



## Intellectual Property SCJ: Ban on descriptive three-dimensional marks, is not contrary to the Paris Convention

On 18 September 2020 was published the precedent “Article 90, fraction IV, of the law relative, not contrary to the Article 7 Convention Paris Convention for the Protection of Property Industrial (previous legislation to reform published in the official journal of the Federation on May 18, 2018)”. It is based on the resolution of the Mexican Supreme Court (SCJ) issued in the constitutional claim (Amparo) 556/2019.

In summary, it was analyzed the constitutionality of Article 90, section IV of the Law of Industrial Property, since there is an apparent contradiction with the Article 7 of the Paris Convention for the protection of Industrial Property.

Let us remember that Article 90 Section IV of the Industrial Property Law establishes that: **“a trademark will not be registrable if is descriptive of the products or services that tries to protect themselves as a brand**, considering all its characteristics; being included in this assumption the descriptive or indicative words that in the trade serve to designate the species, quality, quantity, composition, destination, value, place of origin of the products or the time of production.”

It is relevant because the same rule is established by the “New Federal Law for Industrial Property Protection” which will

enter into force on November 5th.

Moreover, Article 7 of the Paris Convention provides that **“the nature of the product to which the mark is applied, can not be an obstacle to the registration of the mark”**.

In this regard, the SCJ concluded that the content of Article 90, Section IV of the Industrial Property Law is not opposed to what is provided in Article 7 of the Paris Convention; since the text of the Industrial Property Law prohibits the registration of a trademark **when it deals with descriptive terms**. For its part, the Paris Convention

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refers that a member Country can not reject a trademark registration **due to the product or service concerned is prohibited.**

Furthermore, both articles are complemented by the content of article 6 fifth, paragraph B, number 2 of the Paris Convention. It establishes a limitation to brands that are lacking any “distinctive” character or exclusively formed by signs or indications that could serve, in commerce, to designate the species, quality, quantity, destination, the value, the place of origin of the products or the time of production.

In conclusion, It will be interesting the implementation of this precedent regarding to the article 7 of the Paris Convention in other trademark cases, related with banned products and services.

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