

OLIVARES



OLIVARES®
we know

Lack of Specificity in the Description of Goods and Services as a Ground for Nullity of Trademark Registrations.



Jaime Rodriguez
OLIVARES Partner

Jaime Rodriguez joined OLIVARES in 2007 and became a partner in 2023. He has extensive experience in copyright, litigation, trademarks, unfair competition and domain name dispute resolution, and this versatility has allowed him to participate in a variety of relevant matters and cases pertaining to different areas of intellectual property.



Ana Sofia Perez **OLIVARES Legal Intern**

Ana Sofía Pérez joined Olivares in September 2026 and is part of the Litigation team. Her professional practice focuses on the preparation of intellectual property litigation, including administrative proceedings, as well as regulatory matters.

I. INTRODUCTION

Trademark registration grants its holder exclusive rights in relation to specific goods or services. To clearly define the scope of such protection, the Federal Law for the Protection of Industrial Property requires that the goods or services covered by a trademark registration be identified with sufficient specificity.¹ This requirement is particularly relevant when broad terms are used, as they may involve goods or services that differ significantly in their nature, purpose, or relevant markets.

Merely identifying a class that includes goods or services of different natures or purposes is insufficient. Instead, the specific goods or services for which protection is requested must be identified with the greatest possible degree of specificity. This requirement is essential to safeguarding legal certainty, preserving the availability of trademark registrations, and preventing overly broad registrations from unduly restricting market access. Otherwise, vague or indeterminate descriptions could extend trademark protection beyond its legitimate scope, restrict free trade, and confer unjustified exclusive rights that undermine fair competition.

Although closely related, the requirement of specificity in the description of goods or services and the principle of specialty serve distinct legal purposes. The first refers to identifying with pinpoint precision what is being protected, avoiding terms that are too general, vague, or ambiguous; while the second defines the scope of the exclusive right derived from this protection, as opposed to other goods or services.

In this regard, a sufficiently precise description is essential for the proper application of the principle of specialty, as it makes it possible to determine with certainty which goods or services actually fall within the scope of trademark protection.²

This relationship is particularly relevant in the technology field. Terms such as “software”, “computer programs”, or “Software as a Service (SaaS)” can cover a wide variety of goods and services with completely different functions, purposes, and markets. Thus, the use of overly broad descriptions can make it difficult to define the scope of the exclusive right and lead to disputes regarding goods or services that, although they may interact technically, do not necessarily have a sufficient commercial relationship to justify being considered similar.

¹ Mexican Congress. (2020). *Federal Law for the Protection of Industrial Property* (Arts. 171, 176, 214, 233, and 237). Official Gazette of the Federation.

² Murrieta, F. (2021). “Criteria on the Principle of Trademark Specialty in Mexico”. *Revista Abogacía*.

This issue has become increasingly significant as digital markets continue to evolve. Recent judicial precedents in Mexico highlight the importance of precisely identifying the subject matter of trademark protection and raise an additional question: *What are the legal consequences of a trademark registration that fails to identify the protected goods or services with sufficient specificity to clearly delimit the scope of the exclusive rights conferred?*

Based on this question, this article intends to analyze whether a lack of specificity in the description of goods or services may constitute a violation of trademark law that could result in the nullity of the registration. To this end, the article will examine the relationship between the specificity requirement and the principle of specialty; recent judicial rulings regarding the scope of registrations in technology markets; the treatment of broad descriptions; and the limits that the current regulatory framework and administrative criteria impose on the possibility of asserting such an irregularity as grounds for nullity.

II. THE PRINCIPLE OF SPECIALTY IN THE CONTEXT OF BROAD DESCRIPTIONS AND TECHNOLOGICAL EVOLUTION

On September 4, 2026, the Twentieth Collegiate Court in Administrative Matters of the First Circuit issued its ruling in amparo claim 170/2021, establishing three judicial criteria concerning the application of the principles of specialty and specificity in the context of evolving technological and digital markets.

The case originated from an administrative declaration of nullity action filed by the holder of the trademark “*ROCKSTAR*” *AND DESIGN*, registered on February 28, 2000, covering, among other goods, “*information processing equipment and computers*”. The action was brought against the subsequent registration of the trademark “*ROCKSTAR TV*,” registered on November 15, 2016, for “*computer game software downloadable from a global computer network*”. The plaintiff argued that the goods covered by both registrations were similar due to their complementary nature.

The administrative authority denied the requested declaration of nullity. Dissatisfied, the plaintiff filed a nullity claim before the Specialized Chamber for Intellectual Property Matters of the Federal Administrative Court of Justice.

The Chamber determined that the administrative authority had improperly defined the goods protected by the earlier registration and consequently annulled the challenged ruling. However, upon analyzing the merits of the dispute, it concluded that the goods in question were not similar to the point of causing confusion. This determination led to the filing of an amparo claim.

The Circuit Court confirmed that the scope of trademark protection cannot be determined independently of the technological and commercial environment in which the relevant goods operate. In particular, it established three relevant considerations for applying the principle of specialty in technology markets: (i) the categories covered by a registration must be interpreted in light of the technological context existing at the time of its grant and the current structure of the market;³ (ii) mere interaction or technical compatibility between two products is insufficient to establish complementarity and, consequently, similarity;⁴ and (iii) technological developments may give rise to new categories of goods and services that should not automatically be deemed covered by descriptions formulated in an earlier technological context⁵.

The first of these criteria is particularly relevant because it prevents the literal scope of a registration description from automatically translating into an equally broad scope of the exclusive right. Thus, a category formulated in general terms cannot be interpreted in isolation from the context in which it was entered in the registry, particularly when there has been a significant transformation in the market between the time of registration and the product subsequently compared.

