WTR

The Trademark Litigation Review

2027

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The fourth edition of the WTR *Trademark Litigation Review* casts an expert eye on some of the most pressing issues facing those involved in litigation on both sides of the divide, blending analytic insight with on-the-ground expertise from the key regions of the Americas, the Asia-Pacific, and Europe, the Middle East and Africa.

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Contents

Americas Trademark Litigation Review

Specialist chapter: Litigation strategies behind multiple-seller counterfeiting cases at the US federal courts

Justin Gaudio, Amy Ziegler, Allyson Martin

Greer Burns & Crain

Specialist chapter: Trademark law continues to evolve: key decisions shape the future of brand protection in a digital age

Ronald A DiCerbo, Khalfani Maatuka

McAndrews, Held & Malloy Ltd

Mexico: evolving trademark litigation strategies and the challenge of securing effective relief

Abraham Diaz, Jaime Rodriguez

OLIVARES

Asia-Pacific Trademark Litigation Review

China: courts intensify efforts to combat infringement with strengthened protection framework

Aimin Huo, Lei Fu

CCPIT Patent and Trademark Law Office

India: Supreme Court aligns mediation rules with IP enforcement realities

Suhrita Majumdar, Aayush Sinha

S Majumdar & Co

Japan: ensuring success under the trademark enforcement framework

Masayuki Yamanouchi, Yuta Oishi, Koki Sasaki, Satoko Yokogawa

Anderson Mōri & Tomotsune

Vietnam: trademark litigation evolution strengthens civil proceedings amid dual enforcement system

Dang Thi Hong Nga, Dang Thi To Hang

D&N International

Europe, Middle East and Africa Trademark Litigation Review

Specialist chapter: Contrasting Getty Images v Stability AI in the UK with GEMA v OpenAI and GEMA v Suno AI in the EU

Joel Smith, Elinor Cavil

Simmons & Simmons LLP

Specialist chapter: Litigation as leverage and the essential questions brand owners must ask their lawyers before launching trademark action

Ana-Maria Baciu, Ileana Nicolescu-Decsei

BACIU PARTNERS

Germany: latest trends in consumer products and forum shopping raise key trademark law questions

Mathias Zintler, Florian Stoll, Nikolaus Schmidt-Hamkens

KNPZ Rechtsanwälte

Greece: crucial considerations for brand owners contemplating legal action

Marina Perraki

Tsibanoulis & Partners Law Firm

Poland: trademark reform and reputation rulings reshape brand protection

Krystyna Szczepanowska-Koz owska, Katarzyna adno, Adam Kancy

A&O Shearman

Spain: how the OEPM is reshaping trademark nullity actions after Spain's 2023 reform

Carlota Valero Camacho

Grau & Angulo

Mexico: evolving trademark litigation strategies and the challenge of securing effective relief

Abraham Diaz and **Jaime Rodriguez**
OLIVARES

Summary

IN SUMMARY
DISCUSSION POINTS
REFERENCED IN THIS ARTICLE
A CHANGED FRAMEWORK FOR TRADEMARK DEFENCE
CHOOSING THE APPROPRIATE ROUTE
ARTICLE 259 AND REFLECTED RES JUDICATA
SEPI CONTINUES TO REJECT IMPI'S OBJECTIONS TO JUDICIAL REVIEW
PUBLICATION AND THE TIME LIMIT FOR JUDICIAL CHALLENGE
WINNING THE MERITS DOES NOT NECESSARILY SECURE DIRECT INVALIDITY
WHY THE EFFECTS OF INVALIDITY MATTER
OTHER DECISIONS RELEVANT TO TRADEMARK DEFENCE
PROCEDURAL COORDINATION AND REPRESENTATION
CONCLUSIONS
ENDNOTES

