



14 Nov 2013 Trademark Office adopts 'absurd' practice for formalities examination

Mexico - [OLIVARES](#)

Although Mexico became party to the [Nice Agreement](#) in March 2001, the international classification of products and services established therein was in fact adopted by the Mexican trademark system in 1989, and was formally incorporated in the [Mexican Industrial Property Law](#) in 1994. Since then, the interpretation and application of the classification by the [Mexican Trademark Office](#) has undergone many changes.

There is no doubt that the classification of products and services is not always an easy task, in light of the extraordinary developments in the manufacturing and services industries, and the sophistication of the products and services currently offered in commerce.

However, the Trademark Office has recently adopted extremely formalistic and rigid criteria during the formalities examination stage - if the descriptions of certain products or services do not appear exactly in the list of goods and services of the [latest edition of the Nice Classification](#), the examiners now issue official actions requesting the applicants to clarify the nature of the products or services, and to amend/reword the descriptions in order to match exactly those provided in the alphabetical list of products and services of the classification.

Arguably, this practice is absurd and contrary to the intent of the Nice Classification:

- It is obvious that the alphabetical list of products and services established in the Nice Classification is not exhaustive, as it would be impossible to gather all existing products and services in any given classification system.
- The Nice Classification incorporates explanatory notes in connection with each of the 45 classes. These provide clear parameters to assist examiners in determining the correct classification of specific products and services not expressly included in the alphabetical list, based on the nature of such products or services.

Unfortunately, the Trademark Office's approach is causing important delays in the prosecution of trademark applications, and trademark owners are incurring extra costs in connection with the professional and government fees associated with filing responses to the Trademark Office's requests.

Some members of the Mexican Intellectual Property Association are currently working together with the Mexican Institute of Industrial Property to create a complementary list of goods of services that are not included in the 10th edition of the Nice Classification.

However, as this task could be never-ending, and until the classification criteria are amended by the Trademark Office, trademark applicants in Mexico are advised to draft descriptions of products and services that are as close as possible to those provided in the alphabetical list of products and services of the current edition of the Nice Classification. This will save applicants both time and money when seeking to obtain a trademark registration.

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TAGS

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