1. IPR in Mexico for EU SMEs: BACKGROUND
   A. Intellectual Property Rights for SMEs: Why is this relevant to you?
   B. How does the Mexican IP legal framework compare to INTERNATIONAL STANDARDS?

2. IP Rights in Mexico: THE BASICS
   A. Copyright and related rights
   B. Patents
   C. Industrial Designs
   D. Trademarks
   E. Appellations of Origin and Geographical indications
   F. Other IPs

3. ENFORCING Your IPRs
4. Using CUSTOMS To Block Counterfeits
5. RELATED LINKS and Additional Information
6. Glossary

1. IPR in Mexico for EU SMEs: BACKGROUND

   A. Intellectual Property Rights for SMEs: Why is this relevant to you?

   Intellectual Property (IP) refers to any creation, invention or sign, which can be used in commerce and is bound to its creator or inventor, capable of generating profits for its creator, inventor or right holder. Hence, it must be considered as part of the main assets in a company or industry. IP is usually divided into two branches, namely Industrial Property, which relates to inventions, designs or signs used in commerce; and Copyright (or ‘author’s rights’, according to non-English definitions), which relates to literary and artistic works.

   Intellectual Property Rights (IPRs) are exclusive rights granted by a National Authority that allows the rights holder to prohibit any unauthorised use or exploitation of their creations, inventions or signs by third parties. The referred exclusive right is temporary and will differ depending on the IPR.

   The importance of IPR, therefore, lies in the possibility of generating assets and profits for the company based on exploitation of the exclusive right granted and also protection against unfair competition practices.

   In other words, IPRs allow SMEs to turn their intangible rights into assets that can be exploited, transferred, licenced or used as collateral to obtain financing.

   The creation and protection of most IPRs, namely Copyrights, Trademarks or Industrial Designs, do not require significant capital investment in comparison to the potential advantages, whereas development and protection of inventions (Patents) tend to be more expensive. In both scenarios, SMEs are able to benefit from the right protection, management and exploitation of their IPRs by enabling them to:
• Prevent third parties from using their brands, inventions, creative works...
• Differentiate from competitors
• Constitute a strong basis to build a goodwill in the market
• Generate incomes through other business models such as licensing or franchising

Although a certain degree of international harmonization exists in the domain of intellectual property law, some relevant differences can still be found between Mexico and Europe IP legal frameworks. This Factsheet is aimed at explaining such differences concerning Copyright, Patents, Industrial Designs, Trademarks, Tradenames, Geographical Indications and Appellations of Origin.

TIPS and WATCH OUTS

It is useful to check the European Commission's TRADE website for information on trade barriers and market access:
http://madb.europa.eu/madb/indexPubli.htm
http://madb.europa.eu/madb/barriers_crossTables.htm?isSps=false

It is likewise desirable to check with your local Chamber of Commerce and/or other support services before making business decisions as regards exports or investments in Mexico.

B. How does the Mexican IP legal framework compare to INTERNATIONAL STANDARDS?

Mexico is one of the few Latin American countries party to the Patent Cooperation Treaty, the Global Patent Prosecution Highway and the Madrid System. Hence, EU SMEs can obtain an international patent/trademark registration that has effect in each of the designated Contracting Parties, including Mexico. In other words, a single patent/trademark registration serves as a basis for registration on each of the designated countries (see Glossary).

DEVELOPMENT AND ENFORCEMENT

Mexico is party to the Madrid Protocol (Madrid System), which offers a trademark owner the possibility of having the trademark protected in several countries by filing a single international application.

INTERNATIONAL TRADEMARK REGISTRATION

Mexico is also member of the following international conventions and agreements:
• Trademark Law Treaty (TLT) which has been signed but is not in force yet (more information here);
• Singapore Treaty on the Law of Trademarks, 2006, which has been signed but is not in force yet;
• Paris Convention for the Protection of Industrial Property (more information here);
• Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) (more information here);
• Lisbon Agreement for the Protection of Appellations of Origin and their International Registration
• Locamo Agreement Establishing an International Classification for Industrial Designs
• Strasbourg Agreement Concerning the International Patent Classification
• Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks
• Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks, 2001
• Convention on Biological Diversity (more information here)
• International Convention for the Protection of New Varieties of Plants (UPOV- 1978 act) (more information here)
• Berne Convention for the Protection of Literary and Artistic Works (Paris Act – 1971) (more information here)
• Rome Convention for the Protection of Performers, Producers of Phonograms, and Broadcasting Organizations (more information here)
• Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure (more information here)
• World Intellectual Property Organization (WIPO) Convention (more information here)
• WIPO Copyright Treaty (WCT) (more information here)
• WIPO Performances and Phonograms Treaty (WPPT) (more information here)

In addition, the EU-Mexico Free Trade Agreement, which is part of the EU-Mexico Global Agreement that entered into force in October 2000 has just been updated after two years of negotiation. The Agreement includes a comprehensive IP chapter with strong provisions on the protection and enforcement of IP, including border measures.

