



**COUNTRY
COMPARATIVE
GUIDES 2023**

The Legal 500 Country Comparative Guides

Mexico

INTELLECTUAL PROPERTY

Contributor

Dumont



Laura Collada

Managing Partner | lcollada@dumont.com.mx

Christian Thomae

Partner/Head of Trademarks | cthomae@dumont.com.mx

Victor Garrido

Partner/Head of Patents | vgarrido@dumont.com.mx

This country-specific Q&A provides an overview of intellectual property laws and regulations applicable in Mexico.

For a full list of jurisdictional Q&As visit legal500.com/guides

MEXICO

INTELLECTUAL PROPERTY



1. What different types of intellectual property rights exist to protect: (a) Inventions (e.g. patents, supplementary protection certificates, rights in trade secrets, confidential information and/or know-how); (b) Brands (e.g. trade marks, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin, geographical indications, traditional speciality guarantees); (c) Other creations, technology and proprietary interests (e.g. copyright, design rights, semiconductor topography rights, plant varieties, database rights, rights in trade secrets, confidential information and/or know-how).

- a. **Inventions:** patents, utility models, industrial designs, integrated circuit layouts.
- b. **Brands:** trademarks (including non-traditional: scent, sound and holograms), trade names, slogans, trade dress, geographical indications and appellations of origin.
- c. **Other creations, technology and proprietary interests:** copyright, related rights, reservations of rights, plant varieties, trade secrets.

2. What is the duration of each of these intellectual property rights? What procedures exist to extend the life of registered rights in appropriate circumstances?

Inventions

IP right	Regular duration	Procedure to extend the life of IP right
Patents	20 years.	Supplementary certificates will be available from 2025.
Utility models	15 years.	Non-extendable.
Industrial designs	25 years maximum.	Must be renewed every 5 years, up to a total of 25 years.
Integrated circuit layouts	10 years.	Non-extendable.

Brands

IP right	Regular duration	Procedure to extend the life of IP right
Trademarks	10 years.	Renewal application. Declaration of use required upon 3rd year from registration date and with every renewal. Extension for 10 years upon every renewal. No limit of renewals.
Trade names	10 years.	Renewal application. Declaration of use required upon 3rd year from registration date and with every renewal. Extension for 10 years upon every renewal. No limit of renewals.
Slogans	10 years.	Renewal application. Declaration of use required upon 3rd year from registration date and with every renewal. Extension for 10 years upon every renewal. No limit of renewals.
Trade Dress	10 years.	Renewal application. Declaration of use required upon 3rd year from registration date and with every renewal. Extension for 10 years upon every renewal. No limit of renewals.
Certification Marks	10 years.	Renewal application. Declaration of use required upon 3rd year from registration date and with every renewal. Extension for 10 years upon every renewal. No limit of renewals.
Appellations of Origin	As long as the geographic zone including the natural and human factors providing the distinctive characteristics to the product exist.	
Geographical Indications	As long as the conditions that provide the distinctive characteristics to the product exist.	

Copyright and other rights

IP right	Regular duration	Procedure to extend the life of IP right
Copyright	100 years after author's death. In case of co-authorship, as from the death of the last of the living co-authors.	Non-extendable.
Neighbouring rights: artist, performers and executors	75 years.	Non-extendable.
Neighbouring rights: book publishers	50 years.	Non-extendable.
Neighbouring rights: phonogram producers	75 years.	Non-extendable.
Neighbouring rights: video producers	50 years.	Non-extendable.
Neighbouring rights: broadcasting organizations	50 years.	Non-extendable.
Reservation of rights: periodical publications	1 year.	Renewal application. Need to prove use. It is extended for the same period. No limit of renewals.
Reservation of rights: periodical broadcasts	1 year.	Renewal application. Need to prove use. It is extended for the same period. No limit of renewals.
Reservation of rights: characterized, fictitious and symbolic characters	5 years.	Renewal application. Need to prove use. It is extended for the same period. No limit of renewals.
Reservation of rights: artistic and group names dedicated to artistic activities	5 years.	Renewal application. Need to prove use. It is extended for the same period. No limit of renewals.
Reservation of rights: advertising promotions	5 years.	Non-extendable.
Plant varieties: for perennial species	18 years.	Non-extendable.
Plant varieties: for non-perennial species	15 years.	Non-extendable.
Trade secrets	N/A	N/A

