

Practice Update: Amendments to Mexico IP Law

May 22, 2018 – *The TMCA*

by Charlene Krogh



From time to time, we publish updates on changes to trademark laws that may impact our readers and their IP registration and enforcement strategies. Once again, Mexico is making changes to its trademark system (recall Mexico added an opposition system in 2016).

The proposed amendments are extensive and contain provisions related to new protection for non-traditional trademarks, nullity and opposition procedure, and amendments to provisions on well-known and famous brands, as well as many others. The following are a few notable amendments that may immediately impact use, filing and maintenance strategy:

- For all trademark registrations granted from the effective date, trademark owners must file a declaration of use within three months from the third anniversary of the registration. No extensions will be available and failure to file will result in cancellation of the registration.
- Registrants filing renewal applications will be required to file a declaration of real and effective use of the mark in Mexico in connection with at least one of the products or services covered by the registration.
- Trademark applicants will be required to identify a date of first use of the trademark in Mexico. Failure to identify a date of first use will be deemed as a voluntary declaration of no earlier use in Mexico. This requirement will exist regardless of the fact that use is not required to prosecute the application or achieve a registration in Mexico. It is possible the failure to identify a date for a mark in use in Mexico (deemed voluntary declaration of no earlier use) could impact defense and enforcement proceedings.

The Mexican Senate passed the amendment to the Industrial Property Law in April 2018 and it is likely to become effective sometime in the next several months.

Related People

- Charlene Krogh

Related Capabilities

- Trademark, Copyright + Advertising
- Intellectual Property Litigation

