

## **The New Right of Opposition to the Trademark Registration Process in Mexico.**

By Tracy Delgadillo.

On June 1<sup>st</sup>, 2016 an amendment to the Mexican Industrial Property Law (the “Law”) was published on the Official Gazette introducing a new procedure that allows any person the right to oppose, on justified grounds, to the registration of a trademark in Mexico.

Once the amendment to the Law becomes effective on August 29, 2016, the Mexican Institute of Industrial Property (known as “IMPI” for its abbreviation in Spanish), which is the administrative authority on intellectual property matters in Mexico, must abide by the following procedure when receiving an application for a trademark registration (an “Application”):

1. No later than ten business days following the receipt of an Application, the IMPI must publish it in the Gazette of Industrial Property and shall proceed, simultaneously, to examine the form and content of the Application and documentation received, in order to confirm if it complies with the requirements set forth in the Law.
2. Subsequently, any person could oppose to the registration of the Application within a non-extendable term of one month following the date in which the publication mentioned in step 1 above becomes effective, by addressing a written letter to the IMPI accompanied by the necessary documentation and the payment receipt of the corresponding fee, only if the person opposing considers that the published Application:
  - a. is contrary to public order, moral and good conduct;
  - b. violates any legal provision; or
  - c. is one of the non-registrable trademarks according to article 90 of the Law, such as trademarks that are identical or similar to other trademarks that are in process of registration or that have already been registered and are still effective, letters, digits or isolated colors, names, pseudonyms, signatures and portraits without the prior consent of the interested party, among other scenarios.
3. Once the term of one month following the publication of the Application has expired, and no later than ten business days following such expiration, the IMPI will publish in the Gazette a list of the applications from which it has received an opposition.
4. The applicant will then have one month to defend its trademark from the opposition filed to his Application, through a written document addressed to the IMPI.
5. Finally, the IMPI will review the statements of both the opponent and the applicant when analyzing and reviewing the Application, and will inform both parties of its decision, whether the Application was accepted or not.

This right of opposition, although new to Mexican legislation, already exists in other countries such as the United States of America, where any person that considers an Application causes or could cause him a damage, has the right to oppose to its registration within the 30 days following the publication of such Application by the correspondent authority.

In the case of Mexico, the amendment states that any person can oppose to the registration of a trademark only if he or she considers that the Application fits within any of the scenarios mentioned in items a), b) and c) of step 2 above; therefore, any opposition received by the IMPI and which does not comply with the

foregoing, will not prevent the registration of a trademark and the applicant rights will not be affected without justification.

It will be interesting to see how the IMPI carries out this new procedure once the amendment becomes effective and the owners of a trademark can oppose to the registration of another trademark they consider is identical or similar to theirs, since this right was non-existent before and now the trademark owners in Mexico can play a more active role in the legal protection of their trademark.

#### Legal Note

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Do not hesitate to contact us at our numbers below for professional legal advice on the subject matter of this memorandum or for any further information, comments or questions. Let us help.

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