

Legal standing in trademark non-use cancellation actions in Mexico

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Jaime Rodríguez of OLIVARES explains the implications of the revocation by the Mexican Federal Court of Administrative Affairs of the criteria commonly used to allow complainants to credit their legal standing on trademark non-use cancellation proceedings.

In recent years, the Mexican Patent and Trademark Office (IMPI) has allowed complainants to credit their legal standing on trademark non-use cancellation proceedings through the existence of a trademark application without the need to initially demonstrate that the application's registration was blocked in view of the prior existence of third parties' confusingly similar registered marks. This was provided that the official action citing the conflicting registration as a pertinent barrier was submitted as subsequent evidence in the proceedings.

Accordingly, it became common practice to file non-use cancellation actions and submit as evidence a certified copy of the trademark application. This served as a basis to attack the registration not being used accompanied with the results of an availability search showing the existence of the registration subject to the proceedings.

Nonetheless, such criteria adopted by IMPI were revoked by the Federal Court of Administrative Affairs and by federal circuit courts, which sustained that legal standing must be credited initially along with the complaint. Furthermore, it would not be possible to do it at a later stage by submitting the evidence attesting that IMPI rejected the registration of the complainant's trademark application on the ground of likelihood of confusion because of the existence of the defendant's registration.

The court's reasonings behind the revocation of such criteria were mainly based on legal certainty arguments stating that legal standing can only be borne when a formal objection is raised by IMPI communicating to the applicant the existence of a citation based on the likelihood of confusion.

Therefore, IMPI is starting to analyse and resolve non-use cancellation actions following the court's legal reasonings stating that legal standing must be credited initially along with the complaint, and complainants cannot credit such standing subsequently.

Consequently, it is advisable that titleholders file non-use cancellation actions only after being served with the official actions communicating the existence of pertinent barriers blocking the registration.



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