

Madrid Protocol Concerning the International Registration of Marks

Entry into force of an opposition procedure: Mexico

1. The Mexican Institute of Industrial Property (IMPI) has communicated to the International Bureau of the World Intellectual Property Organization (WIPO) information on the opposition procedure against trademark registration in Mexico, which entered into force on August 30, 2016. The procedure also applies to international registrations designating this country and subsequent designations of Mexico notified to IMPI as from the abovementioned date.

Purpose of the opposition procedure

2. The purpose of the opposition procedure is to provide IMPI with more evidence that enables it to conduct the substantive examination and decide whether it should grant protection to marks which are the subject of an international registration. The opposition procedure will be conducted in parallel with the rest of the examination performed by IMPI. The final decision of IMPI will essentially be based on the *ex officio* examination conducted by this Office.

3. Accordingly, IMPI reserves the right to grant or withhold such protection *ex officio*. After performing the substantive examination, IMPI will transmit statements of grant of protection or notifications of provisional refusal, as appropriate.

Opposition to international registration

4. Under the new procedure, any person may oppose to the granting of protection to a mark that is the subject of an international registration based on any of the grounds set out in the Industrial Property Law of Mexico to refuse the registration of a mark in this country. The person raising the opposition is not considered a third party in procedures relating to that mark.

5. As from August 30, 2016, IMPI will publish online, in its Industrial Property Gazette, the international registrations and subsequent designations notified to this Office, under their respective national filing numbers. This information will be published within a maximum period of 10 working days, following the date on which IMPI receives such notification.

6. The opposition must be filed within a non-extendable period of one month, starting from the first working day after the date of the publication indicated in the preceding paragraph. The opposition must be filed directly with IMPI, drafted in Spanish and is subject to payment of a fee. The opposing party may attach to the opposition filing any documents deemed necessary.

Response to an opposition

7. IMPI will publish online, in its Industrial Property Gazette, a list of marks against which opposition has been filed. This list will be published within a maximum period of 10 working days, starting from the next day after expiry of the deadline for filing an opposition. Documents relating to the opposition will be available online at the IMPI records consultation service.
8. If they so desire, holders of international registrations against which an opposition has been filed may respond to the opposition within a non-extendable period of one month, starting from the next working day after the date of publication of the list referred to in the preceding paragraph. The response to the opposition is not a response to a provisional refusal.
9. The response may be filed by the holder of the international registration or his local representative and should bear an address in Mexico for the purpose of receiving notifications. The response must be filed directly with IMPI, drafted in Spanish and is exempt from payment of a fee. The holder may attach to the response any documents deemed necessary.
10. Failure by the holder of an international registration to respond to an opposition is not construed by IMPI as tacit acceptance of the claims made by the opposing party.

IMPI decision

11. The opposition does not suspend the IMPI procedure for determining whether it should grant protection or prolong the time limit for reaching that decision.
12. Upon expiry of the opposition period and of the response period, where appropriate, IMPI will conduct the substantive examination, during which it may consider the claims made by the opposing party and the holder during the opposition proceedings, as well as any other material deemed relevant to the examination.
13. Upon completion of the substantive examination, IMPI will send a statement of grant of protection or an *ex officio* notification of provisional refusal, as appropriate, to the International Bureau of WIPO, and also communicate its decision to the opposing party. The International Bureau of WIPO will transmit a copy of the notification or statement to the holder of the international registration.
14. If they so desire, holders of international registrations or opposing parties may rely on the remedies provided for in the Mexican legal framework to appeal against IMPI decisions.

Useful information

15. The Industrial Property Law of Mexico is available in Spanish at the following link: http://www.gob.mx/cms/uploads/attachment/file/130285/Ley_de_la_Propiedad_Industrial.pdf.
16. The Industrial Property Gazette of IMPI is available in Spanish at the following link: <http://siga.impi.gob.mx/content/common/principal.jsf>.
17. The Records Consultation Service of IMPI can be accessed in Spanish through the following link: <http://marcanet.impi.gob.mx/marcanet/controler/home>.

18. General information on the opposition procedure in Mexico can be accessed in Spanish through the following link:

http://www.gob.mx/cms/uploads/attachment/file/131100/Triptico_Sistema_de_Oposicio_n.pdf.

19. For more detailed information on the opposition procedure in Mexico, holders may contact IMPI directly. The contact information of IMPI is available at the following link:

<http://www.wipo.int/madrid/en/members/profiles/mx.html>.

October 10, 2016