DESIGN REGISTRATION

Mexico is not a member of the Hague Agreement. Therefore, if your company is interested in applying for a Design, you will not be able to extend your international registration to Mexico. In these cases, a separate national IPR registration will be required.

Pending Issues

Regarding the pending issues for improvement, the European Commission has reported the following:
• Lack of ex-officio authority for customs to detain, seize and destroy counterfeit and pirated goods at borders, in free-trade zones, and in-transit.
• Large numbers of counterfeit and pirated products for sale in markets around the country and notably in Tepito (Mexico City) and San Juan de Dios (Guadalajara).
• Online and offline piracy is also very prevalent.
• IPR enforcement remains the main issue due to the length of its judicial proceedings, lack of deterrent sanctions, lack of coordination between federal, state, and municipal authorities; legislative loopholes; the large amount of resources needed to effectively combat this matter given the wide presence of counterfeited items in the Mexican market, and the somewhat permissive attitude that the general public has regarding piracy and counterfeiting.
• The process for applying for marketing authorizations regarding pharmaceutical and agrochemical products is complicated.

2. IP Rights in Mexico: THE BASICS

A. Copyright and related rights

WHAT do you need to know?

Copyright protects artistic, literary and scientific works such as books, lectures, musical compositions, sculptures, computer programs, etc., that may be reproduced or disclosed by any current or future means. Such protection covers both original and derivative works (e.g. adaptations, compilations, transformations, translations or arrangements).

As in Europe, Copyright in Mexico splits into two groups of rights:

• **Moral rights** are personal rights of the author which cannot be transferred to third parties. The main ones are the right to be recognised as author, the right to decide to publish the work and the right to the integrity of the work (i.e. the right of the author to impede any modification of his/her work without his/her consent).

• **Economic rights**, derived from the property of a work, granting the author (or owner) the right to prevent third parties from: communicating to the public (e.g. exhibition in a gallery), reproducing, distributing and transforming the work. Economic rights can be transferred or licensed in order to allow third parties to exploit the work.

Mexican legislation distinguishes between the author and the Copyright holder. The author is the person who creates and owns both moral and economic rights, whereas the Copyright holder is the natural or legal person that owns all or part of the economic rights over the work by virtue of law (e.g. a work developed by an employee) or contract (e.g. transfer of rights by the author to a publishing company).

Likewise, **neighbouring rights** are recognised for performers (actors, narrators, speakers, singers, musicians, dancers); book publishers, producers of phonograms; producers of video games; and broadcasting organisations.

HOW do I register?

You do not have to register your work in Mexico to protect it since it will be protected from its creation. However, registration may be used as proof of ownership that can be very useful in certain circumstances (e.g. the authorship is not specified in the work published). Registration in Mexico should be carried out before the National Copyright Institute (Instituto Nacional de Derechos de Autor or INDAUTOR).

It is possible to register your work in person at the INDAUTOR facilities, by courier or by mail (attaching a pre-paid air waybill). The following information must be submitted by the applicant:

1. Depending on the type of work, you may need to fulfill application form RPDA-01 and/or RPDA-01-A2;
2. Two copies of the work;
3. Proof of payment made through electronic payment at a local bank;
4. Power of Attorney (in case of legal person or representative);
5. If the owner of the work is a legal person, it is mandatory to prove its existence;
6. Simple translation to Spanish of the documents issued abroad;
7. In case the applicant is not the author, the corresponding certificate (transfer licence, collaboration letter, etc.)
8. In the case of pseudonym or anonymous work, sealed envelope with author’s personal information.

A physical copy of the registration of the work, contract, powers, duplicates or earlier registrations can be obtained 14 days after the application has been received by the INDAUTOR. If the author files the application in person at the office, he/she may use the “Expressautor” counter and obtain the certificate the same day.

TRANSFER OF ECONOMIC RIGHTS

Any transfer of economic rights in Mexico must fulfil two requirements:

• **Temporary**: transfers and licenses must be granted for a fixed term. Unless otherwise expressed, the general term is 5 years and it cannot exceed 15 years, except in certain cases (e.g. Computer programs and editorial works have no limitations)

• **At a cost**: free transfers or licenses are not accepted. In case of lack of agreement, the competent court is entitled to define its amount and the terms of payment.

In addition, any transfer or licence over economic rights, shall invariably be executed in writing and be registered before INDAUTOR in order to be enforceable against third parties.