IP right	First owner?	Different for rights created in the course of employment or under a commission?
Patents	Inventor	According to article 40 of the Federal Law for the Protection of Industrial Property, the provisions of the Mexican Labour Law (article 163) shall be applied when it comes to inventions made by a person subject to an employment relationship. Therefore, under the scope of article 163 of the Mexican Labour Law, the ownership of a given invention is subject to the following rules: (i) in any case, the inventor shall be identified as the author of the relevant invention; (ii) if the services provided by the employee are related to research activities, ownership on the invention and the right to exploitation of the same shall be held by the employer; and (iii) if nothing is agreed between the parties, the ownership of the invention will be held by the inventor, but the employer shall have a preferential right -in equal circumstances- to obtain the ownership as well as the exclusive right to use the invention.
Utility models	Inventor	
Industrial designs	Designer	
Integrated circuit layouts	Creator	

Brands

IP right	First owner?	Different for rights created in the course of employment or under a commission?
Trademarks	Applicant	If the trademark / trade name / slogan / trade dress was created during the course of employment or under commission, then the owner will be the employer.
Trade names	Applicant	
Slogans	Applicant	
Appellations of Origin	The Mexican Government	N/A
Geographical Indications	The Mexican Government	N/A

Copyright and other rights

3. Who is the first owner of each of these intellectual property rights and is this different for rights created in the course of employment or under a commission?

Inventions

IP right	First owner?	Different for rights created in the course of employment or under a commission?
Copyright	Author	Article 84 of the Federal Copyright Law provides that in case of a work made in the course of an employment relationship (under a written individual labour contract), the rules that should be applied concerning the ownership of rights are as follows: a) If there is an intellectual property clause, the same should be complied with. Some individual contracts include an intellectual property clause, in which the employer states that the copyright of works created by employees will belong in their entirety to the employer. b) If there is no clause or agreement about the ownership of a copyright, the Copyright Law provides that the rights will be owned by both the employer and the employee (50% each). Furthermore, only the employer is entitled to disclose the work without the need of employee's authorization. c) If there is no written contract, rights will belong to the employee. On the other hand, when it comes to commissions, unless agreed otherwise, the person or legal entity commissioning a party to create a given work shall bear the ownership of the patrimonial rights. If there is not a written contract, the ownership of rights will belong to the employee.
Neighbouring rights: artist, performers and executors	Artist, performers and executors	No, they are not different.
Neighbouring rights: book publishers	Book publishers	No, they are not different.
Neighbouring rights: phonogram producers	Phonogram producers	No, they are not different.
Neighbouring rights: video producers	Video producers	No, they are not different.
Neighbouring rights: broadcasting organizations	Broadcasting organizations	No, they are not different.
Reservation of rights	Applicant	No, they are not different.
Plant varieties	Applicant	No, they are not different.
Trade secrets	Person exerting legal control over confidential information	N/A

4. Which of the intellectual property rights described above are registered rights?

All but copyright (registration is not compulsory, but possible and advisable), related rights and trade secrets.

5. Who can apply for registration of these intellectual property rights and, briefly, what is the procedure for registration?

Inventions

IP right	Who can apply for registration?	What is the procedure for registration?
Patents	Inventor(s) or assignee(s)	Filing of the application; formal examination; publication of the application; substantive examination; granting or rejection; final publication.
Utility models		
Industrial designs		
Integrated circuit layouts		

Brands

IP right	Who can apply for registration?	What is the procedure for registration?
Trademarks	Any person or company	Filing of the application; publication for opposition; opposition (if any); publication of opposition (only if an opposition was filed); response to the opposition (if any); formal examination; substantive examination; granting or rejection; publication (if granted).
Trade names		
Slogans		
Trade Dress		
Appellations of Origin	(i) The Mexican Patent and Trademark Office; (ii) any company or people associated with the extraction, production and manufacture of the product intended to be protected; (iii) the national chambers or associations of manufacturers related with the subject product; (iv) the Mexican Federal Government and associated entities.	i) Application. ii) Review by the Mexican Patent and Trademark Office. iii) Publication in the Federal Official Gazette for opposition purposes. iv) Opposition deadline: Two months as from the publication date. v) Final decision. vi) Publication in the Federal Official Gazette, if granted.
Geographical Indications		

Copyright and other rights

IP right	Who can apply for registration?	What is the procedure for registration?
Copyright registration	Author or Assignee	Filing of application; formal and substantive examination; granting or rejection.
Reservation of rights	Any person or company	Filing of application; formal and substantive examination; granting or rejection.
Plant varieties	Plant breeder or assignee(s)	Application's filing; formal and substantive examination; granting or rejection.

