Practical Law™
GLOBAL GUIDE 2015/16
IP IN BUSINESS TRANSACTIONS

IP in business transactions: Mexico overview

Begoña Cancino

Creel, García-Cuéllar, Aiza y Enriquez, SC

global.practicallaw.com/4-505-4689

OVERVIEW OF MAIN IPRS

1. What are the main IPRs in your jurisdiction? How are they protected?

Patents

The inventions protected under the Mexican IP Law are:

- Patents: protect novel, non-obvious inventions that are capable of industrial application. Patents are effective for 20 years from filing.
- Utility models: protect inventions that are novel and capable of industrial application. Utility models are effective for ten years from grant.
- Industrial designs: protect original and ornamental designs. Industrial designs are effective for 15 years from grant.

Patents (broadly speaking) are protected by federal law. Patents are based on examination and approval of an application. The ownership of an invention is determined by the principle that the first to invent is presumed to be the one who first reduced the invention to practice. An invention is eligible to achieve exclusive protection through a patent, if it is: novel, in relation to all previous developments in the field; non-obvious to a person of ordinary skill in the field (inventive step), and useful or ornamental, in the case of an industrial design (capable of industrial application).

According to the applicable law, the following matter is not patentable:

- Essentially biological processes for obtaining, reproducing and propagating plants and animals.
- Biological and genetic material as found in nature.
- Animal breeds.
- The human body and the living matter constituting it.
- Plant varieties.
- There are also a variety of items, products and processes that will not be considered inventions and therefore, should not be eligible to achieve patent protection.

Protection begins from the date the application is filed and is subject to payment of the appropriate fee. Government filing fees required by the Patent and Trade Mark Office (MPTO) for a standard application is about US$850.

Trade marks

Trade marks, understood as any visible sign used to distinguish products or services from others of the same type or category on the market, are protected by Federal Law and after obtaining the relevant certificate of registration issued by the MPTO. Prior use is also acknowledged as a matter of law. However, exclusivity can only be obtained through registration. Trade mark registrations are effective for a renewable term of ten years. The renewal must be filed within the six months before the end of each ten-year term of six months after, otherwise, the trade mark lapses.

The Industrial Property Law recognises other forms to protect distinctive signs such as "slogans" and trade names. Slogans, understood as all sentences or statements used to identify establishments, businesses, products or services, are protected through a certificate of registration the granting of which is regulated under the same legal provisions applicable to trade marks. Trade Names are understood as the name affixed to establishments. This is a kind of protection that establishes the owner's good faith in adopting and using the trade name in certain geographical area, it does not require registration but must be published in the Industrial Property Official Gazette (Official Gazette). The effects of a publication of a trade name last for ten years as of the filing date of the application and can be renewed for periods of the same duration, otherwise, the effects of the publication cease.

Copyright

Original intellectual creations in Mexico are protected under the author's rights classification. An author's rights include a set of moral and pecuniary rights that a creator of a work possesses from creating that work. There are two types of rights protected under author's rights:

- Moral rights or non-economic rights, which are recognised and perpetually protected for the benefit of an author.
- Copyrights or economic rights, which permit the exclusive use or exploitation of the protected work.

Registration of copyright is not compulsory and protection does not depend on registration. However, registration is necessary to enforce such rights.

Design rights

Industrial designs that are new and are of industrial application can be registered for a non-renewable period of fifteen years.

Trade secrets and confidential information

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

Additionally, the proprietor must have sufficient means, measures and safeguards to preserve the confidentiality. This may include restricting access to authorised parties by implementing passwords, limited access, encryption methods and similar procedures.

© This article was first published in the IP in Business Transactions Global Guide 2015/16 and is reproduced with the permission of the publisher, Thomson Reuters.
The law is stated as at 1 September 2015.

Other

The other IPRs that can be protected are:

- **Appellations of origin.** Industrial Property Law provides for the protection of appellations of origin. This is the name of a geographical region of the country that is used to designate a product originating from there and whose qualities or characteristics are due exclusively to the geographical environment, including both natural and human factors.
- **Layout designs of integrated circuits.** Industrial Property Law also provides for the protection of integrated circuits' three-dimensional arrangement, expressed in any form, of the elements, at least one of which is an active element, and some or all of the interconnections of an integrated circuit, or such a three-dimensional arrangement designed for an integrated circuit intended for manufacture.

