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It's all in the evidence

Declarations for well-known trademarks are issued only after the Mexican Trademark Office has carefully studied all evidence submitted to it

The Mexican Trademark Law was amended in 2005 to take account of declarations of notorious and famous trademarks. Under this new proceeding, an applicant must provide evidence that its mark is notorious or famous in order to be granted the right to exclude competitors from using and benefiting from its distinctive sign. Following these amendments, the Mexican Trademark Office published the schedule of fees that must be paid both on application and then on the issuance of a declaration, along with the evidence that applicants should submit in order to secure an application.

The Mexican legislature considered it important to distinguish just how well known a mark is and whether it has achieved recognition in both Mexico and foreign markets. It thus divided well-known trademarks into two kinds:

- Famous trademarks – trademarks known by most consumers in Mexico.
- Notorious trademarks – trademarks known by a certain and specific sector of the public or trade sector as a result of commercial activities carried out by the rights holder in Mexico or abroad, including the use of the trademark in relation to specific goods or services or as a result of promotion or advertising.

A notorious mark is seen as deserving of special treatment with regard to third-party applications or registrations, due to the degree of recognition that it enjoys in certain economic sectors. A famous mark is a notorious mark, but with an even greater degree of recognition, which extends to the majority of consumers.

Under the Trademark Law, it is vital to identify just how much recognition a trademark enjoys, both in Mexico and abroad. Even a mark that is widely

considered famous is subject to official recognition of this from the Trademark Office, which will study all evidence before it and then deliver a ruling on whether the trademark at issue is notorious or famous.

The 2005 amendments to the Trademark Law established that a rights holder must submit the following evidence in order to secure a declaration that its mark is either famous or notorious:

- a survey showing all existing or potential consumers which identify the trademark with the goods and/or services covered by it;
- a survey showing other consumers (ie, other than existing or potential consumers) which identify the trademark with the goods and/or services covered by it;
- a survey conducted among all players in the trademark's area of commerce (eg, traders, industrialists and service providers) confirming their knowledge of the goods or services covered by the mark at issue;
- the date on which the trademark was first used in Mexico and, if applicable, the date that it was first used abroad;
- the duration of the trademark's continuous use in Mexico and, if applicable, the duration of continuous use abroad;
- the channels of trade used by the trademark in Mexico and, if applicable, abroad;
- the advertising channels used by the trademark in Mexico and, if applicable, abroad;
- the duration of advertising in Mexico and, if applicable, abroad;
- the amount invested in advertising and promoting the trademark in Mexico and, if applicable, abroad over the past three years;

- the geographic area over which the trademark has an effective influence;
- the turnover for the sale of goods and/or rendering of services under the trademark over the last three years;
- an appraisal showing the economic value that the trademark represents as part of the owner's capital;
- the trademark registrations that have been granted in Mexico and, if applicable, abroad;
- any franchises and licences that have been granted over the trademark; and
- the percentage of market penetration enjoyed by the trademark in the relevant sector or area of commerce.

Originals or certified copies of all of these documents and information must be filed. If the documents are not in Spanish, the evidence should be accompanied by Spanish translations. Once all of these documents – including translations and certified copies – have been gathered, the rights holder can file its application before the Trademark Office. It need not specify whether it is applying for a declaration that its mark is famous or notorious – this will be decided by the Trademark Office.

A declaration that a mark is either notorious or a famous is valid for five years. Once this has expired, it can be renewed upon request, provided that the rights holder can demonstrate that the conditions that gave rise to the declaration remain satisfied.

The first declaration for a well-known mark issued by the Trademark Office was for the catalogue sale brand 100% Mexican, which offers footwear for sale.

The ANDREA mark was declared notorious in November 2008, based on Mexican Registration 739383 “ANDREA (& design)”, which covers footwear. The declaration was issued after the rights

holder fulfilled all of the requirements listed above. The Trademark Office decided to include within the declaration the catalogue sale service Class 35, as well as the applied-for Class 25.

