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I. INTRODUCTION

I should start this presentation by congratulating INTA for its effort to put the present forum together.

The topic of Trademark Dilution shall always be interesting for the U.S. practitioner, especially in view of the Dilution Act adopted in 1995. There certainly must be a lot to discuss on the topic, two years after the statute went into effect. However, the forum shall undoubtedly be attractive to foreign practitioners also as the theory of dilution has become so important that it would be simply unacceptable for trademark law experts ignoring it, despite the fact that it does not apply in their particular jurisdictions.

Mexico, as well as many other foreign countries, does not follow the concept of dilution, but rather protects famous marks based on the "confusion" doctrine. For purposes of this presentation I shall assume that dilution can be somehow equated with the Mexican system on well known marks. However, it is also acknowledged moment that there are also great differences, which of course will be referenced and commented.

II. BRIEF REVIEW OF THE U.S. DILUTION THEORY

A. FIRST REMARKS

First of all, it bears mentioning that for preparing the present document I first researched the U.S. law on dilution. I thus went through some books and published articles, written by some leading experts in U.S. Trademark law. The initial purpose was to focus on the concept of dilution, as on first impression, it

did not particularly convey or suggest something with which a Mexican Trademark law practitioner would be familiar.

B. HISTORY

What came to mind in the first place was that the concept of dilution owed its origin to Professor Frank Schechter, who in 1927 wrote an article in the Harvard Law Review entitled "The Rational Basis of Trademark Protection"[\[1\]](#). A prior case was judged in 1925 between *Wall v. Rolls Royce of America*[\[2\]](#), which to some extent covered the issue.

However, Schechter made his point very clearly, and without calling it "dilution", stated that trademark protection involved not only the question of deception to the public, but protection of the owner of the trademark, who should be able to prevent other people from transgressing the uniqueness of its mark. His definition, which is still valid, represents that dilution consists of "the continuous use of a mark by a subsequent user which results in the gradual whittling away or dispersion of the identify and hold upon the public mind of the mark"[\[3\]](#).

Later, 25 States of the American Union enacted local dilution legislations based on the so-called Model State Trademark Bill[\[4\]](#). Finally, during the '90s a strong impulse was made by different sectors, including USTA (now INTA), in order to make amendments to the Lanham Act, and among others, implement a provision on dilution with a federal scope.

C. COMMENTS ON DILUTION

From my research, it was possible to appreciate the unique purpose of the dilution statute: it created a legal figure for protecting trademarks as themselves, from the standpoint of their capacity to identify and distinguish products or services. The House Report on the Dilution Act, follows a definition provided by McCarthy and Schechter which states that dilution applies when defendant's use of a famous mark represents a unique, singular or particular source of goods and services. From the House Report of the Dilution Act it is possible to read that in order for dilution to occur defendant must have used the mark commercially[\[5\]](#).

Based on the foregoing it is possible to draw a first conclusion: Dilution actions

are different from infringement and false designation claims, as they are targeted to protect trademarks (and other trade symbols perhaps) from essentially different wrongs[6].

In accordance with the Dilution Act, dilution can be divided into blurring and tarnishment. "Blurring lessens the capacity of the famous mark to distinguish by informing consumers that the mark no longer represents one source. Tarnishment lessens the capacity of the famous mark to distinguish by interfering with the good will consumers associate with the famous mark and/or products"[7].

Since it was enacted the U.S. Courts have frequently gotten confused and troubled when applying the Dilution Act. That can be appreciated in many of the judgments published by Court Reporters. Also in their articles, commentators have criticized some of the Court's decisions. This becomes evident, for example, as the Courts have had a hard time drawing the dividing line between dilution and confusion as separate and independent wrongs. For one commentator trademark litigation concentrates in few states, which have long had dilution statutes before the Federal Act. Very few Courts have actually awarded relief based on dilution[8].

From my investigation I could appreciate that under the U.S. Dilution Act, to be diluted, the mark needs to be distinct and famous, and has to be used by defendant in commerce. However, the foregoing has led to questions of many sorts.