MAINTAINING IPRS

Search and information facilities

2. What facilities are available to conduct IP searches and obtain IP information on registered IP rights?

Patents

The Patent and Trade Mark Office (MPTO) has three official websites for searching published applications and issued patents:

- Portal SIGA (*www.siga.com.mx*): for Official Gazette searches, circulation and electronic downloads.
- Portal VIDOC (*http://vidoc.impi.gob.mx/ViDoc*): for access to files including those related to administrative proceedings which decision has become final.

Any person intending to register a patent can access and obtain useful information on these websites before applying for the right. These tools can be useful to monitor existing patents, analyse freedom to operate and avoid infringement. The websites are also helpful to persons who wish to maintain patent rights and those who want to monitor the status of a patent application.

Trade marks

The MPTO has three official websites for searching trade mark applications, slogans and trade names:

- Portal SIGA (*www.siga.com.mx*): for Official Gazette searches, circulation and electronic downloads.
- Portal MARCANET (*http://marcanet.impi.gob.mx*): for trade mark, slogans and trade name searches.
- Portal VIDOC (*http://vidoc.impi.gob.mx/ViDoc*): for access to files including those related to administrative proceedings which decision has become final.

Copyright

Information held with the Mexican Copyright Office is not available in public databases and is limited to the written request of interested parties.

Design rights

See above, *Patents*.

Trade secrets

Due to the confidentiality of the information that constitutes trade secrets, such information is not publicly available.

Others

Files with the contents related to appellations of origin are more difficult to search as their contents are not available in a public tool. The interested party must review the official files directly at the MPTO's record room.

Maintenance of main IPRs

3. What steps must a business take to maintain the registration and legally protectable status of its main IPRs?

Patents

To maintain patents and avoid patent expiration, annuities must be paid to the Patent and Trade Mark Office (MPTO).

To avoid compulsory licence under the Intellectual Property Law (MIPL) patents must also be used. After three years starting from the date of granting the patent or four years from the filing date, whichever is later, any person can request MPTO to grant a compulsory licence. To obtain a compulsory licence an applicant must demonstrate that the relevant patent has not been used other than by justified reasons and that the applicant has the technical and economical capacity to produce the product or process covered under the patented invention. MPTO decides on the declaration of a compulsory licence after hearing the patent holder. Once the authority decides to grant a compulsory licence, it must set out, among other things, the royalties due to the patent holder as a consequence of the patent exploitation.

Trade marks

Trade marks are valid for ten years from the filing date and can be renewed for a similar term indefinitely. Requests for renewals must be filed six months before the expiration date or within a grace period of six months after the expiration date. Registration of a trade mark registration lapses if the holder does not request renewal.

To maintain trade mark registration, its holder must use it in accordance with the terms of the MIPL for the products or services for which it was granted. Otherwise, registration can be cancelled based on non-use (*MIPL*).

Under the MIPL, non-use for a period of three years can lead to the cancellation of the right if a third interested party initiates the relevant cancellation proceeding and the owner cannot prove trade mark use directly or through a registered licensee. If a trade mark is cancelled, it can be filed again by its previous owner. If there are no identical or similar trade mark applications or registrations obstructing its granting, it can be granted again. If its owner does not declare a date of first use, then the trade mark cannot be challenged on a non-use basis after a three-year term of its granting. The trade mark must be exploited as it was granted, without modifications that alter its distinctive character. Additionally, all trade marks can be cancelled if they lose their distinctiveness after becoming generic terms understood as those terms ordinarily used to design the specific product or services originally covered by the generic trade mark.

Copyright

See *Question 1, Copyright*.

Design rights

See *Patents*. Annual fees must be paid to MPTO to maintain design rights.

Trade secrets and confidential information

To protect a trade secret, the owner must handle such information as confidential and impose restrictions to its access setting up internal security measures. There are no legal provisions stating specific security measures.