It took almost a year for the Trademark Office to study, analyse and review all of the evidence filed by Fábricas de Calzado Andrea SA de CV – which included invoices, catalogues, surveys, publications, affidavits, certificates of registration from Mexico, the United States, Guatemala, Costa Rica and Argentina, among other countries, and fact sheets including photographs of branch offices around Mexico.

The Trademark Office held that the mark did not meet the requirements necessary to obtain a declaration of famousness, since the filed evidence did not support and show that the mark was known by the majority of consumers in Mexico. However, the evidence was sufficient to show that the mark was well known within the women's footwear market. After identifying that a specific market made up of women older than 12 years old (ie, 54.68% of the Mexican population) recognised the trademark as a consequence of the rights holder's commercial activities both in Mexico and/or abroad, the Trademark Office issued a declaration that ANDREA was a notorious mark.

Once the office had reached this decision, it ordered the rights holder to pay a final fee in order for it to issue the corresponding declaration.

This declaration was followed, also in November 2008, by a declaration that the mark CINEPOLIS was a famous trademark within Mexico, since the majority of the Mexican population were aware of the connection between the mark and services it offered related to cinemas.

Since these first declarations, the Trademark Office has issued various declarations for notorious and famous trademarks, including the following.

Famous trademarks:

- CINEPOLIS
- RED BULL
- GANSITO
- BIMBO
- INTEL
- BMW
- JOSE CUERVO
- MICROSOST
- PEPSI
- YAHOO
- COHIBA
- TELEVISA
- SOY TOTALMENTE



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- PALACIO DE HIERRO
- GANDHI
- BATMAN
- SUPERMAN
- NACIONAL MONTE DE PIEDAD

Notorious trademarks:

- ANDREA
- PRIT
- BARCEL
- RICOLINO
- RESISTOL
- LAS MOMIAS DE GUANAJUATO
- HOTELES CITY EXPRESS
- ELEKTRA
- SUPER PRECIO
- PAYASO
- CORONADO
- MELATE

Benefits of such declarations

Globalisation makes it more important than ever that national laws offer a wider scope of protection to holders of well-known marks in order to preserve their continued value within a constantly changing market.

For rights holders that succeed in obtaining a declaration that their mark is either famous or notorious, some of the benefits include the following:

- The Trademark Office will not grant a registration for an identical or

confusingly similar trademark to commercialise or provide the same or similar goods and/or services in connection with notorious marks, and in connection with any goods or services in connection with a famous trademark;

- The value of the trademark (both economic and commercial) will increase; and
- The rights holder will be able to enforce its rights against third parties without the need to prove that its trademark is notorious or famous (a situation that was common in the past with regard to contentious proceedings).

These declarations are important for rights holders in Mexico, since the applicable law establishes that the following are not registrable as trademarks:

1. *Names, figures or three-dimensional shapes, being identical or similar to a trademark that the Mexican Trademark Institute has considered or has declared as "notorious" in Mexico; to be applied to any good or service.*

This impediment shall apply in any case in which the use of the mark for which registration is sought:

- a) *Could create a risk of confusion or association with the owner of the well-known trademark,*
- b) *Could constitute a non-authorized use of the owner of the well-known trademark,*
- c) *Could lead to the discrediting of the well-known trademark,*
- d) *Could dilute the distinctiveness character of the well-known trademark*

This impediment shall not apply where the registrant is the owner of the well-known trademark

2. *The names, figures or three-dimensional shapes identical or confusingly similar to a trademark that the Mexican Trademark Institute has considered or has declared "famous", to be applied to any good or service.*

This impediment shall not apply where the registrant is the owner of the famous mark.

Declarations for well-known trademarks are a useful tool for protecting IP rights in Mexico. However, even if you are sure that your mark meets the necessary requirements and is well known within the relevant market, it is important to remember that the final decision remains with the Trademark Office, which will issue it only after studying all evidence submitted to it. [WTR](#)