



ICLG

The International Comparative Legal Guide to:

Trade Marks 2017

6th Edition

A practical cross-border insight into trade mark work

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Mexico



Alonso Camargo



Daniel Sanchez

OLIVARES

1 Relevant Authorities and Legislation

1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Mexican Institute of Industrial Property (IMPI).

1.2 What is the relevant trade mark legislation in your jurisdiction?

The most pertinent legislation is the Industrial Property Law (IPL).

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

In accordance with article 89 of the IPL, all visible signs can be protected, provided that they are sufficiently distinctive and able to identify the products or services to which they apply or intended to apply with respect to those in the same class.

2.2 What cannot be registered as a trade mark?

Olfactory and sound trade marks cannot be protected in Mexico. The limitations as to what cannot be protected as a trade mark are established in article 90 of the IPL, which is a list of prohibitions and the only legal source for rejecting a trade mark application. These prohibitions include:

- marks that are identical or confusingly similar to previously registered marks or marks for which registration is pending or applied to the same or similar products or services;
- descriptive and generic marks;
- geographic indications and names of places that are characterised by the manufacture of certain products; and
- three-dimensional forms of common usage, or because said form is imposed by its nature or industrial function.

2.3 What information is needed to register a trade mark?

The following information is required:

- a) An applicant's full name and street address, including town and country.

- b) Identification of the trade mark.
- c) Description of goods or services.
- d) Use in commerce in Mexico. Non-use basis applications are allowed under Mexican law, since use in commerce is not a requirement for obtaining registration. However, if the trade mark is already in use in Mexico, it is recommended to provide the full date (day, month and year). This first use information becomes relevant for the applicant to be afforded priority rights over future applicants who eventually intend to challenge the registration based on use of a similar trade mark covering similar goods or services.
- e) Factory address, business address or commercial establishment (if the mark is in use in Mexico).
- f) Convention priority: if convention priority is to be claimed, it is required to provide the country of origin, application number, the date of filing and the exact description of goods and services.

2.4 What is the general procedure for trade mark registration?

Once the applications are filed before the IMPI, it takes from four to seven months for the IMPI to conduct the relevant examinations. The first is the formalities examination, whereby the IMPI reviews that all of the formal requirements (information and documents) have been met, and verifies the correct classification of the products/services it is intended to protect. If any formal information or documents are missing, or if the products/services are not correctly classified, a requirement from the examiner regarding formalities will be issued, granting a two-month term that can be automatically extended for a further two months to comply with such requirements. The second examination refers to the relative grounds examination (prior rights on record) and absolute grounds for refusal examination (inherent registrability of the mark). Thus, if prior rights are revealed or an objection concerning inherent registrability of the mark is foreseen, the IMPI would issue an official action, granting a two-month term that can be automatically extended for a further two months to respond thereto.

2.5 How can a trade mark be adequately graphically represented?

For design or composite marks it is necessary to provide a clear print thereof. If specific colours are to be claimed, then the label must clearly show the colours. For three-dimensional marks, it is necessary to submit a photograph showing the three dimensions in the same photo (high, wide and front-back).

2.6 How are goods and services described?

Under Mexican Law and Practice, class headings can be claimed; however, when specific goods or services are not mentioned in particular within the class heading, it is strongly recommended to provide a description including each specific good or service to be protected, using the names of products or services exactly as they appear in the Nice Classification List.

2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A Mexican trade mark registration is valid/enforceable only within the Mexican Republic.

2.8 Who can own a trade mark in your jurisdiction?

Article 87 of the IPL establishes who may use and therefore own a trade mark registration, stating: “industrialists, merchants, or service providers may use trade marks in industry, in commerce or in the services they render”. Nevertheless, the right to their exclusive use is obtained through their registration with the Mexican Institute of Industrial Property (IMPI). In Mexican practice, any kind of person or entity is entitled to apply for a trade mark registration before the IMPI.

2.9 Can a trade mark acquire distinctive character through use?

No. The Mexican IPL does not recognise the so-called “secondary meaning” doctrine.

2.10 How long on average does registration take?

If an application is filed complete and no oppositions are filed, no objections as to inherent registrability are issued and no prior references are cited by the examiner, registration may be granted within five to seven months as of the filing date. Otherwise, if oppositions as filed, if formalities requirements or references/objections are cited by the examiner, the prosecution of the application may become quite long (between 12 to 18 months) and it may conclude either in the granting of registration, or the refusal thereof.