³ CC (2026). **"TRADEMARKS. THE PRINCIPLE OF SPECIALTY MUST BE APPLIED IN LIGHT OF THE EVOLUTION OF THE TECHNOLOGICAL CONTEXT, WITHOUT EXTENDING THE SCOPE OF THE REGISTRATION TO SUBSEQUENTLY DEVELOPED DIGITAL CATEGORIES OR EQUATING PRODUCTS BASED ON ONE OF THEIR POSSIBLE USES OR MERE TECHNICAL INTERACTION."** Non-binding judicial precedent, Digital Registration No. 2032590. Semanario Judicial de la Federación.

⁴ CC ((2026). **"TRADEMARKS. COMPLEMENTARITY BETWEEN PRODUCTS IN TECHNOLOGICAL ENVIRONMENTS DOES NOT ARISE FROM MERE FUNCTIONAL INTERACTION, BUT RATHER WHEN A RELATIONSHIP OF NECESSARY COEXISTENCE EXISTS BETWEEN THEM (INTERPRETATION OF ARTICLE 151, SECTION IV, OF THE INDUSTRIAL PROPERTY LAW IN FORCE IN 2016)."** Non-binding judicial precedent, Digital Registration No. 2032591. Semanario Judicial de la Federación.

⁵ CC (2026). **"INDUSTRIAL PROPERTY. THE EXPONENTIAL EVOLUTION OF THE DIGITAL ECOSYSTEM PREVENTS DESCRIPTIONS CONCEIVED IN AN EARLIER TECHNOLOGICAL CONTEXT FROM ENCOMPASSING SUBSEQUENTLY DEVELOPED CATEGORIES OF GOODS AND SERVICES THROUGH AN EXTENTION INTERPRETATION."** Non-binding judicial precedent, Digital Registration No. 2032596. Semanario Judicial de la Federación.

In this regard, the Court held that the principle of specialty must be applied by reference to the goods covered by the registration, without replacing their description with any of the numerous potential uses they may have. Accordingly, similarity cannot be established solely based on a shared purpose, the possibility of interaction between products, or their technical compatibility. Such an interpretation would allow the scope of trademark protection to expand progressively as technological developments introduce new functions for existing products, even where those functions do not correspond to the subject matter originally protected.

This consideration is particularly relevant to technological products, whose multifunctional nature makes it possible to establish numerous connections between otherwise distinct categories. A computer, for example, may be used to run video games, reproduce audiovisual content, conduct financial transactions, access e-commerce platforms, or operate specialized software. However, these potential uses do not establish that all such goods or services are similar to computer equipment for trademark purposes.

Consequently, the Court held that similarity must be determined through a concrete analysis of the goods in question, taking into account factors such as their nature, objective, use, complementarity, target audience, and distribution channels. Belonging to the same international class is also insufficient to establish similarity, since goods with substantially different characteristics and commercial purposes may coexist within the same class.

Furthermore, the Court paid particular attention to complementarity, noting that this is not established merely by the possibility of interaction between two products, but rather when there is a necessary relationship of coexistence that reveals a degree of economic and commercial dependence between them. This distinction takes on special relevance in the digital ecosystem, where virtually any device can interact with multiple programs, applications, platforms, and services without this implying that they all form part of the same commercial offering or that the consumer attributes a common business origin to them.

Finally, it held that technological development can give rise to commercially and functionally distinguishable categories of products and services that did not exist, or did not have the same characteristics at the time a prior registration was granted. Consequently, a broad registered designation cannot automatically be interpreted as covering any subsequent technological development that bears some relation to it.

Precisely for this reason, the Court held that the term “*information processing equipment and computers*” should be understood considering the technological context existing at the time the registration was granted in 2000, when that description referred essentially to physical equipment intended for information processing. Its broad scope did not allow for the automatic conclusion that it included the “*computer game software downloadable from a global computer network*” protected by the later registration. Likewise, the Court established that the plaintiff asserting similarity must prove that the later technological category was reasonably foreseeable within the context of the original registration.

This conclusion is relevant to the issue of specificity in the description of goods and services, which is the central focus of this article. If the principle of specialty requires identifying which goods are actually protected in order to define the scope of the exclusive right enforceable against third parties, the precision with which these goods are described has consequences that extend beyond the examination of an application. An overly broad description can create uncertainty regarding the true scope of the registration and allow the registrant to seek to extend its effects to goods or services other than those that originally justified its protection.

III. JUDICIAL PRECEDENTS

The issues arising from broad descriptions of technological products can be observed in amparo claim No. 514/2025, ruled by the Fourth Collegiate Court in Administrative Matters of the First Circuit on November 13, 2025. The case involved two registrations belonging to different international classes: on the one hand, an earlier registration in **Class 9** that generically covered “*software, including downloadable computer applications*”; and, on the other hand, a later registration in **Class 35** for *retail sales and marketing services for beverages and snacks, through in-person and/or online sales using an e-commerce platform* that connects consumers with stores offering same-day delivery.

The holder of the earlier registration filed an administrative declaration of nullity action before the Mexican Industrial Property Institute (“MIPI”) against the subsequent registration, pursuant to Article 258, Section IV, of the Federal Law for the Protection of Industrial Property⁶ (“LFPPI”). The action was based on the existence of a prior valid trademark registration, the alleged confusing similarity

⁶ Article 258. A trademark registration shall be declared null when: (...) IV. It was granted due to error, inadvertence, or a difference in assessment, despite the existence of an earlier-filed pending application or a valid registration whose rights are considered to have been encroached upon, where the trademark is identical or confusingly similar and is used in connection with identical or similar goods or services. Partial nullity of the registration may be declared solely with respect to the goods or services covered by such registration.

between the signs, and the similarity between the goods and services covered by both registrations, notwithstanding their classification in different international classes. The MIPI denied the requested declaration of nullity, finding that the signs were not used in connection with identical or similar goods or services. The Specialized Chamber for Intellectual Property Matters subsequently upheld that determination.

