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Protecting trademark rights in Mexico poses a number of challenges. The law sets out strict requirements on the types of signs that are capable of registration and the procedures differ in many ways from those in place in other jurisdictions.

Protected signs

Before developing a registration strategy in Mexico it is first essential to understand what types of signs are eligible for protection. Article 88 of the Mexican Law of Industrial Property (LIP) states that a mark must be a “visible” sign distinguishing products or services from others of a similar kind on the market.

As a consequence, non-visible signs, such as motions (eg, holograms), sounds and scents, which can be registered in other jurisdictions, are excluded from the scope of trademark protection in Mexico. This is true no matter whether such a sign is capable of graphical representation. The interpretation of “visible” under current Mexican law bars most unconventional signs from registration and limits protection to literal marks, logos, designs, combinations of colours, letters or numbers, and marks combining one or more of such elements.

Marks consisting of a single colour, letter or number shall not be protected because they are always considered to lack distinctiveness, no matter how ‘original’ the colour mark might be.

Three-dimensional marks are viewed as visible signs and are protectable when distinctive. To qualify as distinctive, a threedimensional sign must overcome the hurdle established in Article 90(3) of the LIP. This article states that three-dimensional signs made up of forms in common use which lack originality cannot be registered as trademarks. ‘Originality’ implies that the sign is sufficiently different from other existing signs and forms used in the market.

Distinctiveness and secondary meaning

The Mexican Institute of Industrial Property (IMPI) applies strict criteria with respect to distinctiveness and it often rejects signs that are viewed as distinctive in other jurisdictions.

Moreover, in Mexico, secondary meaning is not discussed in the LIP. Thus, IMPI will not accept evidence that the mark has acquired distinctiveness through use.

Specification of goods and services

Mexico implemented the Nice Classification in 2001. However, IMPI has adopted its own particular criteria under this classification system and examiners often require applicants to adapt descriptions to follow IMPI's Spanish version of the Nice Classification. Goods and services accepted as falling within a certain class in other jurisdictions may not do so in Mexico unless the description is modified to match IMPI's version of the classification. This is of increased significance when dealing with descriptions in languages other than Spanish, where an exact translation simply does not exist. Thus, rights holders are advised to adapt the relevant product or service translation to IMPI's equivalent or similar 'listed' product or service.

When implementing the required adaptations during the application process, there is a risk that the examiner will conclude that the applicant has modified the trademark application. The legal consequence of this is the loss of the application's legal date leading to the payment of a new application fee.

Considering that the Mexican system allows the use of a class heading in an application to cover all the products or services in that class, it may be quicker and easier to use simply the class heading or make the description as wide as possible. This has the benefit of removing the need to adapt the specific descriptions to meet IMPI's requirements.

Non-use

The LIP does not provide for the partial cancellation of marks based on non-use. A mark owner will never be required to prove the use of the mark for every described product or service. Moreover, one needs only to prove use for at least one of the products or services identified in the register pursuant to Article 134 of the LIP.

In this regard, applications containing very detailed and limited descriptions of products or services are normally based on legal systems where trademark rights derive from use (which is not the case in Mexico, although use does have some legal effects) or where partial cancellation is possible when a mark is not used for every product or service listed (as happens in most European jurisdictions). Such applications do not make as much sense in Mexico, where limitation of products or services in a trademark application may be advisable

only to avoid likelihood of confusion with earlier rights.

Types of application

Multi-class applications are not possible in Mexico. Thus, applicants can file only in one class at a time. It is better to determine whether the mark needs to be protected in other classes at an early stage to avoid running into difficulties at a later date.

Additionally, it is not possible to make divisional applications. Further, as noted above, there is no prior use requirement to apply for a mark in Mexico; thus, there is no differentiation between an application based on use or an intention to use.

Examination

Examination is a two-step process. First, there is formal examination, which ensures that the formal requirements are met and that the description of the products and services is accurate. This is followed by substantive examination, which is carried out by an expert examiner who determines whether the mark is sufficiently distinctive and not descriptive or deceptive. This examiner will also check whether the mark is confusingly similar to earlier rights.

The examiner may refuse an application on relative grounds even if the applicant's own search reports for prior rights proved negative. Unfortunately, electronic search reports based on IMPI's online databases can never be said to be exhaustive due to technical limitations in the current system and delays on the part of IMPI in updating such electronic databases. Moreover, as with its approach to distinctiveness, IMPI has also narrowed its criteria concerning likelihood of confusion. For example, IMPI requires examiners to find a likelihood of confusion when a later mark is included in its entirety within an earlier mark, no matter whether the signs at issue are actually different.

Extensions of time during the application procedure are possible. An applicant can extend by two months the term to answer an office communication containing a requirement. No prior formal request for an extension is necessary; however, the applicant must ensure to pay the additional fee when answering. No specific rules exist that provide for the reinstatement of rights when an applicant fails unintentionally to comply with a time limit despite taking all due care in the circumstances.

Should a mark not meet any objection during examination, it may be registered within four months. However, registration may take a year-and-a-half or more should the mark face one or more office actions.

No opposition

There is no opposition procedure in Mexico. The examination process does not involve any third-party intervention.

Trademark rights can be challenged by third parties only after being granted and published in the IP Gazette. At that point, interested parties must first submit a nullity administrative claim with IMPI if they feel that their rights are threatened by the new registration. There are two administrative instances for such claims and further appeal to the courts is possible.

Therefore, it can take a number of years to reach a final, binding decision.

Related rights

A particularity of Mexican law is its protection of 'reserved rights' ('reserva de derechos'). The Federal Copyright Law grants an exclusive right to use titles, names and distinctive physical and psychological characteristics where they relate to, among other things, real or fictional people, artistic names, or titles of periodical publications or broadcasts. Thus, applicants seeking trademark protection for names and titles for publications or broadcasts and related goods and services in Classes 16, 38 and 41 are also advised to apply for reserved rights.

Cumulative protection for 3D marks

In certain circumstances, threedimensional signs can be protected both as a trademark and as a design, which can be useful if one is unsure whether the sign is distinctive enough to be protected as a mark. If the design is original it may also benefit from copyright protection.

Source: World Trademark Review, Country correspondents, Apr/May 2009.