2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

If no classification requirements, oppositions and/or objections to registration are issued, the average costs for obtaining a Mexican non-priority trade mark registration are estimated at US\$750.00.

2.12 Is there more than one route to obtaining a registration in your jurisdiction?

Yes. Besides the National Route, starting on February 19, 2013, it is also possible to obtain a trade mark registration in Mexico through the International (Madrid) System.

2.13 Is a Power of Attorney needed?

It is no longer compulsory to submit a POA along with a trade mark

application, provided that the IMPI will recognise the authority of the representative signing it through a declaration under oath contained in the application form. However, a valid POA must indeed exist, and it should have been granted (dated) prior to the filing of the application, otherwise the declaration contained in the application form in connection with the representation may be deemed false, thus affecting the validity of the eventual registration to be obtained.

2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

A Power of Attorney is not required for trade mark prosecution. However, for litigation purposes notarisation and legalisation is indeed needed.

2.15 How is priority claimed?

It is required to provide in the application form the country of origin, application number, the date of filing and the exact description of goods and services used in the priority application. It is no longer necessary to file a certified copy of the priority application.

2.16 Does your jurisdiction recognise Collective or Certification marks?

Collective marks are indeed recognised by the IPL currently in force. However, Certification marks are not.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

Pursuant to article 90 of the IPL, the following cannot be registered as trade marks:

- Animated or changing denominations, figures or three-dimensional forms.
- Technical or commonly used names of products or services, or generic designations thereof.
- Three-dimensional forms which are part of the public domain or have become part of common use, as well as those which lack distinctiveness, are the ordinary shape of products or are the shape imposed by their nature or industrial function.
- Descriptive marks or indicative words used in trade to designate the species, quality, quantity, composition, end use, value, place of origin of the product or production era.
- Isolated letters, digits or colours, unless combined or accompanied with other elements, such as symbols, designs or denominations, which provide them with sufficient distinctive character.
- Geographic denominations, proper or common, maps and nouns and adjectives, when they indicate the origin of products or services and may lead to confusion or error as to their origin.
- Names of population centres or places that are characterised by the manufacture of certain products, to protect such products.
- Names, figures or three-dimensional forms that could deceive the public or lead to error, understood as those which constitute false indications about the nature, components or qualities of the products or services they purport to protect.

3.2 What are the ways to overcome an absolute grounds objection?

If the examiners consider that the trade mark incurs any of the absolute grounds for prohibition established in the IPL, an official action is issued, granting the trade mark applicant a two-month term that can be automatically extended for a further two months to provide legal arguments against the alleged absolute grounds for refusal and to try to overcome them.

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

If an application is refused by the IMPI based on absolute grounds, the applicant may choose between three different venues to appeal: a review recourse before the IMPI; an appeal before the Federal Court of Tax and Administrative Affairs (FCTA); or an *amparo* suit before a federal district court.

3.4 What is the route of appeal?

I. A review recourse before the IMPI

This is a remedy that must be filed before the IMPI within 15 working days from the day after the date of notification of the refusal. The review recourse is resolved by the administrative superior of the person who issued the denial at the IMPI. A review recourse is only advisable when the denial is founded on a clear mistake of the IMPI (e.g., a denial based on an alleged lack of a particular document when the document was in fact filed).

If the denial is based on any of the absolute/relative grounds for refusal established in article 90 of the IPL, a review recourse is not advisable as it is likely that the superior court will confirm the refusal resolution. The applicant may file an appeal before the FCTA against a decision issued by the IMPI under a review recourse.

II. An appeal before the Federal Court of Tax and Administrative Affairs (FCTA)

The appeal before the FCTA can be filed within 45 working days following the date of the notification of the refusal or the decision of the review recourse. This appeal is decided by an administrative entity (it is not a court of law) that decides whether the IMPI correctly applied the IPL.

Appeals are resolved by three administrative magistrates in public hearings, where the parties may not make oral arguments but can only hear the discussion of the case between the magistrates. All arguments must be submitted in writing during the prosecution of the appeal.