One of the central issues in the dispute was determining the extent of protection conferred by a registration broadly covering “*software*”. The petitioner for nullity argued that the “*e-commerce services*” protected by the later trademark were functionally and commercially related to *software*, since the platform through which they were provided required applications, digital interfaces, and computer systems to operate. Consequently, she argued that both converged in the same digital environment, could share the same consumer base and distribution channels, and had a complementary relationship capable of creating an association regarding their business origin.

The dispute thus involved two competing interests inherent in trademark law: (i) the exclusive rights of the earlier trademark holder against the subsequent registration of a confusingly similar sign for similar goods or services; and (ii) the need to prevent the broad expression “*software*” from conferring a monopoly over any activity that relies on technology for its provision. Indeed, the Specialized Chamber had considered that recognizing similarity merely because the services covered by the subsequent trademark relied on an e-commerce platform would effectively prevent the registration of distinct goods or services solely because they employed a technological tool.

The Circuit Court, however, reached a different conclusion. First, it recalled that the applicable legislation requires the identification of the specific goods or services for which trademark protection is required and that, pursuant to the principle of specialty, a registration protects only those expressly covered by its registration certificate. The purpose of this requirement is to delimit the exclusive right, allow the coexistence of signs distinguishing sufficiently different goods or services, and provide legal certainty regarding the subject matter of protection.

However, the Court clarified that the specificity requirement does not prevent protection from extending to different goods or services when there is a sufficiently close relationship between them that could give rise to confusion or association regarding their commercial origin. Therefore, the fact that they belonged to different

international classes was not decisive; it was necessary to specifically analyze the nature, intended purpose, use, competitive or complementary nature, target audience, and distribution channels of the goods and services in question.

In applying these factors, the Court concluded that there was a sufficiently close relationship between the *software* and downloadable applications in Class 9 and the e-commerce services in Class 35. It found that, in today's market, numerous e-commerce platforms operate through downloadable applications and that consumers may associate the application through which they access the service with the company providing the service itself. Furthermore, both may be directed at the average digital consumer and appear on the same channels, such as app stores, websites, and digital platforms.

Finally, the Court erroneously held that the *software* was not merely an ancillary tool for the e-commerce service, but rather the indispensable technological means for its operation. The application enabled the management of orders, payments, geolocation, notifications, merchants, logistics, and users, such that the service could not operate independently of the IT infrastructure. From this perspective, there was a sufficiently close functional and commercial relationship for consumers to consider that the software and the service originated from the same business entity.

Consequently, the Court determined that although the products and services belonged to different classes, there was complementarity and overlap in the target audience and marketing channels.

On that basis, the Court considered the requirements of the ground set forth in Article 258, Section IV to be satisfied: (i) the existence of a prior valid registration; (ii) phonetic similarity between the signs to the point of causing confusion; and (iii) similarity, complementarity, or interference between the protected goods and services. Consequently, the Court granted the amparo, ordering that the challenged ruling be set aside and that a new ruling be issued recognizing that the necessary conditions for declaring the subsequent registration null and void had been satisfied.⁷

⁷ It should be noted that the ruling included a dissenting opinion. The dissenting judge considered that software and food and beverage retail services differed in their nature, purpose, distribution channels, and consumers, and that the complementarity recognized by the majority did not exist. This divergence demonstrates that the breadth of the term "software" allows for differing interpretations of the scope of trademark protection, thereby reinforcing the importance of the specificity requirement.

In this regard, the effects of the ruling highlight the substantive importance of the specificity requirement. If the scope of a trademark must be defined by the goods or services actually protected, the precision of its description ceases to be a merely formal matter and has consequences for third parties. The broader that description is, the larger the range of goods or services may be against which similarity, complementarity, or a risk of association may subsequently be invoked. Precisely for this reason, it is necessary to analyze whether specificity is merely a requirement that must be verified during the registration process or whether failure to meet it can affect the very validity of the granted right.⁸

IV. KIRA v. QIRA and the Scope of “Software” Category

The issue regarding the scope of trademark descriptions in the technology sector is not unique to the Mexican system. Recently, the First Board of Appeal of the European Union Intellectual Property Office (“EUIPO”), in Case **R 1989/2025-1, KIRA / QIRA**, identified the existence of conflicting criteria regarding the scope of protection conferred by general terms such as “*computer software*” and “*Software as a Service (SaaS)*”, as well as regarding their possible similarity to goods belonging to other economic sectors.

The case arose from an application filed to register the trademark **KIRA**, among other things, for *software related to autonomous driving* in Class 9 and *vehicles, including autonomous vehicles*, in Class 12. Objecting to the application, the holder of the prior trademark **QIRA**, registered, among other goods and services, for “*computer software*” in Class 9 and “*Software as a Service (SaaS)*” in Class 42, filed an opposition to the registration of KIRA.

The Opposition Division found that Class 12 vehicles were distinct from the software and services protected by QIRA. In particular, it held that they differed in purpose, use, distribution channels, and business origin, and that there was no competitive or complementary relationship between them. In the Division’s view, the fact that software is a necessary component of numerous products -*including vehicles*- does not allow them to be considered similar, as such reasoning would lead to the conclusion that virtually any product incorporating software would be similar to the software itself.

⁸ CC (2025). Ruling in Amparo claim No. 514/2025. Federal Judiciary of Mexico.

Dissatisfied, the holder of the QIRA trademark challenged that determination, arguing that, especially in the case of autonomous vehicles, the *software* is not merely an accessory but an essential component for their operation. To support its position, it cited three previous precedents by the Boards of Appeal -*VDL E-POWER*, *XS DIRECT*, and *XS*- in which a similarity had been recognized between Class 9 software and Class 12 vehicles. On the other hand, the holder of the Kira trademark cited *PONS/PONS SEGURIDAD VIAL*, in which a Board of Appeal had reached the opposite conclusion.

