

The Trademark

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Mindful trademarking can prevent registration headaches

Nicholas Holmes of Caldwell discusses the importance of filing for protection quickly in the world of social media due to the speed at which trends can become popular and the risk this runs for content creators when trademark applications are reviewed on a “first to file” basis by the USPTO.

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Requirements for filing a declaration of actual use by owners of International Registrations designating Mexico

Alonso Camargo and Diego Ballesteros of OLIVARES detail the requirements of Mexican registrations derived from International Registrations when filing a declaration of actual use, identifying the problems with the process, and examining how successful the introduction of the Federal Law for the Protection of Industrial Property (FLPIP) has been in fixing these issues.

As of August 10, 2018, a declaration of actual and effective use was introduced as a maintenance requirement for trademark registrations granted in Mexico. The purpose of this introduction was to clear up the register of trademarks that were no longer of interest to their owners and block the registration of new marks.

The declaration of use requirement is established in two stages:

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

The above regulation also applies to International Registrations derived from the Madrid System designating Mexico.

No evidence of use should be filed with the Mexican Institute of Industrial Property (IMPI) at the time of filing the declarations of use. In both



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Résumés

Alonso Camargo joined OLIVARES in 1995 and became a partner in 2008. Alonso's clients "draw confidence from his complete dedication to their cause," according to World Trademark Review's WTR 1000. He is a highly experienced trademark attorney who represents many of the firm's key clients and their well-known brands. His team serves as the heartbeat of OLIVARES' trademark practice. Alonso studied in Alicante, Spain, where he received his Masters in Intellectual Property. He has extensive knowledge of the European trademark system and is thus able to make comparisons between the European and Mexican systems in order to more effectively explain legal issues to his clients.

Diego Ballesteros joined OLIVARES in 2017. Since then, he has been an enthusiastic and effective member of the OLIVARES trademark team, participating in multiple matters of the highest relevance. Diego intervenes in all kinds of matters related to distinctive signs, such as the processing of consultancies, the supervision of the presentation of applications, assignments, name changes, and other trademark procedures before the Mexican Institute of Industrial Property (IMPI), as well as in the preparation of trademark registrability and availability searches, the preparation of franchise or license contracts, the negotiation of coexistence agreements for our clients, among many others.

cases, the IMPI has published official forms that are to be executed by local representatives on behalf of the trademark owners, stating the specific goods or services on which the trademark owner confirms actual and effective use in Mexico.

Regarding what is considered trademark use in Mexico, Mexican law establishes that the use of a trademark exists when the products or services identified with the mark are available for Mexican consumers.

While the mere availability of a given mark may not suffice to successfully defend a non-use cancellation action, for the purpose of a declaration of use, such use should be sufficient.

In the case of a one-time declaration of actual



Alonso Camargo



Diego Ballesteros

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and effective use, which must be submitted within 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 on which the actual use is declared. On the other hand, regarding renewals, the renewal certificate will be issued reflecting the restriction of the protection according to the submitted declaration of use.

The provision in law intends that the registrants declare use only in connection with the goods or services used. However, no evidence of use is required and in practice, there are no sanctions for those declarations specifying all the goods or services covered by the registration. The only consequence foreseen if the declaration specifies all the registered goods or services – but it turns out that the mark is used with some, but not all of the specified services – is that upon request of a third party, a partial non-use cancellation would be successful in respect to those goods on which the registrant is not able to demonstrate use. No additional consequences have been foreseen in practice for the false or inaccurate statement *per se* that may impact negatively the validity of the registration in its entirety.

It is important to highlight, however, that failing to file the declaration in both cases within the established terms results in the automatic lapsing of the registration.

While the law establishes an exemption for canceling a registration based on non-use when such non-use derives from circumstances beyond the control of the registrant, such as governmental restrictions, similar treatment was not provided concerning the declaration of use.

Concerning the one-time declaration of actual and effective use, this applies to all registrations granted in Mexico as of August 10, 2018, despite the date of filing, whether such registrations were obtained through the National route, or the Madrid System.

Regarding the declaration of use that needs to be filed at the time of renewing Mexican trademark registration, the law establishes that it must be filed along with the renewal application.

When dealing with Mexican National registrations, the declaration of use that needs to be filed along with the renewal is not an issue since the renewal application form contains the so-called declaration of use. Therefore, the party applying for renewal automatically declares the use of the mark when executing the form, and it is only required to specify the products/services used within such form.

However, in cases of Mexican registrations derived from International Registrations which are renewed directly before the World Intellectual Property Organization (WIPO), it becomes quite confusing (or even uncertain) for the trademark



owners. This is because the renewal application form filed through the WIPO does not contain any section, nor any indication on how to comply with this legal requirement derived from Mexican Trademark Law.

After the declaration of use requirement was introduced in 2018, the IMPI issued an internal Administrative Agreement whereby it was specified that for those registrations renewed by the Madrid System, the declaration of actual and effective use should have been filed before the Mexican Trademark Office within two months of the date the WIPO notifies the renewal of the IR.

Following this, the Federal Law for the Protection of Industrial Property (FLPIP) came into force on November 5, 2020, and introduced a new provision to fix this situation. Article 237 of the FLPIP establishes in its fourth paragraph that in cases where the declaration of use is not filed along with the renewal petition, the IMPI will issue an office action, granting a non-extendable two-month term to comply with such requirement.

This change was specially addressed and relevant for the trademark registrations obtained through the Madrid System because the renewal format used in the Madrid System does not include a declaration of use (as required by the FLPIP), causing uncertainty about the deadline to file the declaration of use. However, although this provision was intended to provide clarity to the Madrid System users as to when it is necessary to file a declaration of actual and effective use after applying for renewal before the WIPO, there are still problems with these cases. In practice, the office actions issued by the IMPI to grant the two-month term to registrants to comply with the declaration of use requirement are exclusively published in Mexico in the Mexican Industrial Property Gazette. Therefore, those

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international trademark owners who designated Mexico through an International registration but didn't appoint a local representative will never become aware of the existence of these office actions, and will likely lose their rights.

According to the FLPIP, it is compulsory to indicate a domicile for service in Mexico in all applications filed with the IMPI, a situation that is not considered in the Madrid System but gives the IMPI the authority to make effective the two-month term mentioned above.

In light of this situation, and until a new way to communicate the deadline for complying with these requirements to trademark owners is implemented through the WIPO, a practical recommendation for all international users of the Madrid System who designate Mexico in their International Registrations is to appoint a local representative once served with the Statement of Grant of Protection from the WIPO, to avoid the risk of losing their trademark rights in Mexico.

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