WTR

The Trademark Litigation Review

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Mexico: strategy shifts, SEPI’s reach and new procedural traps

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The third edition of the WTR *Trademark Litigation Review* casts an expert eye on some of the most pressing issues facing those involved in litigation on both sides of the divide, blending analytic insight with on-the-ground expertise from the key regions of the Americas, the Asia-Pacific, and Europe, the Middle East and Africa.

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Mexico: strategy shifts, SEPI's reach and new procedural traps

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Summary

IN SUMMARY

- As the opposition system evolves in Mexico, the trademark-litigation landscape is changing fast.
- While oppositions appear increasingly central, they may also narrow future avenues of defence if not carefully structured.
- The traditional path for protecting trademark rights has shifted; ignorance of these changes can leave marks insufficiently protected.
- The IP-specialised chamber of the Federal Court for Administrative Affairs (SEPI) is now empowered to declare trademark invalidity.
- The lack of uniform criteria among the Mexican Institute of Industrial Property (IMPI), SEPI and the Federal Circuit Courts (FCC), together with IMPI's new formalistic standards on powers of attorney, creates serious procedural pitfalls that can lead to dismissals regardless of the merits.
- IMPI's current handling and communication of opposition decisions and grants or refusals can produce contradictory outcomes unless managed with a coordinated, parallel appeal strategy.

DISCUSSION POINTS

- Evolution of the opposition system
- Precedent-setting legal cases
- The new role of SEPI in trademark invalidations
- Impact of the estoppel provision (article 259)
- Res judicata of reflected efficacy doctrine
- Lack of uniform criteria between authorities handling oppositions
- Relevant procedural hurdles

REFERENCED IN THIS ARTICLE

- Case IX-P-SS-85 (Superior Chamber of the Federal Court for Administrative Affairs): established that it is possible to challenge both the ruling in failed oppositions and the validity of the trademark registration.
- ***Amparo***number 232/2024 (Federal Circuit Court): ordered SEPI to declare the invalidity of the trademark registration after IMPI's failure to do so.
- Federal Law for the Protection of Industrial Property (2020)g>: introduced significant changes to the opposition system, including an estoppel provision (article 259) that prevents invalidity actions based on failed oppositions.

Article 27 of the Federal Law for the Protection of Industrial Property: regulates the formalities for powers of attorney for oppositions and invalidity actions.

- Article 259 of the Federal Law for the Protection of Industrial Property: states that an invalidity action cannot be filed on the same grounds and evidence as those used in a failed opposition.
- Mexican Industrial Property Law (pre-2020): the previous legal framework, under which the opposition system was less structured and developed.
- Mexican Institute of Industrial Property (IMPI): the authority responsible for processing trademark applications, oppositions and issuing trademark-related decisions.
- SEPI: a specialised body within the Federal Court for Administrative Affairs responsible for reviewing IMPI's rulings.
- Federal Court for Administrative Affairs (TFJA): the court tasked with handling appeals concerning IMPI's decisions, including those arising from opposition proceedings.

Injunctions At A Glance

Preliminary injunctions – are they available, how can they be obtained?	Yes, in accordance with Mexican IP law, preliminary injunctions are available and can be obtained from IMPI by filing a motion presenting a prima facie case based on any IP right. Details of the injunctions to be implemented from those available by law must be provided, and a bond posted that warrants any possible damages that may be caused to the party suffering the injunctions.
Permanent injunctions – are they available, how can they be obtained?	Mexican law does not expressly allow permanent injunctions. Preliminary injunctions only become permanent when IMPI declares infringements against the party suffering the injunctions. However, under the new Mexican IP law, IMPI must conduct a balancing exercise to determine who has the better appearance of right and who may suffer greater damage from the lifting or staying of the injunctions. As a result, even if the alleged infringer requests the lifting of the injunctions, it may be denied. Technically, the injunction remains preliminary until the issuance of a final ruling on the merits.
Is payment of a security or deposit necessary to secure an injunction?	Yes, the posting of a bond sufficient to warrant any possible damages that may be caused to the party suffering the injunction is required.
What border measures are available to back up injunctions?	Mexican IP law provides border measures to suspend the free circulation of goods

	intended for import, export, transit, or any customs regime that violate IP law. These measures are coordinated between IMPI and customs authorities.

