

**Question Q277-SGL-TM-2021**  
**Registrability of trade marks against public order or morality**  
**Mexico National Group**

**Questions**

**I. Current law and practice**

1)

a) Are trade marks contrary to public order refused or invalidated under your law? Please answer YES or NO.

Yes.

b) Are trade marks contrary to morality refused or invalidated under your law? Please answer YES or NO.

Yes.

c) Please state any applicable legal provisions.

The Federal Law for the Protection of Industrial Property provides that the trademarks contrary to public order are prohibited of being granted.

**“Article 12.- No patent, registration or authorization will be granted, nor it will be publicized in the Gazette to any of the legal concepts or institutions ruled by this Law when its contents or form are contrary to the public order or contravene any legal provision.”**

Furthermore, even though this prohibition does not include “morality” -as previously contemplated in our Laws, such as the Industrial Property Law<sup>1</sup>- it could be construed from the Paris Convention for the Protection of Industrial Property that the registration of trademarks contrary to morality is still forbidden.

**“Article 6quinquies**

**[Marks: Protection of Marks Registered in One Country of the Union in the Other Countries of the Union]**

**[...]**

**B.- Trademarks covered by this Article may be neither denied registration nor invalidated except in the following cases:**

**[...]**

**3. when they are contrary to morality** or public order and, in particular, of such a nature as to deceive the public. It is understood that a mark may not be considered contrary to public order for the sole

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<sup>1</sup> “Article 4o.- No patent, registration or authorization will be granted, nor it will be publicized in the Gazette to any of the legal concepts or institutions ruled by this Law when its contents or form are contrary to the public order, morality and good manners or contravene any legal provision.”

*reason that it does not conform to a provision of the legislation on marks, except if such provision itself relates to public order. [...].”*

2)

**a) Is there an explicit definition of public order and/or morality under your law? Please answer YES or NO.**

No.

**b) If your answer is YES, please state the definition. If your answer is NO, please still indicate what you believe to be the definition.**

While there is no definition of these concepts in our Federal Law for the Protection of Industrial Property, the criteria and precedents from the Mexican Courts offer some guidance.

The first chamber of the Mexican Supreme Court has found that in cases where “morality” would justify a restriction to freedom of expression, the Government should consider that “morality” does not refer to the personal or private morality of the government officer in charge, nor it refers to the morality of the majority of the population *-which could be discriminatory-*; instead, the Government is supposed to consider “public morality” understood as the core of convictions about right and wrong in society. The Court’s rationale is that if restrictions based on morality were to be based on the morality of the officer in charge or the majorities, then such restrictions could be potentially discriminatory and incompatible with a democratic society. Therefore, we consider that morality in our legal system for the purposed of trademark registrations could be defined as *“public morality, namely the core of convictions about right and wrong in society”*.

The concept of “public order” is similar but not necessarily identical to “morality”. Courts have signalized that “public order”: **(a)** is an indeterminate concept that must be viewed in the light of the essential conditions for the harmonious development of a community, the minimal rules of social interaction; and **(b)** that this concept is to be narrowly construed and applied and that refusing trademark registrations on account of “public order” should be done based on the specific circumstances of the case and not just on hypothetical effects.

Hence, we consider that “public order” could be defined as *“indeterminate concept protecting the minimal rules of social interaction and which may be invoked in exceptional cases to refuse registration to trademarks in specific circumstances”*.

It shall be mentioned that another statute that can offer guidance in elucidating these concepts is the Law for Press Crimes which contains a catalogue of publications that are deemed contrary to morality or public order:

**A. Contrary to morality:**

- Publications that defend or propagate vices, faults or crimes or defend those who commit them.

- Publications that offend modesty, decency, good customs, promote prostitution.
- Publications that are obscene or pornographic.

**B. Contrary to public order:**

- Publications that injure the nation, its essential institutions or its political entities.
- Publications promoting mutiny, anarchy, rebellion or disobedience of the laws.
- Publications promoting fake news which may alter peace, prices or credit.

While this statute does not apply to the registration of trademarks, applicant's facing objections based on morality or public order can try to use this list to argue that their trademark should not be refused on account of being immoral or contrary to public order.

**c) What is the difference between morality and public order?**

"Morality" refers to the core of convictions about right and wrong in society whereas "public order" refers to the minimal rules of social interaction. Thus, the concepts are very similar but not necessarily equal.

3)

**a) Is this ground applied to the trade mark per se, i.e. to the intrinsic qualities of the trade mark in question? Please answer YES or NO.**

Yes.

**b) Please explain.**

The exam carried out by the Mexican Institute of Industrial Property *-and the Courts-* to determine whether a trademark is contrary to public order and morality or not, is conducted by appreciating the trademark itself. That is, the examination will be carried out analyzing its meaning and elements to decide if the components of the prohibitions are applicable.

4)

**a) What is the relevant date for applying the ground of public order or morality?**

**(i) date of application of the trade mark**

(ii) date of the examination/assessment by the office or the court

(iii) date of filing of the proceedings (e.g. when the invalidation request is filed)

(iv) other, namely \_\_\_\_\_

**b) Bearing in mind that views regarding morality and public order can be dynamic and change over time, which of the following is possible?**

**(i) refile a trade mark that has been refused or declared invalid for being contrary to public order or morality**

**(ii) file a new action against a trade mark that previously survived a challenge on this ground**

**(iii) other, namely the argument part of the appeal -when challenging the denial of registration of a trademark by the Mexican Institute of Industrial Property- before the Courts.**

**c) Must this ground apply in the entire territory covered by the trade mark?  
Please answer YES or NO.**

Yes.

