

# Legal 500

## Country Comparative Guides 2025

**Mexico**

**Trademark Disputes**

**Contributor**



**SPECIFIC IP**

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This country-specific Q&A provides an overview of trademark disputes laws and regulations applicable in Mexico.

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## Mexico: Trademark Disputes

### 1. To represent a client before Court in respect of a potential trademark infringement matter, do you require a Power of Attorney – and if so, what are the execution formalities required by your courts?

Yes, for domestic clients, we require a notarized PoA (duly legalized), and for foreign clients, a duly legalized PoA with an apostille.

### 2. Is it a requirement in your jurisdiction to send a cease and desist letter to a potential infringer before commencing proceedings for infringement? What are the consequences for a trademark owner who chooses not to send a pre-action letter?

In Mexico, send a cease-and-desist letter before initiating a trademark infringement proceedings is not a legal requirement but it can be useful strategy to attempt to resolve the dispute without resorting to legal action. There is no legal consequence, however the opportunity to reach an out-of-court settlement is lost, in addition to the fact that it would be helpful to demonstrate the bad faith of the offender.

### 3. In your jurisdiction, is there a risk that a pre-action letter could give rise to claim against the trademark owner for unjustified threats? What steps should a trademark owner take to ensure any cease and desist letter does not expose the trademark owner to any liability.

If the letter is excessively aggressive and/or threatening, it could lead to civil disputes (for damages) or even criminal proceedings. However, there is no specific legal classification for cease and desist letters. We always recommend using a firm yet negotiation-friendly tone in such letters, clearly stating that a legitimate right is being affected—in this case, the trademark registration that is being harmed by the improper use of its name.

### 4. Is it mandatory for the parties to have

### attempted mediation or other alternative dispute resolution proceedings prior to commencing infringement proceedings?

In Mexico, it is not mandatory for the parties to have attempted mediation or any other alternative dispute resolution procedure before initiating a trademark infringement action.

### 5. Are claims for trademark infringements heard before a general commercial Court or a specialist Court focused on Intellectual Property disputes? Are trademark infringement claims decided by a judge or by a jury?

In Mexico, claims for trademark infringement can initially be filed with the Mexican Institute of Industrial Property (IMPI), which is the administrative authority responsible for the protection of industrial property rights, including trademarks. In this case, IMPI conducts an administrative investigation to determine whether an infringement has occurred. If an infringement is confirmed, IMPI may impose sanctions, such as fines or an order to cease the infringement. However, if any party disagrees with the resolution issued by IMPI, they can appeal the decision and take the case to the Federal Court of Administrative Justice (TFJA). This court is responsible for reviewing IMPI's decisions in a judicial capacity and is composed of judges specialized in intellectual property matters. Therefore, while the initial phase is administrative, the final ruling on the infringement is made by a judge in the TFJA.

### 6. Is there a time limit for commencing trademark infringement proceedings once the facts giving rise to the infringement are known to the trademark owner. After how long would such a claim be time-barred?

N/A

### 7. In your jurisdiction does the law protect unregistered trademarks of any kind, including by way of unfair competition or protection of trade

**dress. What are the criteria for their subsistence?**

In Mexico, the Federal Law on Industrial Property (LFPI) establishes that, in principle, trademarks must be registered to enjoy full protection. Trademark registration constitutes a highly important right for taking legal action.

**8. In your jurisdiction will the Court hear claims for registered trademark infringement in parallel with claims for unfair competition, infringement of trade dress or other misleading advertising, or does a claimant need to bring such claims in a separate cause of action?**

In Mexico, the court can hear claims for registered trademark infringement alongside claims for unfair competition, trade dress infringement, or other acts of misleading advertising in the same proceeding, as all these actions are related to the protection of industrial property and fair competition. The Commercial Code and the Federal Law on Industrial Property allow the consolidation of such claims when they are linked to the same facts or conduct that affect the claimant's rights.

**9. In your jurisdiction, do your Courts share jurisdiction with your Trade Mark Office, such that parties need to seek to seize the forum they prefer first in time, or does the Court take precedence and intervene to stay or transfer any live Registry proceedings (for example relating to invalidity or revocation of registered trade mark) which may overlap with an issued infringement claim and related counterclaim?**

They have separate jurisdictions. They are different forums, so if the IMPI does not issue a favorable decision, we can resort to the court.

**10. Where the defendant has a counterclaim for invalidity or cancellation of the registered trademark being asserted against it (either on the basis of earlier rights or as a result of non-use by the trademark proprietor), does the counterclaim become part of the infringement action, so that both issues are heard by the same Court within a single action, with the Court making a determination at its conclusion, or are the**

**validity issues bifurcated and heard in separate parallel proceedings? If in your jurisdiction validity issues are bifurcated, what are the practical consequences of this from a timing perspective? For example, does this mean that a Court will stay the infringement claim and proceed with the validity attack first to avoid finding a trademark infringed, only to have a separate Court find the trademark invalid at a later date?**

They are seen together and resolved at the same time. However, two separate resolutions are issued. One in relation to the invalidity procedure and the other for trademark infringement.

**11. If the main objective in commencing infringement proceedings is to secure an injunction, is a claimant required to state how much their claim is worth at the point their claim is issued?**

In Mexico, generally, when filing a trademark infringement claim, the claimant is not required to state a specific value of the claim if the primary objective is to obtain an injunction. However, if the claimant seeks other remedies, such as damages or monetary compensation, the value of the claim must be stated, as this value is necessary to determine the court's jurisdiction and to calculate potential indemnities.