A. The VDL E-POWER, XS DIRECT, and XS Precedents

An initial line of rulings held that, under certain circumstances, *software* and vehicles could be considered similar products.

In the **VDL E-POWER/e-POWER** case, dated October 20, 2020, products related to vehicles and electrical systems were compared, including *software* for operating vehicles and programs designed for autonomous driving. The First Board of Appeal based its decision on the existence of identity or, at least, a certain degree of similarity between the compared products. The case subsequently reached the General Court of the European Union, which dismissed the appeal filed against the Board of Appeal's decision.

This same approach was subsequently followed in the cases of **XS DIRECT/XS**, dated June 3, 2021, and **XS/XS**, dated September 9, 2021. The First Board of Appeal itself, in KIRA/QIRA, expressly identifies these three precedents as decisions in which it was concluded that "*computer software*" in Class 9 was similar to vehicles in Class 12.

This initial line of interpretation acknowledges that the functional integration of *software* into certain products can become relevant when comparing goods that formally belong to different categories.

B. The PONS/PONS SEGURIDAD VIAL Precedent

This consistency was broken by the decision in the **PONS/PONS SEGURIDAD VIAL** case, dated March 13, 2023. In that case, the Fourth Board of Appeals rejected the existence of similarity between software in Class 9 and vehicles in Class 12, departing from the conclusion reached in previous precedents.

This approach is particularly significant because it demonstrates that the incorporation or use of software in a product does not automatically establish trademark similarity. In other words, a technological relationship between the two does not necessarily imply that they share the same nature, purpose, marketing channels, relevant audience, or business origin.

This position aligns with the one subsequently adopted by the Opposition Division in KIRA/QIRA: the mere fact that a final product contains software is not sufficient to establish similarity, as a contrary interpretation would allow the protection of “software” to be extended to virtually any digitized economic sector.

Thus, when the KIRA/QIRA case reached the First Board of Appeal, two incompatible criteria coexisted: one that recognized similarity between software and vehicles, and another that rejected it. The Board itself expressly acknowledged this divergence.

C. KIRA/QIRA: Current Status

However, the significance of KIRA/QIRA for the issue of distinctiveness goes beyond resolving which of these two lines should prevail. The First Chamber identified a preliminary logical question: before determining whether “computer software” is similar to vehicles, it must be determined what a registration granted for “computer software” actually protects.

Article 33(2) of the European Union Trademark Regulation requires that goods and services be identified in a sufficiently clear and precise manner so that the competent authorities and economic operators can determine, solely on the basis of that description, the scope of the protection required. The Chamber emphasized that this requirement constitutes a fundamental prerequisite for legal certainty, as the specification of goods and services defines the scope of protection and serves as the starting point for proceedings before the EUIPO.

The problem is that the EUIPO's current practice accepts the term "*software*" as sufficiently clear and precise. However, the First Chamber noted that there is a relevant legal position to the contrary. In the opinions presented in the "**Sky**" case, the General Lawyer expressly questioned the scope of "*computer software*", arguing that a registration formulated in those terms could confer on its holder a monopoly of enormous scope that would be difficult to justify on the basis of a legitimate commercial interest. The ruling subsequently handed down by the Court of Justice in *Sky* did not specifically address whether "*computer software*" meets the requirement of clarity and precision.⁹

Thus, KIRA/QIRA demonstrated that the contradiction in the case law on similarity might stem from an underlying issue of specificity. If "*computer software*" includes any type of program without distinction, the comparison with other goods can vary considerably depending on which of its countless potential functions is used as a point of reference.

Faced with this issue, the First Board of Appeal did not definitively rule on the opposition but, by an interlocutory decision dated September 17, 2026, referred the matter to the Grand Board of Appeal, seeking clarification on two successive issues.

(i) To determine whether the terms "*computer software*" in Class 9 and "*Software as a Service (SaaS)*" in Class 42 -as well as their synonyms- are sufficiently clear and precise for the scope of protection to be determined based on those expressions alone.

(ii) If the answer is affirmative, it will be necessary to resolve the second issue: whether software and vehicles can be considered similar goods for trademark purposes.

This shows that the Court will not limit itself to considering the extent to which protection for a software registration may extend, but will first examine whether the description itself makes it possible to define with sufficient certainty what is protected.

⁹ Court of Justice of the European Union. (2020). "*SKY PLC AND OTHERS V. SKYKICK UK LTD AND SKYKICK INC.*" (Case C-371/18).

D. Relevance to the Specificity Requirement

The case at hand illustrates that a lack of precision in the description of technological products can extend beyond the examination stage of the application and have subsequent consequences for the scope of the exclusive right. An extremely broad category can create uncertainty not only regarding what the registration covers, but also regarding which third-party products may be considered similar to or complementary to those protected by it.

This problem is closely related to what was observed in the Mexican case analyzed earlier. The common question is: *Can a broad designation such as “software” define the scope of exclusive trademark rights with sufficient legal certainty?*

V. Lack of Specificity as a Ground for Nullity of Trademark Registration

A. When Did the Specificity Requirement Become Mandatory in Mexico?

The requirement to identify the goods or services protected by a trademark did not arise with the current Federal Law on the Protection of Industrial Property. However, its regulatory framework was progressively strengthened until it became an express requirement for the registration application.

Under the Industrial Property Law prior to the 2018 reform, Article 93 provided that trademarks must be registered in connection with specific goods or services in accordance with the classification set forth in the regulations. Within this regulatory framework, the Circuit Courts had already established that registration could only protect the goods or services expressly and specifically identified, linking this requirement to the principle of specialty and the legal certainty of the registration system.¹⁰

Subsequently, the amend published on May 18, 2018, represented a significant change, as it expressly incorporated “*specificity*” into the mandatory content of the application. Article 113, Section IV, of the Industrial Property Law now requires the indication of “*the specific goods or services to which the trademark will apply*”.