This article updates and expands upon the analysis we published last year on the evolving framework of trademark oppositions in Mexico. Since then, new developments – including recent precedents issued by SEPI and the Federal Circuit Courts, as well as practical challenges arising from IMPI's procedural handling – have further reshaped the litigation landscape. The following sections highlight these advances, illustrate how brand owners are navigating the complexities of estoppel and res judicata and identify emerging risks that continue to transform trademark enforcement in Mexico. Beyond case law, legislative dynamics may soon reshape this field. On 15 September 2025, a bill to reform the Federal Law on the Protection of Industrial Property (LFPPI) was introduced in the Senate, reportedly with IMPI's backing. If enacted, these amendments could recalibrate procedures that intersect with oppositions and invalidity actions, potentially affecting evidentiary burdens and timing strategies. We are monitoring this initiative closely and recommend brand owners do the same.

Since its introduction into Mexican intellectual property (IP) law back in 2016, the opposition system has been constantly evolving. First, the opposition system was very poorly regulated, resembling a letter of protest similar to those used in jurisdictions such as the USA, and IMPI was not even bound to consider or study the oppositions filed.

At that point in time, the structure of the opposition system could be summarised as follows:

- there was a 30-day period to file an opposition, counted as from the date of publication of the application in the Official Gazette;
- any person could file an opposition, but said person was not recognised by IMPI as a party in a proceeding, not even an interested third party;
- the opposition brief could be accompanied by any documentation deemed as relevant, but there was no reference in the law to the possibility of formally filing evidence in support to the opposition; and
- IMPI was bound neither to study nor resolve the opposition filed and was only obliged to state whether the opposed trademark application matured into registration.

In 2018, an amendment to the former Mexican IP law introduced relevant changes to the opposition system, providing it with a more robust structure that could be described as follows:

- there was a 30-day period to file an opposition, counted as from the date of publication of the application in the Official Gazette;
- any person with interest might file an opposition, thus being recognised as a party within the proceeding;
- the opposition brief had to be accompanied by all evidence supporting it, as well as including the proof of payment of the corresponding tariff of services;
- the trademark applicant was notified about the opposition filed and was granted a one-month period to produce a reply to the opposition, which could be accompanied by any relevant evidence;

- the opposition did not suspend the prosecution of the application; and
- IMPI was bound to study and resolve the oppositions filed.

Notwithstanding the fact that under this new scenario IMPI was bound to study and resolve in a formal manner all oppositions filed, the rulings it issued at that point in time were poorly grounded and consisted of a single sheet simply communicating whether the opposition was deemed grounded and whether the opposed trademark application was allowed to mature into registration or finally refused.

In 2019, the above changed when the Second Chamber of the Mexican Supreme Court of Justice decided case number 234/2019 (review recourse in ***amparo***),[1] thus determining that the opposition system constitutes a procedure independent to that of the trademark registration, since the opposition is aimed at achieving objectives different to that of the prosecution of a trademark registration. It has different stages, is developed in parallel to and in a manner independent of the prosecution of a trademark application and therefore, even if there is some connection between both proceedings, it in no way means that one proceeding is subsumed by the other.

The precedent above caused IMPI's rulings for oppositions to become more robust and grounded and, therefore, the door was opened for challenging said rulings with SEPI.

At that time, there was no clarity regarding the effectiveness of appealing the resolutions issued within the opposition proceedings, because it was not even clear if SEPI was entitled to invalidate trademark registrations that had already been granted. Obviously, if SEPI was not entitled to invalidate a trademark registration, then the effects of any decision coming from SEPI in this sort of case was uncertain and did not offer brand owners a secure path to follow, which made them turn instead towards the filing of invalidity actions.

Indeed, many brand owners opted to file invalidity actions as soon as they detected that the opposed trademark application was allowed to mature into registration, instead of challenging an unfavourable ruling issued within the opposition proceeding, as many of said invalidity actions prosecuted before IMPI were successful.

Comparative note: unlike the United States Patent and Trademark Office (USPTO) practice – where oppositions and invalidations (cancellations) are channelled through the Trademark Trial and Appeal Board with clearer procedural symmetry – and the European Union Intellectual Property Office (EUIPO) practice – where oppositions and invalidity actions coexist under a mature body of guidelines – Mexican practice is currently evolving through layered precedents (IMPI, SEPI and FCC). This asymmetry increases the risk of estoppel and 'reflected res judicata' if arguments are not deliberately sequenced from day one.

The scenario above continued until November 2020, when the new Federal Law for the Protection of Industrial Property came into force, thus introducing additional modifications to the opposition system and including as well in its article 259,[2] an estoppel provision that prevented the filing of invalidity actions on the same grounds and evidence that was used in an opposition, if it had been attempted and failed. Hence, the structure of the opposition system is now as follows.

