

The Trademark

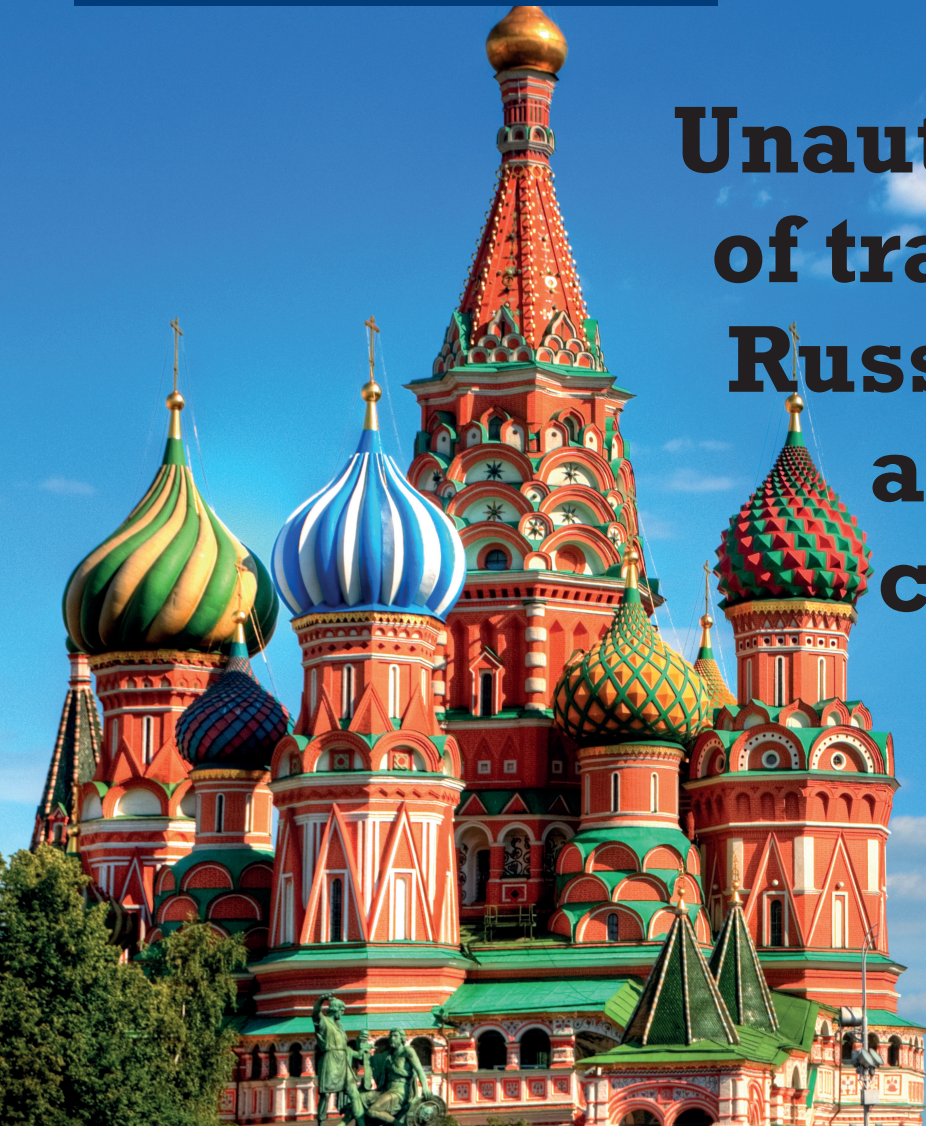
Issue 4 2023

GLOBAL REACH, LOCAL KNOWLEDGE

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Lawyer

Unauthorized use of trademarks in Russia – is there anything that can be done?



Riikka Palmos, Senior Partner and Director of the Trademark Department at Papula-Nevinpat, provides an update on trademark use and registration in Russia's changing IP landscape.