In this appeal, the applicant or appellant must prove that the IMPI's considerations to refuse the application did not comply with the provisions of the IPL. The IMPI will be the counterparty, trying to prove the legality of its refusal.

The losing party can make a final appeal before a federal circuit court against the decision of the FCTA. This appeal must be filed within 10 working days of the day following the notification of the decision to the losing party.

The resolution of the circuit court is final. If the IMPI loses the appeal, it must comply with the resolution within a short period.

III. An *amparo* suit before a federal district court

Due to recent Supreme Court jurisprudence, *amparo* suits are now available as a further venue to appeal refused applications. They can

be filed within 15 working days of the day following the notification of the refusal. The *amparo* is a procedural institution, which makes it highly technical.

One advantage of these proceedings is that, due to the requirements of procedural law, cases are decided in a very short time frame, ranging from two to five months, with stays being studied very quickly (within two days of the filing of a suit). Another advantage is the higher level of preparation of officers and judges at the courts concerning IP affairs.

The main disadvantage is that under the *amparo* law, the judge is bound to first find a clear error in the decision under review and is not entitled to review the case *de novo*; thus, many of the decisions in *amparo* suits are remanded to the IMPI for further consideration, with certain guidelines that can be concerned mainly with the due process of law, although in some cases the judge actually gives guidance on the merits of the case.

Any decisions of the district court can be appealed before a circuit court.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

The relative grounds for refusal are as follows:

- Marks identical or confusingly similar to previously registered marks or marks for which registration is pending, applied to the same or similar products or services.
- Notorious or famous marks, unless applied by the legitimate owner.
- Proper names, pseudonyms, signatures, country flags, symbols, emblems, intellectual property, artworks, etc., without the express consent of the legitimate owner/authority.

4.2 Are there ways to overcome a relative grounds objection?

If the examiners consider any prior mark as a barrier to obtaining registration of the proposed mark, an official action is issued, granting the trade mark applicant a two-month term that can be automatically extended for a further two months to provide legal arguments against the cited mark or marks and to try to overcome them.

4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

If an application is refused by the IMPI based on relative grounds, the applicant may choose between three different venues to appeal: a review recourse before the IMPI; an appeal before the Federal Court of Tax and Administrative Affairs (FCTA); or an *amparo* suit before a federal district court.

4.4 What is the route of appeal?

Please refer to the routes of appeal as explained in question 3.4 above.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

All new applications filed in Mexico as from August 30, 2016 will be published for opposition in the Industrial Property Gazette, and the grounds on which a trade mark can be opposed are all the absolute or relative grounds of refusal as provided in articles 4 and 90 of the IPL.

Article 4 provides that no registration shall be granted when the proposed trade mark is contrary to public order, morals and good customs, or violate any legal provision.

In turn, article 90 provides 17 different grounds for refusal, the most common being: descriptiveness; prior rights as derived from a senior application or registrations for a trade mark identical or confusingly similar covering equal or similar goods or services; and equal or confusingly similar to a famous or well-known trade mark.

5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any person (individual or company) who deems that a published application falls within an absolute or relative ground for refusal as provided in Articles 4 and 90 of the Industrial Property Law.

5.3 What is the procedure for opposition?

The procedure for opposition is as follows:

1. A new application filed in Mexico is published for opposition purposes within the next 10 working days of the filing date.
2. Any interested party may submit a brief of opposition, within a non-extendable, one-month term of publication of the application.
3. The opposition brief shall be accompanied by all documentation supporting the opposition.
4. Once the one-month term for opposition expires, the IMPI will publish all oppositions filed within the next 10 working days.
5. Owners of opposed applications will have a one-month term to raise arguments against the alleged grounds of opposition.
6. It is important to note that the opposition will not suspend prosecution of the applications, as the IMPI will continue to conduct its official examination of trade mark applications on both absolute and relative grounds, in parallel with the opposition proceeding.
7. It will be optional for the IMPI to consider the arguments submitted by the opponent in an opposition, as well as the defensive arguments raised by the applicant, and no decisions will be specifically issued over the opposition. Therefore, a successful opposition may result in the refusal to register, thus an unsuccessful opposition may result in the granting of the registration.

