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The Mexican Industrial Property system, and therefore the legal bodies ruling it, have been amended several times in recent years. One of these amendments relates to the adoption of different systems for the classification of goods and services.

This adoption of different classification systems in recent years has led to some risks to older registrations due to the reclassification of goods and services, and the different criteria held by the Mexican Institute of Industrial Property officials who are in charge of interpreting and applying the laws.

CHANGES TO CLASSIFICATION

The former law, the Law of Inventions and Trade Marks effective as of February 11 1976, established a classification system according to Mexican standards; that is, there was a national classification of goods and services, which was different to the Nice classification. Article 101 of the Law of Inventions and Trade Marks read as follows:

In the application for a trade mark registration, as well as in its description, the products and services to be protected should be specified. Anyhow, the applicant may file for all the products and services on one class. When dealing with unclassified products or services, these should be always specified.

At the time, this was understood as the right to file trade mark applications protecting the whole scope of a certain class, unless the products or services were unclassified according to the national classification system.

On February 20 1981, the issuance of new Regulations to the above-identified law took place, with classification consisting of 75 classes — 55 for products and 20 for services. This classification was quite specific as to the products or services protected, and it was understood that the whole heading of the class

would cover all kinds of products or services falling under its scope. The relevant parts of Article 56 of the Regulations of the Law of Inventions and Trade Marks read as follows:

In an application for a trade mark registration, as well as in its description, it should be indicated the products and services to be protected according to the following classification:

Class 1.- ...

Class 75. ...

The application of the above mentioned classification will be supplemented by a sub-class catalogue and lists of goods and services. Such a catalogue may be modified by the Secretary (authority) with criteria to be in line with national and international requirements of information in this area.

In 1988, the mentioned Regulations were abrogated and the new Regulations established that the classification of goods would be according to WIPO's classification. Nonetheless, it was also established that as long as this classification was not published in the Oficial Gazette, the prior classification would be used. This new classification was never published. Article 79 of the Regulations read as follows:

The classification of goods and services would be done according to the classification of the same to be approved by the World International Property Organization. The Direction (Authority) would publish in the Inventions and Trade Marks Gazette, such classification, and if applicable, the modifications thereto, for the knowledge of the general public.

In 1991, the current law was issued, abrogating the Law of Inventions and Trade Marks. At the time this new law was named the Law of Development and Protection of Industrial Property. However, this new law adopted the classification contained in the Regulations to the abrogated Law of Inventions and Trade Marks — that is, keeping the 75 classes of goods and services, indicating that this situation would remain while new Regulations were to be issued.

By 1994, the Law of Development and Protection of Industrial Property suffered several amendments changing its name to the current one: Industrial Property Law. Its regulations, issued on November 24 1994, established that our country would follow the international classification system. However, Mexico had not yet officially adopted the Nice Agreement.

It was not until September 10 2002 that Mexico ratified the Nice Agreement and

therefore adopted its corresponding classification system.

PROBLEMS ARISING FROM THE CHANGES

All these changes implied that several trade marks needed to be reclassified once they were due for renewal. However, the differences between classification systems imposed the complex problem of how to classify the goods and services according to the newest classification. This was true because some of the goods and services protected in the old registrations necessarily felt under the scope of different classes of the new classification.

As a general rule, the Mexican Law does not authorize the existence of multi-class trade mark registrations; that is, a trade mark application should comprise only goods or services pertaining to a specific class.

In order to avoid an improper reclassification, the Mexican authorities decided to issue an official action establishing general rules as to the classes of the internacional classification where the products and services covered by a trade mark registration, obtained under the Law of Inventions and Trade Marks, should be reclassified when renewed. In this way, a trade mark previously registered in only one national class could now fall in two or more classes of the international classification system.

For example, an old trade mark registration covering the entire heading of the former National Class 19, namely "Vehicles (except their motors)", according to the Mexican Institute of Industrial Property criteria, should have been reclassified, when renewed, in the following International classes: "6: Metal shields for vehicles, metal fittings for vehicles, springs for vehicles", "12: Vehicles, apparatus for locomotion by land, air or water" and "22: Awnings for vehicles".

The current problem that we are facing is that some of those trade marks that were reclassified then, and now cover specific goods or services of two or more classes, could not be necessarily protecting the precise products or services for which they are applied in the practice.

Therefore, their registrations may be subject to a cancellation action brought by a third interested party, on account of non-use. This is the case because their owners would not always be able to prove use of the goods as indicated in the

reclassification.
Indeed, sometimes the reclassification did not indicate the products or services that are being manufactured, sold or rendered with the corresponding trade mark. Moreover, in a very rigid and literal interpretation of the provisions of our Industrial Property Law, a trade mark covering the entire heading of a particular class should not cover those products not included or contemplated in the description or in the generality of the same.
In other words, under this interpretation, if a trade mark registration now covering the entire heading of a particular class is actually applied to specific products that, although pertaining to the same class, are not included in its description or in its generality, the registration might be challenged on account of non-use.
It is important to point out that pursuant to section four of the transitory articles of the Industrial Property Law, the registered trade marks prior to the entry into force of this law, which in their initial applications have claimed an entire class, upon renewal shall specify the products or services according to the classification established by the regulation of this Law.
According to this provision, by the time a registration was renewed, it was mandatory to specify the products to which the same was actually applied. Otherwise, the registration of interest may be contestable on account of nonuse, as the registrant would not always be able to prove use of its mark to cover the specific products for which it was registered.
In addition, article 93 of the Industrial Property Law states that trade marks shall be registered in relation to well-defined products and services depending on the classification set forth in the Regulations of this Law, which provides that the products or services included in the alphabetic list of the classification shall be considered as species and that the list of such goods or services pertaining to a particular class does not exhaust it. Article 93 of the current Industrial Property Law reads:
The trade marks will be registered in relation to products or services determined according to the classification established by the regulations to this law.
Any doubt regarding the class in which a product or service should be classified, would be finally decided by the Institute (Authority).
With the above in mind, again in a rather rigid and literal interpretation of the above-indicated article, it is feasible to conclude that there are more products or services than those described in the heading of a class and that trade marks

in Mexico should only be protected in connection with defined goods or services.
Moreover, from the provisions of our law it may also be concluded that a trade mark covering the entire heading of a class should only cover those products or services comprised in its description or those that can be included as a part of the description.

POSSIBLE SOLUTION

In view of the above, it would be advisable for trade mark owners in Mexico to ensure that a trade mark application specifically cover the products or services to which it is or will be applied. In other words, it is not always enough to obtain protection of a trade mark for the whole heading of the class. When applicable, protection should also be obtained for the specific goods or services of interest nor included in the description of the class nor in the generality of the same.
The current criteria of the Mexican Institute of Industrial Property in this regard is broader than the one explained above. That is, once a litigation arises, they admit as evidence of use any proof regarding a specific product or service. This is the case even if the example is not included in the heading of a particular class, as long as it falls under the scope of that class. It is true, though, that an eventual incorporation of new officers may result in a change in this criteria, with the adoption of a more restricted one, that might be in line with the legal grounds that govern classification issues.
The other possible solution to avoid this type of risk in the future is to have the Industrial Property Law and its regulations duly amended, for either of the following purposes:
1) To clarify that specific products should be indicated in an application, abandoning the practice of only indicating the heading of the class; or
2) To indicate specifically that notwithstanding that a specific product or service is not covered by the heading of a class, it should always fall under the scope of the same, if it pertains to that class. However, the negative impact of this possible alternative may result in several trade mark conflicts concerning marks of the same class.
Source: Managing Intellectual Property Magazine, Mexico Special Focus 2004.