

MEXICO – Don't miss the two-month term to file the Declaration of Actual Use when renewing your Mexican registration derived from an International Registration!

As of August 10, 2018, in Mexico, a DAU of the registered mark must be submitted along with each renewal application (every ten years). This requirement applies to registrations (including International Registrations (IRs) designating Mexico) which renewal was due on or after August 10, 2018.

However, in case of Mexican registrations derived from IRs which are renewed directly before WIPO, it results confusing (or even uncertain), which is the term for filing the DAU, since the renewal application form filed through WIPO does not contain any section to comply with this requirement.

This issue was partially addressed by the new Mexican IP Law, as it establishes that in those cases where the DAU is not filed along with the renewal petition, the Mexican Institute of Industrial Property (IMPI), will issue an office action, granting a non-extendable two-month term to comply with such legal requirement.

Although this provision was intended to provide more certainty, the issue is that the office actions issued by IMPI to grant the two-month term to comply with such a requirement are published in IMPI's Official Gazette, which is published only in Mexico, thus, the owners of IRs designating Mexico that didn't appoint a local representative, will never become aware of the existence of these office actions, and thus will likely lose their rights.

In fact, according to Mexican IP Law it is compulsory to indicate a domicile for service in Mexico in all applications filed with the IMPI, situation that is not considered in the Madrid System, but nevertheless gives IMPI the authority to make effective the two months term mentioned above.

Therefore, the most practical recommendation for all users of the Madrid System designating Mexico in their IRs is to appoint a local representative to avoid the risk of losing their trademark rights in Mexico.



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