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Lawyer

Trademark enforcement outside the courtroom: four underrated tools your clients may be overlooking



Michelle Ciotola and Ali Caless of Cantor Colburn LLP, explain how the United States Customs and Border Protection, trademark watch services, online infringement and modern trademark clearance can be utilized to amplify the strength of a brand and protect against infringement.



Immoral trademarks

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Publicity rights posthumously

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Mauritius for holding IPR

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The New Federal Law for the Protection of Industrial Property in Mexico – a relevant change in the trademark application prosecution procedure

Carlos Reyes, Senior Attorney at OLIVARES, introduces the new trademark application process that came into force in November 2020, comparing the functionality to the previous, overcomplicated system.

The new Federal Law for the Protection of Industrial Property (the new IP Law), that came into force on November 5, 2020, includes some interesting changes in relation to the former Mexican Industrial Property Law (the former IP Law) that it is important to remark.

Those familiar with the former IP law and Mexican trademark applications will know it was quite complex, derived on the fact that these, once filed and after a brief examination on the accomplishment of only filing formalities (i.e. official fees paid, application signed), were approved for publication for opposition purposes just 10 business days after the filing date and before any formal or substantial examination of the mark.

Also derived from the fact that, with oppositions filed or not, a two-step examination procedure was conducted into the term of six months from the filing date in which the Mexican Industrial Property Office (IMPI) could issue, at first term, an office action for formal requirements, in most cases, on proper identification of products or services. Applicants were granted two months, plus a two-month automatic extension, for filing a response to provide these IMPI requirements.

In cases where the response from the applicant was insufficient for the examiner from IMPI, a second - or even a third - office action could be issued on proper identification of products or services, with the same timing of the first office action.

It was not until the examination of formalities was accomplished with a satisfactory response



Carlos Reyes

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from the applicant that the trademark application substantive examination took place. Once again, the examiner from IMPI could issue an office action, this time on absolute or relative grounds of refusal. Identically, the applicant was then granted two months, plus a two-month automatic extension, for filing a response.

At the same time, if there was an opposition from a third party, the opposition procedure was conducted in parallel to this examination procedure with a 30 common days term (from the publication of the opposition) granted to the applicant to file a response, though not mandatory, and later, a two-day business day term granted to both the applicant and the opposing party to file closing arguments.

Then, the IMPI proceeded, in the average term of six months, to prepare and issue a final decision including a rule on the opposition basis. This decision could be granting registration to the mark or refusing its registration.

Up to now you may be a bit lost in our explanation of this quite complicated procedure, most of the foreign applicants were certainly confused to a certain degree by this application procedure under the former IP Law, with having two-step examination parts and oppositions in parallel leading to a single moment decision granting or refusing a trademark registration.

To complicate things further, after Mexico joined the Madrid System in 2013 the requirements of the Madrid Protocol required, for the national designation of an international registration in Mexico, to have a different national trademark



application procedure. This was to include a single office action in the form of a provisional refusal, including the outcome of both formal (e.g., proper identification of products or services) and substantive (e.g., absolute or relative grounds of refusal) examination at the same time.

To summarize, a trademark application filed in Mexico had two successive examinations: the first on formalities and, the second on possible substantive causes of refusal that could result in successive office actions and possible opposition procedures to be conducted in parallel and before the mark examination by IMPI. All these elements lead to a decision on the granting or refusal of the requested trademark registration.

On the other side, a trademark application deriving from a national designation of an international registration - even if it could be the object of an identical parallel opposition procedure - had one single examination on formalities and causes of refusal. That may result in one single office action or provisional refusal with a single response required, and a later decision on the granting or refusal of the requested trademark registration.

In other words, the successive modifications of the IP Law, derived from the decision of regulating an opposition procedure and the Mexican adhesion of the Madrid Protocol, made a kind of patched modification to the former IP Law. It was determining that a Mexican trademark application had a different procedure depending on whether a trademark application was filed directly in Mexico or derived from the Mexican designation of an international registration according to the Madrid Protocol rules. Both procedures had an opposition procedure followed in parallel until the IMPI's decision was to be taken.