RESERVATION OF RIGHTS

Mexico also grants an exclusive right called Reservation of Rights (Reserva de derechos al uso exclusivo) to use and exploit titles, names, designations, distinctive physical and psychological features or original operational characteristics, to any of the following:

1. periodical publications or broadcasts;
2. human characters, whether fictional or symbolic;
3. persons or groups devoted to artistic activities; and
4. promotional advertising.

To protect your exclusive right, you need to obtain a certificate of registration from the National Copyright Office (INDAUTOR).
WHO can register?

Authors, or their representatives, can register their work before INDAUTOR. Mexico’s law also allows foreign companies to register works as long as they have a local domicile in Mexico. Otherwise, a local representative must be appointed.

HOW MUCH does it cost?

Registration of a literary or musical work, a photograph or a computer program amounts to €12, while a registration of a reservation of rights for exclusive use costs between € 95 – 188, depending on the type of work.

Contract registration amounts to € 63 (approx. € 31 in case of INDAUTOR’s model contracts).

All fees and requirements can be found at the INDAUTOR website section (in Spanish only).

Moreover, our Helpline is always open and is available in 5 languages (Spanish, English, German, French and Portuguese).

HOW LONG does legal protection last?

Economic rights shall be protected for a period of 100 years from the 1st of January of the year after the author’s death, which is longer than the legal term of protection in Europe (70 years). The term of protection of economic rights for anonymous or pseudonymous works is 100 years from first publication.

Economic rights on audio-visual and photographic works are protected for a period of 50 and 75 years, respectively, from publication.

Performers’ rights are protected for 75 years from first disclosure (performance, recording or publication).

Book editors are provided with 50 years of protection over their Works, counted from the first publication.

Computer programs are protected for 100 years either from creation or publication. When the owner is a legal person (i.e. employer), the duration lasts 100 years counting from the disclosure or publication of the work.

Reservation of rights to exclusive use may be protected for 1 or 5 years; one year for names or titles of periodical publications or broadcasts; and five years for the other types. This special Mexican right can be indefinitely renewed for equal periods.

B. Patents

There are two kinds of protection for inventions: patents and utility models.

Patents in Mexico: What you need to know

- Patents, to protect products (including substances), processes or uses (e.g. a new type of glue or an automated syringe).
- Utility models to protect minor inventions, such as a new improvement of an already known invention that provides extra functionality. Processes are excluded from this protection mode.

Patents are available for any invention, whether a product or process, in all fields of technology, including chemistry, pharmacy, biotechnology, electronics, telecommunications, mechanics, etc.

In order to have access to patent protection, the new invention must fulfil the following requirements:

Novelty: An invention shall be considered new when it is not included in the state of the art. The state of the art comprises everything that has been made available to the public by written or oral description, by use or marketing or by any other mean prior to the filing date of the patent application or, where appropriate, the recognised priority date (see Glossary).

Inventive step: An invention shall be regarded as involving an inventive step if, for an expert with average skills in the technical field concerned, the said invention is neither obvious nor obviously derived from the state of the art.

Industrial applicability: An invention is deemed industrially applicable when its subject matter may be produced or used in any type of industry. In this context, industry includes all productive activity, including services.

On the other hand, Utility Models protect any new shape, configuration, arrangement of components of any device, tool, mechanism, or any part thereof that leads to an improvement, provides a new use or a new manufacturing process. In order to obtain a utility model, the applicant should demonstrate that the invention has a new use, advantage or technical effect (novelty), as well as its industrial applicability. Hence, it is not necessary to demonstrate any inventiveness (inventive step).

DISCLOSURE and GRACE PERIOD

A disclosure of the invention by the inventor or its assignee within one year before the patent application, for example, in a congress or exhibition (National or International), will not bar novelty. This circumstance must be indicated and proved at the time of filing of the patent application.

What cannot be protected as patents in Mexico?

Nevertheless, some inventions are excluded from patentability, such as essentially biological processes of plant and animal breeding, animal breeds and plant varieties, the human body and parts thereof, and biologic and genetic material as found in nature.

Furthermore, certain creations are not considered inventions, including:

- Theoretical or scientific principles.
- Discoveries consisting of making known or disclosing something
that existed already in nature, even if previously unknown to
man.
• Schemes, plans, rules and methods for carrying out mental
processes, playing games or doing business and mathematical
methods.
• Computer programs or software.
• The presentation of information.
• Aesthetic creations and artistic or literary works.
• Methods of surgical or therapeutic treatment or diagnostic
treatment applicable to the human body, as well as such
methods applicable to animals.

SECOND USE PATENTS

Please bear in mind that second use patents (see Glossary)
are allowed in Mexico, subject to the regular patentability
requirements.

HOW LONG does legal protection last?