- There is a 30-day period to file an opposition, counted as from the date of publication of the application in the ***Official Gazette***.
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The opponent is recognised as a party within the procedure and must prove its legal standing by submitting a power of attorney.

- The trademark applicant is notified in one single communication about:
    - any formalities that need to be corrected in the application;
    - any objections regarding the registrability of the proposed trademark;
    - any anticipations (senior registrations or previously filed applications uncovered by IMPI's analysis) cited; and
    - any oppositions filed. The applicant is granted a four-month period to respond to this.
- The opposition is prosecuted in parallel with the trademark application, does not suspend the prosecution thereof and does not prejudge the trademark registrability analysis conducted by IMPI.
- A common five-day period is opened for both parties to submit their closing arguments in the opposition.
- IMPI is obliged to study and substantiate its decision for each opposition filed.

This led brand owners to deal with the complexity of assessing which invalidity causes to attempt within an opposition and which to reserve for an eventual invalidity action, if the opposition failed, which had to be analysed on a case-by-case basis.

The scenario above continued until the end of 2023, when another chapter in the evolution of the opposition system in Mexico came with a decision issued by the Superior Chamber of the Federal Court for Administrative Affairs, in case number IX-P-SS-85,[3] which held that it was possible to challenge before SEPI, the rulings issued by IMPI within failed oppositions, adding that the validity of the trademark registration that had been granted as a result of the failed opposition could also be challenged simultaneously with SEPI.

This radically changes the traditional scheme of how to challenge the validity of trademark registrations, as now it is not only possible to do it through the traditional path of an invalidity action before IMPI, but also through challenging before SEPI the unfavourable ruling issued by IMPI within an opposition, challenging at the same time the validity of the trademark registration granted as a consequence of the failed opposition.

It is worth noting that the precedent above indicated that the party challenging the validity of an unfavourable ruling issued within an opposition could also challenge, in parallel, the validity of the trademark registration. However, as we will see below, to avoid contradictory rulings, it becomes necessary to challenge both rulings in parallel.

Additionally, another recent chapter in the evolution of the opposition system came when, despite the fact that the Superior Chamber of the Appeals Court considered that SEPI could declare the invalidity of a trademark registration in the aforementioned terms, SEPI declared the nullity of a ruling issued by IMPI within a failed opposition, but refused to declare the nullity of the trademark registration and ordered the matter to be remanded to IMPI so that the latter could resolve it as it deemed convenient.

SEPI's decision was challenged before the FCC and received a favourable decision from the FCC in ***amparo*** number 232/2024, which ordered SEPI not to remand the case to

IMPI but to declare by itself the invalidity of the trademark registration. Hence, SEPI has issued another decision complying with what was ordered by the FCC, in case number 1627/2023-EPI-01-10, finally declaring the invalidity of the ruling issued by IMPI in the opposition attempted, and the invalidity of the registration granted.

Consequently, now there is no doubt that currently, there is a scenario wherein brand owners may obtain the invalidity of a trademark registration by a course of action different to the traditional invalidity action filed with IMPI. However, they must be very careful as to whether the opposition filed is sufficiently grounded; otherwise, an unfavourable ruling in that opposition may prevent them from filing an invalidity action against the granted registration later, because of the estoppel provision of article 259.

At the same time, brand owners must be aware of the current relevance of challenging the rulings issued within opposition proceedings, bearing in mind as well, that if challenging a ruling issued in an unfavourable opposition, they must also challenge in parallel the validity of the trademark registration granted to applicant.

To add more complexity to the above, recently SEPI and the FCC have also been issuing some decisions in appeal cases related to oppositions resolved unfavourably to opponents, which have had a relevant impact on invalidity actions attempted by brand owners who decided to challenge the trademark registrations that were granted as a consequence of the failed oppositions.

As mentioned above, in light of the estoppel provision of article 259, brand owners may opt to base their oppositions on any registrability prohibitions and reserve some legal arguments to be used in an invalidity action, should the opposition fail.

However, SEPI and the FCC are now consistently sustaining the alleged application of the doctrine of 'res judicata of reflected efficacy', explaining that this occurs when there is the same object and the same parties in two lawsuits or complaints, although with different actions. The outcome of the first lawsuit influences the outcome of the following one; the first serves as the basis for the next one to prevent contradictory judgments, always reflecting each other.

Based on this doctrine, SEPI is considering whether reflected res judicata may apply when IMPI has resolved an opposition – specifically where the analysis involves determining the likelihood of confusion between the trademarks in conflict and concludes that no such likelihood exists.

