

Madrid Protocol Concerning the International Registration of Marks

Amendments to the Mexican Industrial Property Law

1. The Mexican Institute of Industrial Property (IMPI) has provided information to the International Bureau of the World Intellectual Property Organization (WIPO) regarding amendments to the Mexican Industrial Property Law which entered into force on August 10, 2018, and has requested that this information be made available to users of the Madrid System.

2. The communication sent by IMPI reads as follows:

“Declaration of actual and effective use

The amendment requires right-holders to submit an official form, directly to IMPI, declaring the **actual and effective use of their respective trademarks**.

Such obligation will take place at two different times:

a) Upon submitting a request for the renewal of a trademark.

Upon submitting a request for renewal, right-holders are due to comply with the filing of a “Declaration of Actual and Effective Use”.

With respect to international registrations renewed under Article 7 of the Madrid Protocol, the right-holder shall declare the actual and effective use of the mark directly to IMPI **within the three following months after the renewal notice** is made by the International Bureau of WIPO.

This obligation will apply to all renewal requests filed as from August 10, 2018, including those related to registrations whose territorial protection was extended with respect to Mexico under Article 3^{ter} of the Madrid Protocol.

This obligation will be governed by the secondary regulations issued to implement the amendment.

The effect of not complying with this requirement is that the protection of the trademark will be considered as lapsed by IMPI on an *ex officio* basis.

b) Within the three months following from the date on which the registration reaches three years from the granting date.

This obligation will apply to all trademarks granted as from August 10, 2018, even where their respective application was submitted before such date. This obligation will also apply to trademarks related to international registrations.

In cases where the protection under an international registration is territorially extended to Mexico under Article 3^{ter} of the Madrid Protocol, the right-holder must declare the actual and effective use within the three months following after three years from the date on which the national registration was granted.

The effect of not complying with this requirement is that the protection of the trademark will be considered as lapsed by IMPI on an *ex officio* basis.

Furthermore, in the “Declaration of Actual and Effective Use”, the right-holder must indicate the goods or services for which use of the trademark is being declared. The scope of protection of the trademark registration will continue for the goods or services for which the actual and effective use has been declared.

Additionally, in both cases of the filing of the “Declaration of Actual and Effective Use”, the right-holder will only be required to submit the payment of the corresponding fee, but there is no obligation regarding evidence to prove the trademark use.

The declaration of actual and effective use of the mark must be submitted by the holder’s authorized representative with a local address or by a legal representative in Mexico. A local address is required for purposes of notification.

New types of trademarks

According to the amendments, the Mexican trademark system will be available for sounds, scents and holographic signs. The granting of protection to these new types of trademarks will be subject to substantive examination by IMPI.

With the amendment, the following signs can also constitute a trademark: the plurality of operative and image elements including, among others, the size, design, color, layout of the shape, label, packaging, decoration or any other that, when combined, distinguish goods or services in the market. In the international context, this type of mark is known as **trade dress**.

To the extent that the reproduction of a trademark is possible within the item 7 of the official form, the applicant may resort to the Madrid System to apply for sound trademarks in Mexico.

Collective and certification trademarks

The regulations for Collective Marks are strengthened by regulating the specific requirements that shall be foreseen by the rules for their use.

The figure of the Certification Mark is incorporated into the IP regime to distinguish goods and services whose qualities or other characteristics have been certified by its right-holder.

The certification mark can be conformed by the name of a geographic area or other indication used to refer to such zone, which identifies a good as originating from that area, when a given quality, reputation or another characteristic of the good is mainly attributable to its geographical origin.

The application for a collective or certification mark shall be accompanied by the “Rules of Use” in which the information foreseen in Article 98 BIS-2 of the Industrial Property Law must be included.

The “Rules of Use” shall be directly submitted by the applicant to IMPI where (i) Mexico is a Designated Contracting Party or (ii) territorial extension of protection is requested for a certification or collective trademark under Article 3ter(2) of the Madrid Protocol.

Any legal entity may apply for a certification trademark, with the limitation that such is prevented from developing a business activity involving the supply of goods or services similar to those protected under the certification trademark.

Opposition

The trademark opposition system is strengthened with the inclusion of the opportunity for the parties (applicant and opponent) to submit evidence and arguments which will be taken into account by IMPI when deciding on the opposition.

The lack of answer to an opposition does not automatically imply that the application is considered as abandoned, therefore IMPI will continue with regular examination.

Filed oppositions will continue to be published in the Industrial Property Gazette. However, IMPI will now issue provisional refusals in connection with oppositions involving international registrations under the Madrid System.

The deadlines and conditions to submit and answer an opposition are not modified by the amendment.

Each opposition filed will be resolved by IMPI in a resolution legally grounded.

The concept of bad faith

Bad faith is included as a ground to (i) deny the registration of a trademark or (ii) nullify a granted trademark.

Bad faith is considered, as among other cases, when registration is requested in a manner contrary to honest uses, customs and practices in the industrial property system, commerce or industry; or, it is requested with the intention to obtain an undue benefit or advantage to the detriment of the rightful holder.

Consent

Exceptionally, IMPI will grant protection to trademarks that are confusingly similar to prior trademark registrations, prior trademark applications, commercial names or names of natural persons, if the legitimate right-holder expressly consents in writing to that protection.”

3. Further information on the new obligation to file a declaration of actual and effective use of the mark in Mexico can be found in Information Notice 14/2018.
4. Users of the Madrid System may contact IMPI for further information regarding the abovementioned amendments.