6 Registration

6.1 What happens when a trade mark is granted registration?

Once a trade mark registration is granted, the rights conferred to its owner enter into full force and effect. In order to maintain such registration, it is necessary to have use of the trade mark in Mexico

within a term of three consecutive years, counted as of its date of grant, and for further terms of three years, otherwise the registration will become vulnerable to cancellation actions based on non-use. It is important to note that if the registration is not used and not contested by any third party, it is in full force until its renewal time.

6.2 From which date following application do an applicant's trade mark rights commence?

Once it is granted, the full effects of a trade mark registration go back to its filing date.

6.3 What is the term of a trade mark?

Ten years as of the filing date, renewable for 10-year periods.

6.4 How is a trade mark renewed?

The only requirement established in the IPL for renewal purposes is that the registered trade mark is used at least within a term of three consecutive years prior to petitioning renewal, otherwise the renewal will not be warranted and the registration would lapse. No proof of use is required. The renewal application includes a declaration under oath that the mark has been used according to the terms provided by the IPL.

7 Registrable Transactions

7.1 Can an individual register the assignment of a trade mark?

Yes. The IPL establishes that the rights deriving from an application for trade mark registration or from a registered trade mark can be transferred in the terms of, and with the formalities established by, civil law. The transfer of rights must be recorded with the IMPI to be effective against third parties.

7.2 Are there different types of assignment?

There is only one special rule in the IPL for cases of transfer, and it refers only to mergers. In the case of a merger, the IPL assumes that all of the trade marks of the merger company are transferred to the merging company, unless stipulated otherwise. In this case, the merger also has to be recorded before the IMPI to have legal effect against third parties.

7.3 Can an individual register the licensing of a trade mark?

Yes, in our jurisdiction the licence to use a mark can be recorded, so it can be enforced against third parties. Pursuant to the provisions of the IPL, licence agreements must be recorded in order that the use of the trade mark by the licensee inures to the benefit of the registration, thus preventing its cancellation on account of non-use.

Notwithstanding the above, pursuant to the North American Free Trade Agreement (NAFTA) and the Trade Related aspects of Intellectual Property (TRIPS) – which both have a higher grade in our legal system than the IPL – the recording of a licence agreement is not required to prove the use of a trade mark through a party (authorised user) different than the owner, *when the use is made*

under the control of the trade mark owner. Thus, in the case of facing cancellation actions on a non-use basis where the mark has not been used directly by the owner but by an authorised third party, it is possible to raise this argument, which has been admitted by the Mexican Trademark Office (IMPI) and the Federal Courts in previous cases.

In this scenario, however, the defendant will have to prove in the litigation that the use made by the third party was indeed conducted under the control of the trade mark owner, whereas in the case of a recorded licence agreement, the defendant will only have to prove the licence was made of record.

7.4 Are there different types of licence?

Yes. For recording purposes, it is important to distinguish between exclusive and non-exclusive licences.

7.5 Can a trade mark licensee sue for infringement?

Yes. Provided that the licensor authorises so in the deed of the licence agreement.

7.6 Are quality control clauses necessary in a licence?

Yes. However, for recording purposes with the IPL, it is possible to submit a short version of the original licence agreement, in which any confidential clauses regarding royalties, distribution and commercialisation means, technical information, quality control requirements and the like may be omitted.

7.7 Can an individual register a security interest under a trade mark?

Yes. Security interests are recognised by the IPL only for recording purposes.

7.8 Are there different types of security interest?

Security interests are regulated under the provisions of the Law of Titles and Credit Operations, which is of a mercantile nature, as well as the Commerce Code under the chapter, ‘Security interests without the transmission of possession’.

8 Revocation

8.1 What are the grounds for revocation of a trade mark?

There are no revocation proceedings in the Mexican system; however, cancellation actions are available. Article 130 and section I of article 152 of the IPL establish that if a trade mark is not used for three consecutive years on the products or services for which it was registered, the trade mark registration will be subject to cancellation for lack of use, unless the holder or the user of a recorded granted licence has used it during the three consecutive years immediately prior to the filing date of the cancellation action for lack of use.

Therefore, if a registered trade mark is not used for three consecutive years, it will become contestable on account of non-use.

Furthermore, a cancellation action can be brought against a registration when the owner of it has provoked or tolerated a trade mark that has become a generic term.

