
MEXICO



In the framework of the commitments undertaken through the Trade Agreement between the United States, Mexico and Canada (USMCA), the Federal Law for the Protection of Intellectual Property was approved on 1 July, 2020.

This new Law comprises 410 articles and 18 transitional provisions and will enter into force on 5 November 2020, repealing the current Intellectual Property Law.

Some of the most significant changes in relation to the recently published Federal Law for the Protection of Intellectual Property are the following:

GENERAL CHANGES

- Definition of the applicable supplementary rules and the manner in which their supplementary provisions should apply, particularly the Federal Law on Administrative Procedure and the Federal Code on Civil Procedure.
- Extension of powers of the Mexican Institute of Intellectual Property (IMPI) in unfair competition proceedings, as well as in the determination of fines with respect to compensation for damages in cases of Intellectual Property rights infringement.
- Regulation of the public nature of Intellectual Property rights. The prosecution will be open for public consultation once the application has been published in the Official Gazette, with the exception of those applications that are confidential.
- The inter-institutional relationship between the Mexican Institute of Intellectual Property (IMPI) and the Health Agency (COFEPRIS) is regulated, with the biannual publication in the Gazette of the list of patents related to inventions that can be used in allopathic medicines.
- The various pending Intellectual Property categories as well as administrative declaration procedures shall proceed according to the Intellectual Property Law that is repealed as they were all initiated under that law.



PATENTS

- The patent protection term adjustment is implemented and may be applied where there is an unreasonable delay due to the IMPI of more than five years between the filing date of the application in Mexico and the grant of the patent, at the request of the applicant.

The period shall be adjusted one day for every two days of an unreasonable delay and may not last for more than five years.

- Divisional applications must contain subject-matter that is different from the original application.

A divisional application may not be the source for voluntary divisional applications. A divisional application may only result from another divisional if requested by IMPI because the unity of invention requirement is not fulfilled.

If an invention was left unclaimed in the divisional application, such invention may not be reclaimed in the original application or in the application in respect of which it is divisional.

After communicating the grant of the patent, the applicant has two months to voluntarily divide the original application.

- The concepts of Article 4 of the Paris Convention concerning the right of priorities and of the PCT concerning the withdrawal of the right of priority during

the international phase are expressly incorporated.

- The possibility of the patentability of new uses of substances or compositions that are part of the state of the art is expressly included.
- The right conferred by a patent shall not be effective against a third party who manufactures, offers to sell or imports a patented product to exclusively generate the experimental information needed to acquire regulatory approvals for medicines (Bolar exemption).
- Only voluntary amendments will be accepted before issuing the decision on whether to allow or reject the grant of the patent.
- Exclusively voluntary amendments for restricting subject-matter, eliminating claims or including dependent claims.

No amendment to granted subject-matter will be accepted if there is an active pending procedure relative to the validity of the patent or registration.

If the administrative declaration is entered on record after the application for amendment, the declaration procedure shall be suspended until it is decided whether or not the claims may be amended.

- Partial invalidations of granted subject-matter may be declared after an administrative procedure.



UTILITY MODELS

- A non-extendable 15-year term is established from the filing date of the application (it used to be 10 years).

TRADEMARKS

- 10-year protection term from the grating date (it used to be from the filing date).
Renewal shall therefore be as from the date of grant, maintaining the possibility to renew six months before the due date and six months after the term has expired.
- Registrations of trademarks granted prior to 10 August 2018 shall maintain their term and, upon renewal, the title must be renewed and simultaneously file a declaration of real and genuine use of the goods and services covered under the same.
When use of a trademark is not declared, the Institute shall request the applicant to rectify the oversight in a period of two months. Should the applicant not fulfill the request made within the mentioned period, the registration shall fully expire.
- Partial revocations may be declared for trademark registrations in respect to the goods or services that are not used.
- It is mandatory to respond to any opposition that may be filed. A trademark applicant shall have a period of two months to respond, and this period may be extended for two further months. If the applicant does not reply to the opposition, the application shall be considered as abandoned. Before, it was not mandatory to reply to oppositions.
- A request for the administrative declaration of invalidity shall not be allowed where opposition was previously filed and the arguments are the same as those filed in the opposition, it shall be considered *res judicata*.

The period for filing allegations in the administrative declaration procedure is extended from two to five days.

Partial invalidity of the registration may be declared, but only relating to part of the goods or services protected under the trademark.

The prosecution of a trademark application may be suspended *ex officio* or at the request of one of the parties involved in the procedure, when an administrative or judicial declaration of invalidity, revocation or cancelation with respect to the earlier trademark is pending.

We will keep you informed of the interpretation and implementation of this new Law and clarify any questions you may have.