The new IP Law - the so-called Federal Law for the Protection of Industrial Property - in force

since November 5, 2020, unifies these two different procedures. IMPI now conducts both examinations (on formal and on relatives or absolute causes of refusal) simultaneous in both the nationally filed trademark applications and in those trademark applications issued from a Mexican designation of an international registration, for issuing a single comprehensive office action including any formal requirements and relative and absolute grounds of refusal.

The absolute novelty here is that the new IP Law, in an attempt to make the trademark application procedure even more integrated, modifies the opposition procedure by integrating

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Résumé

Carlos Reyes, Senior Attorney

Carlos joined OLIVARES in October 2008 and has more than 25 years of experience in Intellectual Property prosecution and litigation. His practice is now mainly focused on the areas of counseling and trademark registration. In summary, he provides counseling regarding trademarks registrability and brings its experience on trademark prosecution and litigation, answering objections related to absolute and relative grounds of refusal, and prepares and files trademark oppositions before the Mexican PTO (IMPI).

As senior attorney in the OLIVARES trademark team, he has helped to secure trademark protection in Mexico to several important trademarks, in particular relating trademark distinctiveness and likelihood of confusion.

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the notice to applicants of oppositions filed into the above-mentioned single comprehensive office action.

Until November 5, 2020, the third parties had a 30-day term from the publication of the trademark application, occurring 10 days from the application filing date, to file an opposition, and then the applicant also had a 30-day term from the publication of the opposition to file or not respond. In other words, the terms were equal from the published notice for both the opposing party and the applicant. Also, the applicant could choose to respond to the opposition or to simply wait for the office action from IMPI (if any) - not filing an opposition response at all.

Now, with the abovementioned modifications in the procedure implemented by the new IP Law in the trademark application procedure, which regulate a single office action for every trademark application including a notice on any opposition filed, the third parties have a 30-day term from the publication of the trademark application to file an opposition. This will be visible and available for everybody's consultation in a few days from filing at IMPI electronic databases, and the applicant will be notified of this opposition filed through such a single comprehensive office action, to be issued in approximately six months from the application filing date, after the formal and substantive examination of IMPI has taken place.

Hence, even if the applicant does not check the status of their trademark application electronically at IMPI databases at all - checking this status would allow them to notice the opposition a few days after the opposition filing date - they will be officially notified of the opposition after the trademark application examination takes place and when the single office action is noted. Then, the applicant will have two plus two months, the same as they had before for responding to any office action, including requirements or refusals, to file arguments against the opposition.

On the other hand, the applicant must file a response to any office action from IMPI to avoid the abandonment of the trademark application, even if such an office action may only note an opposition filed. Thus, in case no requirement or provisional refusal is issued, the applicant must file a response brief and pay official fees even if only to mention that they have nothing to say about the opposition.

These changes have forced us - and presumably all IP service firms - to adapt our rates to this new practice to make it easier for our clients to budget the cost of the requirements all in one office action responses. Mainly, we have changed the way we quote and charge our fees,

considering the two services to be rendered, namely: a) analyzing and reporting the mentioned office action and providing legal advice on the best strategies to overcome the formal requirements and/or the refusals and/or the oppositions; and b) preparing and filing a response to such office actions possibly implying three different strategies and arguments.

Likewise, we have made efforts to establish quotations that would accurately and efficiently take into account the complexity of each trademark matter, in order to be able to provide our clients with fixed and reasonable rates relating to responses which, difficulty, could now be very different -from simple to very complex. This cost-efficiently quotation system will prove useful and beneficial for our clients during this new chapter of the Mexican trademark system.

Of course, we expect this new trademark application procedure to be tested and adjusted, or even improved. For example, we would like to have a term to file an opposition against a trademark application - which very often requires gathering evidence and coordinating and deciding strategies from several possibilities - that could be the same granted to the applicant, and not the 30-days-from-notice now granted to the opposing party to file the opposition vs. four entire months from notice granted to the applicant to respond.

In any case, this procedure is far clearer and far more straightforward than the patched and baroque procedure we have been handling with the former IP Law, derived from the successive modification it suffered during the long timeframe it was in force.

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