

INTERNATIONAL TRADEMARKS MADRID PROTOCOL

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Brief history about Madrid Protocol in Mexico

- ✓ Mexico deposited the instrument of accession to the Madrid Protocol for the International Registration of Marks with WIPO Director General Francis Gurry on November 19, 2012, bringing the total number of members of the international trademark system to 89. The treaty entered into force with respect to Mexico on February 19, 2013.
- ✓ Mexico was the third country in the Latin America region to join the Madrid trademark filing system.
- ✓ Mexico has become in only 6 years the 12th country with more designations by contracting parties, with 10,080 designations (during 2018) and 66,576 (historically) according to WIPO last published stats.

Brief history about Madrid Protocol in Mexico

- ✓ Mexico is the world's 11th largest exporter and has the first in Latin America, 80% of which are manufactured goods. It is the second largest economy in LA. In relation to Mexico's GDP, it is the third largest exporter of high-tech products in the world. It is also a G-20 economy with a trade volume of over 800 billion dollars.
- ✓ Mexico has one of the largest networks of trade agreements in the world and it is also seeking to increase and diversify its trade associations. In this framework, the Madrid Protocol was a logical component which has strengthened the expanding trade policies implemented by Mexican governments.

Brief history about Madrid Protocol in Mexico

- ✓ Mexico joined the Madrid System without a multiclass system nor an opposition system.
- ✓ The single-class system still prevails, and opposition was introduced in August 2016.
- ✓ Domestic legislation requires a local legal representative, as well to answer all official actions (refusals) in Spanish.
- ✓ The above-mentioned characteristics are special conditions that were present since the MP entered into force.

What happened in Mexico with the adoption of Madrid Protocol?

- ✓ The end of an era...
- ✓ Re-inventing the hen of the golden eggs... Same job? Increase quality, enhance the services...
- ✓ Demoralizing?
- ✓ Shifting the way of thinking...
- ✓ Understanding the client, advising the best strategy to file. There are three ways of filing: paper, digital and through Madrid.... Each way works differently.....

Legal aspects of Madrid Protocol in Mexico

Mexico joined with the following declarations and notifications made as a Contracting Party:

- ✓ Extension of refusal period to 18 months (Article 5(2)(b) of the Protocol)
- ✓ Charge individual fee (Article 8(7)(a) of the Protocol)
- ✓ Recording of licenses provided for under domestic law, but recording of license in International Register has no effect (Rule 20bis(6)(b) of the Common Regulations)
- ✓ Division of registrations of a mark not provided for in the domestic law, therefore, division of international registration has no effect in Mexico (Rule 27bis(6) of the Common Regulations)
- ✓ Merger of registrations of a mark not provided for in domestic law, therefore, merger of international registrations resulting from division has no effect in Mexico (Rule 27ter(2)(b) of the Common Regulations)

Legal aspects of Madrid Protocol in Mexico

- ✓ **Domestic legislation** requires a legal representative in the jurisdiction (under certain conditions), as well as to answer all official actions (refusals) in Spanish, and finally a domestic address to receive notifications.
- ✓ Additional requirements regarding legal representation: If a trademark holder is a natural person, there is no requirement to hire a representative in order to provide a response as holders can act on their own behalf. However, the holder should provide an address in the country **so as to receive notifications**.
- ✓ When represented by a representative different from the one mentioned in the original application, the representative must be duly recognized under the provisions of the Law of Industrial Property and the required fees must be paid. Responses to provisional refusals must be filed in writing along with the original signature of the person conducting the filing.

Legal aspects of Madrid Protocol in Mexico

Methods of filing international application, Mexico as Office of Origin

Paper (hard copy)

The application must be signed by the interested party or a representative thereof and the required fees must be paid for the certification and examination pertaining to the international application when Mexico is the Office of Origin and for the transmission or filing of applications, petitions or other documents relating to international proceedings before the International Bureau.

Filing language

Spanish

Legal aspects of Madrid Protocol in Mexico

- ✓ All types of trademarks can be protected (the ones recognized in national law).
- ✓ Specific requirements for three-dimensional (3D) marks, sound marks, scent marks, trade dress and holograms.
- ✓ ***Additional requirements for protection of collective, certification and guarantee marks that might include translations, legalizations and apostille.***

Legal aspects of Madrid Protocol in Mexico

Information on classification practices

The Office applies the current version of Nice Classification. The Office accepts Nice Classification Class Headings, although protection would be granted to goods/services which may be automatically inferred from the headings. The Office accepts certain terms in Nice Classification Class Headings, as well as EUIPO's Harmonised TMClass terms.

