



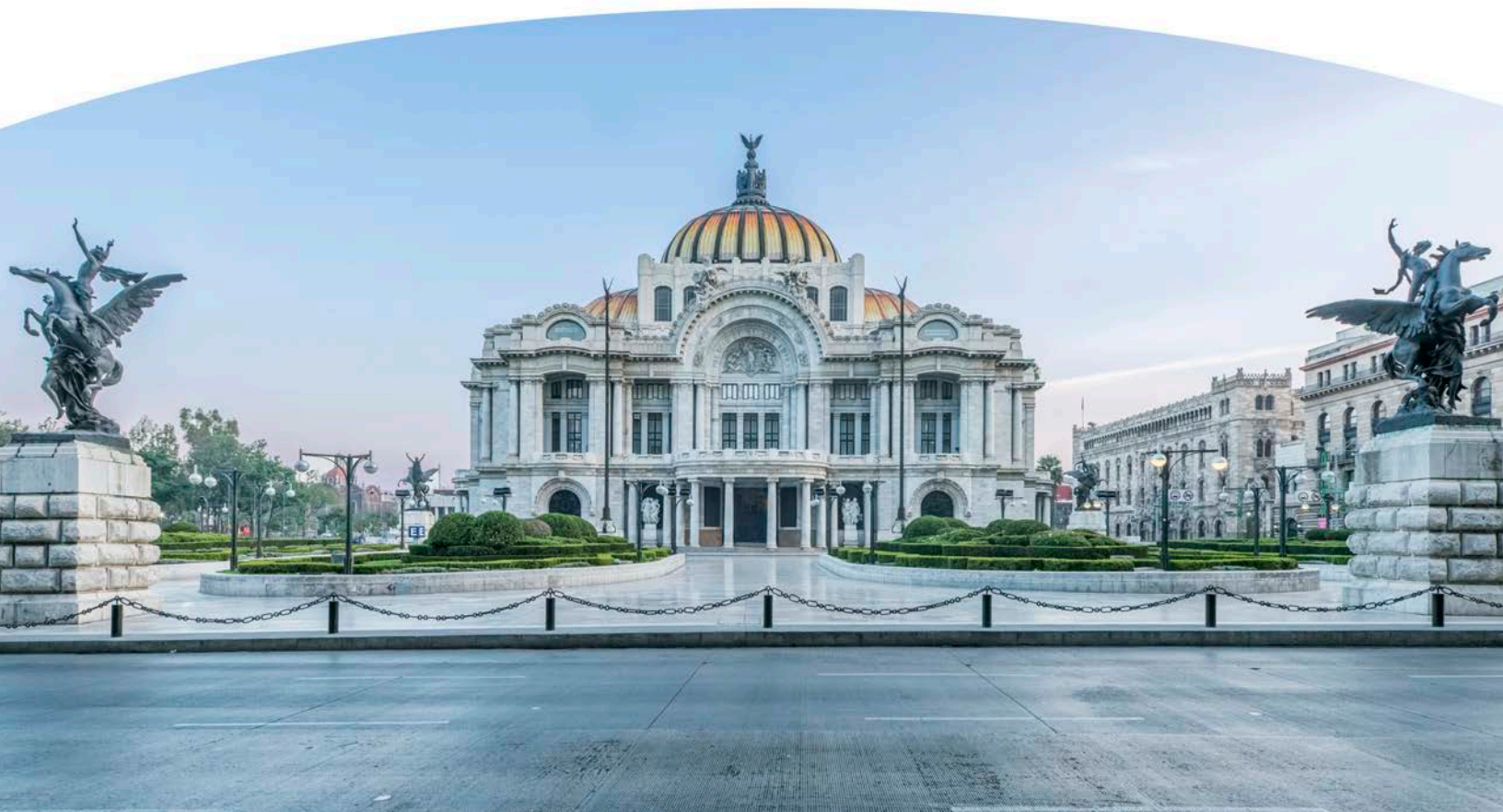
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DOING BUSINESS ABROAD

# Protecting your IP in Mexico



Canada

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DOING BUSINESS ABROAD

# Protecting your IP in Mexico

	<b>Doing business abroad: Protecting your IP in Mexico.....</b>	<b>5</b>
	<b>Where is IP registered?.....</b>	<b>7</b>
	Trademarks	
	Patents	
	Industrial designs	
	Copyright	
	<b>IP enforcement.....</b>	<b>11</b>
	<b>Tips: Important notes.....</b>	<b>12</b>





DOING BUSINESS ABROAD

# Protecting your IP in Mexico

**Intellectual property (IP)** is a valuable asset that can support your business expansion abroad. A Canadian patent, trademark or industrial design does not secure your rights outside Canada. You should consider obtaining IP protection in the countries where you plan on doing business, including selling products online or manufacturing products overseas.

Canada and Mexico are major trading partners, and there are a significant number of business, trade and investment ties between both countries. It is therefore important to know how to recognize, register and enforce your IP rights in Mexico. For the most part, the protection and registration process for IP in Mexico is similar to that in Canada. However, there are certain differences that you should familiarize yourself with by reading this guide.

In Mexico, you can apply for patent, trademark, industrial design and copyright protection. If you wish to enter the Mexican market or are already doing business in Mexico, you should apply to protect your IP rights as soon as practically possible.



## TERMINOLOGY

In Mexico, the term “industrial property” is used to refer to patents, trademarks and industrial designs.





# Where is IP registered?

**The Mexican Institute of Industrial Property (IMPI)** is the decentralized agency responsible for the administration and registration of patents, trademarks and industrial designs. Copyright is granted through the National Institute of Copyright (INDAUTOR).

