Practical issues concerning the Madrid Protocol in Mexico

Why has Mexico's adherence to the Madrid Protocol not fulfilled its potential? **Ariadna Galvez** of **Dumont Bergman Bider & Co** considers the factors

Since the incorporation of Mexico into the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol) in 2012, the options to obtain suitable trade mark protection have increased. This in turn has led to foreign companies seeing the Mexican market as a more attractive place for their development. Nonetheless, there are diverse opinions on the real benefits that this incorporation has brought, in particular to Mexican titleholders.

As a result of the incorporation of Mexico into the Madrid Protocol, international companies now have an easier way of having their trade marks protected in Mexico. On the other hand, the development of trade marks filed by Mexican companies or individuals, has not yet reached similar international markets. This means that the advantages provided by the Madrid Protocol are still insufficient for the development hoped for before its incorporation, specifically in terms of applications filed with the Mexican Trademark Office (MTO) as the office of origin.

In light of the above, it is undeniable that the Mexican government still lacks the confidence of entrepreneurs, as well as small and medium-size companies, in terms of the benefits of obtaining a trade mark registration in Mexico. The incorporation into the Madrid system has fallen short of its potential to increase filing by national applicants and thereby improving the Mexican economy.

It is also worth mentioning that World Intellectual Property Organization (WIPO) statistics for Mexico confirm the dis-

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parity detailed in the preceding paragraph. According to WIPO, there have been only 87 trade marks filed with the MTO as the office of origin, while from March 2013 to July 2015, there have been 15,473 applications filed with Mexico as a designated office.

However, the Madrid system has provided applicants with a more accessible, speedy and cost-effective means of achieving extensive trade mark protection. In addition to advantages for the applicant, brought by the filing of a single application, completed in the applicant's language (with no translation of documents) and with just one filing fee, it is a plus for titleholders that the Madrid Protocol demands time restrictions as well as a coherent criteria for the examination conducted on formal and substantive grounds, which should be fairly applied to national and international applications.

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Hurdles for foreign applicants

Unfortunately, we have seen that foreign applicants are facing some difficulties concerning the registration process of Mexican designations using the MTO´s strict criteria. For instance, with reference to the narrative of products and services, several formal concerns (from WIPO) have arisen in connection with what must be covered in the description, as well as its translation into Spanish.

For example, the MTO has issued several provisional refusals as a result of translation inaccuracies or terms that have been misunderstood. That is, minor inaccuracies in the translation of the narrative of goods and services, or confusion over the strict criteria of Mexican examining attorneys, which intends to force applicants to use descriptions of goods and services as similar as possible to the wording of products or services specifically stated in the Nice classification.

There has also been confusion among titleholders over the MTO´s criteria for issues such as trade marks that, according to the examining attorney, lack distinctiveness, but have been successfully approved in other jurisdictions. Further, there is confusion over notifications in connection with possible contentious matters have been determined along the course of action. That is, the MTO has been struggling to serve defendants (international registration applicants) with a summons, given that, before any legal representative attests its identity, the only registered address is located abroad. This often causes uncertainty among titleholders. In order to expedite the process and secure any procedural right on behalf of the defendant, applicants should appoint a Mexican legal representative for each Mexican designation of international registrations.

Moreover, there are still some actions that are not entirely straightforward for foreign applicants. Even if the Mexican legal system (and Mexican practice and procedures) has been partially adjusted and harmonised with international registrations under the Protocol, there are some areas that need to be tweaked and implemented to ensure the smooth-running of the Madrid system. For example, the adoption of multiple-class trade mark applications and the implementation of an opposition proceeding, which would undoubtedly strengthen the Mexican trade mark system by allowing easier interaction between applicants and opponents and between applicants and the Mexican authority. This would bring fairness to the Mexican practice by ensuring that examination and the corresponding grant or refusal are conducted with legal certainty.

Outlook for the Madrid system

The Madrid system needs to be properly deployed, with the implementation of an opposition proceeding, and the rectification of translation inaccuracies. The harmonisation of the Madrid system and the Mexican system should then result in more applications filed with the MTO as the office of origin and equal treatment for national and international applicants alike, bringing tangible benefits to both.

