

Enrique Diaz and Paolo Massimi of Goodrich Riquelme & Asociados look at the most common misunderstandings about trade mark maintenance in Mexico

Don't be fooled by trade mark folklore

There are many common mistakes and misconceptions around filing Mexican trade marks. One of the most destructive is that you should prosecute or maintain the trade mark as you would in your home country. In this article we will try to correct the most common misunderstandings regarding Mexican trade mark practice.

Limiting goods and services

It is a misconception that filing a trade mark application with a limited and specific description of goods and services will stop the Mexican Patent and Trademark Office (MPTO) from issuing an office action citing prior applications or registrations as anticipations.

The Mexican Industrial Property Law (MIPL) establishes that a trade mark may constitute a bar for securing the registration of another trade mark when it is identical or confusingly similar to the trade mark to be registered and protects the same or related goods and services.

However, in practice the MPTO's novelty examination is carried out in a different way. If the MPTO's examiner considers that the proposed trade mark may be considered as confusingly similar to a prior one, it would be enough for the MPTO to issue an office action citing the trade mark as a bar, even though the goods and services protected by both trade marks could be different. Examiners often cite as bars trade marks that are not in force anymore or covering completely different goods and services based upon the fact that they correspond to the same international class. The main problem here is that the MPTO's criteria do not follow the MIPL's provisions; therefore, the logical assumption that limiting the goods and services will avoid this fate does not bear out in practice.

Based on the above, our suggestion would be filing the trade mark application intending to protect the specific desired goods and services, plus the entire class heading. This way, it would be easier to play around with the description if and when the MPTO issues an office action. The opportunity to limit an application or registration's description of goods and services is available anytime; nevertheless, the protection may not be increased.

In Mexico trade marks may be filed and registered on ITU basis without the need of filing use evidence.

After three years from the granting date the trade mark could be vulnerable to cancellation on grounds of lack of use; however, the use of the trade mark in connection to one of the covered goods and services would be enough for maintaining the rest of them. Consequently, including additional goods and services when filing the trade mark would not affect your defence possibilities at all; on the contrary, it could provide more rebuttal material because its use in connection to any of the goods and services would be enough for defending the validity of the trade mark, keeping it alive. When choosing the description of the goods and services, keep in mind that your trade mark will have protection purposes by including the goods and services you may use, but also defensive purposes,

Enrique A Díaz



Education: Centro Universitario México (Mexico City); Universidad Panamericana (Mexico City) (specialisation in intellectual and industrial property law).

Practice areas: Industrial property rights; intellectual property enforcement; intellectual property infringement; intellectual property licensing; intellectual property litigation; intellectual property protection; international licensing; intellectual property rights; internet intellectual property; software licensing; international copyright law; copyright licensing; copyright registration; copyright infringement; trade mark and patent filing and prosecution in Mexico and Latin America; trade names; trade dress protection; trade mark and patent infringement; trade mark registration; trade mark litigation; domain names disputes; patent licensing; patent litigation; entertainment law.

Member: Mexican Bar Association; INTA; ASIPI; LES; 2008-2009 Non-Traditional Trademarks Committee (INTA); Mexican Association for the Protection of Industrial Property (AMPPI).

Languages: Spanish, English and French.

Paolo O Massimi



Education: Westhill University (Mexico City).

Practice areas: Industrial Property Rights, Intellectual Property Enforcement; Intellectual Property Infringement; Intellectual Property Licensing; Intellectual Property Litigation; Intellectual Property Protection; International Licensing; Intellectual Property Rights; Internet Intellectual Property; Software Licensing; International Copyright Law; Copyright Licensing; Copyright Registration; Copyright Infringement; Trademark Filing and Prosecution in Mexico and Latin American Countries; Trade Names; Trade Dress Protection; Trademark and Patent Infringement; Trademark Registration; Trademark Litigation; Domain Names Disputes; Entertainment Law; Contracts.

Member: Mexican Association for the Protection of Industrial Property Law (AMPPI).

by blocking those that you may not use. A competitor could try to secure some of the goods and services that you did not block for protection, and if these are in any way directly related to you, could take advantage of your goodwill. Therefore all goods and services pertaining to the class in which you are filing your trade mark should be included in the description, regardless of whether you ever plan to use them.