1. FAME: In accordance with the Dilution Act, plaintiff's mark must be famous to qualify or acquaint for protection. U.S. Courts use an eight factor analysis in order to determine how famous a particular mark can be. The test involves examination of distinctiveness as well as the scope and extent of the mark's use. The test has brought the following questions:

- a) The degree of inherent or acquired distinctiveness of the mark. Apparently, the U.S. Dilution Act requires inherent distinctiveness. However, protection by a Circuit Court of the mark THE GREATEST SHOW ON EARTH[9] on a dilution claim, may have opened the possibility that the principles apply to trademarks showing acquired distinctiveness as well.
- b) Is the fame of a mark determined by the likelihood of its confusion? It may not be possible in U.S. dilution type of actions as they are distinct from infringement and unfair competition.
- c) In line with the House Report on the Dilution Act fame of a mark needs to be extended throughout a substantial portion of the U.S. territory. However, by the

reading of cases we came to the conclusion that such a question is still under hot debate.

d) U.S. Dilution Act does not expressly provide protection for trade dress; it merely provides protection for marks, trade names, labels, and forms of advertising. Nevertheless, two Courts have ruled that the Dilution Act indeed protects trade dress[\[10\]](#).

e) It is hard to determine the level of fame of a mark, notwithstanding the eight factor test. Accordingly, a federal super-register has been proposed. This would leave in the PTO and not the Courts the power to determine famous status. However, this proposal was not made part of the Dilution Act[\[11\]](#).

2. USE BY DEFENDANT IN COMMERCE: In accordance with the Dilution Act, a violation of this kind is perpetrated when the defendant uses in commerce plaintiff's famous and distinctive mark. The key questions here would be the following:

a) It is unclear whether the famous and diluting marks must be identical or similar.

b) Some courts have developed a special language for making a distinction between confusion and dilution. For example, a majority of courts are now using expressions such as "substantial similarity" to apply to dilution claims, which would pretend to differ from the traditional "confusing similarity" concept[\[12\]](#).

c) The Second Circuit Court developed a test of factors relevant to determining likelihood of dilution by blurring. This test appears to be a stricter application than the one used for ordinary confusion cases. Among the factors the courts are required to consider is similarity between the marks, which is clearly comprehensible. However, it additionally considers similarity between products or services. There are critiques to that point as in dilution cases, it is not competition, but rather distinctiveness that represents the standard of analysis[\[13\]](#)."

d) Does defendant dilute plaintiff's mark by selling products or rendering services? This question deals with the expression "to use" the mark in the dilution context. Would the dilution provision accept other forms of using marks that are broader and thus not simply restricted to "sales"? From the investigations made it could be possible indeed, if it is considered that U.S. Courts have resolved dilution claims related to domain names in favor to the plaintiffs, when strictly speaking, a domain name may not be generally used as a mark[\[14\]](#).

3. REMEDIES: Injunction is the basic and typical remedy in dilution actions. The scope should be nationwide generally speaking. In addition to the injunction remedy damages and attorney's fees are available as well.

III. PROTECTION OF FAMOUS MARKS IN MEXICO

A. PRINCIPLES OF TRADEMARK LAW

The key function of trademarks is to distinguish products and services from others in commerce. In fact, only marks that perform such a function are protected by the law. The Law of Industrial Property (hereinafter LIP) defines marks as "every visible sign that distinguishes products or services from others of the same kind or class in the market."^[15] Professor David Rangel-Medina considers the principle of "distinctiveness" as an essential condition of validity of trademarks. By this virtue the mark shall specialize, individualize and singularize particular products or services and identify the source from which they originate. Following the ideas of Paul Roubier, Dr. Rangel Medina holds that to justify an exclusive right and the existence of renewal and enforcement rights arising therefrom, the mark shall be distinctive and that will happen only if it is not likely to be confused with other marks, in connection with identical or similar products or services, or if it does not constitute a generic symbol or one of usual use in the market or industry^[16].

Following the legal principles and doctrines referred to above, the Third Circuit Court for Administrative Affairs in the First Circuit (Mexico City), ruled in 1981 that trademarks have the purpose to individualize and distinguish goods, which in addition are not confusingly similar to other prior marks.