Other

The protection afforded to an appellation of origin is determined by the existence of the grounds on which it was made. It ceases to be effective only by virtue of a declaration by the Institute of Industrial Property.

Monitoring infringement

4. What steps can a business take to avoid infringing another party's IPRs and to monitor whether another party is infringing its IPRs?

To avoid infringement and monitor whether other parties are infringing its IPRs a business can conduct periodic searches on the tools provided by the Patent and Trade Mark Office (*see Question 2*). Businesses can also perform independent investigations through external providers such as field investigations, research on different webpages, monitoring the main markets and so on, to detect possible infringements. Monitoring trade catalogues and other commercial sources is typically helpful.

EXPLOITING IPRS

5. What are the main steps in conducting an IP audit in your jurisdiction to determine the content of an IP portfolio?

Different searches on IPR holders can be made during an IP audit. The main steps in an audit are:

- Identify all issued IPRs owned by or licensed to the target and all innovations for which protection is pending.
- Review maintenance and the current status of the IPRs to determine if those rights remain valid.
- Review assignment records to determine if IPRs have been properly assigned and recorded on behalf of target, and if there are licences, liens or security interests involved.
- Conduct searches to determine freedom to operate to ensure if target IPRs are free of infringement claims. Documents and legal opinions should be reviewed to verify if contingencies exist and if there are upcoming deadlines that may affect IPRs.

ASSIGNMENT

Scope of assignment

6. On what basis can the main IPRs be assigned?

Patents

Patents can be assigned, either wholly or in part, in the terms and with the formalities set out in the Industrial Property Law.

Trade marks

See above, *Patents*.

Copyright

Acts, agreements and contracts by which economic rights are assigned must be in writing, temporary and for a consideration. If not in writing the agreements are considered null and void.

Any transfer of economic rights must provide for the grant to the author or to the owner of the economic rights, as applicable, of a proportional share in the proceeds from the exploitation concerned, or a predetermined, fixed amount of remuneration. That right cannot be waived.

In the absence of any express provision, any transfer of economic rights will be for five years. A term of more than 15 years can only be agreed in exceptional cases where dictated by the nature of the work or the scale of the required investment. The assignment of economic rights in connection with computer programs (software) is not subject to a specific term.

Design rights

IPRs can be assigned either wholly or in part in the terms and with the formalities set out in the Industrial Property Law.

See above, *Patents*.

Formalities for assignment

7. What formalities are required to assign each of the main IPRs?

Patents

Patent assignments must be recorded with the Patent and Trade Mark Office (MPTO) to be binding and effective vis-a-vis third parties. The transfer of rights must be in writing and include a specific designation of the serial number of the application and/or registration of the IPR that will be assigned, so as to be recorded with the MPTO. A single submission for registration can be made where there is more than one transfer of ownership or where there are two or more patents or registrations if the transferor and the purchaser are the same in all of them. Either the assignor or the assignees can record the assignment agreement with the MPTO. The submission must identify each of the applications, patents or registrations. Fees may be payable depending on the number of applications, patents and registrations involved.

Trade marks

See above, *Patents*.

Copyright

Acts, agreements and contracts by which economic rights are transferred must be in writing, temporary and for a consideration. If not in writing the agreements are considered null and void.

Design rights

See above, *Patents*.

Trade secrets and confidential information

Acts, agreements and contracts by which trade secrets are transferred must be in writing, mainly to specify the terms on which the assignor will commit to preserve such information in confidence after the assignment. As there is no registration system, those agreements are not recorded.

Other

The right to use an appellation of origin can be transferred by the authorised user in accordance with the provisions of Mexican legislation. Any such transfer will be effective only from the time of its registration with the MPTO, after proof is given of the new user meeting the conditions and requirements laid down in the Intellectual Property Law for granting the right to use the appellation of origin.

Main terms for assignments

8. What main terms should be included in an assignment of IPRs?

Assignments must include the specification on the IPRs to be assigned (application or registration serial number), assignor and assignee, the scope of assignment and the consideration for the assignment. The consideration can remain confidential for the assignment of patents, trade marks or patent designs but it must be included for the transfer of copyrights.

