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The Mexican Industrial Property Law (LIP) protects trade marks, services marks, collective marks, slogans, trade names and appellations of origin, on an exclusive basis, if sufficiently distinctive, and if duly registered with the Mexican Industrial Property Institute (IMPI).

The LIP defines marks as "every visible sign that distinguishes products or services from others of the same kind or class in the market". Denominations and designs, among other symbols, may be registrable. The requirement is that the sign can be perceived though the eyes.

Besides denominations and designs, the LIP grants protection to other less traditional marks as well as the following.

ISOLATED SYMBOLS THAT ARE COMBINED

Under the LIP, letters, digits or colours that are isolated shall not be registrable *"unless they are combined*or accompanied by elements such as symbols, designs or denominations that give them a distinctive character" (emphasis added). From the literal interpretation of that provision, it can be concluded that a combination of two or more "isolated" colours can be subject to trade mark protection and registration, regardless of the form or surface on which they are applied. And the form can be the shape of the capsule of a pharmaceutical product, for example, on which the combination of colour is applied.

Notwithstanding the above, there are no reported cases addressing the issue of whether the combination of colours can be registered. The trend at the Trade Mark Office has been not to grant protection for a combination of colours if they are not part of a design, logo, or the like. However, that criterion is against Supreme Court decisions as it was the case of a mark consisting of the combination of three colours, which were applied on the sides of a denim textile

product. Here the Trade Mark Office refused registration, and the Supreme Court reversed that decision as it "produced a visual impression which was capable of functioning as a trade mark". More recent Supreme Court decisions continue the same trend. In addition, commentators as Professor David Rangel Medina also favour trade mark protection for a combination of colours. All that authority must definitively supersede the wrong interpretation of the Trade Mark Office.

TRADE MARKS THAT MAY BE PROTECTED UNDER CERTAIN CONDITIONS

GEOGRAPHIC MARKS

Names of geographic sites and places, including countries, regions, cities, towns and other population centers and administrative districts, famous business, industrial, commercial and amusement places and buildings are registrable in accordance with Mexican law if they are not indicative of the source of origin of the products and services generating confusion or error in respect to such an origin. They are also registrable if the country, city, population center or place is not noted for the manufacture of products identified by the mark. This also applies for marks consisting of gentle names, maps and even the names of rivers, lakes, seas, mountains and other natural landscapes which are not normally regarded as places where the kind of products to which the mark is affixed are produced, made, extracted or grown. Names of privately owned places are also registrable when they are special and leave no room for confusion, provided that the owner consents thereto.
On the contrary, geographic names will not be registrable if they are likely to produce confusion as to the origin of the product or service or if they indicate such an origin or "describe" it as is said in other countries.
Following the above-cited rules the courts have found HAMILTON as a protectable mark for watches, COLUMBIA for glasses, FRANCO AMERICAN for food products, PANAMA for carbon paper; TAPATIA (female from the city of Guadalajara in the state of Jalisco, Mexico) for threads and stamen, TULSA for tools, and MANHATTAN for clothing products.

SURNAMES

A person's name is composed in Mexico by the given and family names, including both the father and mother's family names. This is reflected in the legal treatment of surnames and makes a difference from protection given in other countries. Names of persons, including surnames as such, have been traditionally protected in accordance to Mexican Trade mark Law. Article 89 (IV) of LPPIP the Law for the Promotion and Protection of Industrial Property of 1991 (in 1994 the name was changed to the Law on Industrial Property) considered individual names to be registrable provided there were no homonyms already registered as a mark.
This restrictive legal view was somewhat upgraded in the amendments of 1994. Now surnames will he protected as long as they are not likely to confuse with an existing registered mark. Additionally, the Law states that names, pseudonyms, signatures and portraits of persons, shall not be registrable as marks if no authorization is given by the interested person, or, in his or her absence or incapacity, by the husband, wife and other members of the family (these are expressly mentioned in the same provision). Finally, a registered mark will not produce effects if it relates to the name of a person which is then applied as a mark on products or services, as long as this latter person applies the name in the form that is regularly used by that person and which is clearly distinguished from the homonym that is registered with the Trade Mark Office.

NON-TRADITIONAL MARKS

TITLES AND CHARACTERS

The Law on Industrial Property (LIP) establishes that titles of intellectual or artistic works, titles of periodical publications, characters, artists names and names of artistic groups are not deemed to be registrable without the express consent of the corresponding title holder, and if inadvertently registered by the Trade Mark Office, the LIP grants a cancellation action against such a registration.
Additionally, Mexican Copyright Law recognizes *sui generis* protection for titles of publications and radio and TV programmes, that are periodically used as well

as fictitious and real characters, artistic names and publicity promotions that are remarkably original, through legal protection known as “Reserva of exclusive rights”. In accordance with the Copyright Law, protection to "Reservas" differs from that afforded to works of authorship, as it is not devoted to protect the work of authorship itself, but features that are related. Reserva protection is closer to principles of trade mark than copyright law. Accordingly, "Reservas" confer rights of exclusive use for characters, titles, etc, but do not recognize additional personal or moral rights. From a procedural standpoint, deposit and periodical renewal are required for maintaining "Reservas" in force, as well as proof showing that the title or character has been used in connection with publications or broadcasts, among others.

Additionally, examination of "Reserva" applications is closer to that of Trade Mark Law, however prosecution proceeding is full of ad hoc practices, and variable and changeable criteria.

Trade mark, "Reserva" and even copyright law may intervene in protecting a particular title or character. In essence, protection afforded by these three legal figures is different and complementary. Trade mark law aims to protect the commercial side, copyright the artistic side, and reserva the psychological and physical characteristics of the character itself. Copyright law may protect a drawing or photo of a character, but not the character itself. The trade mark law would protect a character if used for distinguishing products or services in commerce. The scope is much narrower than protection afforded to a character by reserva law.