The Law of Industrial Property (LIP) protects inherently distinctive trademarks only, that is, trademarks which are suggestive, fanciful or arbitrary. On the other hand, the LIP categorically prohibits registration of generic and descriptive marks, even if they have acquired distinctiveness, as a result of a continuous and extensive use^[17].

B. THE TRADITIONAL CONCEPT OF TRADEMARK INFRINGEMENT

The LIP provides different causes of action against behaviors or conducts against

trademarks and other rights, including the right to compete. One of said causes of action is trademark infringement. The Trademark Law states in that respect: Article 213.— The following constitute administrative infringements.

To use a trademark confusingly similar to another registered trademark, to cover the same or similar products or services as those protected by the registered trademark.

Use of a registered trademark without the consent of the holder or without the respective license, on products or services equal or similar to those to which the trademark is applied.

Offer for sale or place into circulation products equal or similar to those to which a registered trademark is applied, knowing that the mark was used on them without the consent of their holder.

In accordance with Article 62 of the Regulations to the LIP, by trademark use it shall be understood that it applies to products which are then sold, or services that are rendered.

From the analysis of the foregoing provisions it is clear that "confusion" represents the standard applicable in trademark infringement cases. One of the provisions prohibits use of identical marks. Likelihood of confusion would be presumed if the identical mark is applied to the same products or services. If a variant or similar mark is used in connection with same or similar products or services, then a "confusion" analysis would be relevant.

Mexican Trademark jurisprudence and doctrine recognizes application of a test to determine "confusion". Trademarks are viewed from "phonetic", "visual" and "ideological" standpoints. In addition, "confusion" would be examined by having the marks analyzed in their entirety; by viewing them at their differences prior to their similarities; by looking at them alternatively and not simultaneously; and by considering relatedness in the trade channels, and sophistication of consumers.

IMPI is the authority empowered to apply the test, and to decide whether there is likeness between two particular marks. For that end, it has followed the principle that products or services within a particular class are deemed to be similar, with some exceptions. Accordingly, the law and jurisprudence have considered that similarity of products or services can occur when they share the same characteristics (i.e.: similar trade channels or forms of commercialization), despite the fact that they fall in different classes.

C. UNFAIR COMPETITION LAW

In accordance with the Mexican Law on Industrial Property, the Mexican Industrial Property Institute is empowered to repress and impose sanctions on those acts attempting to the good and honest practices in the industry and commerce and the Laws of Congress. Specifically, the LIP provides a cause of action in relation to unfair competition, which has support in the text of article 10 bis of the Paris Convention. The LIP provides as follows:

Article 213.— The following constitute administrative infringements:

To carry out acts contrary to good use and customs in industry, commerce and services, that imply unfair competition and that relate to the subject matter governed by this law.

The foregoing represents a general statement wide enough to cover any conduct violating fair practices in commerce as related to industrial property. However, courts are required to apply the foregoing rule in combination with this other:

Article 213.- The following constitute administrative infringements:

To perform, during the exercise of industrial or commercial activities, acts which confuse or lead the public to confusion, error or deceit, by making it believe or presume, without foundation:

- a) The existence of a relationship or association between one establishment and that of a third party;
- b) That products are manufactured under specifications, licenses or authorization of a third party;
- c) That services are provided or products are sold under the authorization, licenses or specification of a third party;
- d) That the product in question originates in a territory, region or locality other than the true place of origin in such manner as to induce the public to error as to the geographic origin of the product.

As it can be perceived the scope of this rule is very broad and in general would include any behavior or act that would induce or lead the public to believe or presume, mistakenly and without foundation:

- On the existence of an association, relationship, license or authorization between establishments, products or services.
- On the use of false indications of origin in products.

Under the doctrine of unfair competition, it is not necessary that a trademark or trade symbol be registered or even registrable. What is required is that the infringer sells its own products, services or establishments and passes them off as if they belonged to the party that has been affected. The essential characteristics of the products, services or establishments are thus copied or imitated by the infringers, triggering confusion among the consumer public.