Jack Daniel's consumer survey

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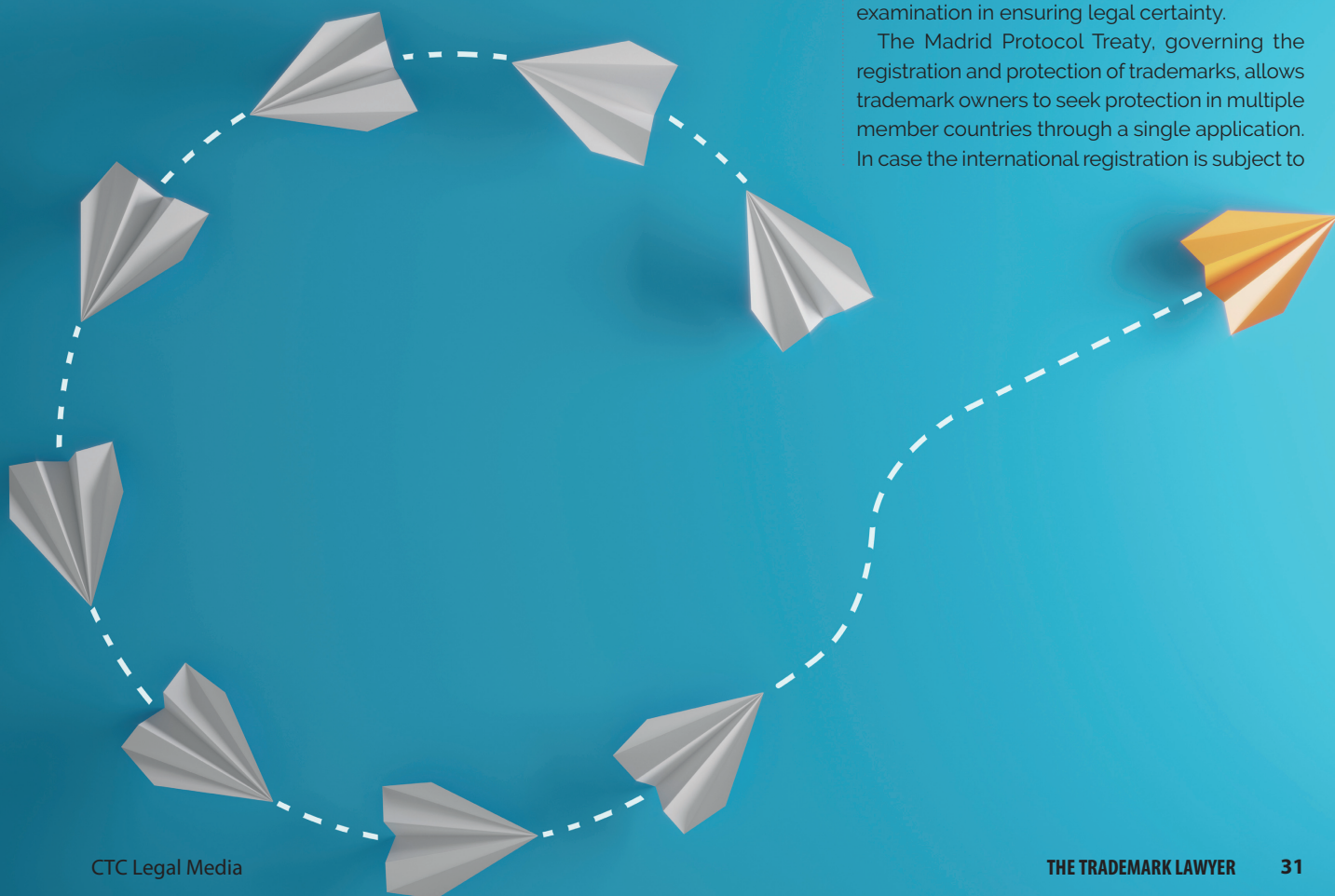
Application criteria for transformation applications in Mexico

Mariana Patiño of OLIVARES details the application criteria of the Mexican Institute of Industrial Property in relation to the validity of international registrations subject to transformation by virtue of the amendments to the Federal Law for the Protection of Industrial Property.

As a matter of introduction, the Mexican Institute of Industrial Property (IMPI) plays a crucial role in overseeing the transformation of international registrations into national or regional applications under the Madrid Protocol. This article explores the application criteria outlined by IMPI and the

relevant amendments to the Federal Law for the Protection of Industrial Property, particularly focusing on the impact of these criteria on the validity of trademarks obtained through the transformation process. Additionally, we will examine the benefits and criticisms associated with this transformation process and the significance of the new substantive and formal examination in ensuring legal certainty.

The Madrid Protocol Treaty, governing the registration and protection of trademarks, allows trademark owners to seek protection in multiple member countries through a single application. In case the international registration is subject to



cancellation by the office of origin, the figure of transformation set forth in Article 9 quinquies of the Protocol establishes a process whereby enables trademark holders to convert an international registration into a series of national or regional applications, offering several advantages to the trademark holder.

Titleholders have a three-month window to request, directly before the contracting offices where the international registration had effect, the transformation of the international registration into a series of national or regional applications. The resulting national or regional applications maintain the original filing date, thereby preserving the right of "preemption" and allowing the holders to enjoy recognition of priority if it was claimed earlier in the international registration.

The three-month window to initiate the transformation process starts running after receiving WIPO's notice of ceasing of effects or the so-called recordation of the cancellation of the international registration in the International Register.

