

MEXICO

Substitution by a posterior international registration

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Trademark Office. We have recently filed a petition requesting our authorities to take note of a substitution of a national registration by a posterior international registration and await their response taking note of this request.

In accordance with Article 4bis (1) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, a national registration can be replaced by its posterior international trade mark registration. This provision concerns the situation where a trade mark that is subject of a national registration is also subject of an international registration designating the same country and applies when both registrations stand in the name of the same person and cover identical goods or services.

In the same sense, Article 4 bis (1) indicates that the following conditions must be met:

- the protection resulting from the international registration extends to the said contracting party under Article 3ter (1) or (2);
- all the goods and services listed in the national or regional registration are also listed in the international registration in respect of the said contracting party,
- such extension takes effect after the date of the national or regional registration.

As provided by Article 4bis §2 of the Protocol Relating to the Madrid Agreement Concerning International Registration of Marks, and upon request of the trade mark owner, the Mexican Trademark Office would be required to take note of this replacement in its register of international trade mark registrations.

In view of the above and in order to ascertain that the rights obtained through the national registration for the concerned goods or services remain valid even after the said earlier right would not be renewed at the next renewal due date the substitution has to be requested through a brief filed before the Mexican