6. How long does the registration procedure usually take?

Inventions

IP right	Registration period?
Patents	3-4 years
Utility models	3 years
Industrial designs	8-12 months
Integrated circuits	2-3 years

Brands

IP right	Registration period?
Trademarks	6-8 months in the case no objections are raised.
Trade names	
Slogans	
Appellations of Origin	10-12 months.
Geographical Indications	

Copyright and other rights

IP right	Registration period?
Copyright registration	15-30 business days.
Reservation of rights	15-30 business days.
Plant varieties:	12-18 months.

7. Do third parties have the right to take part in or comment on the registration process?

Inventions

IP right	Third parties right to take part in or comment?
Patents	Yes
Utility models	No
Industrial designs	No
Integrated circuit layouts	No

Brands

IP right	Third parties right to take part in or comment?
Trademarks	Yes, as opposing parties.
Trade names	
Slogans	
Trade dress	
Appellations of Origin	Yes, as opposing parties.
Geographical Indications	

Copyright and other rights

IP right	Third parties right to take part in or comment?
Copyright registration	No
Reservation of rights	No
Plant varieties	No

8. What (if any) steps can the applicant take if registration is refused?

Inventions

IP right	Available steps if registration is refused?
Patents	Challenge the decision by means of either: a Revision Appeal before the Mexican Patent and Trademark Office or an appeal before the Federal Administrative Court.
Utility models	
Industrial designs	
Integrated circuit layouts	

Brands

IP right	Available steps if registration is refused?
Trademarks	Challenge the decision by means of either: a Revision Appeal before the Mexican Patent and Trademark Office or an appeal before the Federal Administrative Court.
Trade names	
Slogans	
Trade dress	
Appellations of Origin	
Geographical Indications	

Copyright and other rights

IP right	Available steps if registration is refused?
Copyright registration	Challenge the decision by means of either: a Revision Appeal before the Mexican Copyright Office or an appeal before the Federal Administrative Court.
Reservation of rights	Challenge the decision by means of either: a Revision Appeal before the Mexican Copyright Office or an appeal before the Federal Administrative Court.
Plant varieties	Challenge the decision by means of either: a Revision Appeal before the Mexican Ministry of Agriculture or an appeal before the Federal Administrative Court

9. What are the current application and renewal fees for each of these intellectual property rights?

Inventions

IP right	Application fees	Renewal fees
Patents	Paris Convention, basic fee for up to 30 pages: \$ 310.5 USD. Each exceeding page: \$ 4.2 USD PCT Phase I, basic fee for up to 30 pages: \$ 214.8 USD. Each exceeding page: \$ 4.2 USD PCT Phase II, basic fee for up to 30 pages: \$ 102.4 USD. Each exceeding page: \$ 4.2 USD	From the 1st to the 5th annuity: \$ 79.5 USD each. From the 6th to the 10th annuity: \$ 92.9 USD each. From the 11th to the 20th annuity: 104.9 USD each.
Utility models	Paris Convention, basic fee for up to 30 pages: \$ 136.5 USD. Each exceeding page: \$ 4.2 USD PCT Phase I, basic fee for up to 30 pages: \$ 136.5 USD. Each exceeding page: \$ 4.2 USD PCT Phase II, basic fee for up to 30 pages: \$ 92.2 USD. Each exceeding page: \$ 4.2 USD	From the 1st to the 3rd annuity: \$ 75.1 USD each. From the 4th to the 6th annuity: \$ 76.7 USD each. From the 7th to the 10th annuity: \$ 88.1 USD each.
Integrated circuit layouts	For an application up to 30 pages \$ 71.3 USD Each exceeding page: \$ 4.2 USD	
Industrial designs	Basic fee for one design, \$ 136.5 USD. Each exceeding design/embodiment: \$ 4.2 USD.	From the 1st to the 5th annuity: Included in the grant fee. Grant fee: \$ 393.8 USD Each renewal covering five years (up to 25 years): \$ 404.5 USD.

