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Madrid system: the experience 14 months on

Mexico - [OLIVARES](#)

In general terms, there is no doubt that the Madrid system should be beneficial for trademark owners, particularly in terms of cost effectiveness. However, the current experience in Mexico shows that, due to the legal requirements established by the [Mexican Industrial Property Law](#) and corresponding regulations, as well as the extremely formalistic criteria adopted by the [Mexican Trademark Office](#) (IMPI), such cost effectiveness may not be a reality in the country.

First, the fact that the Industrial Property Law does not allow for multi-class applications means that any international application covering several classes designating Mexico has to be split into several national applications (one per class), with each of these applications being subject to an individual examination.

Moreover, although Mexico is part of the [Nice Agreement](#) (and, therefore, the country applies the international classification system derived from the agreement), the IMPI is still requesting that applicants for international trademarks make amendments to their products/services descriptions, despite the fact that such descriptions have been already admitted by the [World Intellectual Property Organisation](#) (WIPO) without any objection.

In addition, the IMPI has [adopted extremely formalistic and rigid criteria](#) during the formalities examination: if the descriptions of specific products or services do not appear exactly in the latest edition of the [Nice Classification](#) of products and services, the examiners will issue provisional refusals, requesting that the applicants clarify the nature of the products/services and amend/reword the descriptions in order to match exactly those provided in the alphabetical list of products and services of the classification.

Second, Mexico is one of the very few countries in the world that does not provide for trademark opposition proceedings. Under the Industrial Property Law currently in force, the IMPI is the administrative authority that is legally empowered to conduct the *ex officio* examination of trademark applications on absolute and relative grounds. Therefore, the IMPI is also issuing provisional refusals against international registrations designating Mexico based on relative and absolute grounds.

Of course, Mexico's recent accession to the Madrid system presents new and complex challenges for the IMPI when examining national trademark applications with respect to earlier international applications designating Mexico, since the timeframe for the prosecution of international applications is so different from that for national applications. This has inevitably resulted not only in legal, but also practical problems, simply because the prosecution of an application filed directly in Mexico is much faster than the prosecution of an application filed through WIPO, and in the long run it may be less costly.

Finally, it must be noted that a large number of international applications designating Mexico have been successfully granted without any obstacle, and the corresponding registrations are currently in full force and effect.

However, even in those cases where registration was obtained without any major obstacle, registrants are still advised to appoint a local agent for service in respect to their international registrations in the country. Under the current legal framework, if a Mexican registration obtained through the Madrid system is challenged by a third party, and no local agent has been recorded for service in respect to such registration, the service of such claim would be effected through letters rogatory, with all the inconvenience that this may bring in terms of time and cost effectiveness.

In short, it is still difficult to tell which way (ie, applying via WIPO or via country-specific applications) may be more beneficial for trademark owners as far as concerns Mexico, since the accession of Mexico to the Madrid system is still relatively recent, and practitioners are still learning about the functionality and efficiency of the system in the country.

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TAGS

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