This may negatively impact any invalidity action filed by brand owners against the trademark registration resulting from the failed opposition. Even if the invalidity action is based on a different legal argument (eg, prior use or bad faith), if it involves a trademark analysis on likelihood of confusion, there is a risk that IMPI, SEPI or the FCC may consider – based on the res judicata of reflected efficacy – that the new invalidity action is unfounded. This is because the likelihood of confusion analysis was already conducted during the opposition, making any additional nuances irrelevant, as the core of the invalidity action would still rely on that same analysis.

In view of the above, even if a brand owner decided to reserve some legal arguments for attempting an invalidity action, should the opposition fail, those reserved arguments could eventually be deemed as ungrounded in view of the res judicata of reflected efficacy

principle, which could negatively affect the strategy originally devised by the brand owner and consequently, extra attention and care needs to be paid when drafting said strategies.

Something additional to ponder is that oppositions are resolved by the Trademarks Division of IMPI, while invalidity actions are decided by IMPI's Division for Contentious Affairs, so that even though they both belong to the same authority, there is still a need for uniform criteria between these two divisions of IMPI.

Another situation that caused some issues in the proper handling of the scenario above, derived from how IMPI is communicating, bearing in mind the time difference in the granting of a trademark registration derived from a failed opposition and the ruling formally declaring the opposition as ungrounded. Since both rulings must be challenged at the same time, although brand owners may become aware of the grant of the opposed registration well in advance, they will have to wait until being formally notified of the ruling declaring the opposition as ungrounded to formally challenge both rulings.

If not properly monitored, both rulings and the right to appeal them in parallel, in accordance with the precedents mentioned above, may be permanently lost.

Confidentiality note: the following example is anonymised and summarised due to ongoing proceedings. To make matters even more complex, in a recent case, an opponent noticed that the trademark registration had already been granted to its counterpart – which necessarily implied that the opposition had failed – but IMPI did not notify the corresponding ruling on the opposition even after a full quarter had elapsed. This prevented the opponent from appealing in parallel both the unfavourable opposition ruling and the granted registration, as required by precedent. Faced with this procedural gap, the opponent decided to file an invalidity action using arguments largely similar to those raised in the opposition. To circumvent the estoppel provision, the opponent also submitted other trademark registrations of its own as evidence. IMPI sustained that, because these additional registrations were offered as proof, estoppel did not apply.

Nevertheless, IMPI resolved the invalidity action by relying exclusively on the very same prior registration that had served as the basis of the failed opposition. In a clear error or illegality, IMPI not only admitted the invalidity action but also, overlooking both the estoppel prohibition and the doctrine of res judicata by reflected efficacy, declared the invalidity of the contested registration.

This proceeding is currently under review before SEPI, which should revoke IMPI's decision. Otherwise, this would set a dangerous precedent, lowering the evidentiary and argumentative threshold required to overcome estoppel and res judicata, thereby generating significant legal uncertainty.

One final procedural hurdle worth highlighting is IMPI's increasingly formalistic approach regarding powers of attorney in invalidity actions.

Based on article 27, section IV of the LFPPI, IMPI now requires that the notary or official before whom the power is granted must expressly certify both the legal existence of the company granting the power and the authority of the individual executing it. Otherwise, the power is deemed defective and the invalidity action is dismissed for lack of standing. This creates serious challenges for companies in jurisdictions where notaries lack public faith, making it necessary to attach additional documents proving corporate existence and the grantor's authority.

The complexity is heightened by the requirement that such powers must be filed together with the initial claim or, for defendants, along with their answers. Given the short one-month response period, parties often file an answer on time while the power is still in the process of notarisation or legalisation. Recently, however, IMPI has considered that if the notarisation and apostille are not dated prior to the expiration of the response deadline, the party lacked standing, leading to dismissals of several answers on this ground.

This criterion has been challenged before SEPI and the FCC, and in a very recent case, Circuit Court overturned IMPI's determination, confirming that such interpretation was illegal. IMPI should therefore revise this approach, although we are monitoring whether further precedents will be required to settle the matter.

Foreign companies should issue standing powers early, ensuring the notary (or competent official) expressly certifies corporate existence and signer's authority, and leave calendar room for legalisation or apostille to pre-date deadlines. Where local notaries lack public faith, corporate registries and incumbency certificates should be attached upfront.

Notably, this problem does not arise in oppositions, since under article 27, section II of the LFPPI, a simple power of attorney signed before two witnesses suffices for opposition proceedings.