Benefits and criticisms of the transformation process

The transformation process offers significant benefits, including the retention of the original filing date and the recognition of priority rights. This facilitates the protection of trademarks in multiple jurisdictions, simplifying the administrative burden for trademark holders. However, criticisms arise from the fact that each Contracting Party or Designated Office has the authority to establish specific criteria for transformation. Consequently, the uniformity and consistency of the process may be affected as the Protocol and the International Bureau is no longer directly involved. This can lead to fluctuating standards and requirements, making the process less predictable for trademark holders regaining protection in multiple jurisdictions.



Mariana Patiño

Résumé

Mariana Patiño, Attorney

Mariana joined OLIVARES in 2017 as an attorney of the Trademarks team in Mexico and abroad. Her practice is focused on Industrial Property matters, mainly consulting, registration and prosecution of distinctive signs.

Her experience includes conducting availability searches, preparation, filing, follow-up of applications, and the handling of requirements and provisional refusals before the Mexican Institute of Industrial Property, drafting of license agreements, franchises, mergers, and transfer of rights, as well as negotiation of coexistence agreements and planning of strategies for the protection of intangible assets abroad.

Represents national and foreign clients in matters related to Intellectual Property rights across a range of industries, such as digital media, entertainment, hotel, and various consumer goods.

Impact of the Federal Law for the protection of industrial property

The interim application of the Federal Law for the Protection of Industrial Property, which took effect on November 5, 2020, holds implications for the validity of trademarks obtained through the transformation process. The law provides that the term of validity of trademarks is established from the date of grant instead of from the filing date as our previous IP law used to establish. This raises the question of which criteria will be applied to applications undergoing the transformation process.

According to the criterion of IMPI examiners, the effective date of transformed applications will align with the international filing date if the office assignment of the new national file number was agreed and issued before November 5, 2020. Regardless of whether the transformation request was filed before the aforementioned date. Consequently, if the national dossier number was assigned after November 5, 2020, the validity period of the transformed application will be 10 years from the date of granting the national registration. Therefore, the date of issuance of the official communication approving the transformation holds paramount importance in monitoring the declaration of use obligation deadlines and maintenance renewal dates.

Now, it is worth mentioning that every transformation petition is subject to a new substantive and formal examination with the aim of safeguarding the principles of legal certainty and maintaining the integrity of the trademark registration process.

Furthermore, while the requirement for a new substantive and formal examination aims to ensure the compliance of transformed applications with local laws and regulations, there have been instances where the process has faced challenges. As local agents, our responsibility is to closely observe whether the substantive examination is conducted in strict accordance with the law. Unfortunately, in practice, it has been observed that the Mexican Institute of Industrial Property (IMPI) may cite registrations with a date later than the filing date of the transformation application, which has benefited from the right of "preemption."

This occurrence has raised concerns among trademark holders and local agents as it can hinder the transformation process and lead to additional investments in rectifying arbitrary citations. The citation of registrations with a later date than the filing date of the transformation application seems to contradict the very purpose of the "preemption" right, which is intended to maintain the original filing date of the international registration.

Such instances create uncertainty for trademark holders who, in good faith, initiated the

transformation process expecting the preservation of their original filing date and granted rights. It can also introduce unnecessary delays and additional administrative burdens as trademark holders are compelled to address these arbitrary citations, diverting resources away from their core business activities.

To address these challenges and ensure a more streamlined transformation process, it is imperative for IMPI to exercise due diligence in conducting the substantive examination. Local agents and trademark holders alike expect a fair and transparent evaluation of the transformed applications. This entails careful scrutiny of relevant trademarks already registered in the jurisdiction to avoid unwarranted citations and to uphold the right of "preemption" in their true spirit.

Enhancing communication and collaboration between trademark applicants, foreign counselors, local agents, and IMPI is a possible solution to the aforementioned issues. A transparent dialogue can help clarify any ambiguities regarding the transformation process and ensure that all parties involved are engaged with the same understanding. Additionally, seeking feedback from trademark holders and local agents on their experiences and challenges can help IMPI refine its examination practices standardize clear guidelines to minimize discrepancies and ensure an efficient transformation process, while safeguarding the principles of legal certainty and fairness.

Moreover, introducing mechanisms for trademark holders to challenge arbitrary citations through efficient and accessible appeals processes can enhance the accountability and fairness of the examination process. This would not only allow for the rectification of erroneous citations but also reinforce the confidence of trademark holders in the transformation process.

Ultimately, the effective implementation of the transformation process and its examination criteria is vital to promote foreign investment and innovation. A smooth and predictable transformation process enhances Mexico's attractiveness as a destination for international trademark protection, encouraging more businesses to re-seek protection in the country and stimulating economic growth.

We would be delighted to assist you with your transformation application.

Contact

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