Patent protection lasts for 20 years, counted from the filing date
of the application. It generally takes 2 to 6 years to get a patent
granted in Mexico. However, this may vary depending on the field
and type of registration (e.g. if the same invention is successfully
patented in another country or if the registration is under the Global
Patent Prosecution Highway). An annual fee has to be paid to
continue the protection of the granted patent. Legal
protection for a Utility Model lasts 10 years from the filing date
of the application and the granting process tends to be shorter than
for Patents (1 to 4 years). An annual fee has to be paid to continue
the protection of the granted utility model.

WHO can register?

The inventor or any person (natural or legal) to whom the right
has been transferred is entitled to apply for Patents and Utility
Models. It can be done directly or through a legal representative.
Applicants without domicile in Mexico must appoint a local legal
representative, which could be any resident in Mexico. However, an
IP agent or attorney is always recommended.

HOW do I register a patent or a utility model?

A patent application, requesting patent protection for an invention,
must be filed at the Mexican Institute of Industrial Property (IMPI)
premises or via online. The patent application must be filed in
Spanish.

INTERNATIONAL PATENT REGISTRATION

Mexico is a member of the Patent Cooperation Treaty (PCT),
which provides the possibility of protection for an invention
simultaneously in a large number of countries by filing a
single “international” patent application instead of filing
several separate national or regional patent applications.

Applicants of a Patent or Utility Model should file before the IMPI:

a. Patent application form IMPI-00-009 (in duplicate)
b. Proof of payment of the official fee
c. Power of Attorney, if necessary
d. Technical information of the patent: title, an abstract,
description, a set of claims and drawings should be
included:
• The abstract consists of a summary of the technical
solution to the problem. However, the abstract only
serves as a source of technical information.
• The description should disclose the invention in a
sufficiently clear and complete way so that a person
skilled in the art would be able to understand and
carry it out.
• The claims define the subject matter of protection in
the patent.
• Drawings, examples (together with their description)
• When the applicant is not the inventor, the contract
proving the invention has been transferred to the
applicant.

DRAWINGS IN PATENTS AND UTILITY MODELS

Applications

Drawings shall be included within the patent application for a
product or a device, when they are necessary to understand
the invention. The same applies to Utility models. As to
processes patent applications, they are only required if they
help to understand the invention. The recommendation is
to draft and file suitable drawings for the patent or utility
model application.

The IMPI will then verify if the formal requirements are met and will
publish the application in the Official Gazette (SIGA) so third parties
can make observations during the following 6 months. The applicant
will be requested to pay the patent certificate fee if the examination
of the patentability requirements is successfully completed, after
which the patent will be published in the Official Gazette.


**Patent Registration Procedure**

1. **GRACE PERIOD**
2. **FILING DATE**
3. **1-3 Months**
   - **FORMAL EXAMINATION**
4. **18 Months**
   - **APPLICATION/PUBLICATION**
5. **6 Months**
   - **OBSERVATION BY THIRD PARTIES**
6. **SUBSTANTIAL EXAMINATION**
7. **GRANT/REFUSAL OF THE PATENT**

---

### Patent Application Costs

Patent application costs do not depend on the number of claims (see Glossary); for the initial 5 years (including application, publication and registration costs) protection cost will amount to €713 approx. While Utility Models registration costs amount to €366 for the first three years. All fees can be found on the IMPI’s website section.

Entering the National Phase via PCT has an extra cost of €80 or €166 for patents and €72 or €105, depending if it is entered within month 30 or 19 from the foreign patent application date, respectively.

Bear in mind that such fees are official and do not include costs for representation, translations, patent drafting and other related costs, such as those incurred in answer to oppositions.

Inventors, research centres and SMEs that are incorporated in Mexico can benefit from a 50% discount.

### C. Industrial Designs

**What does it PROTECT?**

The particular appearance of a product can be protected as an Industrial Design, including lines, combinations of colours, two-dimensional (2D) or three-dimensional (3D) external form, line, outline, configuration, texture or material.

**WHAT do you need to know?**

In order to register a design as an “Industrial Design” (also known as Design patent) in Mexico, the design should be new and allow for industrial applicability. After the last amendment made in 2018 to the Mexican Industrial Property Law, the concept of novelty was clarified and sets out the following requirements:

- **Independent creation**: That no other identical design has been made available to the public in any place by any means such as description, use or marketing prior to the filing date of the design application or, where appropriate, the recognised priority date.
- **Significant degree**: Those designs whose characteristics differ only in irrelevant details will be considered identical.

Technical features, functionality or performance, and colour variations, dimensions, materials cannot be protected as new designs.

**HOW LONG does legal protection last?**

Legal protection for Industrial Designs lasts 5 years from the filing date of the application, the granting proceedings take around 2-4 years. Industrial Designs can be renewed every 5 years up to 25 years, from the filing date of the application.

