

Patents, trade marks, copyright and designs in Mexico: overview

Begoña Cancino
Creel, García-Cuellar, Aiza y Enriquez, SC

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PATENTS

1. What are the legal requirements to obtain a patent?

Under Article 16 of the Industrial Property Law, to be patentable an invention must:

- Be novel.
- Result from an inventive step (non obvious).
- Be capable of an industrial application (possessing utility).

2. What categories are excluded from patent protection?

The following are excluded from patent protection (*Articles 16 and 19, Industrial Property Law*):

- Essentially biological processes for obtaining, reproducing and propagating plants and animals.
- Biological and genetic material as found in nature.
- Animal breeds.
- The human body and the living parts constituting the same.
- Plant varieties.
- Theoretical or scientific principles.
- Findings that consist in making public or disclosing something that already existed in nature, even though it was previously unknown to man.
- Diagrams, plans, rules and methods for carrying out mental processes, playing games or doing business, and mathematical methods.
- Computer programs.
- Methods to present information.
- Aesthetic creations and artistic or literary works.
- Surgical and therapeutic treatment or diagnostic methods applicable to the human body and/or relative to animals.
- Juxtaposition of known inventions or mixtures of known products, or alteration of the use, form, dimensions or materials of them, except where in reality they are so combined or merged so that they cannot function separately or where their particular features or functions have been so modified they produce an industrial result or their use is not obvious to a person skilled in the art.

3. Which authority registers patents? Does its website provide guidance on the application procedure?

The Patent and Trademark Office provides guidance on the application procedure through its website (*see box, The regulatory authority*).

4. On what grounds and when can third parties oppose a patent application or challenge an issued patent?

A third party can oppose a patent application by submitting to the Patent and Trademark Office (MPTO) information that is relevant to show the lack of any of the substantive requirements of patentability of the claims in the patent application. The requirements of patentability are set out in Articles 16 and 19 of the Intellectual Property Law. Oppositions must be sent to MPTO within six months of the publication date of the application in the Industrial Property Official Gazette (Official Gazette) for patent applications.

The validity of a patent can be challenged through a nullity action before the MPTO if:

- The patent was granted in violation of the provisions on the requirements and conditions for the grant of patents or the registration of utility models and industrial designs.
- The granting of a patent/utility model took place in violation of the provisions of the law in force at the time of the patent was granted or registered.
- The application was abandoned during the course of processing.
- The patent was granted due to an error or serious oversight, or was granted to someone not entitled to obtain it.

An action seeking invalidation under the first two circumstances can be exercised at any time. An action deriving from the third and fourth circumstances above may be exercised within five years of the date on which the publication of the patent or registration in the IP Gazette becomes effective.

5. When does patent protection start and how long does it last?

The patent is granted for a period of 20 years from the filing date of the patent application in Mexico or from the international filing date in the case of a Patent Cooperation Treaty application.

6. On what grounds can a patent infringement action be brought?

Patent infringement actions can be brought against parties that are:

- Engaging in acts contrary to proper practice and custom in industry, commerce and services that amount to unfair competition and that relate to the subject matter regulated by the Intellectual Property Law.
- Causing to appear as patented products goods that are not.
- Performing, in the course of industrial activities or trade, acts that confuse, mislead or deceive the public.
- Manufacturing or developing goods covered by a patent without the consent of the owner or without the appropriate licence.
- Offering for sale or bringing into circulation goods covered by a patent in the knowledge that they have been manufactured or developed without the consent of the owner of the patent or registration or without the appropriate licence.

7. Which courts deal with patent infringement actions?

The following courts deal with patent infringement actions:

- Federal Court for Tax and Administrative Affairs.
- Federal Circuit Court.

The Patent and Trade Mark Office deals with patent infringement complaints.

8. What are the defences to patent infringement actions?

The most common defence is that the patent is invalid.

9. What are the remedies in patent infringement actions?

The patent holder can request preliminary measures in patent infringement actions. If the requirements under the Intellectual Property Law are fulfilled:

- The patent holder must demonstrate the ownership of the patent, as well as the imminent violation to its rights and the possibility of suffering irreparable damage.
- A security or economic guarantee must be presented by the patent holder in order to assure the goods at matter.
- The patent holder must provide the necessary information in order to determine the specific goods that are the object of the intellectual property infringement.

The Institute of Industrial Property may:

- Order the infringing merchandise to be removed from circulation.
- Immediately forbid its distribution or use.
- Order the seizure of the goods, where the products or items are seized by the authorities and removed from merchandising.
- Order the infringer to cease and desist on the acts that constitute a violation to the IP provisions.

- Order the infringer to suspend provision of services or order the closure of the commercial establishment if needed.