¹⁰ CC ((2012). “**TRADEMARKS. APPLICATIONS FOR REGISTRATION MUST SPECIFY THE GOODS OR SERVICES FOR WHICH PROTECTION IS SOUGHT AND WHICH BELONG TO THE SAME CLASS.**” Non-binding judicial precedent, Digital Registration No. 2002571. Semanario Judicial de la Federación y su Gaceta, Book XVI, January 2013, Volume 3, p. 2097.

Therefore, as of the effective date of this amendment, specificity ceased to be derived solely from the combined interpretation of the Law, its Regulations, and the principle of specialty, and instead became an express legal requirement of the registration application.

In turn, Articles 57 and 59 of the Regulations required the specific goods or services corresponding to the requested class to be indicated in accordance with the designations of the Nice Classification.

Finally, the Federal Law on the Protection of Industrial Property of 2020 reaffirmed and strengthened this requirement. Article 176 provides that trademarks shall be registered for “*specific goods or services*”, while Article 214, Section IV, requires that the application identify “*the specific goods or services to which the trademark will apply*”. Furthermore, once registration is granted, Article 177 prohibits the subsequent extension of the protected goods or services and requires a new registration to distinguish other, different ones.

In conclusion, prior to 2018, there was already a duty to define the protected goods or services, derived from the registration system, the Regulations, and the principle of specialty; since the 2018 reform, specificity has been expressly incorporated as a legal requirement of the application; and the 2020 LFPPI maintained and reinforced this requirement.

This regulatory development is particularly relevant for the purposes of a potential action for nullity, since it is not sufficient to assert, that the description of the goods or services lacks sufficient specificity; rather, it is necessary to identify the provisions in force at the time the registration was granted and determine whether, under those provisions, the description failed to meet the applicable legal requirements. Only through such an analysis can it be established whether the registration was granted in violation of the relevant legislation and whether such a violation is likely to affect its validity.

However, it is clear from the evolution of the regulatory framework that the obligation to define the protected goods or services is not a requirement recently introduced into the Mexican trademark system, but rather a requirement that has always been part of its regulations, and whose scope and express recognition have been strengthened through subsequent legislative modifications.

B. Is a Lack of Specificity Merely a Formal Irregularity or a Substantive Violation of the Law?

One of the main legal issues related to noncompliance with the specificity requirement is determining whether the failure to adequately identify the goods or services covered by a trademark registration constitutes a purely formal or procedural irregularity, or whether, on the contrary, it represents a substantive violation of applicable law, capable of affecting the validity of the registration granted.

For the purposes of this analysis, a formal irregularity should be understood as a deficiency that arises during the processing of a registration application and that relates to a failure to comply with the formalities or administrative procedures required for the grant of the registration. On the contrary, a substantive violation occurs when the registration is granted in breach of a legal provision that establishes essential requirements for the grant of trademark rights, such that the irregularity directly affects the registration's content, subject matter, or scope.

This distinction is fundamental, as the nature of an irregularity should not be determined solely by the time at which it occurred, but rather by the content of the legal provision violated and the consequences that such noncompliance has on the registration. Consequently, the fact that a violation originates during the examination of an application does not, in and of itself, imply that it should be classified as a merely formal irregularity.

In this context, specificity requirement takes on particular importance, since the identification of the protected goods or services is not a mere administrative formality, but rather an essential element for defining the scope of trademark protection. In this regard, Article 176 of the LFPPI establishes that trademarks must be registered in connection with specific goods or services, in accordance with the classification and rules set forth in the Regulations. For its part, Article 94 of the Regulations sets forth the conditions applicable to the description of such goods or services, in accordance with the International Classification established under the Nice Agreement.

Furthermore, as previously analyzed, the obligation to define the goods or services covered by a trademark registration was already established under the legal framework prior to the 2018 reform, while subsequent legislative amendments expressly incorporated and reinforced this requirement. This demonstrates that specificity is an inherent element of the trademark protection system, the purpose of which is to determine with certainty the subject matter to which the exclusive right applies.

Indeed, the precise identification of the protected goods or services makes it possible to establish the limits of the protection granted to the registrant and provides legal certainty to third parties regarding the commercial activities covered by that right. In opposition, an overly generic or vague description can create uncertainty regarding the scope of trademark protection and may even lead the holder to attempt to extend it to goods or services that were not properly specified at the time of registration.

Consequently, we maintain that an objective failure to meet the specificity requirement can go beyond a merely formal or procedural scope and constitute a substantive violation of applicable law, since the issue is not merely to challenge the administrative action by which the registration was granted, but to determine whether the exclusive right granted actually complies with the legal conditions required for its protection.

Thus, recognizing the substantive nature of the specificity requirement allows us to draw a fundamental distinction between irregularities inherent in the processing of an application and those that directly affect the legality of the granted registration, an issue that is decisive for analyzing in the following section, the legal consequences that may arise from noncompliance.

C. Can a violation of the specificity requirement constitute grounds for trademark nullity?

Article 258, Section I, of the LFPPI provides that a trademark registration shall be declared null and void when it was granted in violation of the provisions of said Law or of the legislation in force at the time of its grant. Furthermore, it excludes the possibility of basing such an action on a challenge to the applicant's legal representation or on procedures relating to the grant or validity of the registration.¹¹

¹¹ See article: Rodríguez, J., Pedroza, S., Patiño, M., & Guevara, M. J. (2026). "Invalidity of trademark registrations due to contravention of law: Demystifying its interpretation and scope." OLIVARES.

Based on the foregoing, we consider that failure to comply with the specificity requirement may constitute grounds for nullity due to a violation of the law, since the precise identification of the goods or services is an expressly established legal requirement, and failure to comply with it may directly affect the content and scope of the exclusive right granted. In this regard, the issue is not simply a matter of challenging a procedural formality of the registration process, but rather of determining whether the granted right complies with the substantive requirements set forth in applicable law.