Class Headings will be accepted, as long as these are specific and they are used with the names or designations with which they appear in the alphabetical list of the Classification or in the Complementary List of Goods and Services published in the Gazette. Acceptable terms for goods and services can be confirmed through the [Madrid Goods and Services Manager \(MGS\)](#)

The Office does not require intent to use, nor a description where the mark is in non-standard characters.

Legal aspects of Madrid Protocol in Mexico

Specific requirements to protect trademarks via the Madrid System

The following requirements are applied:

- ✓ Translation/transliteration of the mark.
- ✓ Word marks may only comprise letters or words using the Roman alphabet, western Arabic numerals, as well as those punctuation marks that assist in correct reading thereof.
- ✓ Marks in standard characters: Marks made up of words, letters or numbers may only consist of elements composed of the modern international Latin alphabet, western Arabic numerals, as well as those signs that assist in the correct understanding thereof. It shall be understood that the applicant reserves the use in any type or size of letter.
- ✓ Collective or jointly owned marks: In case of a jointly owned or collective trademark application, the applicant must submit the rules governing the use thereof before the Mexican Institute of Industrial Property at the time the designation is received.

Legal aspects of Madrid Protocol in Mexico

Examination before the Office

Order of examination for provisional refusals

The Office examines on absolute and relative grounds. The Office provides opposition procedure. The Office conducts *ex officio* examination and the opposition system in parallel.

Provisional Refusals (*ex officio*)

Grounds for refusing protection (ex officio)

Absolute and relative grounds.

Legal aspects of Madrid Protocol in Mexico

Time limit to issue provisional refusal

18 months

Method of communicating ex officio provisional refusal to WIPO

Electronically

Partial ex officio provisional refusals

Partial provisional refusals (i.e., refusal of some of the goods and services in the international registration) can be issued.

Time limit to respond to ex officio provisional refusal

Two months from the day following the date of notification. This time limit may be extended up to two additional months.

Calculation of time limit to respond to ex officio provisional refusal

The time limit begins on the date the holder receives the provisional refusal from WIPO.

Option to extend time limit to respond to ex officio provisional refusal. Requirements for extension of time limit

The time limit can be extended for an additional 2 months without an official request, provided the fee is paid with proof of payment of the relevant fee at the time the response is filed.

Legal aspects of Madrid Protocol in Mexico

Oppositions

Grounds for opposition

Absolute and relative grounds

Publication of international registrations for opposition purposes

The Office republishes international registrations for opposition in the same manner in which national applications are published. Serial number assigned to the application, its filing date, the trademark and class, as well as the link to the electronic file.

Time limit to file opposition

One month as from the business day following the date of publication.

Calculation of time limit to file opposition

The time limit starts from the publication of the international registration by the Office.

Extension of time limit to file opposition. Requirements for extension of time limit

The time limit cannot be extended.

Legal aspects of Madrid Protocol in Mexico

Oppositions

- ✓ ***Authority to which an opposition can be filed***
Mexican Institute of Industrial Property
- ✓ ***Eligibility to file opposition***
Any interested party.
- ✓ ***Requirements to file opposition***
Representation is required. Relevant fees must be paid. Opposition must be filed in Spanish.
- ✓ ***Method of communicating provisional refusal based on opposition to WIPO***
Paper, Electronically
- ✓ ***Time limit for holder to respond to opposition***
Within the non-extendable period of one month as from the business day following the date of publication of the opposition in the Gazette.
- ✓ ***Extension of time limit to respond to a provisional refusal based on an opposition.***
The time limit is not extendable.

Legal aspects of Madrid Protocol in Mexico

Interim Status

Communication of interim status of mark

The Office does not notify WIPO of the interim status of the mark under Rule 18bis of the Common Regulations (notification that the ex officio examination has been completed, but that protection of the mark is still subject to opposition or observations by third parties).

After Protection is Granted

Form of communicating grant of protection to WIPO

The Office sends WIPO a separate document for each international registration.

Issuance of certificate after grant of protection

The Office issues certificate of registration. Holders can obtain the certificate directly from the Office.