IN SUMMARY

- Mexico's opposition system has evolved from a predominantly informational mechanism within trademark examination into a procedure with legal effects of its own, subject to judicial review. Recent SEPI decisions reinforce that evolution by rejecting procedural objections that would otherwise leave opponents facing the restrictions of article 259. Yet access to a decision on the merits is only part of the story: securing a declaration of trademark invalidity with full retroactive effect may still require further judicial intervention.
- Recent litigation highlights the importance of challenging unsuccessful opposition decisions and securing an express declaration of trademark invalidity with retroactive effect.
- More structured examination and statutory decision deadlines may improve the usefulness of oppositions, but do not remove their potential consequences for subsequent litigation.
- Article 259 and reflected res judicata raise different questions and must be assessed separately before selecting a defence strategy.
- In the recent decisions reviewed by the authors, SEPI has consistently rejected IMPI's objections to judicial review of granted registrations, but has remanded matters for IMPI to declare invalidity under its directions.
- Changes to representation requirements must be considered alongside transitional provisions and the distinct rules governing proceedings before IMPI and the courts.
- Monitoring both registration and opposition decisions remains essential to preserve remedies and avoid inconsistent outcomes.

DISCUSSION POINTS

- Legislative and regulatory developments
- Choosing between opposition, administrative invalidity and judicial review
- SEPI's role and the scope of judicial relief
- Article 259 and reflected res judicata
- Recent circuit court decisions
- Representation, notifications and procedural coordination
- Transitional regimes and continuing litigation risks

REFERENCED IN THIS ARTICLE

- Current LFPPI and reform of 3 April 2026: https://www.diputados.gob.mx/LeyesBiblio/pdf/LFPPI.pdf and https://sidof.segob.gob.mx/notas/docFuente/5784017
- Regulations published 28 April 2026, especially articles 38, 113 and transitional provisions: https://sidof.segob.gob.mx/notas/docFuente/5786237

- General commencement date corroborated by AIPPI: https://www.aippi.org/news/new-regulations-to-the-federal-law-for-the-protection-of-industrial-property-in-mexico/
- Original 2020 LFPPI: https://www.diputados.gob.mx/LeyesBiblio/ref/lfppi/LFPPI_orig_01jul20.pdf
- Amparo 232/2024 and SEPI 1627/2023-EPI-01-10
- Isolated thesis 2032297: https://sjf2.scjn.gob.mx/detalle/tesis/2032297
- Jurisprudence 2032240: https://sjfsemanal.scjn.gob.mx/detalle/tesis/2032240
- Jurisprudence 2032298: https://sjf2.scjn.gob.mx/detalle/tesis/2032298
- Jurisprudence 2032298: https://sjf2.scjn.gob.mx/detalle/tesis/2032298

A CHANGED FRAMEWORK FOR TRADEMARK DEFENCE

Since our previous article, Mexico has amended the Federal Law for the Protection of Industrial Property (LFPPI) and issued new implementing Regulations. Although these measures introduce changes across the industrial property framework, they largely preserve the existing trademark opposition system. The most significant developments for the litigation strategy discussed here arise from recent decisions concerning judicial review of unsuccessful oppositions and the relief available against the resulting registrations.

The November 2025 amendment addressed procedural harmonisation with the National Code of Civil and Family Procedure, while the January 2026 amendment concerned substantive equality. The broader April 2026 reform introduced substantive and procedural changes. The long-awaited Regulations were published on 28 April 2026 and took general effect on 22 July 2026. Their transitional provisions must be considered when determining the rules applicable to pending proceedings.

In trademark matters, the April reform expressly recognises position, motion and multimedia marks, clarifies prohibitions concerning non-distinctive signs, and revises protection for publication titles, characters and artistic names without expressly requiring a valid reservation of rights. It also introduces a prohibition protecting Indigenous and Afro-Mexican cultural heritage. Procedural changes include statutory decision deadlines, revised suspension rules and simplified requirements for foreign-company powers of attorney. These changes are relevant to trademark prosecution and litigation, but do not substantially alter the existing opposition system or the strategic relationship between opposition, administrative invalidity and judicial review.

The principal question remains how to choose and coordinate these remedies without compromising the trademark owner's position at a later stage.