**WHO CAN register an industrial design?**

The designer can apply for, transfer or licence Industrial Designs. It can be done directly or through a legal representative. Applicants without domicile in Mexico must appoint a local legal representative, which could be any resident in Mexico. However, an IP agent or attorney is always recommended.

**HOW MUCH does it cost?**

Design initial registration fees amount to €412 (application, publication, certificate and annuities for the first 5 years).

Inventors, research centres and SMEs that are legally incorporated in Mexico can benefit from a 50% discount.

**HOW do I register a Design?**

Applicants of a Design should file before IMPI, either in person or online:

a. Design application form IMPI-00-009 (in duplicate)
b. Proof of payment of the fee
c. Power of Attorney, if necessary
d. Description of the Industrial Design
e. Unique Claim
f. The Graphic Representation of the Design
g. When the applicant is not the inventor, the contract that proves the invention was transferred to the applicant.

In contrast to Europe, IMPI performs a substantial examination of the Design to see if the novelty and industrial applicability requirements are met.

The applicant is then asked to pay the registration fee (corresponding to the fees for the first 5 years and the title of registration).

**Design Registration Proceeding**

**GRACE PERIOD**

**FILLING DATE**

1–3 Months

**FORMAL EXAMINATION**

**SUBSTANTIAL EXAMINATION**

**GRANT/REFUSAL OF THE DESIGN**

**GRACE PERIOD and DISCLOSURE**

Disclosures at trade fairs, in magazines or stores by means of exploitation or advertising will not jeopardise or affect the novelty requirement as long as it was done by the inventors or authorised third parties within 12 months prior to filing the design application. All probationary evidence must be provided, including the publication document bearing the specific date of the disclosure.

**D. Trademarks**

**What does it PROTECT?**

Any sign capable of distinguishing goods or services on the market. The sign can consist of: words, images, figures, sounds, aromas, letters, numerals, a colour or colour combination (with certain limits), a tactile sign, the shape of goods or any combinations of the above.

In the latest reform of the Mexican Industrial Property Law (2018), IMPI extended its trademark protection to any sign, or combination of signs, perceptible to the senses and susceptible of being graphically represented, which is capable of distinguishing goods or services from others of the same kind or class in the market. This opens up in this country the possibility of registering smells, sounds, holograms and corporate image (known in the international context as trade dress) trademarks.

Moreover, certification trademarks are now accepted in Mexico, while collective trademarks are having a better regulation. In relation to these types of trademarks, it is necessary to point out the following:

- **Collective trademarks:** Distinctive signs used to identify the products or services of the members of registered associations/cooperatives and differentiating them in the market from third-party products or services.

- **Certification trademarks:** Distinctive signs used to indicate compliance with standards, specific conditions under which the goods / services are manufactured or rendered and other characteristics pre-established by the owner of the mark (whose owner should be an entity which cannot develop a business involving the supply of the products or services certified).

The application for a collective or certification trademark shall be accompanied by the rules for its use. Both types of trademarks are used by their members in order to promote and build consumer confidence in the products or services offered under the collective sign.

To know more about how to register these types of trademarks, please contact our Helpline. Your question will be answered or signposted to appropriate organisations within a maximum of 3 working days.

**THREE DIMENSIONAL TRADEMARKS**

In Mexico, three-dimensional trademarks are accepted. They can be used to protect containers, wrappings, packaging, bottles, as well as the form or presentation of a product in three dimensions, without words or designs.

**WHAT do you need to know?**

A Trademark is subject to examination to determine if the given sign falls into any absolute or relative ground for refusal.
**Absolute grounds:** refer to all those trademark grounds of refusal based on public interest, such as generic names, lack of distinctiveness, use of state emblems etc.

**Relative grounds:** are based on the existence of prior Trademarks that are equal or confusingly similar to the one applied for and/or when the trademark application may mislead the consumer regarding the origin of the goods and services.

The main prohibitions for obtaining a registration according to trademark law are:

- Marks with contents or form that can be contrary to morality, public order or any law;
- Lack of distinctiveness / originality;
- Common use terms, or generic designation or technical names;
- Appellations of origin or geographical indications;
- Geographical zones, maps, names of private lands;
- Descriptiveness;
- Official signs or seals;
- Coins, banknotes of legal tender;
- Officially recognised medals or prizes;
- Well known or famous trademarks;
- Marks equal or confusingly similar to other previous marks (filed or already registered);
- Bad faith. Introduced with 2018 reform, this applies both to grounds for refusal and for invalidating a registration.

It is strongly recommended to perform a prior search on IMPI’s database (MARCANET) to assess whether there are trademarks that are similar to the sign that you want to register. If you need help to conduct your search, please contact our Helpline.

Mexico has recently implemented an opposition system similar to those established by EU members; however, the opposition does not bind the IMPI, therefore IMPI is not obliged to answer it nor take it into account.

