

LEGARRETA Y ASOCIADOS, S. C.

ABOGADOS

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Mexico City, February 2, 2017.

Dear Clients and Friends:

The following are some criteria that IMPI (Mexican Institute of Industrial Property) follows when pondering the value of evidence coming from other countries in a litigation:

1. While in Mexico one of the main functions of a Notary Public is to certify the truthfulness and accuracy of the copy of a document, the IMPI acknowledges that other countries do not grant the Notary Public with such authorities; thus, it is OK for the officers of the company or entity petitioner to declare in an affidavit that the copies enclosed are true and accurate (or any variation of this formula) copies of the original documents, as long as it is stated the archive or place wherein the original is being kept;
2. TM registrations certificates make prove of the protection of the TM in a country. Do not show use and neither prove notoriety, so the same alone do not serve to prove previous and uninterrupted use in a nullity action pursuant to Article 151 section II of the Mexican Industrial Property Law;
3. Declarations of notoriety from other countries must be accompanied with the statement in the affidavit that the same was issued by the corresponding Office with enough authorities, pursuant to the local Law, to do so;
4. Affidavit must be certified by the Notary Public and apostilled. And all documents must be in Spanish, accordingly to the general rules of the litigation proceedings in Mexico, set forth in the Federal Civil Procedures Code.
5. If a specific document contains several pages and only one fragment (v.g. an article) serves to show use, it's enough to translate such.

In addition, on September 20, 2012 the IMPI published an executive order with the criteria to interpret and apply the International Classification of Nice. In the same it was for the first time stated that the head class is only illustrative and that if an applicant intends to protect a specific product or service, it must express the same.

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While this mention does not impact directly the prosecution of a TM application, it has an important effect in litigation, since all those trademarks filed after October 5, 2012 can only be enforced against the infringement in the specific or similar products or services, and the infringer can argue against a head class coverage. Thus, we suggest to protect each product.

Should you have any questions or comments do not hesitate to contact us.

Best regards,

Legarreta y Asociados, S.C.