



26 Jul 2013 New Trademark Examiners' Manual to be introduced

Mexico - [OLIVARES](#)

In 2012 the [Mexican Institute of Industrial Property](#) (IMPI), together with several members of the Mexican Association for the Protection of Intellectual Property (AMPPI), started working towards the creation of a Trademark Examiners' Manual.

For many years, IMPI's trademark examiners worked without specific examination guidelines, which resulted in several inconsistencies as to the applicable criteria, particularly regarding:

- classification issues;
- compliance with formalities;
- objections as to inherent registrability; and
- objections based on the existence of earlier rights belonging to third parties.

Consequently, the creation of a new manual was necessary in order to:

- establish appropriate guidelines so that examiners could carry out the examination of the relevant formalities and the examination of the application on absolute/relative grounds for refusal, thereby applying uniform criteria during the prosecution of trademark applications; and
- most importantly, provide legal certainty to parties when applying for the registration of new trademarks.

This task was divided into two stages. The first part consisted in the creation of guidelines regarding the examination of the relevant formalities, which was finalised in December 2012, and subsequently published on IMPI's website under the name "*Guía de Directrices del Examen de Signos Distintivos*" ("Examination Guidelines for Distinctive Signs").

These guidelines include an exhaustive list of:

- the legal requirements necessary to fill an official trademark application form correctly;
- the documents that should be attached to the application form (eg, powers of attorney, rules of use, copies and receipts of the payment of the official fees); and
- the legal consequences of any mistake in the data, documents or receipts of payment submitted along with the application.

It was of course difficult to identify all the particular circumstances and facts that could affect the prosecution of a trademark application, but such efforts were necessary in order to provide as much legal certainty as possible to applicants when applying for the registration of new trademarks.

The second part of the task will consist in the creation of guidelines concerning the absolute/relative grounds for refusal. These discussions are due to begin within the next few weeks, with the aim of finalising the guidelines by the end of the year.

This second part will undoubtedly represent the biggest challenge of this task, even though it will rely on the absolute and relative grounds for refusal established in Article 90 of the [Mexican Industrial Property Law](#), which currently devotes 17 sections to this issue. While the absolute and relative grounds for refusal *per se* are already incorporated in the law, the new guidelines should contain uniform criteria to help the examiners interpret these grounds for refusal when considering the inherent registrability of a trademark and the likelihood of confusion with earlier marks.

These guidelines will be written in strict accordance with the Industrial Property Law and the corresponding regulations that are currently in force. They will also take into account all court precedents dealing with absolute and relative grounds for refusal, thus adding to the complexity of the task.

IMPI's initiative, with the support of the members of AMPPI, is welcomed by all trademark practitioners in Mexico, and it is expected that it will result in increased consistency and predictability when prosecuting trademark applications, which should ultimately reduce the legal costs incurred by foreign and domestic companies with large trademark portfolios.

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TAGS

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