Trademark registration applications must specify the goods or services intended to be protected; a mere reference to a class in the Nice Classification is not sufficient. This is relevant because a single class may include goods or services of different nature and purpose, and therefore their administrative classification does not, in and of itself, determine the existence of similarity or a likelihood of confusion between them.¹²

Consequently, allowing registrations to remain in force whose descriptions objectively fail to meet the specificity requirement could encourage their holders to seek to unjustifiably extend trademark protection to generic categories of goods or services, even when those goods or services do not have a legally relevant similarity or complementary relationship to those actually protected. This could result in excessively broad exclusive rights, unjustifiably restrict the ability of third parties to register or use distinctive signs, and undermine the principle of specialty, the purpose of which is precisely to delimit trademark protection with respect to specific goods or services.

Therefore, we maintain that it is legally feasible to seek the nullity of a trademark registration on the grounds of lack of specificity, as long as it is proven that the description objectively fails to meet the legal requirements in force at the time of its grant and that such deficiency affects the scope of the exclusive right granted. This interpretation would prevent trademark registration from becoming a tool for monopolizing indeterminate categories of goods or services, thereby preserving the balance between the protection of rights holders' rights, the legal certainty of third parties, and free competition in the market.

¹² CC (2012). **"TRADEMARKS. APPLICATIONS FOR REGISTRATION MUST SPECIFY THE GOODS OR SERVICES TO BE PROTECTED THAT BELONG TO THE SAME CLASS."** Non-binding judicial thesis, Digital Registration No. 2002571. *Semanario Judicial de la Federación y su Gaceta*, Book XVI, January 2013, Volume 3, p. 2097.

VI. SEPI's Ruling

Notwithstanding the foregoing, the Specialized Chamber on Intellectual Property of the Federal Administrative Court of Justice, in ruling on a nullity claim 1681/ 25-EP-01-1, determined *-erroneously-* that the ground for nullity provided for in Article 151, Section I, of the Industrial Property Law requires the existence of a violation of the legislation in force at the time the trademark registration was granted. Under this interpretation, the Chamber held that this ground for nullity does not apply when the alleged defect stems exclusively from the assessment made by the registration authority, which, upon granting the registration, deemed the description of the covered goods or services to be sufficiently specific, in accordance with the principle of specialty and the provisions of the Industrial Property Law and its Regulations.

Consequently, it held that the action for nullity cannot be used as a mechanism to reexamine assessments previously made by the administrative authority or to remedy omissions attributable to it, as this would imply challenging an interpretive assessment rather than a genuine violation of applicable law, to the detriment of the legal certainty of the trademark holder.¹³

In our opinion, the Chamber's reasoning is legally questionable, since the obligation to specifically identify the goods or services covered by a trademark registration is not a matter subject to the registration authority's discretion, but rather a requirement expressly established in the applicable legislation. Indeed, Article 93 of the repealed Industrial Property Law, in conjunction with Articles 57 and 59 of its Regulations, established the provisions regarding the identification and classification of the goods or services for which trademark protection was requested.

In this regard, a distinction must be made between the authority's power to assess whether a description meets the legal requirements and the very existence of those requirements. Although the MIPI has the authority to examine registration applications, this does not mean that it may waive compliance with the conditions established by the legislature, nor that its assessment renders a description *-which objectively fails to meet the applicable regulatory requirements-* legally valid.

¹³ SEPI (2026). **"NULLITY OF TRADEMARK REGISTRATIONS. IT DOES NOT ARISE WHEN THE ALLEGED DEFECT STEMS FROM AN ASSESSMENT BY THE REGISTRATION AUTHORITY RATHER THAN A CONTRAVENTION OF LAW."** Non-binding judicial thesis. Revista del Tribunal Federal de Justicia Administrativa, No. 50, April 2026.

Therefore, a lack of specificity cannot automatically be classified as a mere interpretive discrepancy, since, when it is established that the goods or services were not identified in accordance with the relevant laws and regulations, the issue goes beyond the examiner's assessment and becomes a matter directly related to the legality of the exclusive right granted.

This conclusion is reinforced by considering the purpose of the International Classification of Goods and Services for the Registration of Trademarks, established under the Nice Agreement, as well as the national provisions governing its application. The classification and description of goods or services is not merely an administrative requirement, but an indispensable tool for determining the scope of protection of the registration and preventing its effects from extending unjustifiably to goods or services other than those for which it was granted.

In this regard, the Agreement setting forth the criteria for the interpretation and application of the Nice Classification expressly established the obligation to clearly specify and define the goods or services intended to be distinguished. It also clarified that the indication of a class heading does not imply protection for all goods or services included therein.

Thus, allowing registrations to remain in force with descriptions that objectively fail to meet the requirements of specificity could lead to an unjustified extension of the exclusive rights of their holders, who might seek to extend the protection granted to categories of goods or services that were not properly identified at the time the registration was granted.

This issue takes on particular significance in nullity proceedings based on the existence of a likelihood of confusion between trademarks, since an excessively generic description could be used to artificially assert similarity between goods or services that -*given their nature, purpose, use, marketing channels, and target audience*- do not necessarily have a legally relevant commercial relationship.

In other words, allowing a broad interpretation of generic descriptions could enable a trademark holder to attempt to monopolize entire categories of goods or services, even when these are not specifically covered by the granted protection, thereby undermining the principle of specialty and unjustifiably restricting the ability of third parties to use or register distinctive signs for different goods or services.

This concern is supported by the criteria recently issued by the Twentieth Circuit Court for Administrative Matters of the First Circuit regarding the scope of specificity requirement and the complementarity among products in technological contexts.

