

designate a Mexican agent on your Madrid designation.

Amid the 10th anniversary since the accession of Mexico to the Madrid system, we have identified some of the key reasons why international registration holders should appoint a Mexican agent to monitor and oversee their designations.

- **possible contentious proceedings that might be brought against granted designations.**

For those designations maturing into registration without encountering any objections, the Mexican Trademark Office will issue the corresponding registration certificates, which will be followed by a notice of allowance that will be sent to WIPO and further served to the applicant.

The resulting registration will lack an address located in Mexico for further correspondence to be sent, which will result in some complications in the service process of any contentious proceedings initiated by a third party.

Even though the Mexican Trademark Office will practice service to the Registrant in accordance to Rule 23 BIS of the Common Regulations, we are of the opinion that practicing service of a contentious proceeding against a registration lacking of an address located in Mexico through WIPO, might, in some way, conflict to what Federal Law for the Protection of Industrial Property and Federal Code of Civil Procedure dictate when it comes to practicing service, which has been considered by our Supreme Court of Justice to be an essential and most important element of due process considerations.

- **declaration of use.**

The recently enacted new Federal Law for the Protection of Industrial Property provides that a declaration of use will need to be filed to keep trademark registrations valid and in force.

The declaration of "real and effective" use of the mark must be filed by the holder's legal representative domiciled in Mexico.

Such declaration of use should confirm that "real and effective" use of the mark has taken place during the preceding three years in Mexico. Please note as well that these declarations will be

submitted under oath and on behalf of the Registrant. Registrations lacking the referenced declarations shall be declared ex officio canceled.

Considering the above, towards avoiding undue risks and the potential loss of rights, we strongly recommend appointing a Mexican agent on all Mexican designations, to ensure that you receive all relevant correspondence and that all due dates are docketed.

We offer this service to our clients on a complimentary basis to ensure proper monitoring and guidance. Once we have been appointed, we will:

- become your agent for the Mexican designation.
- enter the designation into our management system.
- docket and report any official communication received from the MTO; and

Please feel free to address whatever comments or questions you may have on the status of whichever International Registration extended to Mexico. We will be more than pleased to provide you with a full report and upcoming deadlines, if any.

Update February 2021



Rio Lerma 232, 23rd Floor, "Torre Diana",
Cuauhtemoc, 06500, Mexico City.

(55) 8852-7821
contactus@ibarralaw.com.mx
www.ibarralaw.com.mx