Moreover, Mexico adopted the International Nice Classification, but products and services that are not included in any of the classes can use the Complementary list issued by IMPI in order to increase certainty.

The use of “R” symbol or phrases like “M.R.”, “Marca Colectiva Registrada”, “Marca de Certificación Registrada” or “Marca Registrada” is only allowed for registered trademarks and they can be used only in relation to the products or services for which they are registered. Its use is required to enforce your rights in case of infringement (administrative or criminal actions), but if it is used for non-registered marks, it will be considered an administrative infringement.

### OBLIGATION TO USE

Trademarks that have not been effectively used in Mexico during 3 consecutive years may be revoked. Therefore, it is advisable to register only those trademarks that you aim to effectively use, since if you register a trademark for mere defensive purposes it might be cancelled after three years of lack of use.

In this sense, it must be noted that owners of Trademarks granted after August 2018 are required to file declarations of use under oath within 3 months after the 3rd anniversary of the registration date. Failure to do so may lead to cancellation of the registration.

### WHO can register a trademark?

The owner or any person with a legitimate interest (e.g. business manager, mark creator, etc.) can apply for a trademark in Mexico. It can be done directly or through a legal representative. Foreign companies are recommended to appoint a local IP expert.

### HOW do I register a trademark?

Applicants of a trademark should file the following documents at the IMPI premises or via online:

1. Trademark application form IMPI-00-001
2. Proof of fee payment
3. Power of Attorney, if necessary
4. A reproduction or graphic representation of the trademark, when applicable.
5. Copy of the first trademark application, in case of priority claim

It takes approx. 2 to 6 months to get your trademark application granted (without official actions resulting from formal and examinations on substance).

Protection in Mexico is granted for ten years from the filing date and it can be renewed indefinitely for equal periods.

### INTERNATIONAL REGISTRATION

Mexico is a member of the Madrid System. Thus, you can register your trademark in just one or many of the 97 members of the treaty (including the Latin-American country) with a single application.

Registration fees are to be paid to WIPO (approx. € 760)

If you want to know more, please contact our Helpline.
HOW MUCH does it cost?

In contrast to Europe, Mexico has no multi-class application system. Hence, a separate trademark application must be filed for each class of product or service you want to register your trademark in.

Trademark registration in Mexico costs €144 per class (including certificate of registration).

E. Appellations of Origin and Geographical indications

What are they? And what do they PROTECT?

As in Europe, the Mexican system distinguishes between: Appellation of Origin (AO) and Geographical Indication (GI)

An Appellation of Origin (AO) is the name of a given country, region or place or a name, which is used to identify a product originating therein when its quality, reputation or other characteristics are essentially attributable to the geographical environment in which it is produced, including both natural and human factors.

Geographical Indication (GI) is the name of a given country, region or place or a name that is used to identify a product originating therein when its quality, reputation or other characteristics are essentially attributable to its geographical origin.

It must be highlighted that AO have a stronger connection with the place of origin than GI. The quality and the characteristics of a product protected under an AO are required to result as such due exclusively or essentially to its geographical origin.

WHAT do you need to know?

Protection of an AO or GI is acquired with a declaration issued ex officio by the IMPI or upon request of any person (natural or legal) who demonstrates having a legal interest.

According to Mexican regulations, a Mexican AO is owned by the Mexican Government and they may only be used by virtue of the authorization issued by the IMPI.

Illegal use of an AO or IG shall be punished (i.e. use of the AO with indications such as “kind,” “type,” “style,” “imitation” or other similar terms that may lead consumers to confusion or imply unfair competition) via administrative and/or criminal actions.

According to the law, the duration of the declaration of protection for an AO or an IG will remain as long as the conditions that motivated the registration persist. It shall cease to be effective only by virtue of a subsequent declaration made by the IMPI. Revocation is not applicable.

In Mexico, AO and IG are not limited to agricultural products. There are industrial products, like folkcrafts and pottery, which are also protected under the AO and IG concepts.

REGISTRATION OF EUROPEAN APPELLATIONS OF ORIGIN

At this moment, EU applicants cannot directly apply for an AO/GI before IMPI, since in Mexico the Federation is the owner of any AO or IG and authorises third parties to use them.

Since registration is closed to EU users, the only means available to obtain protection is through multilateral (e.g. Lisbon Agreement) or bilateral agreements such as the EU – Mexico Free Trade Agreement (FTA).

An alternative or cumulative means of protection that EU producers usually use in Mexico is to register the sign as a collective trademark (see Glossary).

A list of the AOs and GIs requested and in force in Mexico can be found on IMPI’s website (here for AOs and here for GIs).

How much does it cost?

The fee to apply for Appellation of Origin protection in Mexico is €82.