D. DIFFERENCES BETWEEN TRADEMARK INFRINGEMENT AND UNFAIR COMPETITION

We would identify the following as some of the main differences between trademark infringement and unfair competition causes of action:

1. Trademark infringement:

- a) implies a registered trademark,
- b) the registered marks need to be inherently distinctive,
- c) Requires use of the mark in connection with products or services sold or rendered in commerce,
- d) Infringing mark can be identical or confusingly similar to the one registered,
- e) products or services in connection with the infringing mark is applied can be same or similar to those of the one registered,
- f) requires analysis of "confusion" test.

2. Unfair competition:

- a) does not necessarily imply the need for a registered mark;
- b) it even does not imply the need for a mark. It may protect any trade symbol (i.e.: trade dress) as long as it is capable of distinction;
- c) it is likely that marks or trade symbols that acquire distinctiveness may be protected, as long as the consumer public is mistakenly induced to believe that there is association or relationship between establishments, products or

services;

d) it would not necessarily represent the need that the mark or trade symbol be used by way of sales or commercialization as in the case of trademark infringement. The theory of "association" or "relationship" can be broader than that and embrace the possibility that unfair competition is made through infringer's use of advertisements, copyrighted materials and domain names, among others, pertaining to the holder of the rights subject to violation.

e) requires also analysis of "confusion" test.

E. FAMOUS MARKS

1. NOTION OF FAMOUS MARKS

The 1994 amendment to the LIP introduced a modification to the rule of well known marks. The new rule represents an improvement to the former law as it broadens and elevates the standards of protection of famous trademarks. It is basically grounded on Article 1708(6) of NAFTA^[18], and in certain aspects on Article 6 bis of the Paris Convention for the Protection of Industrial Property^[19]. However, the Mexican provision certainly exceeds the requirements in both article 6 bis of the Paris Convention and article 1708 (6) of NAFTA.

Article 90(XV)^[20] of the LIP understands for "notorious" marks those with which a particular sector in the public or commercial circuits in Mexico is acquainted as a result of commercial activities carried on in Mexico or abroad, by any person that employs the mark in connection with their products or services, as well as the knowledge that the public has of the mark in the territory of Mexico, resulting from the publicity or advertising given to the mark anywhere in the world.

Article 90(XV) imposes a limitation, considering that if registered, the mark subject to registration is likely to create "confusion" or "risk of association" with a famous mark or to "disparage" it.

Accordingly, the LIP will protect famous trademarks upon the existence of a likelihood of confusion, association or disparagement. As mentioned, this would represent a restriction on the principle of "specialty", although it is not absolute. It is not absolute as it would not be possible to seek cancellation or infringement

against a mark which is not sufficiently similar to the famous one, or which is applied to products or services that are entirely different, and that consequently, confusion is not strictly possible. Notwithstanding the fact that the Mexican rule is not absolute, such a provision is still above the standards of the Paris Convention of NAFTA, and has also been interpreted widely by the courts, as it will be commented below.

It bears mentioning that the LIP has appointed IMPI with the powers to decide the famous status of trademarks. This would be true while prosecuting the trademarks, under article 90(XV) of the LIP, as well as when resolving trademark infringement causes of action in conformance with article 213(VII)[\[21\]](#) of the LIP. The question has arisen though, as to whether IMPI would be additionally empowered to grant special registration for famous marks. A specific reference cannot be found in the LIP, however, the statute could be interpreted so widely as to obtain that the LIP has conferred IMPI with sufficient capacity to declare if trademarks have reached the status of well known. This could be made sua sponte or by request of a party with so called "legal interest".

Lastly, the LIP does not make a distinction whatsoever between famous or highly reputed marks and well known marks. It simply refers to "notorious" marks as one single concept. However, it is possible to draw a dividing line between "notorious" marks known to everyone and those known to particular sectors. That can be considered as a difference of degree, however such a division would be purely academic without any practical effect as, being a single concept, notorious and well known marks will be protected equally.

2. HISTORY

The first statute in Mexico recognizing protection of famous marks is the Law of Inventions and Trademarks of 1975, amended in 1986. Prior to that, the issue of famous marks was addressed in cases that go back to the early fifties. The BULOVA decision represents a landmark case, whereby that famous trademark, used in connection with watches, was protected by virtue of article 6 bis of the Paris Convention. The pirate obtained a registration for identical products, namely watches, a situation that allowed the courts to decide in favor of the rightful owners without any trouble.