Brands

IP right	Application fees	Renewal fees
Trademarks	\$ 184 USD	\$ 244 USD
Trade names	\$ 184 USD	\$ 244 USD
Slogans	\$ 184 USD	\$ 244 USD
Trade Dress	\$ 184 USD	\$ 244 USD
Certification marks	\$ 184 USD	\$ 244 USD
Appellations of Origin	\$ 105 USD	N/A
Geographical Indications		

Copyright and other rights

IP right	Application fees	Renewal fees
Copyright registration	\$ 16 USD	
Reservation of rights: periodical publications	\$ 122 USD	\$ 64 USD
Reservation of rights: periodical broadcasts		
Reservation of rights: characterized, fictitious and symbolic characters	\$ 242 USD	\$ 126 USD
Reservation of rights: people and groups dedicated to artistic activities		
Reservation of rights: advertising promotions		
		Non-renewable
Plant varieties	\$ 1030 USD	\$ 214 USD per annum.

10. What are the consequences of a failure to pay any renewal fees and what (if any) steps can be taken to remedy a failure to pay renewal fees?

Inventions

IP right	Consequence of a failure to pay	Steps to remedy a failure to pay
Patents	Falling into public domain.	To file a restoration request within the 12-month grace period provided. Additional official fees would be payable.
Utility models		
Industrial designs		
Integrated circuit layouts		

Brands

IP right	Consequence of a failure to pay	Steps to remedy a failure to pay
Trademarks	The lapsing of the right.	File the renewal application within the 6-month grace period available. No restoration available beyond the grace period.
Trade names		
Slogans		
Trade Secrets		
Certification marks		
Appellations of Origin	N/A	N/A
Geographical Indications		

IP right	Requirement	
Trademarks	Written assignment agreement (signed by both parties) stating forth: 1. Names, addresses and nationalities of both parties, and Agreement must be recorded with the Mexican Patent and Trademark Office.	
Trade names		
Slogans		
Trade Secrets		
Certification marks		
Appellations of Origin	N/A	
Geographical Indications		

Copyright and other rights

IP right	Consequence of a failure to pay	Steps to remedy a failure to pay
Copyright registration	N/A	N/A
Reservation of rights	The lapsing of the right.	File the renewal application within the 1-month grace period available. No restoration available beyond the grace period.
Plant varieties	To become part of the public domain.	N/A

Copyright and other rights

IP right	Requirements
Copyright	Written assignment agreement (signed by both parties) stating forth: 1) Names and nationalities of both parties; 2) Details of the work; 3) Agreed remuneration; and 4) Term, unless it's a work made for hire.
Related rights	N/A
Reservation of rights	Written assignment agreement (signed by both parties) stating: 1) Names, addresses and nationalities of both parties, and 2) Details of the reservation of rights. Record the agreement with the Mexican Copyright Office.
Plant varieties	Written assignment agreement (signed by both parties) stating: 1) Names, addresses and nationalities of both parties, and 2) Details of the right. The agreement must be executed before a Notary Public and further legalized by Apostille or Consular legalization. Record the agreement before the Mexican Seed Inspection and Certification Service.
Trade Secret	Written assignment agreement, signed by both parties, stating the relevant trade secret and all the mechanism and measures to keep the confidentiality of the information.

11. What are the requirements to assign ownership of each of the intellectual property rights described above?

Inventions

IP right	Requirements
Patents	Written assignment agreement (signed by both parties) stating: i) Names, addresses and nationalities of both parties, and ii) Details of the registration related to the invention.
Utility models	
Industrial designs	
Integrated circuit layouts	Agreement must be recorded with the Mexican Patent and Trademark Office.

Brands

12. Is there a requirement to register an assignment of any of these intellectual property rights and, if so, what is the consequence of failing to register?

Inventions

IP right	Requirements	Consequence of failing to register
Patents	Original document or certified copy of the assignment agreement. Spanish translation; Power of Attorney; Recordal request containing: i) Names, addresses and nationalities of both parties; ii) Details of the invention; iii) New address of record for correspondence; iv) If applicable, name of the new domestic representative; and v) Payment of official fees.	The assignment agreement will not have legal effects against third parties unless it is recorded.
Utility models		
Industrial designs		
Integrated circuit layouts		

Brands

IP right	Requirements	Consequence of failing to register
Trademarks	Original document or certified copy of the assignment agreement. Spanish translation. Recordal request containing: i) Names, addresses and nationalities of both parties; ii) Details of the right; iii) New address for service; iv) If applicable, name of the new domestic representative; and v) Payment of official fees.	The assignment agreement will not have legal effects against third parties, unless it is recorded.
Trade names		
Slogans		
Trade dress		
Certification marks		
Appellations of Origin	N/A	N/A
Geographical Indications		

