



C & L ATTORNEYS
INTELLECTUAL PROPERTY BOUTIQUE

***AMENDMENTS TO TRADEMARK PROVISIONS OF THE
MEXICAN INDUSTRIAL PROPERTY LAW HAVE BEEN PUBLISHED***

On May 18th, 2018, the Amendment Bill to the Industrial Property Law which relevantly changes trademark law in Mexico was published in the Official Gazette.

The Amendment Bill will be enacted after 60 working days.

At **C&L ATTORNEYS** we find this updates particularly relevant because through the Decree, non-traditional trademarks are included in the Law, secondary meaning is now accepted, coexistence agreements are recognized, trade dress will have a better definition and protection, collective marks are having a better regulation, certification marks are now included, the trademark opposition proceedings will have a more contentious nature which will allow the filing of evidence and a resolution will have to be issued with respect to them, a declaration of real and effective trademark use must be filed by all trademark owners the Mexican Trademark Office in order to avoid the automatic lapse of their trademark registrations, bad faith trademark registration will be forbidden and will also be a ground for trademark cancellation, no trademark registration will be allowed when it includes characters or any element of an artistic or literary work, and no trademark registration will be granted if it includes a plant variety.

Our Team will work together with you to obtain the best results regarding your trademark portfolio.

The relevant changes, as were recently described are:

- “Any person” may register a mark (Article 87). The law previously stated that only “industrialists, traders and service providers” may apply for registration.

Article 87: any person being natural or legal can make use of the mark or marks in industry or commerce and not only businessmen or service providers as it was established before.

- Marks no longer need to be visible to be registered (Article 88). A mark needs only to be perceptible to the senses, and capable of being graphically represented so that it is clear exactly what is being protected.



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Article 88: *New definition of trademark: “any sign perceptible to the senses and susceptible of being graphically represented, which is capable of distinguishing goods or services in industry or commerce from one and other”. This new definition introduces to Mexican IP Law, the protection of Non-Conventional Trademarks such as sound, scent and holographic marks.*

- Some types of non-traditional marks that were previously denied protection will now be registrable, including **sounds, scents, holograms and trade dress** (Article 89).
- Descriptive terms, terms in common use and non-distinctive trade dress previously ineligible for registration will now be registrable, based on secondary meaning (Article 90).
- Applicants may now overcome a refusal based on confusing similarity by obtaining letter of consent of the prior trademark owner (Article 90).
- The provisions regarding to collective marks have been expanded and clarified (Articles 96-97 bis 1).
- Certification marks will now be registrable (Articles 98-98 bis 4).
- Applications for registration must now identify “specific” products or services (Article 113).
- The provisions governing trademark oppositions have been modified (Articles 120-125). The trademark opposition proceeding will include the possibility to file the corresponding evidence by the opponent and the solicitant. Also, IMPI will have to issue a resolution with respect the opposition.
- Registrants must now file a declaration of continued use during the three months after the third anniversary of the registration date (Article 128). The registration will lapse automatically if the declaration is not filed.
- When filing for renewal of a trademark registration; a declaration of use must be filed along with the renewal application.
- Provisions contained in Article 115 related to disclaimers are now abolished.



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- A trademark registration may be declared invalid if it was “obtained in bad faith” (Article 151.VI).
- Cancellation Action proceedings in connection with **Article 151**, the windows to file before the Mexican Patent and Trademark Office are modified according to: provisions contained in **section II** (a mark is confusingly similar), **section III** (false information in application) and **section IV** (unawareness or miss appreciation by examiner attorney) will have a non-extendable term of **5 years** from the date of publication in the Official Gazette. Provisions contained in **section I** (against provisions of Law), **section V** (the authorized agent or user of the mark in a foreign country, files for registration) and the new added **section VI** (obtaining a registration on bad faith) can be filed **at any time**.

We shall keep you posted as further information is disclosed.