CHOOSING THE APPROPRIATE ROUTE

Mexico's opposition system has evolved considerably since its introduction in 2016. The 2018 amendments and the LFPPI gave it a more structured procedure, including evidence, responses and reasoned decisions. Judicial precedents subsequently confirmed that an unsuccessful opposition decision could be challenged and, in appropriate cases, contested together with the resulting registration.

Most familiar procedural features remain unchanged: a one-month opposition period, evidence submitted with the opposition, an opportunity to cure certain formal defects, and closing submissions. The April reform expressly separates formal and substantive examination and introduces decision deadlines, including a maximum of five months after closing submissions under article 229. These deadlines should not be confused with a universal five-month period running from the application date.

For trademark owners, the choice of remedy depends on the dispute. An opposition may prevent registration where the earlier right and the conflict are readily demonstrated. Cases involving extensive prior-use evidence, bad faith or disputed ownership may require a different approach. In either situation, the decision should account for what happens if the opposition fails.

That assessment is particularly important because a subsequent invalidity action may be restricted by article 259 or affected by a determination made in the earlier proceedings.

ARTICLE 259 AND REFLECTED RES JUDICATA

Article 259 bars an administrative invalidity request where it repeats the arguments and evidence presented in an opposition and IMPI has already ruled on them. An unsuccessful opposition therefore does not prevent every later invalidity action, but it may close the door to presenting the same case again before IMPI.

Reserving arguments for a later action requires care. Changing the legal label or adding documents does not necessarily create a different dispute. Any new claim or evidence should have a substantive purpose and explain why the later action requires a different determination.

Reflected res judicata raises a related but separate issue. Rather than asking whether the arguments and evidence are identical, it concerns whether a prior final determination binds the resolution of an issue in the later dispute. For example, a finding on likelihood of confusion may affect a subsequent prior-use claim that depends on the same comparison of signs. Its effect must be assessed by examining what was actually decided, whether that determination is final and why it matters to the later claim.

The practical consequence is that reserving a ground of invalidity does not necessarily preserve every issue needed to establish it. Opposition and possible subsequent litigation should be planned together, including whether an adverse decision must be challenged to prevent it from affecting the next proceeding.

SEPI CONTINUES TO REJECT IMPI'S OBJECTIONS TO JUDICIAL REVIEW

Judicial review offers an important route following an unsuccessful opposition. In precedent IX-P-SS-85, published in September 2022, the Superior Chamber of the Federal Tribunal of Administrative Justice recognised that the opposition decision and the resulting registration could be challenged together because both concern whether an impediment to registration exists.[1]

Despite that precedent, IMPI has continued to raise procedural objections. In decisions issued during the past year and reviewed by the authors, its principal arguments have been that:

- the granted registration is not a definitive act subject to judicial review, and the opponent should instead seek administrative invalidity before IMPI;

- granting the registration irreparably consummates the opposition's subject matter and creates a new legal situation that cannot be affected by reviewing the opposition; and
- the registration affects only its holder, leaving the opponent without legal interest to challenge it, or reserving substantive challenges exclusively to the holder.

SEPI has consistently rejected these objections in the cases reviewed and proceeded to examine the merits. The fact that the certificate benefits its holder does not, by itself, answer whether its grant affects another person's earlier rights.

IMPI's insistence on a separate administrative invalidity action is particularly problematic in light of article 259. It would direct the opponent towards a remedy that may be unavailable precisely because IMPI has already decided the same arguments and evidence in opposition.

These decisions reinforce the role of judicial review. Granting the registration does not automatically remove the dispute from judicial scrutiny or require the opponent to return to IMPI through a new invalidity action.

PUBLICATION AND THE TIME LIMIT FOR JUDICIAL CHALLENGE

IMPI has also argued that publication of the registration in the Industrial Property Gazette starts the judicial challenge period, making a later action untimely even where the opponent challenges the registration together with the subsequently notified opposition decision. SEPI has rejected this objection in the decisions reviewed.