There are also decisions by the Mexican Courts where the issue was whether the products to which the alleged infringer applied the mark was "similar" in the

context of article 6 bis of the Paris Convention. Thus, among others, trademark CADILLAC was protected against application of the same to clothing products. Similarly, trademark GE was protected against a registration cover hardware, plumbing and steam fitting supplies. The same happened concerning trademark OMEGA associated with machinery and tools; trademark GUERLAIN as applied to perfumes and cosmetics; MARLBORO as applied to clothing; and CHANEL in connection with clothing as well.

Notwithstanding the importance of BULOVA as well as the other resolutions that were produced later, the GUCCI case would perhaps represent the most relevant decision on the subject of famous marks. The GUCCI case involved two spurious registrations, that the Trademark Office had granted to a pirate for trademarks GUCCI and GUCCI AND DESIGN to cover footwear. In that case the courts discussed, among others, whether the Paris Convention as an international treaty, was self executing. Plaintiff brought two actions which were handled by two different courts. Judgments came in opposite directions, creating contradiction. As a result, and before the two decisions were taken to the Supreme Court, Congress passed an amendment to the law, implementing protection of famous marks^[22].

Accordingly, with the exception of the GUCCI court, the remaining have been flexible, and have given a wide and positive interpretation of the rule.

3. PRESENT SITUATION

Coming back to the new rule on famous marks, we are not aware of any decisions pronounced by the courts interpreting the notions of "confusion", "association" or "disparagement". We tend to believe that as the language used in that provision is broader than that of the Paris Convention, the rationale of the CADILLAC and other courts would still be applicable to situations arising from the new rule.

IMPI has imposed a strict view in connection with the famous status of a mark, and has imposed a burden so high, that has triggered problems to plaintiffs, as they would have to undoubtedly demonstrate to the satisfaction of IMPI, that the mark is widely sold and advertised, and that the consumer public, or at least the sector connected with the products or services to which the mark is applied, has knowledge of existence of that mark.

Thus in brief, the Mexican Trademark Law would protect famous marks when

the following is met:

- i) That they are known in Mexico, by virtue of trade or advertisement made in Mexico or abroad:
- ii) that they are known at least among a particular sector of industry or trade;
- iii) that a third party use a mark which is likely to create confusion or risk of association mark with the famous mark or produce its discredit.

IV. COMPARISON BETWEEN U.S. DILUTION AND MEXICAN WELL KNOWN THEORIES

As mentioned above, Mexico does not follow a system of dilution, but rather protects highly distinctive and famous marks on the grounds of a "confusion" type rule. Accordingly, a first distinction can be made between the way U S and Mexican laws offer protection to famous marks. Additional differences can be identified as follows:

- A.** The Dilution Act requires distinctive marks to qualify for this type of protection. Distinctiveness should be inherent, however, marks may be "diluted" if acquired distinctiveness as well. Under LIP there is nothing that would initially impede non-distinctive marks from becoming famous and deserving of protection as a result, as long as they acquire distinctiveness. However, the question arises at the same time as to whether the law would protect such marks on the basis of trademark infringement, of unfair competition.
- B.** The Dilution Act requires famous marks to qualify for this type of protection. The LIP would require that situation as well.
- C.** The U.S. Courts follow an eight factor test in order to determine the level of fame of a mark. Neither IMPI nor Mexican Courts rely on any particular standards.
- D.** The U.S. Dilution Act requires that the fame of the mark extends throughout a substantial portion of the U.S. territory. The LIP establishes that marks have to be famous in Mexico, which would initially make one consider whether the provision refers to the entire country. However, this is not clear, and the question would arise what would happen if a mark is known in part of the country. It is important to consider that more than 60% of the population of Mexico lives in Mexico City, Guadalajara, Monterrey, Puebla, Ciudad Juárez and Tijuana.

E. The U.S. Dilution Act may protect trade dress besides trademarks. Under LIP it would not be possible to protect trade dress through trademark infringement actions. Enforcement of trade dress rights would be available through unfair competition actions.