**5) From whose perspective is it judged whether or not a trade mark is contrary to public order or morality?**

**(i) the relevant consumer**

**(ii) the general public**

**(iii) a reasonable person with average thresholds of sensitivity and tolerance, taking into account the context in which the mark may be encountered**

**(iv) other, namely \_\_\_\_\_**

**6) What factor or factors are taken into account when assessing whether a trade mark is contrary to public order or morality?**

**(i) the meaning of the words or other elements contained in the mark**

**(ii) the background or origin of the words or other elements contained in the mark**

**(iii) the identity or origin of the applicant/registrant**

**(iv) the designated goods and/or services**

**(v) the goods and/or services for which the mark is used in practice by the applicant/registrant**

**(vi) fundamental rights (e.g. freedom of speech/expression)**

**(vii) other, namely \_\_\_\_\_**

**7) In what types of proceedings can the morality and/or public order ground be invoked?**

**(i) examination (i.e. ex parte examination by the trade mark office)**

**(ii) opposition proceedings (i.e. inter partes proceedings before the trade mark is approved for registration, or after registration in jurisdictions with post-registration oppositions)**

**(iii) invalidation/cancellation proceedings before the trademark office (i.e. inter partes proceedings after the trade mark is approved for registration)**

**(iv) invalidation/cancellation proceedings before a court (i.e. inter partes proceedings after the trade mark is approved for registration)**

**(v) other, namely \_\_\_\_\_**

**II. Policy considerations and proposals for improvements of your Group's current law**

**8) Can your Group's current laws or practice relating to the registrability of trade marks contrary to public order or morality be improved? Please explain.**

Yes, as no definition nor scope of "morality" and "public order" in respect to the registration of trademarks was established in our Industrial Property Law it was expected that said definitions were to be included in the Federal Law for the Protection of Industrial Property, but our new Law failed to include them, and we only have what has been set by Court precedents.

However, considering that the Federal Law for the Protection of Industrial Property is very new *-it came in effect on November 5, 2020-* there is still some uncertainty as to how the Mexican Institute of Industrial Property will apply this prohibition established for trademarks contrary to public order. Nevertheless, the Regulations for the Federal Law for the Protection of Industrial Property are pending of being published *-and still being drafted-*, therefore we expect that the new Regulations will clarify this concept and allow for more certainty and uniformity in the application of this kind of prohibition.

**9) Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?**

No.

**III. Proposals for harmonisation**

**10) Do you believe that there should be harmonisation in relation to the registrability of trade marks contrary to public order or morality?**

Yes, harmonisation is desirable at a general level.

11)

**a) Should trade marks contrary to public order be refused or invalidated? Please answer YES or NO.**

Yes.

**b) Should trade marks contrary to morality be refused or invalidated? Please answer YES or NO.**

No.

12)

**a) Should there be an explicit definition of public order or morality? Please answer YES or NO.**

No.

**b) If your answer is YES, please state the definition.**

**c) What should be the difference between morality and public order?**

Morality should not be a legal concept. Public order should refer to the general legal framework and conditions that must exist so that individuals can exercise their rights and freedoms.

13)

**a) Should this ground be applied to the trade mark per se, i.e. to the intrinsic qualities of the trade mark in question? Please answer YES or NO.**

Yes.

**b) Please explain.**

This ground should be applied to the trade mark per se but other factors should be taken into account too, such as the use of the mark in practice or if the goods or services for which the trade mark is applied for or registered are considered illegal.

14)

**a) What should be the relevant date for applying the ground of public order or morality?**

**(i) date of application of the trade mark**

(ii) date of the examination/assessment by the office or the court

(iii) date of filing of the proceedings (e.g. when the invalidation request is filed)

**(iv) other, namely date of first use**

**b) Bearing in mind that views regarding morality and public order can be dynamic and change over time, which of the following should be possible?**

**(i) refile a trade mark that has been refused or declared invalid for being contrary to public order or morality**

**(ii) file a new action against a trade mark that previously survived a challenge on this ground**

(iii) other, namely \_\_\_\_\_

**c) Should this ground apply in the entire territory covered by the trade mark? Please answer YES or NO.**

Yes.

**15) From whose perspective should it be judged whether or not a trade mark is contrary to public order or morality?**

(i) the relevant consumer

(ii) the general public

**(iii) a reasonable person with average thresholds of sensitivity and tolerance, taking into account the context in which the mark may be encountered**

**(iv) other, namely different factors could also be analyzed on a case by case basis.**

**16) What factor or factors should be taken into account when assessing whether a trade mark is contrary to public order or morality?**

**(i) the meaning of words or other elements contained in the mark**

**(ii) the background or origin of the words or other elements contained in the mark**

(iii) the identity or origin of the applicant/registrant

- (iv) the designated good and/or services
- (v) the goods and/or services for which the mark is used in practice by the applicant/registrant
- (vi) fundamental rights (e.g. freedom of speech/expression)
- (vii) other, namely \_\_\_\_\_

**17) In what types of proceedings should it be possible to invoke the morality and/or public order ground?**

- (i) examination (i.e. ex parte examination by the trade mark office)
- (ii) opposition proceedings (i.e. inter partes proceedings before the trade mark is approved for registration, or after registration in jurisdictions with post-registration oppositions)
- (iii) invalidation/cancellation proceedings before the trade mark office (i.e. inter partes proceedings after the trade mark is approved for registration)
- (iv) invalidation/cancellation proceedings before a court (i.e. inter partes proceedings after the trade mark is approved for registration)
- (v) other, namely \_\_\_\_\_

**18) Please comment on any additional issues concerning any aspect of the registrability of trade marks contrary to public order or morality you consider relevant to this Study Question.**

Globalization in trade today makes it almost impossible for trademarks (registered or not) to be strictly territorial.

**19) Please indicate which industry sector views provided by in-house counsel are included in your Group's answers to Part III.**

No.