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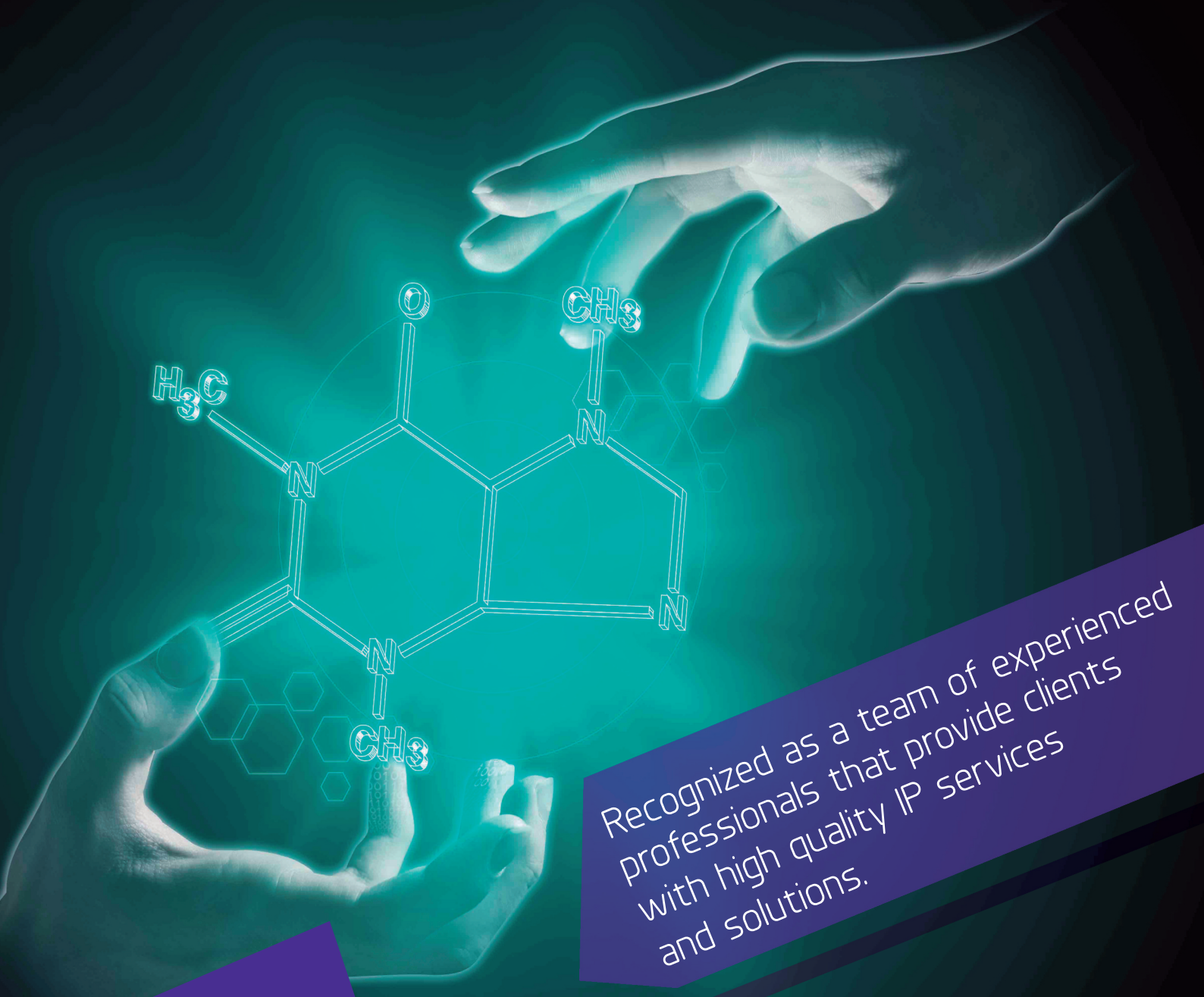

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