

Uthhoff, Gomez Vega &amp; Uthhoff

# Time to update the law

Although Mexican law grants protection to some non-traditional marks, it requires updating in order to meet modern demands

In view of the increasing globalisation of trade and commerce, jurisdictions around the world are having to employ alternative means of protecting the rights of trademark owners in order to safeguard them from possible infringements.

A trademark is traditionally associated with words, phrases, designs or combinations thereof that serve as a source for distinguishing the products or services of one entity from those of others.

However, in recent years, elements other than words, designs and logos have emerged as distinctive signs which can identify goods or services, and which consequently serve the same purpose as a traditional trademark.

The following are the main types of non-traditional mark:

- shape – a three-dimensional representation of the product;
- sound – a piece of music, a recorded representation or a reproduction of a common sound (eg, a mobile phone ringtone);
- scent – a perfume, the particular scent of a place, product or store and chromatographic techniques;
- taste – a particular flavour or recipe used to elaborate a product;
- touch – the particular texture of a product;
- motion – moving images;
- appearance – colours or colour combinations; and
- trade dress – the visual appearance of a product or its packaging that indicates the source of the product to consumers.

Not all jurisdictions grant the same level of protection to non-traditional marks. Article 15(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights states that its signatories can require, as a condition of registration,

that signs be visually perceptible; thus, different jurisdictions grant varying levels of protection to non-traditional marks.

While some non-traditional marks are afforded reliable protection under Mexican law, others are excluded.

## Industrial Property Law

Under the Industrial Property Law, a 'mark' is understood as any visible sign that distinguishes the products or services to which it is applied, or is intended to be applied, from other goods or services. Rights in a mark are generated at the time that registration is granted by the Trademark Office. In other words, Mexico is a first to register jurisdiction, and the exclusive right to use a trademark is secured only with its registration.

Article 89 of the Industrial Property Law stipulates that the following signs constitute a mark:

- visible names and figures that are sufficiently distinctive and capable of identifying the products or services to which they are applied or are intended to be applied;
- three-dimensional shapes;
- trade names or corporate or business names; and
- the proper names of individuals, provided that they are not identical to a registered mark or published trade name.

Some visible signs, such as moving images and holograms, are not eligible for trademark protection in Mexico. Article 90(I) of the Industrial Property Law states that "denominations, figures or three dimensional shapes which are animated or expressed in an animated manner although they are visible, shall not be registrable as a mark".

Thus, for any party to have exclusive rights to use a trademark, the mark must be:

- a visible sign;
- inherently distinctive; and
- registered with the Mexican Institute of Industrial Property (IMPI).

Mexican law excludes sound, scent, taste and touch marks from trademark protection.

## Non-traditional trademarks

Certain non-traditional marks are recognised under Mexican law, and are therefore enforceable in Mexico. These are:

- colours;
- letters and numbers; and
- three-dimensional shapes.

As mentioned above, Article 89 of the Industrial Property Law expressly states that three-dimensional shapes can be protected as trademarks, and therefore can be registered with IMPI. Distinctive signs, such as colours, letters and numbers, are not expressly mentioned in this article. However, they can be considered to be protected under Mexican law; Article 90(V) states that such signs are not protectable if they are isolated, but implies that colours, letters and numbers with distinctive character can be protected as marks in Mexico.

However, such marks must comply with certain requirements in order to be granted protection. IMPI's standard practice is to deny most applications for three-dimensional marks, since according to the recently held criteria, such marks are often not inherently distinctive and tend to be descriptive or reproduce the common shape of goods of that nature.

In light of this, in order to obtain protection for a three-dimensional mark, it must comply with the originality and distinctiveness requirements; otherwise, it will likely be refused registration.

Colours, numbers and letters must be accompanied by elements such as signs, designs or names that provide them with sufficient distinctiveness in order to obtain protection.

### Unregistered non-traditional marks

The main problem for owners of unregistered marks under Mexican law is that their signs are vulnerable to infringement, since only signs that are registered with IMPI are afforded full and effective protection.

Thus, unregistered non-traditional marks can be used by any third party, due to the fact that no individual or entity has the right to their exclusive use. In these circumstances, trademark owners must seek out alternative means of protection in order to prevent third parties from reproducing or imitating their rights.

### Other protection mechanisms

Sound marks can be eligible for copyright protection under the Federal Copyright Law, which grants protection to musical works. Although some sound marks are formed of commonly used sounds or a piece of music, Article 13 of the Federal Copyright Law states that copyright protects all works that have an equivalent nature to those expressly mentioned in the Federal Copyright Law.

Another form of protection against infringement with regard to smells, scents, tastes and textures falls within the industrial and trade secrets area, whereby the formulae of smells, scents, tastes or textures can be preserved as confidential, and thus may be enforceable by executing confidential agreements with parties that have access to them.

Trade secrets are regulated under Article 82 of the Industrial Property Law, which sets out the main criteria that any information must contain in order to be considered as a trade secret. In order for the owner to take action against infringement, a trade secret must comply with the following requirements:

- The information should be industrially, commercially, professionally or technically applicable;
- The information must represent an economic or competitive advantage for its owner;
- The information should be contained in a document or other material form;
- The information must be confidential and measures must have been adopted in order to preserve its confidentiality; and



**Ana Soto**  
Associate  
[asoto@uhthoff.com.mx](mailto:asoto@uhthoff.com.mx)

Ana Soto is an associate at Uhthoff, Gómez Vega & Uhthoff, with experience of trademarks. She studied law at *Universidad La Salle* and received a master's in international law from the University of Queensland in Australia. Ms Soto is a member of the International Trademark Association.

- The information should relate to the nature, characteristics or purposes of a product, a production method or process, or to distribution or marketing channels for the products or services.

### Tackling infringement

Although the Industrial Property Law does not expressly regulate distinctive signs such as sounds, scents, tastes and textures, this does not mean that there is no course of action available against alleged infringers of such signs.

In the event that a third party reproduces or imitates a distinctive sign, under applicable law this constitutes an act of unfair competition, even if that sign has not been registered with IMPI and therefore is not enforceable by law.

Article 213(X) of the Industrial Property Law states that an 'administrative infringement' constitutes the performance of an act in the course of industrial activities or trade that confuses, misleads or deceives consumers by causing the erroneous belief or assumption that:

- a relationship or association exists between a given establishment and a third party;
- products are manufactured according to specifications, licences or authorisations from a third party;

- services are rendered or products are sold according to authorisations, licences or specifications from a third party; or
- products originate from a region or locality that is different from their true place of origin, in order to mislead the public as to their geographical origin.

Following this line of thinking, if a trademark owner demonstrates that its goods or services are clearly identified by consumers and that those products are being sold without its authorisation, this constitutes an administrative infringement and is consequently prohibited under Mexican law.

### Conclusion

Although Mexican law grants protection to some non-traditional marks such as three-dimensional shapes, colours, letters and numbers accompanied by a distinctive element, and there are alternative ways to protect and enforce other non-traditional marks such as sounds, scents, tastes and textures, Mexican legislation must be updated to meet modern demands.

The Industrial Property Law, which has been in force since 1991, must be amended in order to include expressly within its remit many modern and commonly used non-traditional signs which in 1991 were not common to marketing practice.

The Mexican Association of Intellectual Property, in conjunction with IMPI, must lobby Congress for amendments to the law, not only in the trademark arena, but also for other IP-related issues.

In the meantime, despite the apparent lack of protection for non-traditional trademarks in Mexico, trademark owners may, with suitable professional assistance, defend their rights by taking alternative courses of action as provided by Mexican law. [WTR](#)