

# ECIJA

WELCOME  
TO MEXICO



LEGAL  
GUIDES

## REGISTRATION OF A TRADEMARK IN MEXICO

The ABCs of the registering a trademark, a commercial notice, or a commercial name in Mexico



## Introduction

# Welcome to Mexico



## Your business starts here

When you incorporate a company in Mexico, you will start a journey that will open business opportunities in one of the most dynamic and exciting developing markets in the world.

We are here to accompany you during your business.

## Introduction

# About Us



EVERYDEAL  
EVERYTECH  
EVERYWHERE

## About ECIJA Mexico

We are positioned as one of the leading law firms in Mexico, with a team of more than 750 professionals around the world and with presence in 16 countries, reinforcing our full-service offer throughout the Mexican territory, also offering coverage in Europe, China and Latin America.

## Our Practice Areas

- Aviation
- Banking and Finance
- Business, Human Rights & Corporate
- Social Responsibility
- Compliance 360
- Competition and Antitrust
- Corporate M&A
- Dispute Resolution: Litigation and Arbitration
- Energy
- Fashion Law
- Gaming and Gambling
- Health Law
- Intellectual Property
- Immigration Law
- Labor and Social Security
- Privacy and Data Protection
- Project Finance
- Real Estate
- Sports Law
- Tax Law
- TMT

## Preparation and availability search

Before filing an application for trademark registration with the Mexican Institute of Industrial Property (“IMPI”), it is advisable:

- To identify the distinctive signs to be protected (names, logos, etc.)
- To determine the products and/or services relevant for the activity of the client and thus identifying the relevant classes in which the trademark(s) needs to be protected and,
- To conduct an **availability search to identify previously registered trademarks** or applications that are similar to a confusing degree to the trademark to be registered in the relevant classes. The aforementioned in order to estimate the success probability of achieving the registration.

## Requirements

Any application for registration must comply with the following requirements.

### 1

Trademark, commercial notice, or trade name to be registered.

Mexican legislation provides that trademarks include: i) denominations, ii) logos iii) combination of denomination and logo, iv) three-dimensional shapes and, v) non-traditional brands such as trade dress, olfactory, holographic, sound, and certification marks. It is worth mentioning some provisions ruling signs that cannot be registered as a trademarks, such as:

- The commonly used names of products and services that are intended to be protected with the trademark, as well as the words that have become their usual or generic designation.
- The names and shapes that, considering their characteristics as a whole, are descriptive of the products or services that the trademark aims to protect. That is the words that designate the species, quality, quantity, composition, destination, value, place of origin of the products, or the time of production.



- The translation into other languages, the capricious spelling variation, or the artificial construction of unregistered words.
- A trademark that is identical or confusingly similar to another being processed for registration and previously filed, or to a currently registered trademark, applied to the same or similar products and services.

## 2

State the elements appearing in the logo and for which protection is not requested. For example, the symbol:

®

## 3

International class in accordance with the International Classification of Goods and Services for the Purposes of Registration of Marks established in the Nice Agreement ("**Nice Classification**"). In this regard, it is important to consider that the trademark system in Mexico is uniclass.

## 4

Products or services to be protected with the trademark.

## 5

Data of the titleholder of the trademark. Indicating whether it is an individual or legal entity, its name or company name, nationality, and full address.



6

Date of first use in Mexico, if used before the filing date of the application and, with respect to which, there must be demonstrable conclusive evidence, in case of controversy

7

Address of the place of business, if any.

8

Priority claim, in case of having a previously filed application in another country, including the file number, filing date, and country.





# Registration

## Proceeding

Once the application has been submitted, the IMPI must publish it in the corresponding Gazette within the following 10 days. Starting from the date in which the publication becomes effective, the third party has a one-month period to oppose the request by means of a brief containing all those arguments for which the IMPI should not grant the registration and produce the available evidence.

Once the one-month period has concluded, the IMPI begins the formal and substantial examination of the request, and if applicable, it notifies the applicant so that the later can plead in his/her best interest within a two-month term (extendable for up to two additional months) regarding the opposition, requirements, prior registrations/applications and/or objections related to the trademark application processed.

Once the two-month term has elapsed and the evidence produced, the applicant and the opponent will have a five-day period to submit their final pleadings. Once this term has elapsed, the IMPI shall issue the corresponding resolution

## Estimated Time

The estimated time to obtain the registration, without opposition or official notice of requirements, prior registered trademarks/applications, and/or objections is 4 to 6 months. In the later cases, the estimated time can be increased.

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