Legal aspects of Madrid Protocol in Mexico

DECLARATION OF ACTUAL AND EFFECTIVE USE OF THE MARK:

Domestic legislation right-holders to submit an official form, directly to IMPI, declaring the actual and effective use of their respective trademarks. Such obligation will take place at two different times:

- a) **Upon submitting a request for the renewal of a trademark**, right-holders are due to comply with the filing of a “Declaration of Actual and Effective Use”. With respect to international registrations renewed under Article 7 of the Madrid Protocol, the right-holder shall declare the actual and effective use of the mark directly to IMPI within the three following months after the renewal notice is made by the International Bureau of WIPO.

This obligation will apply to all renewal requests filed as from August 10, 2018, including those related to registrations whose territorial protection was extended with respect to Mexico under Article 3ter of the Madrid Protocol. The effect of not complying with this requirement is that the protection of the trademark will be considered as lapsed by IMPI on an ex officio basis.

Legal aspects of Madrid Protocol in Mexico

DECLARATION OF ACTUAL AND EFFECTIVE USE OF THE MARK: (continues...)

b) Within the three months following from the date on which the registration reaches three years from the granting date. This obligation will apply to all trademarks granted as from August 10, 2018, even where their respective application was submitted before such date. This obligation will also apply to trademarks related to international registrations.

In cases where the protection under an international registration is territorially extended to Mexico under Article 3ter of the Madrid Protocol, the right-holder must declare the actual and effective use within the three months following after three years from the date on which the national registration was granted. The effect of not complying with this requirement is that the protection of the trademark will be considered as lapsed by IMPI on an ex officio basis.

Furthermore, in the “Declaration of Actual and Effective Use”, the right-holder must indicate the goods or services for which use of the trademark is being declared. The scope of protection of the trademark registration will continue for the goods or services for which the actual and effective use has been declared. Additionally, in both cases of the filing of the “Declaration of Actual and Effective Use”, the right-holder will only be required to submit the payment of the corresponding fee, but there is no obligation regarding evidence to prove the trademark use.

The declaration of actual and effective use of the mark must be submitted by the holder’s authorized representative with a local address or by a legal representative in Mexico. A local address is required for purposes of notification.

Legal aspects of Madrid Protocol in Mexico

Transformation

Requirements to request transformation

The Office does not require use of any official form(s) to request transformation. Holders should submit a letter requesting transformation and indicate the number and date of the international registration on which it is based.

Office procedure following request for transformation

The Office re-opens examination on absolute and relative grounds after the request for transformation.

Replacement.

Requirements

The Office does not require submission of any official form(s) to take note of the international registration. Representation is not mandatory. The request must be submitted in Spanish.

Is this a minefield for practitioners? Should the Madrid Protocol nevertheless always be the first choice for multi-jurisdictional registration protection?

“International trademarks” extend over a large number of countries. Hence, such trademark owners might feel encouraged to utilize the Madrid Protocol to obtain registration protection. While this Protocol has been adopted by many countries, some adherents have set, inter alia, special conditions for use; classification, and issuance of individual certificates. What happens to the unaware? Is this a minefield for practitioners? Should the Madrid Protocol nevertheless always be the first choice for multi-jurisdictional registration protection?

MADRID PROTOCOL, ADVANTAGES

ADVANTAGES:

- ✓ Simple
- ✓ Efficient
- ✓ One application
 - ✓ One language
 - ✓ One fee
- ✓ One registration
 - ✓ One renewal
 - ✓ One application for recordal of amendments
 - ✓ No legalisation

MADRID PROTOCOL , ADVANTAGES

Other advantages:

- ✓ Subsequent designations
- ✓ Deselecting countries at renewal
- ✓ Optimisation of the portfolio
- ✓ An increasing number of online tools continuously improved

MADRID PROTOCOL , DISADVANTAGES

Disadvantages:

- ✓ Some times national filing requires less time than Madrid.
- ✓ No agent or address in designated countries to receive notifications, which could invalidate them.
- ✓ Invalidation risks according domestic legislation.
- ✓ Original documents might be kept at the Office of Origin.
- ✓ Multiclass/single class