Copyright and other rights

IP right	Requirements	Consequence of failing to register
Copyright	1) Original document or certified copy of the assignment agreement; 2) Identifications of the parties or of their representatives (for companies); 3) Spanish translation; 4) Recordal application form; and 5) Payment of official fees.	The agreement will not be presumed valid.
Related rights	N/A	N/A
Reservation of rights	1) Original document or certified copy of the assignment agreement; 2) Identifications of the parties or of their representatives (for companies); 3) Spanish translation; 4) Recordal application form; and 5) Payment of official fees.	The assignment agreement will not have legal effects against third parties.
Plant varieties	1) Original document or certified copy of the assignment agreement; 2) Complete name, nationalities and addresses of the parties; 3) Letter signed by the new owner stating that he will maintain the characteristics of the plant variety; 4) Spanish translation; 5) Recordal application; and 6) Payment of official fees.	The assignment agreement will not have legal effects against third parties.
Trade secret	N/A	N/A

13. What are the requirements to licence a third party to use each of the intellectual property rights described above?

Inventions

IP right	Requirements
Patents	Written agreement stating: 1) Names, addresses and nationalities of the parties; 2) Details of the registration related to the invention; 3) Indication as to if the license will be exclusive or non-exclusive; 4) Indication as to if licensee will be authorized to initiate legal actions for defending the licensed rights against infringement; 5) Term of the license.
Utility models	
Industrial designs	
Integrated circuit layouts.	

Brands

IP right	Requirements
Trademarks	Written agreement stating the following information: 1) Names, addresses and nationalities of the parties; 2) Details of the trademark; 3) Indication as to if the license will be exclusive or non-exclusive; 4) Indication as to if licensee will be authorized to initiate legal actions for defending the licensed rights against infringement; 5) Term of the license.
Trade names	
Slogans	
Trade dress	
Certification marks	
Appellations of Origin	Written application filed before the Mexican Patent and Trademark Office. Such application shall meet the following additional requirements: The applicant's activities shall be related to extraction, production and manufacturing of the products covered by the appellation of origin; That such activities shall be conducted inside the area that the appellation of origin covers; All other requirement stated by both the Ministry of Economy and the appellation of origin.
Geographical Indications	

Copyright and other rights

IP right	Requirements
Copyright	Written license agreement stating the following information: 1) Names, addresses and nationalities of the parties 2) Details of the Copyright; 3) Term of the License; and 4) Agreed royalties.
Related rights	N/A
Reservation of rights	Written license agreement (signed by both parties) stating forth: 1) Names and nationalities of both parties, and 2) Details of the Reservation of Rights.
Plant varieties	Written license agreement (signed by both parties) stating forth: 1) Names and nationalities of both parties, and 2) Details of the Plant variety.
Trade secret	Written agreement stating: 1) Names, addresses and nationalities of the parties; 2) Details of the trade secret, for identification purposes; 3) Measures or mechanisms to safekeep the confidentiality of the information; 4) Term of the license.

14. Is there a requirement to register a licence of any of these intellectual property rights and, if so, what is the consequence of failing to register?

Inventions

IP right	Requirements	Consequence of failing to register
Patents	Original document or certified copy of the license agreement.	The license agreement will not have legal effects against third parties, unless it is recorded.
Utility models	Spanish translation; Recordal application stating:	
Industrial designs	Names, addresses and nationalities of both parties;	
Integrated circuit layouts	Details of the invention; and Payment of official fees.	
Trade secret	N/A	N/A

Brands

IP right	Requirements	Consequence of failing to register
Trademarks	Original document or certified copy of the license agreement.	The license agreement will not have legal effects against third parties, unless recorded.
Trade names	Spanish translation; Recordal application stating:	
Slogans	i) Names, addresses and nationalities of both parties;	
Trade dress	ii) Details of the trademark; and	
Certification marks	iii) Payment of official fees.	
Appellations of Origin	Since the authorization to use is granted by the Mexican Patent and Trademark Office, it is automatically registered.	N/A
Geographical Indications		

Copyright and other rights

IP right	Requirements	Consequence of failing to register
Copyright	Original document or certified copy of the assignment agreement; Identifications of the parties or their representatives (for companies); Spanish translation; Recordal application form; and Payment of official fees.	The agreement will not be presumed valid.
Related rights	N/A	N/A
Reservation of rights	Original document or certified copy of the assignment agreement; Identifications of the parties or their representatives (for companies); Spanish translation; Recordal application form; and Payment of official fees.	The license agreement will not have legal effects against third parties, unless recorded.