LICENSING

Scope of licensing

9. On what basis can the main IPRs be licensed?

Patents

Patents can be licensed or sub-licensed, either wholly or in part, exclusively or non-exclusively. They can be limited as to time and or field of use.

Trade marks

See above, *Patents*

Copyright

Only economic rights can be licensed, either holly or in part, exclusively or non-exclusively.

Design rights

See above, *Patents*

Trade secrets and confidential information

See above, *Patents*

Formalities for licensing

10. What are the formalities to license each of the main IPRs?

Patents

Patent applications or registrations can be licensed or sub-licensed, exclusively or non-exclusively, in whole or in part, through a written agreement. The term of a patent licence agreement is usually linked to the validity of the patent that is licensed. Licence agreements must be registered with the Patent and Trade Mark Office (MPTO) to be effective *vis-a-vis* third parties. A single submission for registration can be made where there is more than one IPR sought to be licensed and both licensee and licensor are identical. The submission must identify each of the applications, patents or registrations that will be licensed. Fees are payable depending on the number of applications and registrations involved. Either the licensor or the licensees can record the licence agreement with the MPTO. However, both parties must request cancellation of the licence.

Trade marks

See above, *Patents*.

Copyright

Acts, agreements and contracts by which economic rights are licensed must be in writing, temporary and for a consideration. If not in writing the agreements are considered null and void.

Any licence of economic rights must provide for the grant to the author or to the owner of the economic rights, as applicable, of a proportional share in the proceeds from the exploitation concerned, or a predetermined fixed amount of remuneration. That right cannot be waived.

In the absence of any express provision, any licence of economic rights is for five years. A term of more than 15 years can only be agreed in exceptional cases where dictated by the nature of the work or the scale of the required investment. The licence of economic rights in connection with computer programs (software) is not subject to a specific term.

Design rights

See above, *Patents*.

Trade secrets

Acts, agreements and contracts by which trade secrets are licensed must be in writing, mainly to specify the terms on which the licensee will commit to preserve such information in confidence during the licensing period and afterwards. As there is no registration system, those agreements are not recorded.

Main terms for licences

11. What main terms should be included in an IP licence?

Licences must include the following:

- Specifications of the IPRs to be assigned (application or registration serial number).
- Licensor and licensee.
- Scope of the licence (that is, the goods or services for which the licence is granted, field of use, specific rights subject to license (use, make, sell, offer for sale or import)).
- Term of the agreement.
- Whether it is an exclusive or non-exclusive licence.

Whether the licensor will be entitled or not to bring legal action for the protection of the IPRs to which the licence agreement relates and the consideration for the licence must also be included. The consideration can remain confidential when it comes to the license of patents, trade marks or patent designs but it should be expressed when it comes to the license of copyrights.

Optionally, the licence can contain record keeping, audit rights, indemnification, warranties of title, force majeure provisions, arbitration or dispute resolutions, change of control provisions. For an exclusive licence, whether it includes best efforts, milestones and minimum payments can be included.

TAKING SECURITY

12. What are the key issues in taking security over the main IPRs?

IPRs (either applications or registrations) are typically assigned as security, except for copyrights (*see Question 13*). Depending on the terms of the relevant agreement, the security can restrict the IP owner in asserting, selling or licensing the secured IPRs, until the security is released. The lender is compelled to maintain IPRs secured in full force during the term of the agreement and must keep using those IPRs in order to avoid their cancellation on a non-use basis.

13. What are the main security interests taken over IPRs?

Security interests can be granted in each of the IPRs except for copyrights. For copyrights, the owner of economic rights can only secure the benefits from their exploitation. Moral rights cannot be secured. IPRs security agreements must be in writing and registered with the Patent and Trade Mark Office in order to be effective *vis-a-vis* third parties.

M&A
DUE DILIGENCE

14. What IPR-related due diligence is commonly carried out in both a share sale or merger and an asset sale?

In general terms, the due diligence is performed to detect the scope of the IP assets, their value and related liabilities.