Mexican practitioners normally recommend obtaining as much protection as possible, considering the legal problems and disputes that may arise. Trade mark, reserva and copyrights have been confronted when one party owns a trade mark registration and someone else a reserva or even a copyright registration.

There is limited legal authority to solve this type of issue. In general terms, it can be concluded that the cancellation provision in the LIP is the guideline to follow. However, it would have only a limited effect as it is incapable of solving all potential problems that in fact could develop. Just to provide an example, how would this rule be applied if a non-authorized third party seeks and obtains a reserva for a title or character owned by somebody else? Should this Reserva be cancelled despite the absence of a senior trade mark registration? These unchartered areas in the application of the double or cumulative protection principles definitively affect protection of titles and characters and should be

improved.

THREE-DIMENSIONAL MARKS

Product and container shapes, among other forms of three-dimensional designs, are protectable under the LIP. However, the following four basic limitations have been imposed:
(1) That the three-dimensional marks are not part of the public domain.
(2) That the three-dimensional marks have not become of common use.
(3) That the three-dimensional marks lack sufficient originality to be easily distinguished.
(4) That the three-dimensional marks represent the shape of the product or that imposed by their nature or industrial function.
Specific comments on the foregoing point follow:

PUBLIC DOMAIN

There is not a clear and uniform criterion of what the Trade Mark Law should understand as "public domain". However, it appears that the meaning implies a patent connotation. In accordance to Mexican Patent Law, protection is available for designs that are novel and that are applied to industrial products, devices, containers or any other kind of forms. Novelty is restricted to the industrial forms not fund in the sate of the art anywhere in the world.
An industrial design may fall in to the public domain if no proper and timely registration is sought therefor before it is used in commerce, in accordance with the Patent Laws and Regulations. Also, it can fall into the public domain after the term of protection of the industrial design, which in Mexico is of 15 years. From a practical standpoint, one should be very careful to know whether the three-dimensional device has been already exploited and whether patent protection has already been sought therefor. In the affirmative, it should be taken into account whether the corresponding industrial design registration has expired. The filing of a three-dimensional trade mark application does not necessarily require that an industrial design application is simultaneously or previously filed. Protection afforded by trade mark and industrial design is

alternative, therefore, it is important that the three-dimensional mark "has not fallen into the public domain".
Notwithstanding the above, from a theoretical point of view, Congress should re-examine the "public domain" requirement, as it clearly contradicts principles of trade mark law. Inventions and designs that are used or exploited prior to the filing of an application lose novelty and fall into the public domain. It would be difficult to say that marks that were used prior to registration also fall into the public domain.
Distinctive marks used prior to registration trigger — not lose - rights in accordance with trade mark law. Therefore public domain is not an appropriate concept for trade marks, as it is contradictory to established principles under trade mark law.

COMMON USE

Mexican trade mark law considers to a certain degree that a novelty standard is to be applicable for three-dimensional trade marks. It thus will be required that the mark meets a minimal level of uniqueness, and not be reputed or recognized as of common use. Forms and shapes in general that are too simple or that have served as containers or the shape of products, shall be definitively not be protected.

DISTINCTIVENESS

As explained above, this represents a basic principle of Mexican trade mark law. Accordingly, the following will have to be considered:

- That the three-dimensional mark shall not be confusingly similar to pre-existing ones.

- It also shall not be generic, or descriptive as regards the products or services to which it will be applied.

ORIGINALITY

The word "original" is vague and cannot be used in the context of three-dimensional trade mark protection or even trade mark protection in general, as it is exclusively related to copyright law. As the concept is so imprecise, it could be concluded that works of authorship that are original are entitled to protection, which probably would go too far in terms of how the scope of three-dimensional trade mark protection should be determined.

ORDINARY INDUSTRIAL FUNCTION

The present requirement is related to the previous three. However, in this case the law is intended to ensure that ordinary forms or functionality features of products, devices, containers, packages and other three-dimensional forms, are not exclusively appropriated by single entities, which would be detrimental to third parties. Thus, the shape of the three-dimensional product, container, etc, will have to be distinct and unrelated to its ordinary form or function if trade mark protection is intended to be made available thereto. Non-functional devices or features of products or packages, boxes or containers will represent the most adequate forms of protection in accordance to trade mark law.

ADDITIONAL COMMENTS/REGULATIONS OF 1994

In accordance with the Regulations of 1994, wrappers, packages, containers and the form of presentation of products have been expressly considered three-dimensional forms for the purpose of the LIP. This regulatory provision has given a more precise understanding of that term, making clearer that product shapes can function as three-dimensional marks. Needless to say that they have to comply with the LIP requirements explained above. Notwithstanding the foregoing, it has been the Trade Mark Office's interpretation that shapes of products cannot represent three-dimensional marks, which is obviously wrong. It is worth mentioning, again, that the LIP does not confer protection on descriptive marks regardless of how widely they have been used and how much

consumer recognition they possess. This has a particular importance in cases of "three-dimensional marks", considering that products and container shapes may not be inherently distinctive. Frequently, it is not only the non-functional feature of the shape, wrapper, package, bottle or container, that applicants wish to protect, but additionally some features that may be not registrable or that may at least not be considered inherently distinctive. Other times, a dividing line between functional and non - functional, useful and useless, art and industry is just impossible to be drawn.

The lack of an acquired distinctiveness doctrine makes it more difficult for many three-dimensional marks to become registered under Mexican Law. Patent and Copyright Laws may not offer much additional assistance as well. However, the Trade Mark Office has generally taken a flexible approach in conducting registrability exams and a positive view in protecting these forms of