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Jorge León would like to acknowledge the assistance of Ana Castañeda, attorney at law in the drafting of this article.

Co-existence of trademarks and *Reserva of Rights* in Mexico

Jorge León, assisted by **Ana Castañeda** of C & L Attorneys explore the *Reserva of Rights* in Mexico since its application in 1991

As of its date of application in the year 1991, the Mexican Industrial Property Law has suffered several reforms and additions.

Besides the newest additions made in the year 2006 regarding well-known marks and franchising, the current Mexican legal framework requires additional developments to enable more consistent and formal rules regarding the trademark and *Reserva of Rights* co-existence in our country.

Independently to the trademark registration procedure before the Mexican Institute of Industrial Property, the Federal Copyright Law establishes the right to obtain legal protection concerning the exclusive use of a title regarding the following genres: periodic publication; periodic broadcast; as well as human characterisation or fictitious or symbolic characters; persons or groups engaging in artistic activities and; advertising promotions.

As a trademark owner would, eventually the owner of a *Reserva of Rights* will expose its publication, broadcast or character to individuals throughout Mexico, a situation that will indeed be considered as a commerce act.

Avoiding duplicity

Due to the fact that both a trademark registration and a *Reserva of Rights* can coexist, even though they belong to different owners, considerations must be given in order to avoid incurring in duplicity, and thereof in infringement of rights, and to determine the primacy of either of the above mentioned legal figures.

According to Article 173 of the Federal Copyright Law, the reservation of rights is the power to use and utilise exclusively titles, names, denominations, distinctive physical and psychological features or characteristics of original operations pertaining, according to their nature, to one of above mentioned genres.

Once the *Certificate of Reserva* is issued, an additional requirement in order to start distributing a periodic publication must be compiled; the owner of a *Reserva of Rights* must file and obtain the corresponding Legality of Contents Certificate and the Legality of Title Certificate from the Evaluating Committee of Illustrated Publications and Magazines of the Ministry of the Interior.

The validity of the *Reserva of Rights* will vary depending on the genre; one year for publications and periodic

broadcasts and five years for the remaining genres. The protection terms of the corresponding *Reserva of Rights* may be renewed for equal successive periods. Excepted are advertising promotions, which at the end of their term shall pass into public domain.

On the other hand, Article 88 of the Industrial Property Law establishes that a mark is understood as being any visible sign that distinguishes products or services from others of the same type or category on the market. The validity of a trademark registration will be of ten years, which may also be renewed for equal successive periods.

In a hypothetical scenario, there may be cases in which a *Reserva of Rights* is granted to be used for an specific title in relation to a periodic publication e.g. the exclusive use of a title for a magazine, and where a third party has requested and obtained trademark registration for products covered in international class 16 (which includes magazines) for the exact same word or a similar one which creates confusion among customers.

Certainly the Mexican Industrial Property Law has established, within section XIII of Article 90, a prohibition to obtain a trademark registration when the applied mark is identical to the titles of intellectual or artistic works, as well as the titles of periodical publications and broadcasts, fictional or symbolic persons, real personages portrayed, or the names of individual artists or groups of artists. This is unless the holder of the corresponding right expressly authorises the registration thereof.

The said restriction would indeed work efficiently if the two following premises were applied:

- That Mexican Institute of Industrial Property and the Mexican Copyright Office shared an updated database which would allow displaying filed applications and/or registrations for trademarks and *Reserva of Rights*. Nevertheless, both institutions do not share said information, therefore, many cancellation and infringement actions have arisen.
- That the referred section of Article 90 foresees that not only identical marks should be restricted, but also considers a restriction against similar marks.

Legal action

Certainly, strong advice from IP experts in Mexico regarding the particular needs of their client may avoid entering legal actions. In cases where legal actions are required, Federal Laws foresee the right of a trademark or *Reserva of Rights* owner to start legal action against a third party which is using their exclusive right without authorisation.

As a previous step towards determining the course of action, it is suggested a search is filed before the Mexican Institute of Industrial Property or the Federal Copyright Office in order to determine the adequate legal action which could go from a straight forward infringement action or a commercial violation to a nullity or cancellation action in between.

The Mexican Institute of Industrial Property resolves the controversy considering seniority rights based on the principle of first in time, first in right, over junior registration for identical or confusingly similar words granted by mistake, and subsequently in view of other legal venues by which IP practitioners may challenge the resolutions issued by the Mexican Institute of Industrial Property. Both trademark and *Reserva of Rights* owners, however, may continue the use of their corresponding intellectual property rights, thereof, the only entity damaged is the general public, who may be confused when choosing between products that are identical or confusingly similar but may contain different content and quality.

No legal precedents are available that clarify the above type of situation. In the years to come, however, we expect to have additional legislative and judicial development to enable a more consistent and formal regulation of both trademark and *Reserva of Rights* in Mexico.