15. Are exclusive and non-exclusive licensees given different rights in respect of the enforcement of the licensed IP, and if so, how do those rights differ?

Both licenses grant the same rights to enforce the licensed intellectual property rights. However, such right can be limited completely or partially according to what the parties state in the agreement.

16. Are there criminal sanctions for infringement of any intellectual property rights, and if so, what are they and how are they invoked?

According to the Industrial Property and Criminal Law, the sanctions are: imprisonment and/or fine.

These criminal sanctions may be invoked by means of a criminal action filed before the Specialized IP Prosecution section at the Federal Attorney General's Office.

17. What other enforcement options are available for each of the intellectual property rights described above? For example, civil court proceedings, intellectual property office proceedings, administrative proceedings, alternative

dispute resolution.

IP right	Other enforcement
Inventions	Mexican PTO proceedings: cancellation, infringement and invalidation actions.
Brands	Alternative Dispute Resolutions, namely, arbitration.
Copyright	Civil Courts proceedings: compensation for damages derived from infringement. Copyrights Office proceedings: invalidation and infringement actions. Mexican PTO proceedings: trade-related copyright infringements and preliminary injunctions or preventative measures. Alternative Dispute Resolution, namely, arbitration and conciliation.

18. What is the length and cost of such procedures?

Inventions and Trademarks

Procedures	Length	Cost
Intellectual Property Office proceedings	From 8 to 12 months approximately.	Official fees: \$ 95 USD approximately.
Alternative Dispute Resolutions	From 3 to 6 months approximately.	

Copyright

Procedures	Length	Cost
Civil Courts proceedings.	From 12 to 15 months approximately.	No official cost to consider.
Copyright Office proceedings		Official fees: \$ 95 USD approximately.
Intellectual Property Office proceedings	From 8 to 12 months approximately.	
Alternative Dispute Resolution	From 3 to 6 months approximately.	

19. Where court action is available, please provide details of which court(s) have jurisdiction, how to start proceedings, the basics of the procedure, the time to trial, the format of the trial, the time to judgment and award of relief and whether any appeal is available.

Court	How to start	Basics	Time to trial	Format	Time to judgement	Any available appeals?
Federal Administrative Court	By filing an initial pleading	1) In written 2) PoA required 3) No discovery	1 - 2 years; however, it would depend on the complexity and particularities of the case.	1) Initial pleading 2) Response by the defendant 3) Closing arguments 4) Revision of evidence 5) Ruling/Decision	6 - 8 months; however, this time would depend on the complexity and particularities of the case.	Yes
Civil Courts						
Criminal Courts						
Federal Circuit Court						
Mexican Supreme Court						No

20. What customs procedures are available to stop the import and/or export of infringing goods?

An administrative procedure which is conducted by the Mexican Patent and Trademark Office, known as “border measures”, which is a kind of preliminary injunction. Its main purpose is to seize or interrupt the free circulation of infringing products at the border. This action may also be followed criminally before the Special Prosecutor of the Federal Attorney General’s Office.

21. Are any non-court enforcement options or dispute resolution mechanisms mandatory in respect of intellectual property disputes in any circumstances? If so, please provide details.

No mandatory mechanism of such nature is available in Mexico. All of them are only optional for the parties.

22. What options are available to settle intellectual property disputes in your jurisdiction?

Arbitration and Mediation.

23. What is required to establish infringement of each of the intellectual property rights described above? What evidence is necessary in this context?

Inventions

IP right	Requirements for establishing infringement	Necessary evidence
Patents	Any non-authorized use of the intellectual property right (unfair competition).	All sort of evidence is allowed but that one contrary to the morality or the law. Examination of parties is not allowed.
Utility models		
Industrial designs		
Integrated circuit layouts		

Brands

IP right	Requirements for establishing an Infringement	Necessary evidence
Trademarks	Any non-authorized use of the intellectual property right (unfair competition).	All sort of evidence is allowed but that one contrary to the morality or the law. Examination of parties is not allowed.
Trade names		
Slogans		
Appellations of Origin	Any non-authorized use of the intellectual property right (unfair competition).	
Geographical Indications		

Copyright and other rights

IP right	Requirements for establishing an Infringement	Necessary evidence
Copyright	Any non-authorized use of the intellectual property right as well as any violation of the author’s moral rights.	All sort of evidence is allowed but that one contrary to the morality or the law. Examination of parties is not allowed but only when the case is decided by a civil court.
Related rights	Any violation of the holder’s rights.	
Reservation of rights	Any non-authorized use of the intellectual property right.	
Plant varieties	Any non-authorized use of the intellectual property right.	All sort of evidence is allowed but that one contrary to the morality or the law.
Trade secret	Disclosure.	All sort of evidence is allowed but that one contrary to the morality or the law.

