or a shape imposed by the goods' nature or industrial function.

Unfortunately, under current TO practice it is very difficult not to fall into one of these categories. Any suspicion that the sign applied for is a common shape for the relevant products will trigger an objection based on the mark's descriptiveness and lack of distinctiveness.

The good news is that the Federal Court of Tax and Administrative Affairs (FCTAA), which hears all appeals against TO decisions, has issued a number of resolutions that reversed objections issued by the TO with regard to the registrability of threedimensional signs. Further, the author expects that the creation of the Specialized IP Court within the FCTAA, which started operating in January 2009, will result in an increase in the number of decisions granting registration to three-dimensional shapes. This in turn should force the TO to change its practice with regard to threedimensional marks.

MOTION MARKS

In contrast, motion marks are not only unprotected under Mexican law; they are also expressly considered as signs that cannot constitute trademarks. Article 90(1) of the Law of Industrial Property provides that morphing names, figures or forms shall not be registered as trademarks, regardless of whether they are visible.

OTHER SIGNS

As for the other types of mark listed above, none can be registered as trademarks in Mexico. However, this does not mean that they are left completely unprotected. For instance, sound marks consisting of musical pieces may be eligible for protection under copyright law. Although not all sound marks will comply with the requirements for musical works, Article 13 of the Federal Copyright Law protects musical works (with or without words) which, by analogy, can be considered artistic works. Thus, it appears that as long as a sound mark is of a similar nature to a musical work – that is, it consists of a harmonic composition and can be reproduced identically each time it is performed – such sound may obtain copyright protection. However, the decision as to whether this premise applies to a sound mark lies with the Mexican Copyright Office.

Smells, tastes and textures do not meet the requirement of being visible signs. Thus, one can assume that they, along with other non-traditional marks which do not comply with the requirements established by the Law of Industrial Property in order to be registered by the TO, do not enjoy full and consistent protection in Mexico.

However, Article 213(IX) of the Law of Industrial Property provides that an administrative infringement has occurred when a party commits, in exercising an industrial or commercial activity, acts which deceive or induce the public to confusion, error or deceit, leading them to believe or assume without foundation that:

- there is a relationship or association between an establishment and a third party;
- the products are manufactured under specification, licences or authorization of a third party;
- the services are rendered or products are sold under authorization, licences or specifications of a third party; or
- the product in question originates from a territory, region or location other than the true place of origin, in such manner as it induces the public into error in respect of the geographical origin of the product.

This implies that to obtain a favourable ruling on the use of a non-traditional mark that is not recognized and protected under the Law of Industrial Property, a plaintiff should file evidence which proves that:

- consumers identify its goods or services from the sound, smell, taste or texture at issue; and
- the unauthorized use of such sign constitutes an act of unfair competition and consequently should be stopped, even though the sign is not registered as a trademark.

However, to date there has been no cases – whether pending or decided – involving these types of mark.

CONCLUSION

Mexican trademark law grants protection to non-traditional trademarks if they are distinctive, visible signs. This applies to colours – if combined with other distinctive elements – and three-dimensional forms, as long as they are not the common shape of the product to which they apply. Sound marks may be protected under copyright law, provided that they can be considered musical works. Smells, tastes and textures, as well as any other distinctive signs that are not protected under trademark law, cannot be registered as trademarks. However, administrative infringement actions can be initiated against any unauthorized use of these signs.

Finally, an amendment to the Law of Industrial Property to include, among other things, the recognition of non-traditional trademarks such as sound, texture, olfactory and motion marks was introduced into Congress recently. While Congress did not approve the changes and the proposed amendments failed to define or regulate non-traditional marks (which would have left their recognition to subjective interpretation), the proposals opened the door to future changes on this important issue. Non-traditional trademarks are used increasingly often to distinguish products and services in the marketplace. Accordingly, as modern marketing strategies continue to evolve, trademark protection in Mexico will have to adapt. **WTR**

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