Although these guidelines address the analysis of similarity between goods and do not directly concern the ground for nullity based on lack of specificity, their considerations are relevant to the case at hand, as they highlight the importance of delimiting the scope of trademark registrations in accordance with the goods or services actually protected, thereby avoiding broad interpretations that grant holders exclusive rights broader than those derived from the registration.

Indeed, if the principle of specialty prevents the protection of a trademark from being extended to goods or services that do not have a legally relevant relationship of similarity or complementarity with those expressly covered, it follows all the more that the registration must, from the moment of its grant, comply with the requirement of specificity regarding the protected goods or services.

Otherwise, a lack of precision in the registration description would be allowed to become an advantage for the holder by facilitating broad interpretations of the scope of their exclusive right and creating unjustified obstacles to the registration or use of third-party trademarks.

Consequently, we consider that the criterion adopted by SEPI is restrictive, as it gives priority to the examiner's prior assessment without sufficiently distinguishing between an administrative determination and an objective violation of a legal requirement. The legal certainty of the rights holder cannot be invoked as a basis for precluding an examination of a possible substantive violation of applicable law, especially when such a violation affects the scope of the exclusive right and may impact the rights of third parties.

Therefore, the fact that the MIPI has deemed a description sufficiently specific should not preclude an analysis of its legality through an action for nullity. The decisive factor must be whether the goods or services were effectively identified in accordance with the requirements of the legislation in force at the time the registration was granted and whether their non-compliance triggers the corresponding legal ground for nullity.

To argue otherwise would imply allowing an administrative assessment to prevail over an express requirement of the law, undermining the principle of specificity and favoring the continued existence of registrations whose scope could unjustifiably exceed the limits of legally permissible trademark protection.

VII. Can Regulations Limit the Circumstances of Violation of the Law That the Legislature Established as Grounds for Nullity?

An additional issue that is fundamental to determining the scope of the ground for nullity due to violation of the law is whether a regulatory provision can restrict the circumstances established by the legislature for challenging the validity of a trademark registration.

Article 258, Section I, of the LFPPI provides that a trademark registration is null and void when it has been granted in violation of the provisions of that Law or of the legislation in force at the time of its grant. However, Article 126 of its Regulations provides that, for the purposes of this ground for nullity, a violation of the law shall be deemed to exist when the registration falls under any of the impediments set forth in Articles 12 and 173, subsections I through XVII and XIX through XXII, of the LFPPI, or their equivalents in previously applicable legislation.

It is worth noting that Articles 171, 176, 214, 233, and 237 of the LFPPI establish the mandatory requirement of specificity for the registration of a trademark. That said, at first glance, a possible contradiction between the two provisions might be apparent, given that while the legislature established a ground for nullity formulated in broad terms, the Regulations appear to limit its applicability to certain legal impediments. This issue takes on constitutional significance in light of the principles of the reservation of law and the hierarchy of norms, which define the scope of the Executive Power's regulatory authority.

Indeed, the principle of the hierarchy of norms requires that regulatory provisions be subordinate to the law they implement, such that they cannot contradict it or modify its content. On the other hand, the principle of the reserve of law implies that it is the legislature's responsibility to establish the essential elements of legal institutions and the circumstances that give rise to legal consequences, without the Executive Power being able to introduce, through regulatory provisions, restrictions that alter the scope of the rights, obligations, or actions recognized by law.

In this regard, the Mexican Supreme Court of Justice, through its precedent under the heading “*Regulatory Power: Its Limits*”, has recognized that the exercise of such power is subject to the principles of the reservation of law and hierarchical subordination; therefore, regulatory provisions must be limited to implementing and supplementing statutory provisions, without altering their content or exceeding their limits established by the legislature.¹⁴

Specifically, in the article titled “*Invalidity of Trademark Registrations Due to Contravention of Law: Demystifying Its Interpretation and Scope*”, they analyze the constitutionality of Article 126 of the LFPPI Regulations and warn that, if that provision were to restrict the grounds for nullity due to violation of the law to a closed list of impediments, it could exceed the limits of regulatory authority.¹⁵

In the case at hand, the constitutionality of Article 126 of the Regulations is called into question because it excludes from the analysis of nullity any failure to comply with legal requirements not expressly mentioned in that provision. In other words, if it is interpreted that only the violations expressly provided for in Articles 12 and 173 can give rise to grounds for nullity -excluding even those violations of other legal provisions that might fall under the general clause of Article 12- the Regulations would cease to serve a merely instrumental function and would become a provision that restricts the scope of a ground for nullity established by the legislature.

This problem is particularly evident in the failure to comply with the specificity requirement. As noted, Article 176 of the LFPPI establishes the obligation to register trademarks in connection with specific goods or services, while Article 94 of its Regulations sets forth the conditions that the corresponding descriptions must meet.

Consequently, when the MIPI grants a registration whose description objectively fails to meet these requirements, the problem is not limited to a procedural irregularity but may directly affect the content and scope of the exclusive right conferred on the holder. A lack of specificity can create uncertainty regarding the goods or services actually protected and lead to broad interpretations that allow for claims of trademark protection broader than what is legally permissible.

¹⁴ SCJN (2007). “**REGULATORY POWER. ITS LIMITS.**” Binding precedent. Digital Registration No. 172521. *Semanario Judicial de la Federación y su Gaceta*, Volume XXV, May 2007, p. 1515.

¹⁵ **Read article:** Rodríguez, J., Pedroza, S., Patiño, M., & Guevara, M. J. (2026). “*Invalidity of trademark registrations due to contravention of law: Demystifying its interpretation and scope.*” OLIVARES.

From this perspective, preventing the failure to meet the specificity requirement from being analyzed as a possible ground for nullity -simply because Article 176 is not expressly mentioned in Article 126 of the Regulations- would imply introducing a limitation that does not necessarily follow from the text of Article 258, Section I, of the LFPPI.