24. How does the court acquire any necessary information (fact or technical) and in what circumstances does it do so? In particular a) Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the parties, and/or parties’ expert witness evidence? b) What mechanisms are available for compelling the obtaining and protecting of evidence? Is disclosure or discovery available?

a) There are experts that shall be firstly appointed by each party. Then if the opinion rendered by such experts is contradictory, the judge appoints a third expert to resolve the contradiction.

b) Discovery is not available in Mexico. However, when it comes to confidential information that needs to be submitted in a trial, the court shall implement the required measures to keep its confidentiality.

25. How is information and evidence submitted to the court scrutinised? For example, is cross-examination available and if so, how frequently is it employed in practice?

Cross-examination is not available in our jurisdiction. The Courts shall follow certain guidelines and principals when analysing some piece of evidence. Such guidelines and principals are provided in our legislation but also in our jurisprudence.

26. What defences to infringement are available?

Infringers might either file a response arguing that the infringement action is groundless and providing evidence that supports the legal use of the intellectual property right in matter; or file an invalidation action (as a counteraction) against the registration used as legal standing by the plaintiff.

27. Who can challenge each of the intellectual property rights described above?

Any third party that proves its legal standing to challenge the intellectual property right. The legal standing can be proven -among other scenarios- by means of any prior intellectual property right considered affected because of the existence of the right to be challenged.

28. When may a challenge to these intellectual property rights be made (e.g. during any registration process or at any time during the subsistence of the right)?

During the subsistence of the right.

29. Briefly, what is the forum and the procedure for challenging each of these intellectual property rights and what are the grounds for a finding of invalidity of

each of these intellectual property rights?

Inventions

IP right	Forum	Procedure for challenging each intellectual property rights	Grounds of invalidation
Patents	Mexican Patent and Trademark Office	1) Initial pleading. Evidence shall be submitted as well; 2) Response by the defendant along with his evidence; 3) Closing arguments; 4) Decision.	I. Lack of novelty; II. Lack of inventive step; III. Lack of industrial application. IV. When the patent was granted to the wrong person. V. Abandonment of the patent application.
Utility models			
Industrial designs			
Integrated circuit layouts			Lack of novelty.

Brands

IP right	FORUM	Procedure for challenging each intellectual property rights	Grounds of invalidation
Trademarks	Mexican Patent and Trademark Office	1) Initial pleading. Evidence shall be submitted as well; 2) Response by the defendant along with his evidence; 3) Closing arguments; 4) Decision.	I. Being granted against the provisions of the law; II. Earlier use in Mexico or abroad; III. False data stated in the application; IV. Earlier registration; and V. Bath faith.
Trade names			
Slogans			
Appellations of Origin			I. Being granted against the provisions of the Industrial Property Law; and II. False data declared in the application.
Geographical Indications			

Copyright and other rights

IP right	FORUM	Procedure for challenging each intellectual property rights	Grounds of invalidation
Copyright	Mexican Copyright Office or Civil court	1) Initial pleading. Evidence shall be submitted as well; 2) Response by the defendant along with his evidence; 3) Closing arguments; 4) Decision.	I. False authorship; II. Earlier creation; III. Granted against the provisions of the law.
Related rights			I. Earlier registration; II. False data declared in the application; III. Granted against the provisions of the law.
Reservation of rights			I. Lack of novelty; II. Lack of distinctiveness; III. Lack of stability; IV. Lack of homogeneity.
Plant varieties	Ministry of Agriculture		

30. Are there any other methods to remove or limit the effect of any of the intellectual property rights described above, for example, declaratory relief or licences of right?

