

The Trademark

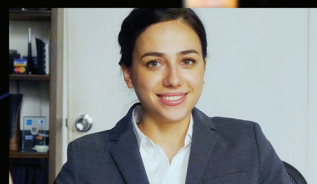
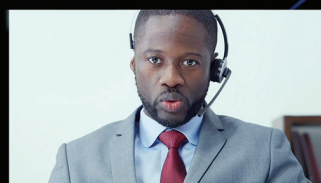
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Motion Marks in Mexico

Wilma Caraza and Santiago Pedroza, of OLIVARES, review the Mexican practice surrounding non-traditional trademark registration.

On November 5, 2020, the new Federal Law for the Protection of the Industrial Property (FLPIP) came into force in Mexico. Consequently, the IP legal framework was modified, following the amendments to the Mexican Industrial Property Law of August 2018. Prior to the 2018 modifications, the official definition of trademark was as follows: "Every visible sign that distinguishes products or services from others of their same kind or class in the market". Therefore, in order to be considered as a mark, the sign must be "visible" or observed through the sense of sight.

Since 2018, the definition of trademark was amended to read as: "Any sign perceptible by the senses and capable of being represented in a way that allows determining the clear and precise object of the protection, which distinguishes products or services from others of the same kind or class in the market.", opening the possibility of protecting non-traditional trademarks in Mexico.

Additionally, both the abrogated Law and the new FLPIP enumerate those non-traditional signs that can be considered as trademarks, for example, smells, sounds, holograms, etc. However, motion marks are not expressly included in the Law as a trademark that can be protected in our country.

Article 3(3)(h) of the European Union trademark



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implementing regulation (EUTMIR) defines motion marks as "trade marks consisting of, or extending to, a movement or a change in the position of the elements of the mark," and these shall be represented by submitting a video file or by a series of sequential still images showing the movement or change of position.

For incorporating the motion marks and other non-traditional trademarks within its legislation, the European Union Intellectual Property Office (EUIPO) modified its regulations and eliminated the requirement of the graphical representation of a sign and now it is only necessary for the mark to be represented in a manner "which enables the competent authorities and the public to determine the clear and precise subject matter of the protection."

In light of the above, it is clear that with the modifications to the Industrial Property Law on 2018 and now with the implementation of the new FLPIP, the IP legal framework has been aligning with the international rulings and standards. By eliminating the requirement of "visual representation", now the only condition for a sign to be considered as a trademark is to be perceptible by the senses and be capable of being represented to clearly determine the object of protection.

As a consequence of the execution of the United States-Mexico-Canada Agreement (USMCA), Mexico has been placed in the forefront of non-traditional trademark protection in Latin America.

The trade agreement contains an important Intellectual Property Chapter, which among other provisions, includes the protection eligibility for non-visual signs, such as sounds, smells, etc.

In Latin America protection for these types of trademarks is still pending. However, with Mexico in the avant-garde, it is very possible that in the near future we could see the expansion of protection for non-traditional trademarks to the rest of the countries in Central and South America.

In Mexico, the new FLPIP includes a list of those distinctive signs that will be recognized as a trademark:

- Words, letters, numbers, figurative elements, color combinations, and holograms;
- Three dimensional shapes;
- Trade names;

Résumés

Wilma Caraza

Wilma joined Olivares in 2011 and became an associate for the trademark team in 2015. She has an in-depth knowledge of trademark law and extensive experience in filing distinctive signs, conducting phonetic and design searches, filing responses to official actions and consultancy related to trademark matters.

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- The name of an individual;
- Sounds;
- Smells;
- The combination of all the above;
- Trade dress.

This list should be considered as enunciative, but not limitative of the distinctive signs that can constitute a trademark. If the mark complies with the requirement of being perceptible through the senses and represented in a way that allows determining the object of the protection, it will be possible to obtain its registration.

Nevertheless, following the suppression of the visual representation requirement from the Law, many non-traditional trademark applications have been filed in our country, including those not expressly included in the Law such as flavor marks.

Regarding the applications for flavor marks, the Mexican Trademark Office objected and eventually denied the same, arguing that they were not enlisted in the Law as distinctive signs that could be subject of protection, without considering that these marks are indeed noticeable through the sense of taste, and it is possible to represent the same in a manner that allows to determine the object of the protection, for example, with a description of the flavor or a formula for obtaining the same.

Consequently, the range of possible non-traditional trademarks that can be protected in our country should be broad than the enunciative list included in the Law, that should serve as a guide and not as a limiting catalog.

The clear example are the motion marks. These non-traditional trademarks are not enlisted in the Law as a "sign that can constitute a trademark.". However, considering that these marks are noticeable through the eyesight, and it is easily represented to be able to determine its protection.

Derived from the information obtained from the Mexican Trademark Office's database, until today the authority has granted at least five registrations for motion marks. However, many other applications are still pending or under

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examination. With no doubts, this constitutes an important precedent for our legal landscape.

Together with the traditional requirements to be able to file a trademark application (name and address of the applicant, description of goods or services, date of first use of the mark in Mexico), motion marks must be accompanied with an electronic file showing the mark in motion, such as CD's, USB's or the like.

Motion marks have joined to the valuable variety of protectible traditional and non-traditional trademarks in Mexico, which heightens the trademark protection standards in our country. Additionally, these registrations will transform in examples for trademark owners and its legal representatives to help them achieve registrations for other non-traditional trademarks which are not enlisted in the FLPIP.

In conclusion, despite the fact that our FLPIP does not expressly recognizes motion marks as trademarks that can be protected in our country, the fact that our Trademark Office has granted at least five trademark registrations for these types of non-traditional marks, as well as other smell and sound marks, has settle an important precedent in Mexico for the recognition and protection of non-traditional trademarks that will bring important benefits to the Mexican IP system, trademark rights holders, and of course, consumers.

Some of these benefits are more legal certainty, foreign investment, economic benefits, among several others which are also closed related to the capacity of changing towards the new reality of our world, the technological advances and the adaptability of the international standards and rules with the Mexican IP legal provisions.

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