

# A closer look at declaration of actual and effective use in Mexico.

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## **Diego Ballesteros of OLIVARES examines the evolving law of declaring trademarks in Mexico**

As of August 10 2021, declarations of actual and effective use (DAEU) need to be filed after the third anniversary of all those registrations granted on or after August 10 2018.

In fact, some changes in the Mexican Industrial Property Law (IPL) came into force as of August 10 2018, in which a DAEU use was introduced in two stages, namely:

- a) A DAEU of the registered mark to be submitted along with each renewal application (every 10 years); and
- b) A one-time DAEU which has to be submitted within the three months after the third anniversary of the date of grant of the registration in Mexico.

The new regulation applies to all registrations (including international registrations designating Mexico) which renewal was due on or after August 10, 2018, when it comes to the DAEU of the registered mark to be submitted along with each renewal application (every 10 years).

Regarding the one-time DAEU, which has to be submitted within the three months after the third anniversary of the date of grant of the registration in Mexico, it only applies to registrations which were granted on or after August 10 2018, despite the date of filing.

No evidence of use should be filed with the Mexican Trademark and Patent Office (IMPI). In both cases, IMPI has published official forms, and the same should be executed by filling in the specific goods or services on which the trademark owner confirms actual and effective use in Mexico.

In the case of renewals, the renewal certificate will be issued reflecting the restriction of the protection according with the DAEU. Likewise, regarding the one-time DAEU use which must be submitted within the three months after the third anniversary of the date of grant of the registration in Mexico, the scope of protection of the registration will be restricted to the goods or services on which the actual and effective use was declared.

Regarding renewals, the DAEU must be filed along with the renewal application when dealing with Mexican national registrations.

However, in case of Mexican registrations derived from IR's which are renewed directly before WIPO, the DAEU must be filed before the Mexican Trademark Office within the next two months as of service date of the relevant requirement that WIPO will issue to the trademark owner.

In turn, concerning the one-time DAEU, the term to file it is of three months from the third anniversary of the registration date, and no extension of the term is allowed. This term is the same for international registrations designating Mexico.

The above new regulation will also apply for IR registrations designating Mexico.

Up to now, the statement of protection served by the International Bureau to the holders of international registrations does not specify the date on which protection was granted in Mexico (date of grant), thus being necessary for the IR's holders to consult such information through the Mexican Trademark Office's database, where the base date is clearly reflected as fecha de concesión (date of grant). Of course, if the owner of an international registration designating Mexico has appointed a local agent for recovering the national registration certificate, it would be easier to obtain such information and keep it on dockets.



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