Share sale or merger

In transactions involving share sales or mergers, it is advisable to analyse the IPRs within the context of the business. In this regard, the following documents related to the target and its affiliates are typically reviewed: relevant documents, articles of incorporation, bye-laws and outstanding securities.

It is also important to, among other things:

- Identify the most important products or services (in terms of their sales) and suppliers,
- Confirm ownership and in or out licences.
- Review releases from employees who develop internal IPRs.
- Review internal IP policies and operations including quality standards compliance with applicable regulations on IP matters and advertising.
- Review import/export permits of labelled products, warning letters or legal opinions from inside/outside counsels reflecting potential liabilities.

Asset sale

In transactions involving asset sales, the analysis is focused on the IPRs used (either owned or licensed) by the target and its affiliates. It is crucial to identify those assets, review the file history (confirm ownership, maintenance payments, release of any encumbrances, if applicable).

For assignments or licences, it is important to, among other things:

- Confirm that they have been properly executed and registered with the relevant authorities.
- Confirm that all assets are properly used, that is:
  - check that patents are used in accordance with the written description;
  - check if there are unregistered IPR in use and if so check if there may be third party rights that can be asserted against the target.

WARRANTIES/INDEMNITIES

15. What IPR-related warranties and/or indemnities are commonly given by the seller to the buyer in both a share sale or merger and an asset sale?

Share sale or merger

The seller commonly warrants the ownership of stock, that it has complied with applicable laws and regulations and has timely paid royalties and annuities for the maintenance of IPRs. The buyer warrants corporate matters and having the consents required to enter into the transaction.

Asset sale

The seller typically warrants that the target is properly organised, identifies all IPRs either owned or licensed by the target in its ongoing business activities. The seller also warrants that:

- IPRs are free and clear of any liens and encumbrances and that no infringements or warning letters have been received by seller.
- There are no litigation or contested proceedings.

He also identifies commitments, licences and agreements affecting the IPRs.

The buyer warrants corporate matters and having the consents required to enter into the transaction.

Transfer of IPRs

16. How are the main IPRs transferred in both a share sale or merger and an asset sale?

Share sale or merger

In a share sale or merger the assets are not transferred directly. Typically, the target changes its corporate name as a result of the transaction. The change must be registered with the Patent and Trade Mark Office (MPTO) to be effective vis-a-vis third parties. In addition, all IP agreements executed by the target should be reviewed in order to ensure that there is no change of control provisions that could affect their validity once the change of name is recorded.

Asset sale

For the IPRs to be transferred in an asset sale it is necessary to execute an assignment agreement and register that agreement with the MPTO so as to be binding. It is also recommendable to review all IP agreements executed by the target to ensure that there is no change of control provisions that can affect their validity once the assignment is recorded. Identical or confusingly similar trade marks owned by the same person will be considered linked and for purposes of their assignment the owner must transfer all or break the link so the transfer can be effective (Intellectual Property Law (MIPL)). Breaking the link is provided in the MIPL but requires an intense lobbying with MPTO authorities, under the criteria that co-existence is only allowed when the trade marks are owned by the same person and come from the same source. The linkage provision becomes an issue in asset sales where the seller preserves part of the trade marks for its own business. The link issue only applies to trade marks, slogans and trade names.

JOINT VENTURES

17. Is it common for companies to set up joint ventures in your jurisdiction to develop projects that heavily involve IPRs?

Joint ventures are becoming more popular due to the high risks involved in research and development. A joint venture agreement usually contains the following IP-related provisions:

- Scope of venture.
- Titles and IPRs registrations (obtained directly by the venture) assigned or licensed to the venture as a contribution of one or both parties.
- Rules for using those IPRs.
- Dispute resolution.
- Non-compete and non-disclosure provisions (which are difficult to enforce in Mexico).
- Termination.

