

Managing Intellectual Property

The Global IP Resource

MEXICO: CONFUSION ANALYSIS BETWEEN TRADE MARKS

23 March 2017

It has been approximately a decade since the Mexican Institute of Industrial Property (IMPI) adopted very strict criteria when assessing the likelihood of confusion between trade marks. As a result of this strict approach IMPI's trade mark examiners had some criteria that were troublesome, especially when marks including designs or associated to a concept were compared to each other.

These troublesome criteria were to consider designs as secondary elements usually deemed insufficient to grant distinctiveness to the marks. As a result the examiners tended to focus their confusion analysis on the phonetic elements of the mark.

Unfortunately, these criteria were able to stand for a long time, because IMPI's resolutions were reviewed by the IP Specialised Court of the Federal Court of Administrative Matters (TFJA), which for a long time supported IMPI's criteria by confirming their resolutions as correctly issued.

However, in late 2015 early 2016 new magistrates were appointed to the IP Specialised Court of the TFJA and as a result the criteria of this Court have also changed.

Consequently, during the course of 2016 we received various resolutions in which the Court reversed IMPI's decisions by pointing out that when analysing and comparing marks it is necessary to consider the marks as a whole, determine which of the elements of the mark is the most relevant element and take this element as the axis for the eventual analysis of confusion.

As a result, the Court has stated that if in a certain case the design or the conceptual element of the marks are the most relevant element, which in the result allows for the marks to be considered as different when compared as a whole, then registration for the junior mark should be granted.

Of course we consider that this change of criteria from the Court is a step in the right direction and expect IMPI to adjust their criteria accordingly during the course of 2017, resulting in the issuance of fewer refusals by IMPI, especially in connection with marks including designs or associated with a clear concept.



Sofia Arroyo

Olivares

Pedro Luis Ogazón No 17

Col San Angel

01000 México DF

Tel: +5255 53 22 30 00

Fax: +5255 53 22 30 01

olivlaw@olivares.com.mx

www.olivares.com.mx