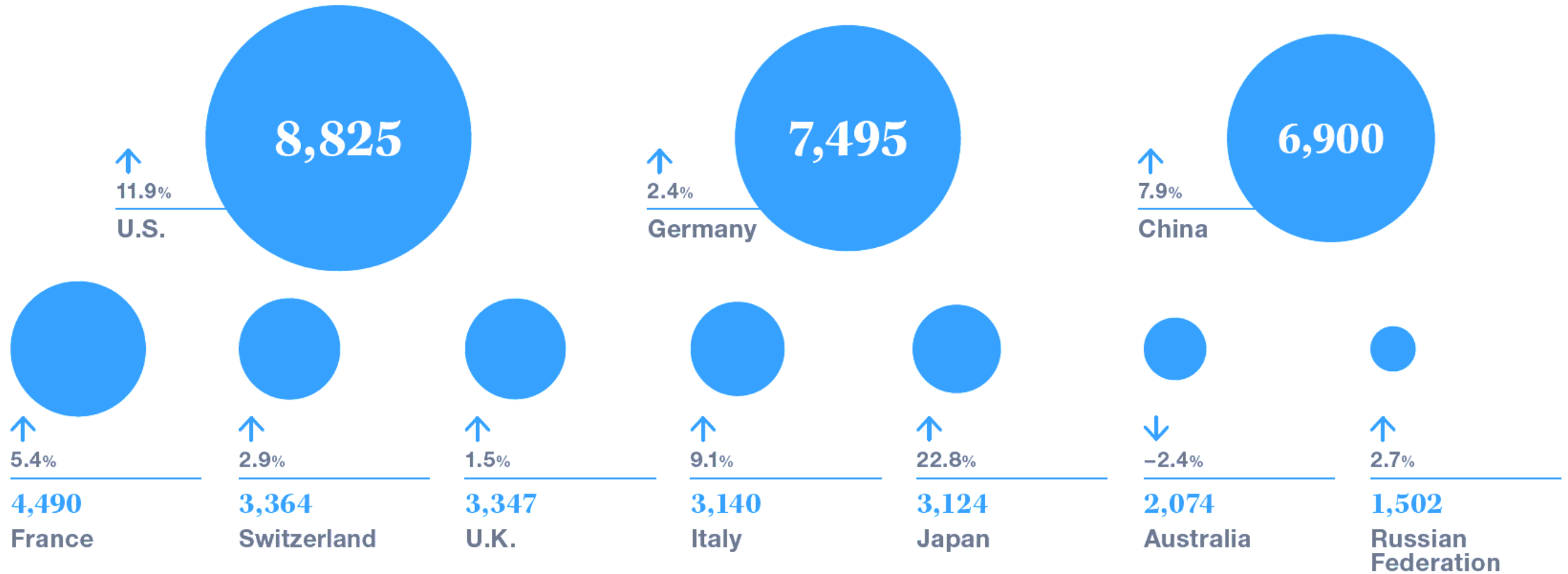
MADRID PROTOCOL , DISADVANTAGES

Disadvantages:

