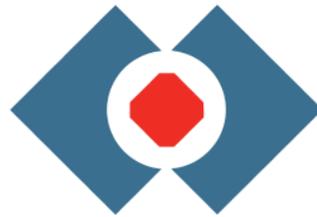


FICPI 17th OPEN FORUM

What is Registrable as a
Trademark and where?



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INTELLECTUAL PROPERTY
CORPORATE & COMMERCIAL LAW

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What is Registrable as a Trademark and where?

Articles **88** and **89** of Mexican Industrial Property Law (IPL) currently in force establish the definition of Trademark, and what can be protected as a trademark as follows:

“**Article 88.** Understood as a trademark is any visible sign that distinguishes products or services from others of the same kind or class in market”.



What is Registrable as a Trademark and where?

“Article 89. The following signs may constitute a Trademark:

- I. Visible, sufficiently distinctive names and figures...;
- II. Three-dimensional forms;
- III. Trade Names and corporate denominations or names;
and
- IV. The name of a natural person, provided that it is not confusingly similar with a registered trademark or a published trade name”.



What is Registrable as a Trademark and where?

Two main provisions establishing what is not registrable as a trademark, namely Articles 4 and 90 of the IPL.



What is Registrable as a Trademark and where?

Article 4 generally provides that no registration shall be granted when the proposed trademark is contrary to:

- a) public order
- b) morals and good customs;
- c) or violate any legal provision. (This is extremely broad).



What is Registrable as a Trademark and where?

Article 90 of the IPL: “Not registrable as a trademark are:”

I. Animated or changing denominations, figures or three-dimensional forms which are expressed dynamically, even though they are visible.



II. Generic names

Two Kinds:

- a) Technical or commonly used names of products and services; and
- b) Words which, in the everyday language or commercial practice, have become the usual or generic designation thereof.



- III. Three-dimensional forms which either:
- a) Are part of the public domain;
 - b) Have become of common use;
 - c) Lack of distinctive character;
 - d) Constitute the ordinary shape of the products; or
 - e) Constitute the shape imposed by their nature or industrial function.



What is Registrable as a Trademark and where?

IV. Descriptive names (including indicative words used in trade to designate species, quality, quantity, composition, end use, value, place of origin of the product or production era.



What is Registrable as a Trademark and where?

V. Isolated letters, digits and colors, unless these are combined or accompanied by elements such as symbols, designs or names that give them a distinctive character.



What is Registrable as a Trademark and where?

VI. Translations into other languages, fanciful orthographic variations and artificial constructions of non-registrable words.

This prohibition was originally intended to be applicable over the absolute grounds for refusal established in law.



What is Registrable as a Trademark and where?

VII. Signs reproducing or imitating (without authorization) flags, emblems, names, acronyms or symbols of any government or non-government organizations.



What is Registrable as a Trademark and where?

VIII. Signs reproducing or imitating (without authorization) official control quality seals or emblems adopted by any state, bills and coins or other commemorative coins.



What is Registrable as a Trademark and where?

IX. Signs reproducing or imitating names or the graphic representation of decorations, medals or other awards obtained in officially recognized exhibitions, fairs, conventions, cultural or sporting events.



What is Registrable as a Trademark and where?

X. Geographical denominations, maps, gentile nouns and adjectives when these indicate the origin of products or services and may cause confusion as to their origin.



What is Registrable as a Trademark and where?

XI. Names of towns or cities characterized for the manufacture of certain goods, to protect such goods.

Exception:

- Names of privately owned places, with the consent of the owners.



What is Registrable as a Trademark and where?

XII. Names, pseudonyms, portraits and signatures of persons without the consent of the interested parties.

Note:

If the persons have passed away, the consent may be granted, in their order:

- The Spouse; or
- Straight line blood relatives by adoption or collateral relatives, up to the fourth degree.



XIII. Titles of Intellectual or artistic works, including:

- a) Titles of periodical publications;
- b) Fictitious characters;
- c) Characterized human characters;
- d) Artistic names;
- e) Artistic groups names.



What is Registrable as a Trademark and where?

XIV. Deceptive names, figures or three-dimensional forms that may constitute false indications about the nature, components or qualities of the products or services.



What is Registrable as a Trademark and where?

XV. Identical or confusingly similar marks to notorious marks.

XV bis. Identical or confusingly similar marks to famous marks.



What is Registrable as a Trademark and where?

XVI. Identical or confusingly similar marks to previously applied for or registered marks, when these intend to distinguish identical or similar products or services to those protected by the senior mark.

XVI. Identical or confusingly similar marks to previously published trade names, when these intend to distinguish identical or similar products or services to those protected by the senior published trade name.



What is Registrable as a Trademark and where?

Although the above prohibitions seem to be quite clear, in Mexico we still face certain reluctance from the Trademark Authorities to grant protection for certain non-traditional trademarks, though visible, such as three-dimensional marks.





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THANK YOU

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