Administrative infringements are punishable with:

- A fine of up to 20,000 times the minimum daily wage in Mexico City (about US\$98,500).
- An additional fine of up to 500 days of the general minimum daily wage in Mexico City for each day that the infringement persists.
- Temporary closure of the business for up to 90 days.
- Permanent closure of the business.
- Administrative detention for up to 36 hours (that is detained by the state without trial).

Once the decision declaring the infringement has become final it is possible to claim damages before a Civil Court.

10. Is there a fast-track and/or a small-claims procedure for patent infringement actions?

There is no fast-track or small-claims procedure.

TRADE MARKS

11. What are the legal requirements to obtain a trade mark?

Under Article 89 of the Intellectual Property Law the visible signs that can constitute a trade mark are:

- Denominations or visible signs that are sufficiently distinctive and capable of identifying goods or services from others of the same class or kind.
- Three-dimensional forms.
- Trade names and denominations or corporate names.
- The name of a natural person, as long as same is not confusingly similar to a registered trade mark or a published trade name.

12. Is it necessary or advisable to register trade marks?

Whether a mark is registered or not, it is considered to exist from the moment a product or service is distinguished with a visible sign. However, registration is necessary as it confers the exclusive right to use a trade mark and to oppose third parties use of that mark.

13. Which authority registers trade marks? Does its website provide guidance on the application procedure?

The Patent and Trade Mark Office provides guidance on the application procedure through its website (*see box, The regulatory authority*).

14. On what grounds can the regulatory authority refuse to register a trade mark?

Under Article 90 of the Intellectual Property Law, the grounds for refusal are:

- Animated or changing denominations, figures or three-dimensional signs.

- Generic terms.
- Descriptive marks or indicative words.
- Isolated letters, digits or colours.
- The translation into other languages, the spelling variation or the artificial construction of unregistrable words.
- Signs that include the coats of arms or emblems of any country, state, municipality or other political division.
- Geographically descriptive or misdescriptive marks.
- Names of towns or places that are characterised by the manufacture of certain products.
- Names, pseudonyms, signatures and portraits of persons without the consent of the interested parties.
- Titles of intellectual or artistic works, titles of periodical publications, advertising promotions and fictitious characters.
- Trade marks that constitute false indications as to the nature, components or qualities of the goods or services.
- Denominations, figures or three-dimensional forms identical or similar to a trademark that the Patent and Trade Mark Office considers to be well-known or famous in Mexico.
- A trade mark that is identical or confusingly similar to previously registered trade marks or trade names that have been previously filed or published.

15. On what grounds and when can third parties oppose a trade mark application or cancel a registration?

The Intellectual Property Law (MIPL) does not foresee an opposition proceeding against a trade mark application. However, it is possible to challenge the validity of a trade mark registration through a cancellation action before the Patent and Trade Mark Office under any of the following:

- Non-use: the trade mark registration has not been used within the three consecutive years before the cancellation action filing date. This cancellation action may be exercised after three years as from the granting date of the challenged trade mark.
- The trade mark registration was granted in violation of the provisions of the MIPL. This action may be exercised at any time.
- Prior use: the trade mark registration is identical/confusingly similar to another that has been used in Mexico or abroad before the application for registration and is applied to the same or similar products or services. This action may be exercised within three years of the publication date of the registration in the Official Gazette.
- False data: the trade mark registration was granted on the basis of false information in the application. This action may be exercised within five years of the publication date of the registration in the Official Gazette.
- The trade mark registration was granted in error, by mistake, or owing to a difference of judgement due to the prior existence of an identical or confusingly similar mark applied to identical or similar services or products. This action may be exercised within five years of the publication date of the registration in the Official Gazette.
- Bad faith: the trade mark registration will be cancelled when the agent, representative, user or distributor of the owner of a trade mark registered abroad applies for and obtains the registration of the mark or of a confusingly similar one, without the express consent of the owner of the foreign trade mark. This action may be exercised at any time.

16. When does trade mark protection start and how long does it last?

The exclusive trade mark rights start from registration. The registration is valid for ten years of the filing date and can be renewed indefinitely for further ten-year periods.

17. On what grounds can a trade mark infringement action be brought?

A trade mark infringement action can be brought where:

- A trade mark used is confusingly similar to another registered trade mark.
- Without the owner's consent, a registered trade mark is used, or a trade mark confusingly similar is used, as an element of a trade name or of a firm or corporate name, or vice versa, provided that the names, firm or corporate names relate to establishments that operate with the products or services protected by the trade mark.
- A trade mark is used as a name, sign, symbol, initial or emblem.
- Without the trade mark holder's written consent, a previously registered trade mark is used, or a confusingly similar one is used, as a trade name, firm or corporate name or as part of it, of a natural or corporate person whose activity is the production, import or marketing of commodities or services equal or similar to those applied to the registered trade mark.
- A registered trade mark is used without the consent of the holder or without the respective licence, on products or services equal or similar to those to which the trade mark is applied.