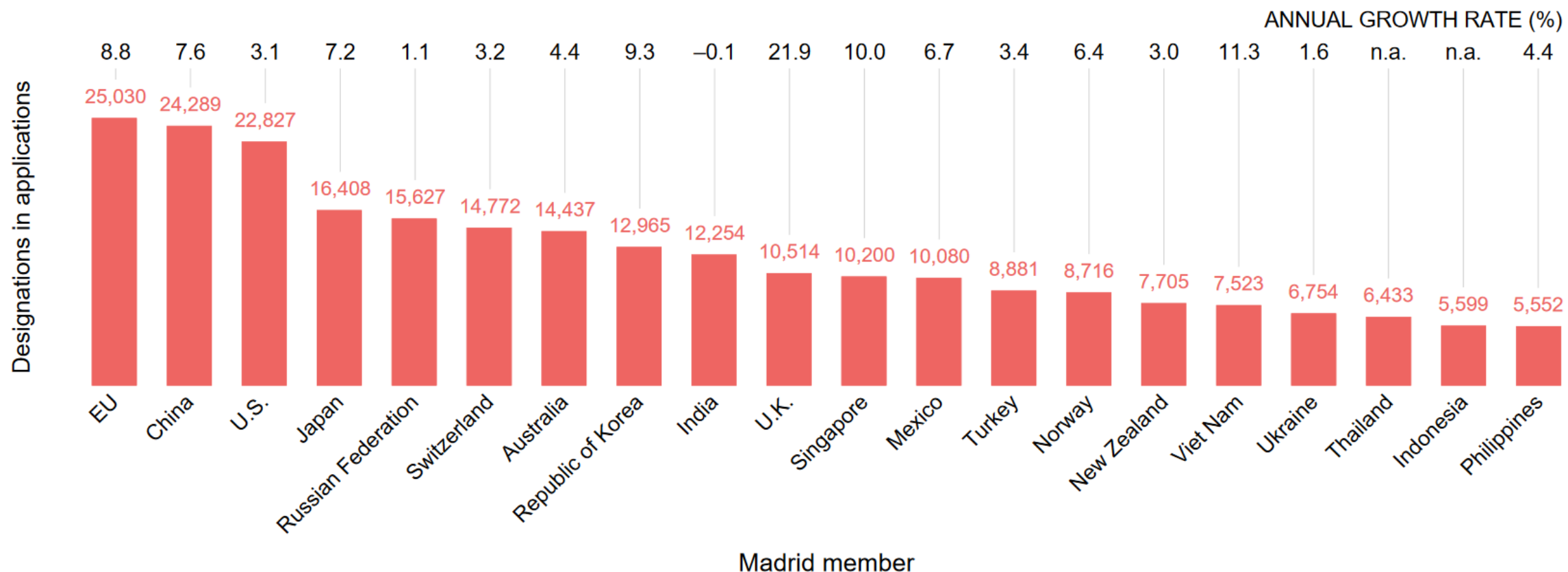
- ✓ Very tight terms for opposition
- ✓ Renewal requires domestic expertise
- ✓ Invalidation/cancellation on the grounds of non-use.
- ✓ Risk of coexistence in countries in which there is no substantive exam, in which no opposition was filed.
- ✓ Depends on what client wants to accomplish

TOP TEN FILING ORIGINS (2018)

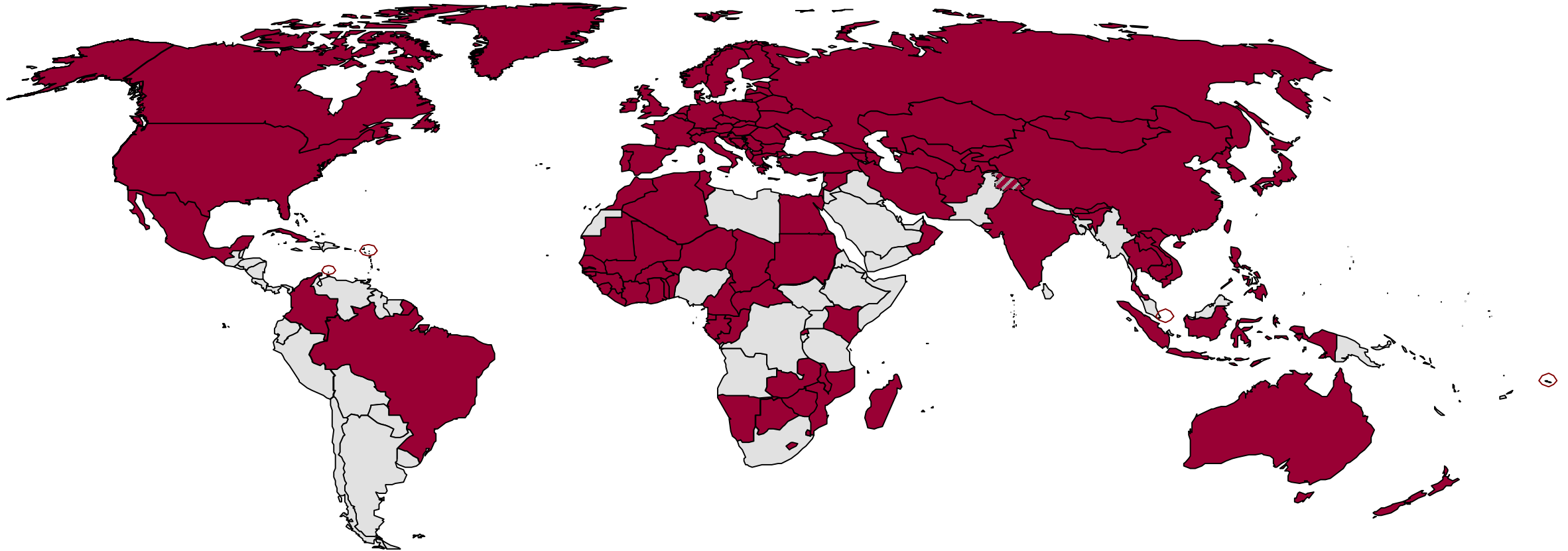
Number of Madrid applications and percent growth since 2017



TOP 20 DESIGNATED CONTRACTING PARTIES (2018)



MEMBERS OF MADRID



*All are party to the Protocol, the governing treaty, while 55 are also party to the Agreement

**105 members* (including EU and OAPI)
covering 121 countries**

STATS....

