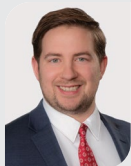


## Mexican trademark registration: Declaration of use now required



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On Nov. 5, 2020, Mexico enacted new intellectual property laws impacting trademark registration. These new laws are structured to align Mexico's national intellectual property laws with the new intellectual property standards prescribed in the United States-Mexico-Canada Agreement (USMCA), the new trade agreement with the U.S. and Canada replacing North American Free Trade Agreement (NAFTA).

While the new laws make numerous changes to Mexico's intellectual property framework, the most substantial change is that a declaration of use must now be filed for all trademark registrations within three months of the third anniversary of the registration date. So, for example, if a trademark is registered on Jan. 1, 2021, a declaration of use must be filed before April 1, 2024. This new rule is applicable to all registrations granted after Aug. 10, 2018. A declaration of use must also be filed when a trademark owner seeks to renew its registration. If the trademark owner does not prove use of the mark in Mexico in the appropriate manner and timeframe, the owner will be considered to have waived and renounced its trademark.

One of the intended effects for this new requirement is to eliminate unused marks from Mexico's trademark registry. This would allow others who wish to use those unused trademarks the ability to do so. This ensures that a trademark's owner is using the trademark in commerce and not merely claiming or holding marks and preventing others from using them. As such, the change installs an important safeguard against opportunistic trademark land-grabbers: use the trademark or lose it. This has long been the rule in the U.S.

This change in the law has disadvantages as well. Specifically, a U.S. company owning a trademark registration in Mexico might have registered its mark with uncertain future plans to use the mark in Mexico, or just to ensure that others did not lock the company out of Mexico by registering ahead of it. Under the new law, a U.S. company should have clear plans to use the mark in Mexico within three years of the application, or the resources spent obtaining the registration could be wasted.

In addition to this major change, the law includes additional changes of which applicants need to be aware when filing for trademark protection in Mexico. Some of these include:

1. The deadline for filing a trademark renewal application is now 10 years from the grant date rather than 10 years from the filing date;
2. An applicant must refer to a physical established domicile, rather than a post office box, if a date of first use is claimed; and
3. A power of attorney no longer needs be included when filing a trademark application, which can save substantial time.

**For more information or questions on this new law's impact on trademark applications and registrations in Mexico, please contact a member of our Intellectual Property Practice Group.**

*The information contained herein is based on a summary of legal principles. It is not to be construed as legal advice and does not create an attorney-client relationship. Individuals should consult with legal counsel before taking any action based on these principles to ensure their applicability in a given situation.*