This consequence would be particularly questionable given that the specificity requirement not only protects the legal certainty of the registrant but also the legitimate rights and interests of third parties, by preventing trademark protection from being unjustifiably extended to generic categories of goods or services that were not properly identified.

However, a possible solution to this problem consists of interpreting Articles 12 and 176 of the LFPPI jointly, based on the reference that Article 126 of the Regulations itself makes to the former.

Indeed, Article 12 of the LFPPI provides as follows:

"No patent, registration, or authorization shall be granted, nor shall any of the legal concepts or institutions regulated by this Law be published in the Mexican Official Gazette, when their content or form is contrary to public policy or contravenes any legal provision."

It follows from the foregoing that the prohibition against granting trademark registrations is not limited to the grounds expressly enumerated in Article 173, but also extends to cases in which a registration, by virtue of its content or form, contravenes other applicable legal provisions. Accordingly, since Article 176 expressly requires that the goods or services covered by a trademark registration be identified with sufficient specificity, failure to comply with this requirement could constitute a violation of the general prohibition established in Article 12 and, pursuant to Article 126 of the Regulations, potentially give rise to the ground for nullity provided for in Article 258, Section I, of the LFPPI.

This interpretation would make it possible to uphold the admissibility of the action for nullity without needing to challenge the constitutionality of Article 126 of the Regulations, since the reference to Article 12 itself would preserve the scope of the ground established by the legislature.

However, this solution raises an additional interpretive question: determining what is meant by the “content” and “form” of the registration for the purposes of Article 12 of the LFPPI. In particular, it is necessary to establish whether these terms refer exclusively to the characteristics of the distinctive sign for which protection is required or whether they also include the description of the goods or services for which the exclusive right is granted.

In our view, an interpretation that limits the concept of “*content*” exclusively to the word, graphic, or figurative elements of the sign would be too narrow, since a trademark registration does not confer abstract protection on a distinctive sign, but rather an exclusive right linked to specific goods or services. Consequently, the description of these goods or services constitutes an essential element of the legal content of the registration, insofar as it determines the subject matter and scope of the protection granted.

Likewise, the reference to “*form*” contained in Article 12 raises the possibility of interpreting certain legal requirements regarding the structure and expression of the registration. However, for the purposes of this analysis, we consider that the strongest argument lies in the concept of “content,” since the specification of the goods or services materially determines the scope of the exclusive right granted to the holder.

Thus, the connection between Articles 12 and 176 would support the view that an objective breach of specificity requirement constitutes a legal violation that may be examined under the ground for nullity provided for in Article 258, subsection I, without the absence of an express reference to Article 176 in the Regulations constituting an impediment to this.

Consequently, we consider that Article 126 of the Regulations must be interpreted systematically in conjunction with Articles 12, 176, and 258(I) of the LFPPI, such that the reference to the impediments provided for in Article 12 also includes those legal violations that affect the content of the registration, including the lack of specificity regarding the protected goods or services.

If this interpretation is not accepted and it is upheld that Article 126 absolutely precludes the analysis of substantive breaches other than those expressly listed, there would be grounds to challenge its constitutionality on the basis that it violates

the principles of statutory reservation and hierarchical subordination by restricting, through regulation, a ground for nullity whose scope was established by the legislature.¹⁶

VIII. Conclusion

The principle of specialty must be interpreted with reference to the goods or services specifically covered by the trademark registration; it is not legally permissible to extend its protection, through broad interpretations, to categories of goods or services that were not specifically included at the time of registration.

Specifically, we consider it correct that the Twentieth Circuit Court recognized that technological evolution and the growing interconnection between goods and services do not imply the existence of a likelihood of confusion. Indeed, mere functional compatibility between certain products is not sufficient to establish a legally relevant complementary relationship, as this requires analyzing whether there is a sufficiently close economic and commercial link to allow the consumer to attribute the same business origin to them.

However, this issue is not unique to the Mexican legal system; rather, it currently poses an international challenge, raising the question of whether generic terms such as *“computer software”* and *“Software as a Service (SaaS)”* allow for a sufficiently clear and precise definition of the scope of trademark protection, as well as the consequences that the scope of such protection may entail when analyzing the similarity between products belonging to different economic sectors.

In this regard, while one position seeks to justify the similarity between products based on the presence or use of software as an indispensable technological component for their operation, another maintains that this circumstance is not sufficient to extend trademark protection, and that it is necessary to consider the nature, purpose, consumers, marketing channels, and degree of economic and commercial complementarity of the products in question.

¹⁶ Read article: Rodríguez, J., Riquelme, S., & Salazar, A. C. (2026). *“Non-appealability of trademark renewal certificates and recordal notices of declarations of use?”*. OLIVARES

In our view, this last position is more consistent with the purpose of the principle of specialty and the requirement of specificity, since the fact that a wide variety of products currently incorporate software does not mean that all of them should be considered similar or that they can fall within the scope of protection of a registration granted generically for computer programs. Otherwise, it would allow trademark registrants to unjustifiably extend their exclusive rights to different commercial sectors, thereby restricting the ability of third parties to use or register distinctive signs for products that lack a legally relevant relationship of similarity or complementarity.

In this regard, the specificity requirement takes on fundamental importance, as it constitutes the starting point for defining the scope of the exclusive right conferred by a trademark registration. Therefore, compliance with this principle should not be understood as a mere administrative formality, but rather as a substantive legal requirement that ensures legal certainty for both trademark holders and third parties participating in the market.

Finally, we hold that it is legally possible to seek the nullity of a trademark registration on the grounds of failure to meet the specificity requirement, provided that it is objectively demonstrated that the description of the goods or services violates the applicable legal provisions and that such irregularity affects the scope of the exclusive right granted. In such circumstances, the defect is not limited to a mere interpretive discrepancy regarding the examiner's assessment, but may constitute a genuine substantive violation of the law, capable of triggering the corresponding ground for nullity.



OLIVARES®
— we know —