8.2 What is the procedure for revocation of a trade mark?

Cancellation procedures are filed and prosecuted directly at the IMPI. However, the decision of the IMPI may be appealed by recourse to a review before the IMPI or before the FCTA, and the decision of this court may be further appealed before a circuit court.

8.3 Who can commence revocation proceedings?

Legal standing to file a cancellation action is achieved when the trade mark to be challenged is cited during the prosecution of an identical or a confusingly similar trade mark. It is also achieved when the trade mark registration is enforced against a third party in an infringement action.

8.4 What grounds of defence can be raised to a revocation action?

The trade mark owner may argue that, independently of his will, circumstances arose that constituted an obstacle to the use of the trade mark, such as importation restrictions or other governmental requirements applicable to the goods or services to which the trade mark applies.

8.5 What is the route of appeal from a decision of revocation?

Please see question 3.4 above.

9 Invalidity

9.1 What are the grounds for invalidity of a trade mark?

The grounds of invalidation are established by the IPL in article 151, when:

- the trade mark is identical or confusingly similar to another one that has been used in Mexico or abroad prior to the date of filing of the application, and it is applied to the same or similar products or services, provided that the party who asserts the greater right for prior use proves they have used the trade mark continuously in Mexico or abroad prior to the mentioned filing date or declared use, then the applicable statute of limitations is three years as of the date the Trademark Gazette that published the disputed registration was put into circulation;
- the registration was granted on the basis of false information mentioned in the application. The applicable statute of limitations is five years as of the date the Trademark Gazette that published the disputed registration was put into circulation;
- the existence of a senior registration for a trade mark identical or similar to that covered by a junior registration, and the goods or services covered thereby are similar or identical in nature. The applicable statute of limitations is five years from the publication date of the Trademark Gazette detailing the disputed registration;
- registration is obtained by the agent, representative, user or distributor without the authorisation of the owner of the foreign trade mark registration. No statute of limitations applies to this action; or

- a general cause of invalidity is available and it relies on the granting of registration against any provision of the IPL or of the law in force at the time registration was granted. This cause of cancellation has no statute of limitations.

9.2 What is the procedure for invalidation of a trade mark?

Invalidation proceedings in Mexico are of an administrative nature as they are prosecuted at the Mexican Institute of Industrial Property (IMPI), though these are followed in the form of a trial. They start by filing a complete claim, enclosing all evidence supporting the invalidation grounds. Thereafter the IMPI serves notice to the defendant, who has a term of 30 days from the service date to respond thereto. A copy of such response is served to the plaintiff, who has three days for filing allegations against thereto. In turn, the allegations for the plaintiff are served to the defendant for filing counter allegations within a term of three days. Thereafter, the IMPI issues a decision.

9.3 Who can commence invalidation proceedings?

Any party with sufficient legal interest. Legal interest for invalidity actions varies depending on the cause of action enforced.

9.4 What grounds of defence can be raised to an invalidation action?

This is not applicable to Mexico.

9.5 What is the route of appeal from a decision of invalidity?

The decisions of the IMPI regarding invalidity may be appealed by the counterparty either through: a review recourse before the IMPI; an appeal before the Federal Court of Tax and Administrative Affairs (FCTA); or an *amparo* suit before a federal district court. Please refer to question 3.4 above.

10 Trade Mark Enforcement

10.1 How and before what tribunals can a trade mark be enforced against an infringer?

The prosecution of an infringement claim before the IMPI is rather simple, and it begins with the filing of a formal written claim. The IMPI is not a court of law; it is an administrative agency that has jurisdiction over trade mark infringement in the first instance.

Once the IMPI admits the claim, it serves notice to the defendant, giving a term to answer of 10 days; the defendant is to answer the claim alleging whatever it is deemed pertinent, and thereafter the IMPI decides on the merits of the case. Both the plaintiff and the defendant must produce supporting evidence at the time of filing the claim or answering it, respectively. The IMPI's decision can be appealed before the Federal Court of Tax and Administrative Affairs (FCTA). The decision of this administrative court can be appealed to a circuit court.

To prove the infringement, the plaintiff is entitled to file any kind of evidence available except confessional and testimonial evidence. The most commonly used evidence to help prove an infringement is an inspection visit to the premises of the infringer. This is conducted

by IMPI inspectors and it usually takes place at the moment of serving notice of the claim and/or the order imposing a preliminary injunction on the defendant.