F. The U.S. Dilution Act does not contemplate a register for famous marks. Neither is it provided by the LIP, however, from interpreting the statute it may be possible to conclude that IMPI has a general power to determine the well known status of marks.

G. Under the U.S. Act it appears not to be clear whether famous and diluting marks must be identical or similar. This would not represent a question under LIP as it is precisely the standard of "confusion" that prevails in trademark infringement actions, including famous marks.

H. The U.S. Dilution Act has created language applicable to dilution, which differs from the traditional concepts of trademark infringement. The LIP has not been obligated to make differentiations as it does not recognize the concept of dilution.

I. The U.S. Courts have developed a test of factors relevant to determining likelihood of dilution by blurring. Mexican Courts have not made the same as the theory of dilution is not applicable in Mexico.

J. The U.S. Dilution Act divides dilution into blurring and tarnishment. The LIP would grant protection against blurring of a famous mark by virtue of trademark infringement and cancellation actions. Trademarks could be protected against tarnishment by application of article 90 (XV), as well as the principles of unfair competition, and article 213 (X) of the LIP [\[23\]](#). This latter provision prohibits third parties from disparaging products, services, activities or establishment of others. From the foregoing, it could be concluded that the LIP provides protection equivalent to dilution by tarnishment without the need to examine "distinctiveness" or the status of "famous" marks.

K. The concept of "use" that is employed in the U.S. Dilution Act is flexible enough not to be restricted to "sales". For example, domain names, which are not "used" in the context of the Lanham Act, may be protected by virtue of the principles of dilution. The LIP would require "sales" of products or services in order for trademark infringement actions to become available. Domain names and other symbols that are not "used" in the traditional context required by the LIP, would be still protectable under the principles of unfair competition.

CONCLUSIONS

From all the foregoing, it can be obtained that both, the U S and Mexican Laws afford special protection to famous marks. The regimens are equivalent as they are aimed at protecting the same object, however, they are different at the same time, considering that under the U.S. Dilution Act, famous marks are given protection from the perspective of their capacity to distinguish. In Mexico protection of famous marks is viewed from the standpoint of "confusion" that would arise in terms of competition. The Mexican LIP grants trademark infringement actions and in a minor context unfair competition actions for repressing use of famous marks, and for prohibiting their tarnishment. The standards of the Mexican rules are much above that those in NAFTA and Paris Convention.

[1] Reference obtained from Leimer, Jacqueline A., "Trademark Dilution in the US", Trademark World, issue 62, November 1993. Armstrong Group IP Publishing Ltd., England, p. 16.

[2] 4F2d 333 (3d Cir 1925) ROLLS-ROYCE automobile opposed to ROLLS-ROYCE radio parts.

[3] Leimer, Jacqueline A., opus cit p. 16.

[4] 1964 and 1992 Model State Trademarks Bills.

[5] Hein, Clinton, "Confused About Federal Trademark Dilution?", The Trademark Reporter, Vol. 87, July-August, 1997, No. 4 INTA, USA, pp 370-417.

[6] Id. at p. 334.

[7] Id. at p. 395

[8] Kirkpatrick Richard L. and Klein Sheldon H., "U.S. Federal Dilution Law", Trademark World, issue 88, June/July 1996, Armstrong Group IP Publishing Ltd., England, p. 35.

[9] Ringling Bros.-Barnum & Bailey Combined Shows Inc. v. B.E. Windows Corp., 937 F Supp 204, 40 USPQ2d 1010 (SDNY 1996).

[10] Clinique Laboratories, Inc. V. Dep Corp., 945 F Supp 547 (SDNY 1996), and Sunbeam Products, Inc. V. West Bend Co., 39 USPQ2d 1545 (SD Miss 1996).

[11] Kirkpatrick et al., opus cit at p. 36.

[12] See Hein, Clinton, opus cit, at p. 387 (He states: Does dilution require substantial similarity between the marks?). See also Sommer, Mark, "The News U.S. Trademark Dilution Act: Problems Lurking?," Trademark World, Issue 84, February 96, Armstrong IP Publishing Ltd., England, P. 16.