**12. Is it possible to seek a preliminary injunction in your jurisdiction? If so, what is the criteria a trademark owner needs to establish and is there a bond or other undertaking in damages payable to compensate the defendant if the Court finds no infringement following a substantive hearing?**

Yes, in Mexico, it is possible to seek a **preliminary injunction** (also known as a **cease and desist order**) within the framework of a trademark infringement proceeding. The claimant must demonstrate that they hold the rights to a registered trademark. Generally, the court may require the claimant to provide a **bond** or **other security** to compensate the defendant in the event that, at the conclusion of the trial, the court determines that no infringement occurred and the claimant sought the injunction without merit.

**13. Is a licensee (whether exclusive or non-exclusive) of a registered trademark entitled to commence proceedings for trademark infringement? Does the trademark proprietor need to be joined as a party to the proceedings, and does it have an effect whether the licensee is registered before the local Trademark Registry?**

Yes, but the trademark owner must agree. This is established in the license agreement signed by both the owner and the licensee, allowing the latter to initiate actions.

**14. Where the claim for trademark infringement is premised on similarity between the defendant's mark and the trademark owner's registered mark, does the proprietor need to demonstrate that confusion has occurred or simply that there is a risk of confusion? What is the minimum standard required to secure a finding of infringement?**

In Mexico, according to the Federal Law for the Protection of Industrial Property (LFPPI), it is not necessary to prove that confusion has actually occurred in practice; rather, it is sufficient to establish the possibility or risk of confusion for an infringement to be deemed as such. The LFPPI states that a trademark constitutes an infringement when an identical or confusingly similar sign is used in connection with the same or similar goods or services as those covered by a registered trademark, without the need to demonstrate actual confusion.

**15. In your jurisdiction what type of disclosure or discovery is typically ordered by the Court in respect of trademark infringement actions from both parties?**

In Mexico, the Institute requests documentary evidence, expert opinions, physical and visual inspections, as well as testimonies.

**16. What type of expert evidence is permitted by the Court in your jurisdiction? Does the Court accept consumer surveys and are there specific rules about how consumer surveys are conducted. Do the parties need to request prior permission from the Court to adduce survey**

**evidence?**

The Court does accept consumer surveys, and they must meet the minimum standards to be adequate. However, all evidence offered by the parties must be related to the dispute.

Finally, neither party should request permission from the Tribunal to offer evidence. However, this will be left to the Tribunal's discretion.

**17. Does evidence submitted by your client in trademark infringement proceedings have to be accompanied with a statement of truth or other similar declaration?**

No, it is not necessary to submit a declaration of truthfulness as the Tribunal may decide whether these are truthful, or the opposing party may decide whether to challenge their truthfulness.

**18. In your jurisdiction is it possible for a claimant to seek summary judgment of an infringement claim? What are the legal criteria for a Court to grant summary judgment?**

Intellectual property summary judgments are not applicable. However, the parties may decide to seek the justice of alternative means of dispute resolution (such as arbitration) to resolve their dispute.

**19. How long does it typically take to reach judgment in a trademark infringement action from issue of the claim, through to first instance decision? What is the lower and upper range of legal costs for such an action?**

The approximate time is 1 year.

The lower range is between \$6,000.00 USD and the upper range is between \$10,000.00 USD.

**20. Following a first instance decision, is it possible for either party to appeal the decision? What are the grounds upon which an appeal can be lodged? Is it necessary to request permission to appeal, or are appeals automatically permissible? If either party file an appeal, is the**

**enforcement of the first instance decision stayed pending the outcome of the appeal?**

If it is possible for any party to appeal the decision of the IP Office and the grounds on which it may do so are that the Office made an incorrect assessment of the facts, inadequate evaluation of the evidence, did not rule on all the evidence submitted, did not apply the law correctly, etc.

**21. If the parties have been involved in a dispute before the local Trademark Office, what relevance does this have on later infringement proceedings? For example where trademark owner (A) may have already sought to oppose the registration of a third party (B's) mark in proceedings before the local Trade Mark Office, is the trademark owner estopped from seeking invalidity of a registered trade mark where its opposition failed where the invalidity action is based on the same grounds as the unsuccessful opposition?**

It is correct, when one of the parties files an opposition and obtains an unfavourable decision, it may request the nullity of that decision before the National Office, but the evidence provided must not be the same as that already provided in the opposition proceedings, or it may appeal that decision before the Federal Court of Administrative Justice.

**22. In your jurisdiction, does the Court consider both liability and quantum within the same proceeding, or will any damages be assessed after the Court has reached a decision on liability? How are damages for trademark infringement proceedings typically assessed in your jurisdiction?**

Damages will be assessed after the Tribunal has reached a decision and the Federal Law for the Protection of Intellectual Property establishes that the compensation for the violation of one or some of the industrial property rights regulated in this Law, in no case may be less than forty percent of the legitimate value indicator presented by the affected owner.

**23. In addition to an injunction and damages, what other remedies are available in your jurisdiction?**

There are no others.

**24. Following a decision on the merits, is the winner entitled to recover all or a portion of its legal costs incurred in bringing or defending the proceedings. If legal costs are recoverable, what is the procedure involved and how does the Court assess the level of legal costs which should be reimbursed by the losing party.**

The Mexican authorities that rule on intellectual property matters do not provide for the recovery of legal costs. However, the T-MEC, to which Mexico is a party, does provide for it.

**25. Once the Court has issued a judgment, how long typically does the losing party have to comply with the Court's judgment including any final injunction issued? What are the consequences for failing to comply and how would the winning party seek enforcement of its judgement.**

Once the Tribunal's decision becomes final and can no longer be challenged by the parties, it must be complied with immediately.

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