18. Which courts deal with trade mark infringement actions?

The following courts that deal with trade mark infringement actions:

- Federal Court for Tax and Administrative Affairs.
- Federal Circuit Court.

The Patent and Trade Mark Office deals with trade mark infringement complaints.

19. What are the defences to trade mark infringement actions?

The most common defence is to challenge the validity of the trade mark's registration.

20. What are the remedies in trade mark infringement actions?

The remedies are similar to those in patent infringement actions. See *Question 9*.

21. Is there a fast-track and/or a small-claims procedure for trade mark infringement actions?

There is no fast-track or small-claims procedure.

COPYRIGHT

22. What are the legal requirements to obtain copyright protection?

Under the Federal Law on Copyright, the basic requirements for obtaining copyright protection are:

- Fixation (the incorporation of the work in any form or material).
- Authorship (only individuals are susceptible of being granted an author's right).
- Originality (original creations).

23. Can copyright be registered? If so, is registration required?

Copyrights can be registered and the authority in charge of registration is the Copyright Office. Registration is not compulsory and copyright protection does not depend on registration. However, registration is necessary in order to enforce copyrights as it is evidence of copyright ownership.

24. When does copyright protection start and how long does it last?

Protection starts from the moment the work is created. An author's rights are protected for a term consisting of the life of the author plus 100 years after his death. For joint works, the protection is extended for the same period of time, after the death of the last surviving author. Reserved rights will be granted for five years from the date the certificate is issued. Neighbouring rights are protected for a term of 50 years from the date of first publication or fixation.

25. On what grounds can a copyright infringement action be brought?

Under the Federal Law on Copyright (FLRC), copyright infringement actions can be brought where, among others (*Article 229, FLRC*):

- The licensee violates the terms of the compulsory licence.
- A publisher, impresario, producer, employer, broadcasting organisation or licensee of a contract concludes a contract for the purpose of transferring copyright in a manner contrary to law.
- The requirements as set out in the FLRC to not insert in a published work.
- A work is published without mentioning in it the name of the author, translator, compiler, adapter or arranger.
- A work is published in a manner that damages the reputation of the author, translator, compiler, arranger or adapter.
- A title of a work is used fraudulently, which causes confusion with a work published previously.

Additionally, the FLRC establishes as a trade-related infringement, certain behaviours with commercial purposes such as (*Article 231, FLRC*):

- Using a protected work without the prior authorisation of the author.
- Using the image of a person without his permission.

- Producing, manufacturing, stocking, distributing, transporting or marketing of unlawful copies of protected works.
- Commercialising a protected work without authorisation.
- Using, reproducing or exploiting a computer program without the consent of the owner.

26. Which courts deal with copyright infringement actions?

The following courts deal with copyright infringement actions:

- Federal Court for Tax and Administrative Affairs.
- Federal Circuit Court.

The Copyright Office and the Patent and Trade Mark Office deal with copyright infringement complaints.

27. What are the defences to copyright infringement actions?

The most common defence is to challenge the validity of the copyright.

28. What are the remedies in copyright infringement actions?

Preliminary injunctions are the most common remedy.

Administrative infringements are punished with fines ranging from 500 to 15,000 days of minimum salary effective in Mexico City, depending on the nature and severity of the offence and an additional fine of 500 times the minimum salary effective in Mexico City for each day the violation persists.

Once the decision declaring the infringement is final it is possible to claim damages before a Civil Court.

29. Is there a fast-track and/or a small-claims procedure for copyright infringement actions?

There is no fast-track or small-claims procedure.

REGISTERED DESIGNS

30. What are the legal conditions to obtain a registered design right?

Industrial designs that are new and susceptible of industrial application are registrable.

Designs that are independently created and differ in significant degrees from known designs or combinations of known design features are deemed novel. Industrial designs and industrial models are included in this category.

31. Which authority registers designs?

The Patent and Trade Mark Office provides guidance on the application procedure through its website (*see box, The regulatory authority*).

32. On what grounds and when can third parties oppose a registered design application?

The Intellectual Property Law does not foresee an opposition proceeding against a design application.

33. When does registered design protection start and how long does it last?

Designs can be registered for a non-renewable term of 15 years from the filing date of the design application.

34. On what grounds can a registered design infringement action be brought?

A design infringement action can be brought where:

- Goods are manufactured or goods covered by an industrial design registration are developed without the consent of its owner or without the appropriate licence.
- Goods protected by an industrial design registration are offered for sale or brought into circulation in the knowledge that they have been manufactured or developed without the consent of the owner of the patent or registration or without the appropriate licence.
- Industrial designs protected by registration are reproduced or imitated without the consent of its owner or without the appropriate licence.

