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Amendments to Industrial Property Law due to come into force - key features explained

Mexico - [OLIVARES](#)

- **Decree amending provisions of Industrial Property Law due to come into force**
- **Non-visible signs will be registrable for the first time**
- **Mexican Institute of Industrial Property still due to publish implementing regulations**

On 22 March 2018 the Mexican Senate approved a decree which amended some articles of the Mexican Industrial Property Law, introducing new provisions relating to trademarks.

The decree was published on 18 May 2018 and will come into force on 10 August 2018, pursuant to the first article of the transitional provisions. The Mexican Institute of Industrial Property needs to publish a set of regulations before 10 August, so that there is a clear understanding as to the scope of the amendments and new provisions.

The key features of the amendments can be summarised as follows:

- For the very first time in Mexico, trademark protection may be granted to non-visible signs, such as smells and sounds, as well as certain animated marks, such as holograms, and so-called 'trade dress' in a broader sense.
- Acquired distinctiveness (secondary meaning) will be recognised as an exception to the absolute grounds for refusal.
- Consent and co-existence agreements will be able to overcome earlier rights, except in cases involving identical trademarks for identical goods or services.
- Bad faith, in a broad sense, will be recognised as a ground for opposition, as well as a ground for invalidation.
- The protection of certification marks will now be recognised.
- It will no longer be possible to use class headings in trademark applications; it will be necessary to use specific descriptions of products and services according to the Nice Classification.
- Oppositions will be binding on the Mexican Trademark Office. Therefore, the latter will have to issue decisions that are duly grounded and justified based on the merits of each opposition.
- In order to clear the Mexican Register of unused marks, mark owners will have to make a declaration of use under oath, which must be filed within the three months following the third anniversary of the registration date. This declaration must specify the goods and/or services for which the trademark has been effectively used in Mexico, using the names of products and services according to the alphabetical list of the Nice Classification; the protection granted by the registration will be restricted to those goods for which use has been declared. If no use is declared by such date, the registration will automatically lapse. This new provision will apply to all registrations granted as of 10 August 2018, regardless of the date of filing.
- It will no longer be possible to renew a trademark registration in a certain class based on use of the registered trademark in other classes.
- As of 10 August 2018, all trademark registrations which are due for renewal will have to include a declaration of use specifying the goods and/or services for which the trademark has been effectively used in Mexico, as described in point 8. The renewal certificate issued by the Mexican Trademark Office will restrict protection to those specific goods/services.

The fact that the Mexican Institute of Industrial Property has not yet published the regulations that are due to clarify how these amendments will be implemented has generated a lot of nervousness among trademark holders in Mexico, as well as among professionals in the field of industrial property. However, there is no doubt that the amendments constitute the greatest advancement in trademark protection in the country in several decades.

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