F. Other IPs

I. Trade Secrets

In addition to registered – or unregistered – IPRs, Mexico provides for the protection of other Intangible assets such as Trade Secrets or Undisclosed Information. The legal requirements for Trade Secrets to be protected as such in Mexico are:

a. it should be secret, meaning the information has not been disclosed
b. it must have a commercial value due to its secrecy
c. the right holder should adopt reasonable measures to keep it secret such as signing confidential agreements with employers and providers

Unauthorised disclosure of trade secrets is a criminal offence and prosecutable by the Attorney General’s Office. The sanctions for infringers may include imprisonment and fines.

In Mexico, Undisclosed Information used to obtain a market authorisation in pharmaceuticals and agricultural chemicals enjoys a specific type of protection. The requirements are:

a. obtaining such information entailed considerable effort
b. the information is related to new chemical compounds employed in the production of pharmaceutical products or agricultural chemicals

The term of protection for Undisclosed Information is currently 10 years for agricultural chemicals and 5 years for pharmaceutical products.
II. Domain Names (DN)

NIC (Network Information Center) Mexico is in charge of registering and managing “.mx” domain names. NIC established in its internal policies the use of an Alternative Dispute Resolution Mechanism when someone considers its rights to be affected and wishes for a DN to be cancelled or for the ownership to be transferred to them; the dispute will be settled by an authorised dispute resolution provider (in this case WIPO Arbitration and Mediation Centre) formed by an independent and specialized group of experts. This procedure can be initiated if:

- the domain name is identical or confusingly similar in respect of a trademark, registered service, registered trade announcement, appellation of origin
- the registrant has no rights or legitimate interests in the domain name
- the domain name has been registered or used in bad faith

You will find available in the Registry .MX (a division of NIC Mexico) website all the relevant information related to this procedure.

WHO can register?

Anyone in the world can register a Domain Name with a TLD “.mx” without any restriction.

HOW MUCH does it cost?

Registration of Domain Names can cost from € 34 upwards, depending on the number of years and the registrant provider. The maximum registration period for a .MX domain name is up to 10 years.

3. ENFORCING Your IPRs

IPRs may be enforced through administrative, civil or criminal actions.

Administrative proceedings must be brought by the holder or by a duly recorded licensee before IMPI, which is the competent authority to decide patent, trademark and copyright (when it is related to commercial exploitation of the works) infringements, and has the authority to take preliminary measures against alleged infringers and to resolve trademark invalidation, revocation and cancellation actions.

Note that INDAUTOR is the competent authority for the protection of moral rights as well as for those economic rights not related to commercial exploitation.

Actions for invalidity, revocation or cancellation of the registration of a trademark, patent or other IPRs shall be made by IMPI, either ex officio or ex parte.

In addition, unfair competition is also considered under infringement actions and, based on this particular ground, it might be possible to initiate legal proceedings without actually having an IP right protected at IMPI.

IP rights’ infringements are punishable by fines (up to about € 4,200), temporary or permanent closure of the business, or even through administrative arrest for 36 hours. In the event of repeat offences (after the administrative decision has become final), fines will be doubled and penal actions may be taken against the infringer.

Criminal actions are initiated by filing a “querella” (complaint), where the complainant may conclude the proceeding by filing a “pardon”. IP crimes may also be initiated ex officio but, in these cases, “pardon” shall not be granted.

Criminal penalties range from two to ten years’ imprisonment (i.e. Counterfeit product commercialization can be punished with 2 to 6 years of prison).

Finally, after the administrative and/or criminal decisions become firm, plaintiffs may initiate civil actions claiming damages in a Civil Court. Damages are calculated according to the commercial value of the infringing products (the minimum standard applicable in damages is 40%).

4. Using CUSTOMS To Block Counterfeits

Trademarks registered before the IMPI can benefit from the Customs’ Trademark Database (CTD). Main advantages:

- Eases the identification of presumably counterfeit goods when these are being imported into Mexican territory.
- Facilitates the entry of genuine goods in Mexican Customs.
- Helps the Customs’ personnel in the verification of goods, and if potential counterfeit products are detected:
  - retain the entry of suspicious goods up to five days, and
  - inform the trademark owner who should bring actions against the infringer

Finally, we encourage TM owners to be proactive on their TM’s protection with customs by:

1. Updating the IMPI’s records of their TM registrations, with all the ownership changes as well as all the license agreements executed. Usually Mexican Customs Authorities use the information available in IMPI’s databases to contact right holders.
2. Recording their TM registration information at CTD, as well as licensees, authorized importers and distributors.