35. Which courts deal with registered design infringement actions?

The following courts deal with registered design infringement actions:

- Federal Court for Tax and Administrative Affairs.
- Federal Circuit Court.

The Patent and Trade Mark Office deals with registered design infringement complaints.

36. What are the defences to registered design infringement actions?

The most common defence is the challenge the validity of the design.

37. What are the remedies in registered design infringement actions?

See *Question 9*.

38. Is there a fast-track and/or a small-claims procedure for registered design infringement actions?

There is no fast-track or small-claims procedure.

UNREGISTERED DESIGNS

39. What are the legal conditions for unregistered design rights to arise?

There is no protection for designs that have not been registered.

40. When does unregistered design protection start and how long does it last?

There is no protection for unregistered designs in Mexico (see *Question 39*).

41. On what grounds can an unregistered design infringement action be brought?

See *Question 39*.

42. What are the defences to unregistered design infringement actions?

See *Question 39*.

43. What are the remedies in unregistered design infringement actions?

See *Question 39*.

TRADE SECRETS AND CONFIDENTIAL INFORMATION

44. What are the legal conditions for rights in confidential information to arise?

To be considered a trade secret information must have an industrial, commercial, professional or technical nature. It must relate to the nature, characteristics or purposes of products, to production methods or processes, or to ways or means of distributing or marketing products or rendering services. The information must also represent an economic or competitive advantage for the owner.

The proprietor must apply sufficient means, measures and safeguards to preserve this confidentiality.

45. On what grounds can an action for unauthorised use of confidential information be brought?

The disclosure of a trade secret implies the payment of damages under Article 86 of the Intellectual Property Law (MIPL). An individual or company that hires a worker who is working or has worked, or a professional, advisor or consultant who provides or has provided his services, for another person in order to obtain industrial secrets will be responsible for payment of damages caused to that person.

Specific cases considered as criminal offences include (*Article 223, MIPL*):

- Revealing to a third party a trade secret that was known by virtue of employment or as a result of the granting of a licence.

- Appropriating a trade secret without the right to do so.
- Using information constituting a trade secret that is known by virtue of employment without the consent of the person keeping it or its authorised user.

46. Which courts deal with actions for unauthorised use of confidential information?

The following courts deal with actions for unauthorised use of confidential information:

- Federal Criminal Courts.
- Federal Circuit Court.
- Civil courts.

47. What are the defences to actions for unauthorised use of confidential information?

The following will not be considered to be a trade secret:

- Information that is considered to be in the public domain.

- Information that is evident to a person skilled in the art on the basis of previously available information.
- Information that must be disclosed by virtue of a legal provision or court order.

48. What are the remedies in actions for unauthorised use of confidential information?

The most common remedy is an injunction (preliminary and final)

The penalties if found guilty of unauthorised use of confidential information are:

- Imprisonment for between two and six years.
- A fine between 100 and 10,000 days of the general minimum salary effective in Mexico City.

49. Is there a fast-track and/or a small-claims procedure for actions for unauthorised use of confidential information?

There is no fast-track or small-claims procedure available.

THE REGULATORY AUTHORITY

Patent and Trade Mark Office

W www.impi.gob.mx

Main areas of responsibility. Trade marks, patents, design registration, enforcement of IPRs.

Guidance on application procedure. This authority does not provide English guidance on the application procedure.

Copyright Office

W www.indautor.gob.mx

Main areas of responsibility. Copyrights.

Guidance on application procedure. This authority does not provide English guidance on the application procedure.

Practical Law Contributor profile



Begoña Cancino, Partner

Creel, García-Cuellar, Aiza y Enriquez, SC

T +52 55 4748 0679

F +52 55 4748 0690

E begona.cancino@creel.mx

W www.creel.mx

Professional qualifications. Mexico, Lawyer, 2001

Areas of practice. Intellectual property; entertainment.

Non-professional qualifications. JD, Universidad La Salle, Mexico, 2001; post-graduate diplomas in intellectual property, Universidad de Buenos Aires (UBA), Universidad Nacional Autónoma de México (UNAM) and the Ilustre Nacional Colegio de Abogados.

Recent transactions

- Advising a multinational alcoholic beverages company in several transactions intended to grow its tequila segment including the acquisition of two premium brands in Mexico.
- Advising a multinational dairy and food corporation in the acquisition of a brand of dairy products in Mexico.
- Advising several clients in litigious actions with the Administrative Authorities and Federal Courts.
- Advising several clients on data privacy matters in order to align their legal structure to the specific provisions of the recently enacted Data Privacy Law.

Languages. Spanish, English

Professional associations/memberships. International Trademark Association (INTA); Mexican Association for the Protection of Intellectual Property (AMPPI).

Publications. *MCI can look but not touch, (regarding amendments to the Mexican Copyright Law), World Intellectual Property Review, July/August 2013.*