This issue becomes especially important where the registration is published well before the opponent receives the opposition decision. The two acts are closely connected, but their publication, notification and the opponent's knowledge of them may occur at different times.

Counsel must therefore monitor both acts and assess the relevant challenge periods. The decisions reviewed should not be read as establishing that Gazette publication never starts time running, or that notification of the opposition decision always postpones the deadline for challenging the registration. Equally, the possibility of a joint challenge should not be treated as a reason simply to wait without assessing the procedural consequences.

WINNING THE MERITS DOES NOT NECESSARILY SECURE DIRECT INVALIDITY

Access to judicial review is only the first part of the problem. In the recent cases reviewed, SEPI has favoured remanding the matter to IMPI rather than directly declaring the registration invalid. IMPI must then issue its decision under SEPI's directions.

This can occur even after a successful ***amparo*** on the merits. In one case identified by the authors, SEPI initially upheld IMPI's rejection of the opposition. Following ***amparo***, it annulled that decision so that the opposition would be upheld, but again remanded the matter instead of directly declaring the registration invalid.

By contrast, in some matters litigated by the authors, challenges to the relief ordered have led collegiate courts to require SEPI itself to declare invalidity. The case discussed in our previous article – ***amparo*** 232/2024 and SEPI proceedings 1627/2023-EPI-01-10 – illustrates that route.[2]

The distinction is important. The cases reviewed do not show uniform agreement between SEPI and the collegiate courts in favour of remand. They show that SEPI generally chose

remand on its own initiative, while obtaining direct invalidity required further judicial intervention.

A favourable merits judgment must therefore be examined for the relief it actually provides. Counsel should determine whether the registration itself is declared invalid or whether another administrative decision is required, and assess whether the remand should be challenged through ***amparo***.

WHY THE EFFECTS OF INVALIDITY MATTER

Remand can create a problem beyond additional time and expense. The authors are aware of a matter handled by another firm in which IMPI implemented the judgment by "leaving the registration without effect" (ie, ***dejar insubsistente***), rather than expressly declaring its invalidity.[3]

Article 263 provides that a declaration of invalidity destroys the registration's effects retroactively from its grant. Obtaining that result is materially different from securing a decision whose effect on the registration's past existence remains unclear.

The wording of the implementing act must be considered together with its reasoning and the judgment it purports to fulfil. The expression ***dejar insubsistente*** should not, by itself, be assumed to establish either prospective or retrospective effects. Nevertheless, a decision that omits an express declaration of invalidity or leaves its temporal consequences unresolved may provide incomplete relief.

This can be particularly important where the registration has been invoked against the successful opponent or relied upon in other disputes. The objective is to obtain a decision that clearly establishes the invalidity sought and its legal consequences.

Where the matter returns to IMPI, counsel must therefore scrutinise compliance with the judgment. Winning the opposition arguments does not end the task if the resulting administrative decision fails to give effect to the required relief.

OTHER DECISIONS RELEVANT TO TRADEMARK DEFENCE

Several recent decisions provide useful context without changing the central relationship between opposition and invalidity.

In ***amparo en revisión*** 217/2024, decided on 8 January 2026, the Fourth Collegiate Court of the Thirtieth Circuit held that publication of the application in the Gazette did not violate the hearing rights of indeterminate third parties. The isolated thesis, registration 2032297, concerns legislation predating July 2020 and reinforces the importance of trademark surveillance.[4] It addresses public notice of an application, rather than resolving the separate question of notification to an opponent who has already participated.

In ***amparo directo en revisión*** 7274/2024, decided on 11 December 2025, the Supreme Court upheld the legal certainty of the renewal grace period under article 237. Jurisprudence P./J. 116/2026, registration 2032240, confirms the relevance of a registration during that statutory period.[5] An earlier right should therefore be assessed by its renewal status, rather than its nominal expiry date alone.