Further information on the CTD and other border measures can be found in our Factsheet Customs in Mexico.
5. RELATED LINKS and Additional Information

Find out more about Intellectual Property Rights in Latin America, visit the Latin America IPR SME Helpdesk website: www.latinamerica-ipr-helpdesk.eu

IMPI’s patent and utility model guide for users

IMPI’s design guide for users

IMPI’s online registration FAQs
https://eservicios.impi.gob.mx/seimpi/ayudaSEIMPI/Preguntas_Frecuentes_RDUDi.pdf

IMPI’s trademarks guide for users
https://www.gob.mx/tramites/ficha/solicitud-de-registro-de-marca-ante-el-impi/IMPI88

Mexican Industrial Property Office (IMPI)
http://www.impi.gob.mx/

Mexican Intellectual Property Office (INDAUTOR)
http://www.indautor.gob.mx/

IMPI fees list
https://www.gob.mx/impi/acciones-y-programas/servicios-que-ofrece-el-impi-tarifas

Customs Authority
http://omawww.sat.gob.mx/duanas/Portal/index.html - /

IPR Mexican Regulation

Factsheet Customs in Mexico:
http://www.latinamerica-ipr-helpdesk.eu/content/customs-mexico

6. Glossary

**Designated countries**: Refer to the countries to which the applicant aims to extend its international application by means of any of the WIPO international registration systems: PCT, Madrid, Hague and Lisbon.

**Derivative works**: This type of works modify prior works and require the consent of the owner of the original work: a translation, the adaptation of a novel or a version of a song are some of the most common examples of derivative works.

**Right of priority**: Whenever a person, from any signatory country of the Paris Convention, files a national application for a trademark, patent, utility model or industrial design in any of the 176 members, the date on which the first application was filed is established as the date of priority for any future application in any of the member countries, provided that subsequent applications are applied for within six or twelve months of the first application, depending on the right.

**Second use**: Refers to the possibility of patenting a different use of an already known object/product (e.g. Use of a chemical composition as a medicine to treat heart diseases when the original patent claims its use as antibiotic). In general, in Europe it is possible to patent such a second use subject to the fulfilment of the Novelty and Inventive Step requirements.

**Collective trademarks**: This type of trademarks used to identify the goods and/or services of members of a specific entity or from a group of entities/companies.

**Claim**: Part of a Patent application or specification that defines the matter for which protection is sought in terms of technical features.
The Latin America IPR SME Helpdesk offers multilingual services (English, French, German, Spanish and Portuguese¹), with free information and first-line legal advice on IP related subjects, as well as training, webinars and publications, especially designed for EU SMEs.

HELPLINE First-line advisory service on IP protection and enforcement for EU SMEs working or planning to operate in Latin America.

TRAINING Targeted trainings and webinars on IPR protection and enforcement for EU SMEs (including sector-specific approaches).

IP CONTENT State-of-the-art publications (factsheets, learning modules, videos, IP glossary, infographics, case studies and newsletters) on the protection and enforcement of IPR in Latin America – specifically addressing IP matters from the SME business needs point of view.

AWARENESS RAISING EVENTS Participation in events attended by EU SMEs to increase the awareness of IP and of the visibility of the services provided by the Helpdesk.

IP ANALYSIS Analysis of IP challenges faced by EU SMEs in the target markets.

IP DIAGNOSTIC TOOLKIT Toolkit for self-evaluation of the IP-status of the user in terms of IP knowledge and management.

IP COST TOOL Online tool that allows the user to pre-evaluate the costs related to IP management in every Latin American country covered by the Helpdesk.

¹The language offer will depend on the specific service and experts' availability.

If you have any queries on how to protect your Intellectual Property in Latin America contact our Helpdesk service: helpline@latinamerica-irp-helpdesk.eu +34 96 590 9684 Working Hours: Monday - Friday 9:00 -16:30 (CEST)

If you want more information on additional free services offered by the Helpdesk contact the coordination team: info@latinamerica-irp-helpdesk.eu University of Alicante, Campus San Vicente del Raspeig, Edificio Torre de Control, 03690 Alicante, Spain +34 96 590 9684

Follow us on Social Media and stay tuned on new releases of factsheets and other IP content: @latinamericaipr www.latinamerica-irp-helpdesk.eu

©European Union, 2019

Reuse is authorised provided the source is acknowledged.

The Latin America IPR SME Helpdesk is a free service for SMEs which provides practical, objective and factual information about Intellectual Property Rights in Latin America. The services are not of a legal or advisory nature and no responsibility is accepted for the results of any actions made on the basis of its services. The content and opinions expressed are those of the authors and do not necessarily represent the views of the European Commission and/or the Executive Agency for Small and Medium-sized Enterprises or any other body of the European Union.

Before taking specific actions in relation to IPR protection or enforcement all customers are advised to seek independent advice. Neither the European Commission nor the Agency may be held responsible for the use which may be made of the information contained herein.

Last update February 2019