Pitfalls for the unwary include:

- appealing the grant and the unfavourable opposition ruling must be done in parallel – monitor both notices or lose the window.
- re-using the same prior registration or evidence in an invalidity action after a failed opposition risks article 259 estoppel and reflected res judicata; and
- powers of attorney: lack of explicit certification of corporate existence or authority, or late notarisation or apostille, may trigger dismissal for lack of standing.

All the above may appear to tilt the balance in favour of pursuing oppositions as the preferred tool for brand owners. However, this apparent advantage is offset by the multiple procedural pitfalls and substantive risks that accompany the system. The complexity of deciding whether to rely on an opposition or to reserve arguments for an invalidity action – while at the same time navigating estoppel, res judicata and strict procedural requirements – makes it even more complicated to determine the most effective course of action. As a result, highly specialised IP counsel is essential to avoid jeopardising the legal remedies available to safeguard trademark portfolios in Mexico.

CONCLUSIONS

The opposition system has certainly become a very relevant and useful tool for brand owners to use to protect their registered trademarks in Mexico, significantly reducing the number of trademark squatting and copycat cases, thus very relevant for brand owners.

Unlike in the US, where the USPTO opposition is a fully adversarial procedure with binding outcomes, the Mexican opposition remains formally tied to IMPI's examination, creating fertile ground for estoppel disputes.

Similarly, while EUIPO decisions allow for parallel oppositions and invalidity actions, Mexican courts are now limiting such strategies through the doctrine of res judicata by reflected efficacy.

However, the opposition in Mexico has evolved into a very complex system with serious intricacies impacting the traditional trademark litigation, posing new hurdles and raising new challenges, especially in connection with the prosecution of invalidity actions, thus creating a convoluted landscape for brand owners to navigate in Mexico, which requires highly specialised legal counsel.

A wrong assessment of which legal arguments to use in an opposition and which to use in an invalidity action may deprive brand owners of the opportunity to properly safeguard their trademark rights. While oppositions appear increasingly central, they may also narrow future avenues of defence if not carefully structured.

In the same manner, a wrong assessment as to how to deal with appeals to be filed against failed oppositions, or final refusals, may result in an inadequate defence of trademark rights, either from the party opposing a registration or the party trying to secure one.

The traditional path for challenging trademark registrations has fundamentally changed. IMPI is no longer the sole authority empowered to declare the invalidity of such registrations – SEPI now shares that authority. Therefore, if not properly handled, the appeal stages related to oppositions may also severely affect the proper protection of trademark rights.

Also, the lack of uniform criteria between IMPI, SEPI and the FCC continues to generate legal uncertainty, raising the stakes for litigation strategy.

Additionally, foreign companies must pay particular attention to IMPI's new formalistic standards on powers of attorney, as non-compliance may lead to dismissal of claims or answers, regardless of the merits.

Finally, it should be noted that legislative reform is already on the horizon. The September 2025bill to amend the LFPPI,[4] if enacted, may once again shift the balance between oppositions and invalidity actions. This dynamism makes it essential for brand owners to anticipate not only judicial precedents but also institutional and political changes when designing their trademark protection strategies.

Endnotes

1 Complete text of the decision issued in case number 234/2019, with names of the parties suppressed for privacy reasons: https://www2.scjn.gob.mx /consultatematica /paginaspub /DetallePub.aspx?AsuntoID=252568. ^ Back to section

2 Federal Law for the Protection of Industrial Property (English version): https://www.jpo.go.jp/e/system/laws/gaikoku/document/index/mexico-e_industrial-property.pdf. ^ Back to section

3 Text of precedent IX-P-SS-85 (in Spanish) on page 137 of the FCAA's September 2022 magazine: https://www.tfja.gob.mx /media/media /biblioteca /revistas /2022/Rev_TFJA_Sep_2022.pdf. ^ Back to section

4 *Senate Gazette* (Mexico Senate), LXVI Legislature, 15 September 2025. 'Iniciativa con proyecto de decreto por el que se reforman, adicionan y derogan diversas disposiciones de la Ley Federal de Protección a la Propiedad Industrial' [Bill with a draft decree to amend, add to, and repeal various provisions of the Federal Law for the Protection of Industrial Property]. PDF: https://infosen.senado.gob.mx/sgsp/gaceta/66/2/2025-09-15-1/assets/documentos/EJ_Ini_Ley_Federal_Proteccion_Propiedad_Industrial.pdf. ^ Back to section

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