Solicitudes de marca por nacionalidad del titular / principales países / 1993 - enero/diciembre de 2018												
Trademark applications by nationality of holder / main countries / 1993 - January/December 2018												
Año	Total	México	Alemania	Brasil	España	Estados Unidos	Francia	Italia	Japón	Reino Unido	Suiza	Otros países
Year	Total	Mexico	Germany	Brazil	Spain	United States	France	Italy	Japan	United Kingdom	Switzerland	Other countries
1993	28,920	16,132	520	104	386	8,093	529	326	360	344	423	1,703
1994	33,803	19,184	651	131	502	8,992	667	353	403	485	498	1,937
1995	30,201	16,152	1,274	161	328	7,505	732	537	445	537	579	1,951
1996	32,336	19,562	956	108	383	7,013	930	273	327	377	520	1,887
1997	35,426	21,497	999	91	491	7,484	887	336	383	574	525	2,159
1998	40,042	24,669	1,206	159	518	8,065	1,067	318	362	702	671	2,305
1999	46,156	29,367	1,461	128	642	8,861	877	372	385	769	789	2,505
2000	59,721	36,698	1,877	301	1,031	11,414	1,234	352	537	1,053	1,248	3,976
2001	61,488	40,236	1,986	313	1,107	9,608	1,219	527	910	809	1,241	3,532
2002	56,237	37,764	1,604	315	876	8,491	997	396	637	653	1,035	3,469
2003	53,724	34,763	1,552	188	772	9,215	916	478	739	568	1,000	3,533
2004	58,553	38,314	1,579	263	787	9,608	1,057	440	701	646	992	4,166
2005	63,899	41,680	1,529	254	918	10,591	1,115	524	768	952	1,201	4,367
2006	68,975	45,161	1,627	217	935	10,839	1,189	503	759	766	1,449	5,530
2007	77,065	49,329	1,968	278	1,132	12,821	1,329	696	839	1,076	1,815	5,782
2008	77,467	50,680	2,390	309	1,286	11,172	1,307	731	930	1,168	1,320	6,174
2009	75,250	53,405	1,455	207	923	9,742	1,088	540	669	853	1,511	4,857
2010	87,477	61,947	1,707	271	1,217	11,196	1,085	610	831	845	1,500	6,268
2011	92,671	64,360	1,817	328	1,306	11,992	1,314	791	1,070	1,129	1,659	6,905
2012	98,628	69,546	1,911	278	1,404	12,589	1,392	787	1,184	1,278	1,752	6,507
2013	107,063	76,251	2,039	381	1,523	12,358	1,325	890	1,131	1,163	1,795	8,207
2014	118,745	79,840	3,012	446	1,895	14,527	2,052	1,286	1,262	1,765	1,992	10,668
2015	134,342	89,415	3,988	401	1,869	16,669	2,014	1,461	1,822	1,954	2,156	12,593
2016	138,745	96,692	3,878	326	1,928	15,107	2,231	1,305	1,124	1,818	1,776	12,560
2017	153,853	106,309	4,124	449	2,266	16,999	2,262	1,590	1,471	1,855	2,544	13,984
2018	156,156	107,002	4,551	573	2,044	17,449	2,343	1,666	1,383	1,991	2,039	15,115

COMMON DELAYS, IRREGULARITIES

- ✓ Classification of goods and/or services – Office of origin
Goods and services not in the appropriate classes or not classified (**Rule 12**)
- ✓ Indication of goods and/or services – Office of origin
too vague for the purposes of classification or is
incomprehensible or is linguistically incorrect (**Rule 13**)
- ✓ Fees (**Rule 11.3**)

Note: Most of the information provided on this presentation can be found at the Madrid members profile WIPO site under Mexico.

Thank you very much!!

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