In ***amparo directo en revisión*** 6714/2025, decided on 24 February 2026, the Supreme Court upheld article 258(IV), concerning invalidity for error, inadvertence or difference of assessment. Jurisprudence P./J. 135/2026, registration 2032298, supports the continued

availability of administrative invalidity as a corrective mechanism. It does not, however, resolve article 259 or permit unrestricted repetition of a failed opposition.[6]

The Court's description of opposition as an administrative mechanism in *amparo en revisión* 37/2025, concerning the opposition tariff, should likewise be distinguished from the question of judicial review. The nature of the mechanism and the ability to challenge its outcome are separate issues.[7]

PROCEDURAL COORDINATION AND REPRESENTATION

Two practical points complete the picture.

First, proceedings before different IMPI divisions must be coordinated. Where an application encounters an earlier registration that is itself challenged, the reformed suspension rules require attention to the application file as well as the contentious proceedings. Counsel should not assume that initiating one proceeding automatically secures the necessary action in another.

Second, representation requirements must be checked for each route. The revised article 27(IV) recognises foreign company powers granted under the applicable foreign law or treaties and presumes their validity unless disproved. Oppositions continue to permit the simpler power under article 27(II). The Regulations also address cure requirements and reliance on the General Register of Powers in administrative declaration proceedings.

These provisions must be applied under the relevant transitional regime. They also do not replace the separate representation requirements governing judicial proceedings. Preparing the appropriate authority to act at the outset helps prevent a procedural defect from undermining an otherwise sound defence.

CONCLUSIONS

The 2026 amendments and new Regulations largely preserve the existing relationship between trademark opposition, administrative invalidity and judicial review. The most significant developments for litigation strategy during the past year arise from judicial decisions addressing access to review and the scope of relief against registrations granted following unsuccessful oppositions.

In the cases reviewed, SEPI consistently rejected IMPI's procedural objections and examined the merits. These decisions reinforce the availability of judicial review without necessarily requiring the opponent to initiate a separate administrative invalidity action – a route that article 259 may restrict where the same arguments and evidence have already been decided in opposition.

Obtaining a favourable judgment, however, does not necessarily secure complete relief. SEPI has continued to favour remand to IMPI rather than directly declare the registration invalid. In some matters litigated by the authors, successful ***amparo*** challenges have required SEPI to issue that declaration itself. The scope of relief must therefore receive as much attention as the merits.

Where remand occurs, counsel must scrutinise IMPI's compliance. Merely leaving a registration without effect should not be assumed to provide the same result as a declaration of invalidity, which destroys the registration's effects retroactively from its grant under article 263. The judgment and implementing decision must be examined to determine whether that result has been achieved.

The choice between opposition, administrative invalidity and judicial review remains case-specific. Article 259, reflected res judicata, notification dates and challenge periods must be considered together from the outset. Effective trademark defence requires planning not only how to obtain a favourable decision, but also how to secure the legal consequences necessary to protect the client's rights.

Endnotes

1 TFJA September 2022 journal, printed page 137, IX-P-SS-85: https://www.tfja.gob.mx/media/media/biblioteca/revistas/2022/Rev_TFJA_Sep_2022.pdf. ^ Back to section

2 Amparo 232/2024 and SEPI 1627/2023-EPI-01-10. ^ Back to section

3 Matter handled by another firm: author-reported example of IMPI compliance using ***dejar insubsistente*** rather than an express declaration of invalidity. See the SEPI judgment and implementing decision; the case identifier and precise effects have not been independently verified. ^ Back to section

4 Isolated thesis 2032297: https://sjf2.scjn.gob.mx/detalle/tesis/2032297. ^ Back to section

5 Jurisprudence 2032240: https://sjfsemanal.scjn.gob.mx/detalle/tesis/2032240. ^ Back to section

6 Jurisprudence 2032298: https://sjf2.scjn.gob.mx/detalle/tesis/2032298. ^ Back to section

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Abraham Diaz abraham.diaz@olivares.mx
Jaime Rodriguez jaime.rodriguez@olivares.mx

http://www.olivares.com.mx

Read more from this firm on WTR