Mexican Supreme Court of Justice Rejects Contradiction of Criteria in Connection with The Article Regulating Invalidity Actions Against Trademark Registrations

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Today, in a plenary session, the Mexican Supreme Court of Justice (SCJN) analyzed a Contradiction of Criteria, whose central issue was to determine if article 151, section I, of the abrogated Industrial Property Law, violates or not the principles of
legality and legal certainty by providing that invalidity actions can be exercised at any time, in the case of trademark registrations granted in contravention of the provisions of that law or the one that would have been in force at the time of registration.

In this plenary session, the SCJN proposed not to enter into the study of the contradiction, since the contending criteria between the First and Second Chambers had not been raised derived from the same problem.

The SCJN explained that in the case analyzed by the First Chamber of the SCJN, the constitutionality of section I of article 151 of the Industrial Property Law was confirmed, because although as a general rule sanctions and infractions must be foreseen, the legislator cannot foresee all technical, scientific and technological issues that may lead to declare the invalidity of a trademark registration, thus considering it legal to have such an open norm, mostly considering that this Section I of Article 151 implies the breach of other behaviors that are set forth in other legal systems, so there is no violation of legality and legal certainty.

On the other hand, in the cases analyzed by the Second Chamber, the unconstitutionality of section I of article 151 of the Industrial Property Law was raised, based on the analysis of its “imprescriptibly” and the consequent violation of the human right of legal certainty, considering that if an invalidity action can be attempted against a trademark registration at any time, it leaves the holders of said rights in a state of defenselessness and legal uncertainty.

Thus, the plenary of the SCJN, through a majority with 8 votes in favor and 1 dissenting vote, concluded that there is no matter of contradiction of criteria, since there is no genuine point of contradiction, because the contending criteria were not studied from a very same problem.

In OLIVARES, we celebrate this decision of the SCJN determining that there is no contradiction of criteria in connection with this important legal provision of Mexican IP legal system. Likewise, we reiterate that the scope of the thesis that did declare the unconstitutionality of section I of article 151 of the Industrial Property Law, is limited only to declare as unconstitutional the imprescriptibility of this Article, when the grounds for the invalidity are related to the breach of the formal and secondary aspects of a trademark.

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