*by Sofía Arroyo*

According to the Mexican IP Law, the study of all trademark applications in Mexico is divided in two stages.

The first stage corresponds to a review of the formal requirements in order to confirm the application form was correctly filled by the applicant and the second stage analyses the registratbility of the proposed mark, considering both relative and absolute grounds of refusal.

Now, the first analysis stage includes a review of the description of the products or services of interest which currently has become very relevant for two reasons.

The first reason is because according to the Mexican IP Law, the final decision regarding the classification of goods and services corresponds to the examiner.

The second reason is because the Mexican examiners have a very strict criteria regarding classification, as the Mexican Examiners consider that the products and services of interest, need to be indicated as closely as possible to the lists included in the Nice Classification, in order to provide certainty to both the trademark owner and third parties about the scope of protection of the eventual trademark registration.

Of course, as you will realize the above described criteria has resulted in the issuance of a significant number of official actions addressing classification issues. Additionally, said criteria presents a practical problem because as you know science, technology and the development of new products and services in the market occurs much more faster that the pace at which the Nice classification is updated.

Nonetheless, in order to try to avoid official actions with classification issues, when filing a trademark applications in Mexico we recommend whenever possible to use the descriptions contained in the Nice classification, and if this is not possible to describe the product or service in question as closely as possible to the descriptions contained in such lists.

Likewise, clarifications between parenthesis indicating the nature of the product or services are also helpful to reduce classification requirements, for example a description a long the lines of *"apparatus for monitoring the sleeping patterns (medical apparatus)"* is helpful to maintain the product in class 10 and reduce the risk of receiving an official action regarding classification issues.

Also, it is very important to have in mind that as previously mentioned, the final decision regarding classification issues pertains to the examiners, therefore even when the examiners allegedly try to issue as few official actions as possible, if the examiner in charge of the case is not satisfied with the description of the products or services in question, said examiner can issue as many official actions as needed until he or she is satisfied with the description, because the Mexican IP Law does not establish any limit to the number of official actions that can be issued during the trademark application process.

Of course, as you will realize receiving multiple official actions not only delays the trademark registration process but also increases the prosecution costs, because according to the Mexican IP Law it is necessary to pay government fees with each response to an official actions and failure of payment is penalized with the automatic abandonment of the application.

Finally, it is also important to comment that multiple class applications are not possible in Mexico, therefore if the same mark is to be filed in two or more classes and there is doubt about the proper classification of a certain class product or service, we recommend to include the conflicting product or services in all relevant classes, because we can always delete the product or service after filing, but we cannot include said product or services in an already filed application.

The reason for the above is because we increase the number of products or services covered by an application after filing, this is considered by the law as an alteration of the originally filed application and therefore treated as a new application filing which will result in the change of the filing date and the need to pay the government fees for the study of a new application.

Now, once the formal analysis stage is cleared, the Mexican examiners proceed to analyze the registrability of the mark as such.

In this point is important to comment currently there is no opposition procedure in Mexico, therefore all absolute and relative grounds for refusal are determined by the Mexican trademark examiners based on Article 90 of the Mexican IP Law which establishes all the relative and absolute causes by which a mark may be refused for registration in our country.

Regarding the absolute grounds for refusal it is important to comment the Mexican examiners are prone to object the inherent registrability of a trademark based on descriptiveness.

The reason for the above is because trademark examiners in Mexico have difficulties to distinguish between descriptive terms and evocative marks, therefore although evocative marks can be registered as trademarks in Mexico, many evocative marks get objected and eventually refused based on descriptiveness even when these marks have been accepted and registered in other countries. Forcing us to go through an appeal process before the courts to try to revert the refusal and obtain trademark protection.

Likewise, obtaining registration for 3D marks in Mexico can also be challenging because the examiners tend to object this kind of registrations on the basis of considering that the 3D form is the “usual form” or the “form imposed by the nature of the product of interest”. Nevertheless, our firm has had significant success in obtaining trademark registrations for 3D marks in Mexico through litigation and as a consequence the examiner’s criteria regarding these type of marks has slowly but surely become more flexible in benefit of the trademark applicants.

As for the relative grounds of refusal, it is up to the trademark examiner to determine which of the senior trademark registrations and applications constitute an obstacle for registration on the grounds of likelihood of confusion.

Again, in accordance with the classification issues and the absolute grounds for

refusal, the Mexican examiners also have very strict criteria when assessing likelihood of confusion between marks.

Additionally, for the purpose of assessing likelihood of confusion, Mexican examiners tend to consider the names of the marks as the most relevant element while designs are regarded as secondary elements and usually deemed insufficient to distinguish two marks from one another and overcome a barrier which has been considered as *"phonetically"* similar by the trademark examiners.

Of course we do not agree with the above criteria because in accordance to international law and jurisprudence trademarks in Mexico are supposed to be analyzed and compared as a whole; however Mexican trademark examiners tend to divide the elements of the marks when making the comparison analysis.

Fortunately, the Mexican examiners resolutions are not final and can be appealed before the Courts which although they also have a strict criteria it is not as strict as the criteria from the trademark examiners and have the faculty of reverting the Mexican Institute of Industrial Property (IMPI) refusal and order this authority to grant the registration certificate. Likewise, our firm has ample litigation experience and has had significant success in reverting IMPI's decisions which again has resulted in the change and flexibility of some of IMPI's criteria.

Consequently, when responding to official actions issued by IMPI is important to take into consideration the following.

1. IMPI has very strict criteria regarding both classification issues and absolute/relative grounds for refusal.

2. According to the Mexican Jurisprudence IMPI is completely independent to issue their own resolutions, therefore this Institute is not obliged to grant a trademark registration even if this registration has been granted in other countries, which in practical terms means that even if we submit certified copies of trademark registrations granted in other countries IMPI can still refuse registration for the mark in Mexico.

3. Our Supreme Court has ruled that IMPI is not obliged to accept letters of consent and/or coexistence agreements to overcome senior trademarks that have been cited as barriers, because said documents are not expressly indicated in the Mexican IP Law as a valid option to overcome barriers.

Consequently, letters of consent and coexistence agreements are studied on a case by case basis and their acceptance depends on the criteria of the examiner in charge of the case, though in our experience we have noted the examiners in general are more prone to accept these documents and grant registration when the scope of protection of the involved marks is limited to the specific products/services of interest in each case or expressly excludes the products/services of interest of the counterpart.

4. All IMPI's resolutions can be appealed before the Courts in two possible stages.

Finally, it is very important to comment that a project to amend the Mexican IP Law and include an opposition procedure has been recently presented to our Congress and is currently being discussed by our law makers, therefore, even when we do not know when this project will be voted, we are closely monitoring the evolution of the situation and will readily inform our clients about the changes to the trademark registration process in Mexico, derived from this amendment in due course.

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