

INFORMATIVE BULLETIN

Reforms to Mexican Industrial Property Law

On March 13, 2018, new amendments to the Industrial Property Law were published, which became effective as of April 27 of this year.

Also, on April 26, new official tariffs were published, which were modified in accordance to the Industrial Property Law amendments.

The most important changes derived from the new reforms are the following:

INDUSTRIAL DESIGNS:

- Validity: Previously the registration of an Industrial Design was valid for 15 years, now with the new reforms, the registration will be valid for five years which may be renewed for periods of the same duration, establishing a maximum term validity of 25 years. **(Art.36)**

The renewal of industrial design must be done six months before the expiration term, or within six months after the expiration term, this last term will be definitive. **(Art. 36 BIS)**

- The concepts of "independent creation" and "significant degree" are included, which are related to the requirement of novelty that must comply by industrial design to be subject to protection. **(Art. 32 BIS)**

- The creator of an industrial design is recognized as the designer.

It is recognized the designer right to be mentioned with such personality inside the design application and in the corresponding title, this right is unrenounceable. **(Art. 13)**

- It is ordered the publication in the Industrial Property Gazette the industrial design and utility model applications, once that they have passed the form examination. **(Arts 30 BIS and 37 BIS)**

- It is ordered the publication of divisional applications for patents, utility models and industrial designs in the Industrial Property Gazette. **(The last paragraph of Art. 44 was eliminated, which expressly stated that divisional applications would not be published).**

- For the industrial designs applications that be in process and have been filed before the Law reforms, the applicants can decide for applying for the new dispositions,

for which, must be filed a letter within thirty working days after its entry into force, this period expires on **June 11, 2018. (second Transitory, first paragraph)**

In the aforementioned situation, the Patent Office may request to the applicant by just one time, the replacement of the documentation, complementation of missing information, clarification or correction of omissions, which will be necessary in the process for adapting the application to the reforms. **(Second Transitory, second paragraph)**

- The industrial designs registrations that have been previously granted and that be in force, will keep the original validity until their expiration (15 years subject to the payment of the corresponding annuities). Six months before the expiration of the original term, can be requested the renewal of the registration for a subsequent period of five years, without exceeding the 25 years term. **(third and fourth Transitories)**

- The archives of patent applications, utility model registration and industrial design registration published in the Industrial Property Gazette can be consulted by any person. **(Article 186)**

As an exception, third parties are allowed to consult the archives of patent applications, utility model registrations or industrial design registrations, before its publication in the Industrial Property Gazette, only if said files be cited by another applicant or when they are offered as evidence in an administrative declaration procedure, observing the necessary procedures to preserve confidentiality. **(Article 186)**

PATENTS

- It is reduced the term from 6 to 2 months so that the Patent Office receives information from third parties against a patent application. **(Art. 52 BIS)**

APPELLATIONS OF ORIGIN AND GEOGRAPHICAL INDICATIONS:

Appellation of origin:

- The definition of the appellation of origin is modified, establishing a broader concept under the geographical zone expression, being as follows:

Concept: Appellation of origin is understood as the name of a geographical zone or that contains said name, or another name known to refer to said zone, which serves to designate a product as originating therein, when the quality or product characteristics are due exclusively or essentially to the geographical environment, including natural and human factors, and that have given to the product its reputation. **(Article 156)**

Geographical indication:

- The protection of geographical indications is included, and the following definition is established: Geographical indication means the name of a geographical zone or that contains said name, or another indication known to refer to said zone, which identifies a geographical indication product as originating from it, when certain quality, reputation or

other characteristic of the product is attributable fundamentally to its geographical origin. **(Art. 157)**

- It is established the obligation to use the appellation of origin or protected geographical indication, as it appears in the corresponding declaration, as well as to apply the legend "Protected Apellation of Origin" or "Protected Geographical Indication" or the acronym "D.O.P" or "I.G.P", as applicable, to the products covered by them. **(Article 165 BIS 18)**

APPELLATION OF ORIGIN AND GEOGRAPHICAL INDICATIONS PROTECTED ABROAD

- It includes the registration process of appellations of origin or geographical indications protected abroad, in terms of International Treaties, which must be requested by the owner thereof. **(Art. 166)**

Once registered the appellation of origin or geographical indication, it will be published in the Official Gazette of the Federation. The owner of the appellation of origin or protected geographical indication abroad, may exercise the legal actions that correspond to the illegal use thereof. **(Articles 175 and 176)**

- The registration of recognition for an appellation of origin or protected geographical indication abroad will cease to have effects by **(Article 178):**

I.- Nullity, in any of the following cases:

- a) When granted in contravention of the provisions of this Act, and
- b) When granted based on false data and documents.

II.- Cancellation, when the document by means of which the protection has been granted to the appellation of origin or geographical indication, according to the applicable legislation of the country of origin or according to the International Treaties, has ceased to have effects in the country of origin.

INFRACTIONS AND CRIMES:

In order to fortify the protection of appellations of origin and geographical indications, behaviors related to appellations of origin and geographical indications are included in the catalog of infractions and crimes.

Infractions:

Article 213: ...

XXX.- To use an appellation or indication identical or similar in degree of confusion to an appellation of origin or national geographical indication protected or foreign geographical indication protected recognized by the Institute, to protect the same or similar products. It is included in this assumption, the use of the appellation or indication in services;

XXXI.- To use the translation or transliteration of an appellation of origin or national protected or foreign geographical indication recognized by the Institute, to protect the same or similar products. It is included in this assumption, the use of the appellation or indication in services;

XXXII.- To produce, store, transport, distribute or sell products identical or similar to those that are protected by a protected or foreign national designation of origin or geographical indication recognized by the Institute, using any type of indication or element that creates confusion in the consumer about its origin or quality, such as "gender", "type", "manner", "imitation", "produced in", "with manufacturing in" or similar, and

Crime:

- The following is included as a crime:

Article 223: ...

Fraction VII.- To produce, store, transport, distribute or sell products of national origin that do not have the corresponding certification according to the appellation of origin or geographical indication and the corresponding Official Mexican Standard, with the purpose of obtaining an economic benefit for itself or for a third party.

It is included in the previous case, to perform any act of customs clearance before the competent authorities, for the introduction to the country or leaving thereof.

There will not criminal responsibility when the corresponding Official Mexican Standard is not in force or the respective conformity assessment entity is not accredited, in terms of the applicable legislation.

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