10.2 What are the pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

This is not applicable to Mexico.

10.3 Are (i) preliminary and (ii) final injunctions available and if so on what basis in each case?

The trade mark owner is entitled to request provisional injunctions before the filing of the infringement claim, or at any time during the prosecution thereto against infringers. The authority of the IMPI is quite broad and discretionary as it, among others, can order an alleged infringer to stop or cease from performing their infringing activities. It can also impose that products are withdrawn from the marketplace, and conduct seizures. The proceeding is *inaudita altera pars* with no formal hearing, as it is followed in writing. The trade mark owner, as the party moving for the application of preliminary measures, is required to file an infringement claim within a term of 20 business days after the measures are duly notified to the alleged infringer. Likewise, preliminary injunctions are confirmed and become a permanent injunction only once the infringement action is resolved.

10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

The plaintiff in an infringement action is entitled to request from the defendant all the documentation in its possession necessary to help prove the infringement. The plaintiff must request from the IMPI the issuance of an order addressed to the defendant requesting this documentation, pointing out exactly what documents he/she is pursuing and the importance and relevance of them to the prosecution of the infringement case. In case of a lack of compliance with this order, a fine will be imposed on the defendant and the facts that the plaintiff were seeking to prove with the documentation requested will be considered proved.

10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Everything must be submitted in writing.

10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

In case of counterclaiming the validity of the trade mark registration enforced, this action is resolved before resolving the infringement claim. Counterclaims must be filed at the moment of responding to the infringement action.

10.7 After what period is a claim for trade mark infringement time-barred?

This is not applicable to Mexico.

10.8 Are there criminal liabilities for trade mark infringement?

Yes, criminal liabilities are available for trade mark falsification/counterfeit.

10.9 If so, who can pursue a criminal prosecution?

Either the trade mark owner or the recorded licensee.

10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

This is not applicable to Mexico.

11 Defences to Infringement

11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Prior use: the use of the same or a confusingly similar mark on the national territory for the same or similar products or services, provided that the third party had begun to make uninterrupted use of the mark prior to the filing date of the application for registration, or the date of the first declared use of the mark.

Exhaustion of rights: any person may market, distribute, acquire or use the product to which the registered trade mark is applied, after said product has been lawfully introduced on to the market by the owner of the registered mark or his licensee. This case shall include the import of lawful products to which the mark is applied.

11.2 What grounds of defence can be raised in addition to non-infringement?

The most common defence is challenging the validity of the trade mark registration enforced.

12 Relief

12.1 What remedies are available for trade mark infringement?

Preliminary and permanent injunctions. Please see question 10.3 above.

12.2 Are costs recoverable from the losing party and if so what proportion of the actual expense can be recovered?

They are available to the trade mark owner through civil actions. Civil actions are filed once an administrative action has been resolved beyond the shadow of appeal. The IPL provides a rule, applicable in all types of patent, trade mark and copyright infringement actions, imposing on the civil courts the obligation of imposing monetary damages of at least 40% of the commercial value of the infringing products.

13 Appeal

13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

For the process of appeal, please see question 3.4 above.

13.2 In what circumstances can new evidence be added at the appeal stage?

In the case of appealing any decision of the IMPI before the FCTA, the appellant is entitled to file new evidence and to submit new arguments.

14 Border Control Measures

14.1 What is the mechanism for seizing or preventing the importation of infringing goods or services and if so how quickly are such measures resolved?

The IMPI's personnel, per request of the trade mark owner or as a consequence of an infringement action, may conduct a search to summon the importer and to seize goods in customs premises. This option is also available for criminal cases.

Mexican customs, with the IMPI, developed a database to improve the protection of Intellectual Property rights. When the trade marks are registered at the database, customs provides a folio to be used in the import manifesto to ease the transit of the goods bearing the trade mark. When a manifesto does not bear a registration folio, or it does not match the information in the trade mark database, the shipment will be stopped and inspected by customs, and it will notify the trade mark owner for advice on the goods' authenticity.

15 Other Related Rights

15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Only registered trade marks are enforceable.

