

# CURRENT ISSUES OF THE MEXICAN INTELLECTUAL PROPERTY

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# INTRODUCTION

- The main objective of this presentation is to provide the assistants with information in the latest topics in Mexico regarding IP issues as well as information on how our IPR system works.
- I have worked at the Mexican PTO as Raid Coordinator for the Copyright Division and at the Arochi firm as Senior Associate of Enforcement for over 7 years.
- I am currently opening my own law firm and continuing with my practice under my own name.

# Topics of discussion

1. Basic information on the Mexican IPR system
2. Notorious and Famous Marks
3. Sound Marks
4. Punishment for buyers
5. Fighting counterfeiters *ex-officio*

# 1. BASICS FOR MEXICAN IPR

- The authority in charge of registering trademarks in Mexico is the Mexican Institute of Industrial Property (IMPI)
- The registration has to be made in Mexico since the Congress has not ratified the Madrid Protocol (multi-country filing)

# BASICS FOR MEXICAN IPR

- There is no on-line filing.
- A trademark commonly takes from 8 to 14 months to be granted.
- There is no opposition system.
- Once granted trademarks are to be in full force for renewable terms of 10 years from the date of *filing*.

# BASICS FOR MEXICAN IPR

- The estimate cost for government fees for filing a trademark application is around \$210.00 for study of an application (includes the official certificate of registration if granted) and \$250.00 for Renewal.
- The registered trademark is published in the Official Gazette printed by the IMPI.
- No mandatory filing of evidence of use.
- 3 years of no use = chance of cancellation for no use.

## BASICS FOR MEXICAN IPR

- Copyrights are to be granted by the National Institute for Copyrights (INDAUTOR)
- Copyright infringements are to substantiated before the IMPI
- Copyrights are obtained in 6 to 8 months approximately.

# BASICS FOR IPR IN MEXICO

- **Enforcement with IMPI**

- 1. Administrative measure.
- 2. Needs the posting of a bond to guarantee possible damages.
- 3. The final result is a fine.
- 4. No weaponry involved.
- 5. No need to involve expert witnesses.

- **Enforcement with PGR**

- 1. Criminal case (Federal Prosecutor).
- 2. No need to post a bond
- 3. Final result is jail.
- 4. Heavy weaponry and Police Forces involved.
- 5. Original product and expert opinion are mandatory.

# BASICS FOR IPR IN MEXICO

- **Enforcement with IMPI**
  - **6.** Takes a month or two to take action (normal course).
  - **7.** No lock breaking allowed.
  - **8.** You can settle the case.
  - **9.** Enforcement light.
- **Enforcement with PGR**
  - **6.** Takes a month or two to take action (needs a search warrant )
  - **7.** Authorized to break locks if needed
  - **8.** You legally can settle the case but should never do it.
  - **9.** High cholesterol enforcement.

## 2. NOTORIOUS AND FAMOUS MARKS

- Already considered as Law
- Two breeds of trademarks are brought into the legislation
  - a) *NOTORIOUS MARKS*
  - b) *FAMOUS MARKS*

# NOTORIOUS MARKS

- The notorious marks existed but only as a referral in the Industrial Property Law (LPI)
- They were mentioned as a cause for refusal of registration
- The Mexican Institute of Industrial Property (IMPI) had no guidelines on how to consider a trademark notorious.
- The only way for the IMPI to declare a trademark notorious was on an official action inside a resolution issued for a declaration of nullity, cancellation action for no use or for an administrative infringement.

# NOTORIOUS MARKS

- **DEFINITION:** Is the trademark that is well known by a specific section of the consumers or the industry due to the commercial activities and advertisement done by the owner.
- All type of evidence can be submitted to the IMPI to demonstrate notoriousness of a trademark.
- An specific application should be filed before the IMPI for analysis (as in a trademark registration)

# NOTORIOUS TRADEMARKS

- The IMPI may refuse granting the recognition of notoriety.
- The effects of this recognition are not creating specific rights but making applicable certain preference for opposition to third parties and saving money in filing evidence of Notoriety every time needed by issuing an official action of declaration of Notoriety.

# FAMOUS MARKS

- **DEFINITION:** Trademarks known by the majority of the consumers.
- Deserve broader protection.
- Also need a declaration from IMPI
- Follow the same procedure as the Notorious marks for obtainment of declaration.

# NOTORIOUS AND FAMOUS MARKS

- Regardless of the fact that this dispositions have become Law, we still need the particulars for the filing (official Formats and Costs).
- The IMPI is still discussing the amount to be charged for government fees for the application for declaration of Notoriousness and Famous Marks
- It can not be requested to the IMPI until the above is settled.

## 3. SOUND MARKS

- Still in Congress
- Proposed amendment to the LPI
- Not an specific date to be passed by the Congress and sent to the President for Publication.

# SOUND MARKS

- The current LPI does not include the possibility of registering a sound mark.
- The current definition of a trademark in the LPI states the a mark is:  
“all *visible* signs that distinguish products or services from others of the same class in the market”

## 4. PUNISHMENT FOR BUYERS

- The counterfeiting business causes millions of dollars in losses for companies.
- This cancer is spreading fast and new approaches to the problem are needed.
- Strong links between drugs and terrorism with counterfeiting are documented.

# PUNISHMENT FOR BUYERS



- The Interpol mentions:  
“Law enforcement agencies have to recognize that Intellectual Property Crime is not a victimless crime. Because of the growing evidence that terrorist groups sometimes fund their activities using the proceeds, it must be seen as a very serious crime with important implications for public safety and security”

# PUNISHMENT FOR BUYERS

- In enforcing the IP rights there are several authorities involved.
- a) IMPI
- b) Attorney General's Office (PGR)
- c) Customs (not mandated by Law)
- d) Federal Preventive Police (not mandated by Law)

## PUNISHMENT FOR BUYERS

- In some circles of the IP community the idea of Punishing the buyers of counterfeit products is gaining strength.
- Several problems are faced when trying to take this into application.
- A) Evidence needed: should be applied only at the time of purchase?
- B) Administrative punishment (fine of \$250.00 USCy proposed)
- C) Using them as witnesses against sellers in criminal procedures.

## 5. FIGHTING COUNTERFEITERS *EX-OFFICIO*

- In order to initiate a criminal investigation or an administrative declaration of infringement the trademark owner must formally request the intervention of the Attorney General's Office (PGR) or the IMPI.
- The IMPI is the only authority authorized by Law to initiate an *ex-officio* administrative procedure of declaration of infringement but in the practice they limit the action to copyrights and never ends in imposing a fine.
- The PGR under no circumstances is able to initiate a criminal action if a prior criminal complaint has not been filed by the affected trademark owner.

# FIGHTING COUNTERFEITERS *EX-OFFICIO*

- Advantages:
- 1. Unlimited actions.
- 2. Actions would be taken nationwide.
- 3. No expenses for offended party.

# FIGHTING COUNTERFEITERS EX-OFICIO

- Disadvantages:
  1. Only for copyrights (amendment for criminal code)
  2. No control whatsoever over actions taken for each offended party.
  3. No clear lines of communication to provide original products for mandatory expert opinion.
  4. No control over criminal procedures indicted.
  5. No possibility for copyright owner to deny to appear before Judge any were in Mexico.

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