[13] Hein, Clinton, opus cit at p. 391.

[14] Hein, Clinton, opus cit at p. 413.

[15] Article 88 of the LIP.

[16] Rangel Medina David, "Tratado de Derecho Marcario", Editorial Litores de México, S.A., México, 1960 p. 184.

[17] Article 90 subsections I through V of the LIP.

[18] Article 6 bis of the Paris Convention shall apply, with such modifications as may be necessary, to services. "In determining whether a trademark is well-known, account shall be taken of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Party's territory obtained as a result of the promotion of the trademark. No Party may require that the reputation of the trademark extend beyond the sector of the public that normally deals with the relevant good or services". NAFTA art 1708.

[19] Article 6 bis [Well-Known Marks]. (1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. The provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith. (2) A period of at least five years from the

date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested. (3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or use in bad faith.

[20] Article 90.- Not registrable as trademark are: "...XV.- Names, figures or tri-dimensional forms, equal or similar to a trademark which the Institute considers to be notoriously known in Mexico when a particular sector of the public or of the trade circles in the country know the trademark as a result of commercial activities developed in Mexico or abroad by a person who uses this trademark in connection with its products or services, as well as knowledge of the trademark in the territory resulting from its promotion or advertising. In order to demonstrate the notoriety of the trademark, all evidentiary media allowed by this law may be used. This impediment will be appropriate any time that the use of the trademark by the person who requests its registration may create confusion or a risk of association with the holder of the notoriously known trademark, or when it constitutes an utilization that causes a loss of prestige of the trademark. Said impediment will not apply when the applicant of the registration is the holder of the notoriously known trademark..."

[21] Article 213.- The following constitute administrative infringement: "...VII.- Use as trademarks the names, signs, symbols, initial or emblems referred to in article 4th and sections VII, VIII, IX, XII, XIII, XIV and XV of article 90 of this law".

[22] A more in depth discussion can be found at: Gomez-Vega Bernardo and Rangel Ortiz Horacio, "Protection of unregistered but well-known Trademarks (Art. 6 bis Paris Convention) and Protection of Highly Known Trademarks; Reports AIPPI Exco'90, Barcelona, Spain, AIPPI, Zurich, 1990, pp. 157-172. Olivares Sergio L., "Protection of Well-Known Trademarks in Mexico, Brazil and Venezuela", The United States Trademark Association 110th Annual Meeting, Phoenix, Arizona May 1-4, 1988. Rangel-Medina David, "La protección de las marcas notorias en la jurisprudencia Mexicana", Actas de Derecho Industrial, 10, 1984-85, Instituto de Derecho Industrial, Universidad de Santiago, Editorial Montecorvo, S.A. Madrid. Rangel-Medina David, "La piratería de marcas en México", Jurídica, anuario del departamento de derecho de la Universidad Iberoamericana, número 18, 1986-1987, México, D.F. Rangel-Medina David, "La especialidad de la marca en la jurisprudencia mexicana", en Revista Mexicana

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Rangel-Ortiz Horacio, “La protección de la marca notoria en las reformas a la Ley de Invenciones y Marcas”, EL FORO, Órgano de la Barra Mexicana Colegio de Abogados, Octava Época, Tomo I, Número 2, 1988, México, D.F. Rangel-Ortiz Horacio, “Conceptos fundamentales de la competencia desleal en materia de propiedad industrial”, Revista de Investigaciones Jurídicas, Escuela Libre de Derecho, AÑO 9, Número 9, 1985, México, D.F.

Sepúlveda César, “La discusión sobre las llamadas marcas notorias o marcas de gran renombre”, Revista de la Facultad de Derecho de México, Tomo VIII, núm. 29, enero-marzo del 1958. [\[23\]](#) Article 213.- The following constitute administrative infringements: “...Attempt or succeed in giving a bad name to the products, services, industrial or commercial activity or establishment of another. Not included in this provision is a comparison of products or services covered by the trademark for purposes of informing the public, provided that said comparison is not slanted, false or exaggerated in the terms of the Federal Consumers Protection Law;...”