15.2 To what extent does a company name offer protection from use by a third party?

A registered mark or a mark confusingly similar to another previously registered mark may not be used or form part of the trade name or company or business name of any establishment or legal entity where the establishments or legal entities concerned are engaged in the production, import or marketing of goods or services identical or similar to those to which the registered trade mark applies.

15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Book titles and, in general, titles of any work of authorship are enforceable against trade mark registrations.

16 Domain Names

16.1 Who can own a domain name?

Any individual or legal entity that requests the registration of the domain name before any of the registrars.

16.2 How is a domain name registered?

There is only the need to verify the availability of the name you want to register at the webpage of any of the registrars authorised by the Internet Corporation for Assigned Names and Numbers (ICANN).

If the name is available, you will have to pay the corresponding fees to the registrar and to provide the administrative, technical and contact information for the domain name.

The registrar will keep records of the contact information and submit the technical information to a central directory known as the Registry.

16.3 What protection does a domain name afford *per se*?

Obtaining registration for a domain name will avoid anyone else registering the same name with the same ending (gTLDs or ccTLDs). In other words, you will protect your name (company name, individual name or trade marks) on the Internet.

No other protection will be granted with the registration of the domain name. This is very important, because no intellectual property rights will be generated.

17 Current Developments

17.1 What have been the significant developments in relation to trade marks in the last year?

The introduction of an opposition system in Mexican Trademark Law.

17.2 Please list three important judgments in the trade marks and brands sphere that have issued within the last 18 months.

There are none.

17.3 Are there any significant developments expected in the next year?

No significant developments are foreseen.

17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

Recording trade marks with the customs authorities. Please see section 14, above.

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Alonso Camargo obtained his J.D. degree from Universidad Iberoamericana (UIA) in 1998, and later received his Master's in Intellectual Property Law and Information Society Law from Universidad de Alicante (Magister Lvcentinvs) in Spain. Mr. Camargo is the author of several articles related to trade mark procurement and litigation in publications such as *Managing Intellectual Property* and *IAM Magazine*, among others. He is a member of the *Asociación Mexicana para la Protección de la Propiedad Intelectual* (AMPPI), as well as various other associations for Intellectual Property Law, including the International Trademark Association (INTA), the European Community Trademark Association (ECTA) and MARQUES. Mr. Camargo is an experienced intellectual property attorney and has dedicated much of his career to this specialty, with a particular focus on trade mark law, both in prosecution and litigation.

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Daniel Sanchez joined OLIVARES in 2000 and became a partner in 2011. He is one of the most sought-after IP and administrative litigators in Mexico, and his expertise is recognised by many industry rankings and titles.

He has vast experience in the prosecution and litigation of all areas of intellectual property. The broad nature of his background allows him to build enforcement strategies that take on a series of different angles.

At OLIVARES, Mr. Sanchez co-chairs the Litigation team and the Patent team. Also he is one of the few true regulatory and administrative litigation experts in Mexico.

His group of litigation attorneys is specifically focused on litigation before the Mexican Institute of Industrial Property (IMPI) and the Federal Courts, and his patent group is focused on electrical, mechanical and IT Technologies.

He has chaired the Intellectual Property Committee of the Mexican Bar Association since 2015 and was VP of the Mexican Association for the Protection of Intellectual Property (AMPPI) from 2013 to 2016. He is also member of the International Trademark Association (INTA), the Biotechnology Innovation Organization (BIO) and the International Association for the Protection of Intellectual Property (AIPPI) and participates as an observer at the Asian Patent Attorneys Association (APAA).



OLIVARES began in 1969 as an intellectual property boutique. Today, the IP Practice serves many different industries, receives numerous awards for excellence in legal services, and leads the charge in protecting clients' valuable IP assets. Whether navigating complex pharmaceutical patent regulations, developing trade mark protection strategies or litigating copyright disputes, OLIVARES gets results.

The Trademark Group has won various awards, including *Managing IP* magazine's Trademark Award. Additionally, OLIVARES is the only firm to be ranked in the top tier of *Chambers Latin America* and *Managing IP*'s ranking systems.

Having been in business for over 40 years, OLIVARES continues its legacy of excellence in client service and attracts clients from all areas of Mexico, in addition to international clients needing counsel regarding Mexican laws, regulations and cases.

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