COMPETITION LAW

Main provisions and common issues

18. What are the main provisions of your national competition law that can affect the exploitation of the main IPRs?

The Economic Competition Federal Commission is the federal authority that enforces competition law to guarantee fair competition and prevent monopolistic practices. Under the Constitution of the United Mexican States, all privileges granted for a specific period of time to authors or inventors for the exclusive use of their works of authorship and inventions do not constitute monopolies. Therefore, the provisions of competition laws do not affect the exploitation of main IPRs. The Industrial Property Law provides that activities of unfair competition constitutes administrative infringements, which may be sanctioned with fines and the closure of the commercial premises owned by the infringer.

19. What are the most common national competition law issues that arise in the exploitation of the main IPRs?

IPRs are subject to the restrictions of the applicable IP law and copyright law. The most common issues are misuse of IPRs and unfair competition. For certain licensing and settlement practices, non-compete clauses including the prohibition to use certain trade marks or inventions, will be void, as it may be interpreted as a violation to the individual right to perform a work or activity.

Main provisions and common issues

20. What exclusions or exemptions are available for national competition law issues involving the exploitation of the main IPRs?

The enforcement of IPRs are subject to the restraints of IP Laws and no exceptions or exclusions apply.

ADVERTISING

21. To what extent do advertising laws impact on the use of third party trade marks?

False and misleading advertising constitutes administrative infringement under the Industrial Property Law. Comparative advertising is permitted and will not fall into the hypothesis of administrative infringement as long as it does not cause confusion, mistake or deception among consumers. Relevant claims are filed and prosecuted before the Patent and Trade Mark Office. The Federal Consumer protection law clarifies what would be considered as false advertising however it does not make any reference at all to IPRs.

EMPLOYEES AND CONSULTANTS

22. Who owns each of the main IPRs created by an employee in the course of his employment? Must compensation be paid to the employee? What main steps can an employer take to ensure it owns each of the main IPRs?

Ownership

The Federal Labour Law provides that the employer owns the IPRs on all inventions developed by employees within the scope of employment, as long as the development of the inventions constitutes the purpose of the employment relationship. This is when employees are engaged in research or improvement of the procedures used in the company, the ownership of the invention and the right to exploit them belongs to the employer. In all other cases (that is, inventions developed by employees without having such responsibility provided in the employment contract using the employer's resources) the proprietary rights associated to the invention belong to the employee; the employer only has a right of first refusal if the employee decides to assign the right to file the patent/design application or the corresponding patents, design registrations or patents/design applications.

A trade mark is owned by the person who applies for and obtains the registration, whether a natural or legal person.

Copyright is owned by the author who first reduced the work to a tangible medium of expression (unless it is a work made for hire). This is always a natural person except for software, for which authorship can be attributed to a legal entity.

Trade secrets can be owned by individuals or legal entities who use the secret to obtain some commercial advantage and maintain it in confidence.

Compensation

Payment is determined contractually by the interested parties. Otherwise and in case of controversy, the court has the final decision within the context of litigation.

The employee has the right for an additional compensation only if the invention benefits the employer in such a way that the regular wage of the employee is not proportioned with said benefit (*Federal Labour Law*). Compensation must be independent of his regular remuneration.

Main steps

Employment agreements typically require employees to assign patent rights to the employer. As a condition of engagement, external consultants should be required to assign patent rights to the business retaining them.

Copyright can also be a work for hire, or can be assigned. Works made by employees in the regular course of their employment are not considered works made for hire.

Trade secrets can be assigned. As a condition of employment or contractual provisions with independent contractors, either employees or independent contractors should be required to sign an agreement setting out their obligations to assign and maintain the trade secrets in confidence.

23. Who owns each of the main IPRs created by an external consultant? What main steps can a business take to ensure it owns each of the main IPRs?

Ownership

Businesses that use consultants to develop IPRs should include in their consulting agreements provisions defining who owns the IPRs and specifying the consultants' obligations to transfer and assist in perfecting IPRs.

See *Question 22, Ownership*.

Main steps

See *Question 22, Ownership*.

TAX

24. What are the main taxes payable by a licensor on the licensing of the main IPRs?

The main taxes payable are income tax and value added tax (VAT) and the rates are:

- Income tax: legal entities pay up to 30% of tax profits; individuals pay from 2% to 35% depending on the revenues received.
- VAT: legal entities and individuals pay 16% depending on the royalties in each case.