Inventions

IP right	Methods to remove or limit the effect
Patents	Educational reasons with non-commercial purposes and/or the exhaustion of the right of the patent owner and/or use an invention before someone else files a patent application and/ the use of the invention referred to in transportation vehicles of other countries when it forms part of such vehicles and when the vehicles are in transit in national territory and/or using patents with living beings as a resource for obtaining new products and/or an obligatory license in case of lack of use/national security/public emergency.
Utility models	
Industrial designs	
Integrated circuits	

Brands

IP right	Methods to remove or limit the effect
Trademarks	A trademark registration shall not be effective against any third party that markets, distributes, acquires or uses the product to which the registered trademark is applied, after the relevant product has been lawfully introduced in the market and/or when an individual or entity applies his own name or its company or business name to goods or services and/or any third party that can prove an earlier use of an identical or confusingly similar trademark in Mexico to cover identical or similar products.
Trade names	
Slogans	
Appellations of Origin	When the subject right has not been used for a minimum period of 3 years before a non-use cancellation action is lodged before the Mexican Patent and Trademark Office.
Geographical Indications	

Copyright and other rights

IP right	Methods to remove or limit the effect
Copyright	Copyright could be limited a) if the author is mentioned in the quoting and does not represent a substantial reproduction; b) for scientific, literary or artistic investigation and security purposes; c) reproduction for private use; d) for using as evidence in an administrative or judicial procedure; e) for the use of disabled people with non-commercial purposes; f) for utility public service
Related rights	Related rights could be limited a) if the holder of the right is recognized and does not represent a substantial reproduction; b) for scientific, literary or artistic investigation and security purposes; c) reproduction for private use; d) for using as evidence in an administrative or judicial procedure; e) for the use of disabled people with non-commercial purposes; f) for utility public service.
Reservation of rights	Any third party that can prove an earlier use of an identical or similar reservation of rights.
Plant varieties	Plant varieties could be limited by a license in case of national security or public emergency.

31. What remedies (both interim and final) are available for infringement of each of the intellectual property rights described above?

Inventions

IP right	Interim remedy	Final remedy
Patents	1) Withdrawal from circulation the merchandise that infringes IP rights; 2) Stop the use and commercialization of infringing products; 3) Seizure of infringing goods; and 4) Closure of the establishment.	1) Fine 2) Temporary/permanent closure 3) Administrative detention 4) Infringement declaration 5) Stop the commercialization of the infringing products 6) Payment of damages
Utility models		
Industrial designs		
Integrated circuits		

**recovery available for successful parties?
Is there a procedural mechanism enabling or requiring security for costs?**

Enforcement Proceeding	Cost (approximately)
Invalidation actions	\$ 4,000 - \$ 6,500 USD
Cancellation actions	\$ 3,000 - \$ 5,500 USD
Infringement actions	\$ 4,500 - \$ 7,500 USD
Criminal actions	\$ 4,000 - \$ 8,000 USD

Brands

IP right	Interim remedy	Final remedy
Trademarks	1) Withdrawal from circulation the merchandise that infringes IP rights; 2) Stop the use and commercialization of infringing products; 3) Seizure of infringing goods; and 4) Closure of the establishment.	1) Fine; 2) Temporary/permanent closure; 3) Administrative detention; 4) Infringement declaration; and 5) Order to stop the commercialization of the infringing products 6) Payment of damages
Trade names		
Slogans		
Appellations of Origin		
Geographical Indications		

There are no costs recovery available in these proceedings, but only for civil actions related to copyright and related rights.

33. The Unified Patent Court ("UPC") [came into] [will come into] existence in certain European states on 1 June 2023, as did the introduction of European patents with unitary effect ("unitary patents"). Have industry-specific trends developed in your country in terms of the number of patent applicants seeking unitary patent protection and/or enforcing European patents or unitary patents before the UPC?

Copyright and other rights

IP right	Interim remedy	Final remedy
Copyright	1) Withdrawal from circulation the merchandise that infringes IP rights; 2) Stop the use and commercialization of infringing products; 3) Seizure of infringing goods; and 4) Closure of the establishment.	Within an administrative procedure, the final remedies available are the following: 1) Fine; 2) Temporary/permanent closure; 3) Administrative detention; 4) Infringement declaration; and 5) Order to stop the commercialization of the infringing products. On the other hand, if a civil action is initiated, the final remedies available would be the following: 1) Infringement declaration; 2) Order to stop the commercialization of the infringing products; 3) Order to pay damages; and 4) Order to pay litigation expenses.
Related rights		
Reservation of rights		
Plant varieties		

No. So far, the UPC has not impacted the trends in seeking patent protection in Europe.

32. What are the costs of enforcement proceedings and is any kind of costs

Contributors

Laura Collada
Managing Partner

lcollada@dumont.com.mx



Christian Thomae
Partner/Head of Trademarks

cthomae@dumont.com.mx



Victor Garrido
Partner/Head of Patents

vgarrido@dumont.com.mx