Use of all goods and services

It is often thought that it is necessary to use the trade mark in

mark to be renewed has not been suspended for three or more consecutive years in connection to at least one of the protected goods or services. Affidavits of use and physical evidence are not necessary; however, some firms request declarations of use for protection purposes, although these are never submitted to the Mexican authority.

Additionally, if your trade mark is challenged on grounds of lack of use, the use of it in connection to any of the protected goods or services would be enough for maintaining the entire registration. There are no partial cancellations in Mexico.

Some misconceptions can empty our pockets and risk our assets

connection to all the goods and services covered by its registration in order to file for its renewal or maintenance.

However, by statutory provision, a trade mark registration may be renewed if it is being used in connection to at least one of the goods or services protected by it.

Moreover, the MIPL establishes that the use of an identical trade mark in a different class would inure in the benefit of the registration to be renewed, provided that there is a trade mark registration covering such a different class. If this were the case, the registration number for said different class where the trade mark is used would be sufficient to renew the one that is not in use or may even have never been used.

Declarations of use are not requested by the MPTO; however, when filing a renewal application, the owner or legal representative must state under oath that the use of the trade

Multiple class registrations

Mexico officially adopted the Nice Classification System in 2001; however, the MPTO started using the international classification system several years before. Previously, Mexico had its own classification system (a national classification) which was very different from the international one.

The transition from a national to an international system was not easy, and up to the present day, several issues continue to arise from it.

The most common conflict refers to the reclassification of the old registrations (those that were granted before the international classification was adopted) to the international classification.

The national classification was very broad, so once the old registrations were reclassified, they immediately secured protection over goods or services included in different international classes. Consequently, although multiple class applications and registrations are not possible in Mexico, you may find old registrations protecting goods or services from several different international classes.

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Enrique A. Diaz	ediaz@goodrichriquelme.com	(5255) 5525 1422
Jaime Delgado	jdelgado@goodrichriquelme.com	(5255) 5207 5324
Juan Carlos Suarez	jcsuarez@goodrichriquelme.com	(5255) 5207 9261

Paseo de la Reforma 265, M2
 Col. y Del. Cuauhtemoc
 06500 Mexico, D.F.
 Tel. (5255) 5533 0040
 Fax. (5255) 5207 3150

e-mail: mailcentral@goodrichriquelme.com **website: www.goodrichriquelme.com**

Based on the above, it is common to become confused when the renewal is due.

As previously mentioned, we do not have multiple class applications or registrations in Mexico, so anyone who wants to protect products and services from different classes must file independent applications for each class.

The question is, should old reclassified registrations be considered as divided into several independent registrations depending on the number of different classes it protects and should the renewal be made based on the number of reclassified classes? The answer is no. When renewal time comes, the owner of an old reclassified registration should only pay the correspondent fee as if the registration protected one international class, regardless of the number of classes it was reclassified into.

Linked trade marks

The assignment of trade mark registrations between particulars is not restricted; nevertheless in practice we may face several problems. A common complication that may arise occurs when a company or individual A is the owner of two or more registrations that are considered similar and decides to assign one or more (but not all) of such similar trade marks to a com-

pany or individual B.

Although the assignment would be effective between the parties, the problem results when trying to record the assignment before the MPTO.

The MIPL states that for recording purposes, the assignment of any of the linked marks shall be registered only where all of them are transferred to the same person or entity.

Consequently, before entering into any assignment negotiations, we always suggest conducting a full search for any registrations that may be considered as linked to the desired registration. Otherwise, there will always be a risk of the MPTO rejecting the recording of the assignment in case a similar trade mark in the name of the same entity is found.

Some misconceptions can be harmless and affect nothing more than our notion of reality; however, others can empty our pockets and risk our assets. It is clear that the myths surrounding Mexican trade mark prosecution and maintenance can lead to costly decisions and in some cases even to the loss of a trade mark registration. It is hoped that this explanation will provide foreign companies with more knowledge as to how to prosecute and maintain their trade marks in Mexico, without having to battle with confusing rumours about Mexican Industrial Property Law and its practise.