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New approach concerning estimation of trademark notoriety or fame will benefit brand owners

Mexico - [OLIVARES](#)

Historically, the [Mexican Industrial Property Law](#) has provided protection for well-known and famous marks without registration, in line with the provisions of the [Paris Convention for the Protection of Industrial Property](#).

However, while, under the provisions of the Industrial Property Law, the [Mexican Institute of Industrial Property](#) (IMPI) is duly entitled to "estimate" the notoriety or fame of a given mark when conducting the examination on relative grounds of a trademark application, for many years examiners have failed to perform this task, arguing that such estimates, without documentary evidence effectively proving the notoriety of the mark, would be very weak when defending a refusal based on such an assessment. On that basis, when the examiners had to consider an application for registration of a well-known mark filed by a party other than the rightful owner, but there was no registration in Mexico protecting the well-known mark in the name of the legitimate owner, they granted the corresponding registration to the 'trademark kidnapper', precisely because no registered rights were enforceable.

This practice undoubtedly led to countless registrations for notorious and famous marks being granted to trademark hijackers in Mexico, creating an undesirable environment of legal uncertainty for trademarks owners, and forcing them to obtain so-called "defensive registrations" in all or several classes, which was inconvenient for trademark holders, particularly in terms of costs.

Fortunately, by the end of 2014, the IMPI changed that practice and began to object to, or refuse, the registration of notorious and famous marks by illegitimate third parties, based on a simple estimation of the notoriety or fame of the mark, in its capacity as trademark authority in Mexico.

While it is true that such estimates may sometimes not be well-founded (and, therefore there is always a risk that the applicant may challenge an objection or refusal based on such an estimate), the simple fact that IMPI is now putting an additional obstacle in the path of trademark kidnapers is a breakthrough that will undoubtedly result in greater legal certainty for trademark owners wishing to venture into the Mexican market.

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TAGS

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