25. What are the main taxes payable by a seller on the sale of the main IPRs?

The main taxes payable are income tax and value added tax (VAT) and the rates are:

- Income tax: legal entities pay up to 30% of tax profits; individuals pay from 2% to 35% depending on the revenues received.
- VAT: legal entities and individuals pay 16% depending on sales revenues.

CROSS-BORDER ISSUES

26. What international IP treaties is your jurisdiction party to?

Mexico is a party to the following:

- World Intellectual Property Organization (WIPO) Convention, since June 1975.
- Paris Convention (Industrial Property), since September 1903
- Berne Convention (Literary and Artistic Works), since June 1967.
- Patent Cooperation Treaty, since January 1995.
- Nice Agreement (International Classification of Goods and Services), since March 2001.
- Lisbon Agreement (Appellations of Origin), since September 1966.
- Locarno Agreement (International Classification for Industrial Designs), since January 2001.
- Strasbourg Agreement (International Patent Classification), since October 2001.
- Rome Convention (Performers, Producers of Phonograms and Broadcasting Organizations), since May 1964.
- Geneva Convention (Unauthorized Duplication of Phonograms), since December 1973.
- Vienna Agreement (International Classification of the Figurative Elements of Marks), since January 2001.
- Brussels Convention (Distribution of Programme-Carrying Signals Transmitted by Satellite), since August 1979.
- Budapest Treaty (Deposit of Micro-organisms), since March 2001.
- Nairobi Treaty (Olympic Symbol), since May 1985.
- WIPO Copyright Treaty, since March 2002.
- WIPO Performances and Phonograms Treaty, since May 2002.

Mexico is a member of the following:

- World Trade Organization: member and signatory to the TRIPS Agreement since January 1995.
- Asia-Pacific Economic Cooperation, since November 1993.
- G3 Free Trade Agreement (between Mexico, Colombia and Venezuela), since December 1994.
- North Atlantic Free Trade Agreement, since January 1994.
- Universal Copyright Convention UCC, since February 1957.
- International Union for the Protection of New Varieties of Plants, since August 1997.

A detailed list of treaties can be found at *www.wipo.int/wipolex/en/profile.jsp?code=MX*.

27. Are foreign IPRs recognised in your jurisdiction?

Patents

Mexico is a signatory to many international treaties (*see Question 26*) and must therefore recognise foreign IPRs. This recognition is mainly related to the priority date in connection with the filing date in the country of first filing.

Patent applications must be filed within the periods specified by international treaties, or within 12 months of the application for a patent in the country of origin

Trade marks

For trade mark priority to be recognised, the application in Mexico must be filed within the periods specified in international treaties, or within six months as from the filing of applications in other countries.

Copyright

For copyrights, foreign authors or owners of rights and their successors in title have the same rights as nationals by virtue of international treaties on copyright and neighbouring rights signed and ratified by Mexico.

Design rights

See above, *Patents*.

Trade secrets and confidential information

See above, *Patents*.

Other

See above, *Patents*.

REFORM

28. Are there any proposals for reform?

There are currently no proposals for reform.

ONLINE RESOURCES

Patent and Trade Mark Office

W www.impi.gob.mx

Description. Official website of the Mexican Patent and Trade mark Office, which contains information on trade marks, patents, design registrations and enforcement of IPRs. The information may not be accurate or up-to-date.

Copyright Office

W www.indautor.gob.mx

Description. Official website of the Mexican Copyright Office, which contains information on copyrights.

Practical Law Contributor profile



Begoña Cancino, Partner

Creel, García-Cuéllar, Aiza y Enriquez, SC
T +52 55 4748 0679
F +52 55 4748 0690
E begona.cancino@creel.mx
W www.creel.mx

Professional qualifications. Mexico, Lawyer, 2001

Areas of practice. Intellectual property; entertainment, data privacy and administrative litigation.

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

Recent transactions

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

Languages. Spanish, English

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

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