

Important notes on amendments to Mexico's industrial property law

Dear clients and colleagues,
Mexican Intellectual Property law has experienced very important changes.
Among the most important ones are:

1. New types of trademarks.

We can now register, protect and enforce sounds, scents, holographic signs, "Trade Dress" of products and commercial identity of establishments, and any particular combination thereof.

2. Statements of Effective Use for trademarks (on their 3rd year term, and upon 10-year renewal).

All Mexican trademark registrations granted after August 10, 2018, must file a compulsory Statement of Effective Use, on the goods / services covered by each mark, on its third-year anniversary (within 3 months following its 3rd year anniversary).

Important: Failing to file this statement of use will cause the registration(s) to lapse automatically.

Likewise, all trademark renewals must now file an additional Statement of Effective Use, together with their renewal petition, upon reaching their 10-year anniversary.

For International Trademark Registrations (Madrid Protocol):

- i) International trademark holders must file a Statement of Effective Use for each registration (before the Mexican Institute of Industrial Property), once the granted registration has reached its first 3-year term (based on its registration date in Mexico), within the next 3 following months of said anniversary.
- ii) Likewise, all TM registrations filed for their 10-year renewal pursuant to the Madrid Protocol, must file a Statement of Effective Use in Mexico (before the Mexican Institute of Industrial Property), within the 3 months following the date of notification of the registration renewal before the international IP Office (WIPO).

Trademark protection will continue solely for the goods / services of which the Statement of Effective Use was filed.

In all cases, trademark holders must cover the applicable Government Fees, but are not required to provide any actual evidence, nor to prove the use of the mark in any way.

Finally, statements of effective use must be filed by a duly empowered agent (or legal representative), addressed in Mexico for official notification purposes.

If our Firm is in charge of your Trademark files in Mexico, we will contact you in due term for these purposes.

If not, we would be glad to assist you accordingly.

Please contact us if you have any doubt or question about these important considerations.

Greetings from Mexico!

