The Italian SME immediately contacted an IP lawyer seeking advice on how to handle this. The legal advisor explained that, according to the Mexican Industrial Property Law, using a registered trademark without the consent and authorization of the owner constitutes an administrative infringement. The same law also establishes that copying trademarks is a crime. Since the unauthorised use of the trademark in the company’s campaign could be deemed as fraudulent, but also as commercial speculation (and hence as a piracy crime) Septtris was suggested to:

- Immediately remove all videos and images of the campaign including the trademark “TeleHolly”.
- Send a letter notifying the withdrawal of the infringing materials, along with a commitment to stop using the mark of TeleHolly without previous authorization.
- Contact the other party immediately to solve the matter in an amicable way.

Online piracy and counterfeiting is not limited to the sale of physical products, such as Rolex’s watches or Nike’s trainers. Any trade or service mark may be illegally used and reproduced. Such use may constitute a criminal offence and not only an administrative infringement.

- Using logos or any IP protected material without obtaining the permission of its owner (e.g. written authorisation or license agreement) can have not only legal consequences but can also have an impact on the corporate image of the company.

Although owners cannot rely 100% on the enforcing authorities, trademark and copyright laws are well enforced in Mexico. Be prepared to face legal actions, when warned with a C&D letter.

The infringing videos were removed within the next 24 hours following the Mexican company’s warning, with a letter of apology from the Italian company and a commitment to avoid using the concerned trademark, without the compulsory authorization, in the future.

However, TeleHolly, imposed Septtris to make a declaration in all their social media accounts informing about the unauthorised use of the Mexican trademark, as a condition not to bring the case to Court. The Italian SME, although reluctant, agreed in order to avoid further disputes.

Lessons learned

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- Using logos or any IP protected material without obtaining the permission of its owner (e.g. written authorisation or license agreement) can have not only legal consequences but can also have an impact on the corporate image of the company.
- Although owners cannot rely 100% on the enforcing authorities, trademark and copyright laws are well enforced in Mexico. Be prepared to face legal actions, when warned with a C&D letter.