Applications for patents, trademarks and industrial designs can be filed electronically at [www.gob.mx/impi](http://www.gob.mx/impi) (in Spanish only), and copyright applications can be filed at [indautor.gob.mx](http://indautor.gob.mx) (in Spanish only). Both websites also have online searchable databases. A good first step is to search existing IP to check whether your anticipated IP use may conflict with or infringe on someone's prior rights. A Canadian IP professional may be able to coordinate work with an IP professional in Mexico.

## Trademarks

- Mexican trademarks may consist of names, letters, numerals, figurative elements, holographic signs, 3-dimensional shapes, sounds, scents, the plurality of operating elements, image elements (including the size, design, colour, layout form, label, packaging and decoration) or any other elements that, when combined, distinguish goods or services in the market.
- Trademark applications must be filed directly with the IMPI. The application process may vary from 3 to 8 months, based on whether you submit your application on paper or online. The process may last up to 18 months if an opposition is filed.
- The term of protection of a trademark is 10 years from the filing date. Protection may be renewed indefinitely every 10 subsequent years as long as the trademark continues to be used.
- In Mexico, an owner of a trademark must file a Declaration of Use stating that the mark has been used as a trademark within Mexico after 3 years from the registration date. This declaration must be filed within the first 3 months after 3 years have elapsed since registration.
- As in Canada, if your trademark remains unused in Mexico after the 3 years following registration, it may be challenged for non-use. If you receive a challenge for non-use, you must prove that you have used the trademark during the 3 years following registration. If you are unable to do so, your trademark may be expunged from the trademark register.
- Similar to Canada, Mexico is a signatory to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

Through this agreement, trademark owners can file for protection in all the participating countries, including Mexico and Canada, through a single international application.

- Mexico follows a “registration” and “first-to-use” system for trademark rights. This means that any natural person may use a trademark in association with their goods and services without registration, but the right to exclusive use may only be obtained by registration.
- Research to ensure your mark is not currently being used by a third party in Mexico. If someone has been using a similar mark in good faith before your filing date, your registered trademark may not be effective.
- IMPI uses the Nice Classification system, which is used to classify goods and services according to internationally agreed-upon categories. This system simplifies the process of drafting trademark applications.
- Since Spanish is the official language in Mexico, consider protecting the Spanish translations of your trademark as well.
- For **more information** on trademarks and applying for trademark registration, visit [www.gob.mx/impi](http://www.gob.mx/impi) (in Spanish only).

## Patents

- A patent is a legal right to prevent others from making, using or selling your invention. Patents are granted only for inventions, which are defined as new technical solutions or improvements to existing products or processes. You can patent products, processes, machines, chemical compositions and improvements to or new uses of any of these.
- If your invention is an improvement over an existing invention, consider filing an application for a utility model as well. You can obtain a

utility model registration for an invention that is a minor improvement to an existing product. Unlike with patents, you don't need to demonstrate “inventiveness” for a utility model.

- Generally, the application process in Mexico takes up to 3 years. You may pay additional annual maintenance fees to maintain protection of your patent.
- There are 2 ways to file an application: send it directly to the IMPI or apply through the Patent Cooperation Treaty (PCT).
- Mexico has a “first-to-file” system, which provides patent protection to the first applicant to file an application for an invention.
- Similarly to Canada, Mexico allows for a 1-year grace period for inventors to file their patents. Therefore, if an inventor publicly discloses their invention, there is a 1-year period from the time of disclosure until the invention is considered as part of the public domain.
- The Global Patent Prosecution Highway may be used by Canadian applicants to speed up the examination process for corresponding patent applications filed in Mexico.
- It is important to use your patent, because someone may apply for a compulsory license after 4 years from the filing date of the patent on the basis of non-use, and you will need to provide justification for the lack of use.
- For **more information** on patents and applying for patent protection in Mexico, visit [www.gob.mx/impi](http://www.gob.mx/impi) (in Spanish only).

## Industrial designs

- In Mexico, industrial designs refer to the appearance of a product in particular: the lines, contours, figures, colours, shape, pattern, texture and/or materials of the product.

- Generally, the application process takes up to 1 year.
- The term of protection for an industrial design is 5 years from the date of filing. The protection may be renewed every 5 years for a maximum of 25 years from the filing date, as long as applicable fees are paid.
- As with the patents process, an inventor who publicly discloses their design has a 1-year grace period from the time of disclosure to file an industrial design.
- Industrial design protection is administered by the IMPI under the authority of the *Industrial Property Law*. Design protection is under a “first-to-file” system.
- It is important to note that foreign applicants are not required to be represented by a Mexican patent attorney or agent. However, the applicant must provide an address to receive notifications in Mexico.
- For **more information** on industrial designs and industrial design registration in Mexico, visit [www.gob.mx/impi](http://www.gob.mx/impi) (in Spanish only).
- For **more information** on copyright and copyright registration in Mexico, visit [indautor.gob.mx](http://indautor.gob.mx) (in Spanish only).

## Copyright

- In Mexico, as in Canada, copyright is the exclusive legal right to produce, reproduce, publish or perform an original literary, artistic, dramatic or musical work.
- The registration of copyright is administered by the INDAUTOR under the authority of the *Federal Copyright Law*.
- As in Canada, copyright is automatic and requires no formal registration. Copyright protection begins upon creation of the work.
- The term for copyright protection in Mexico is the life of the author, plus 100 years after the author’s death.





# IP enforcement

**There are several ways to enforce your rights** against unauthorized use of your IP in Mexico:

- Enforcement is administered on a country-by-country basis. Therefore, you must monitor the Mexican marketplace for any unauthorized use of your IP. Enforcement of your IP rights is your responsibility.
- The Mexican Customs Authority (*Aduanas de México*) may provide you with some assistance in enforcing your IP rights in Mexico, as they help prevent counterfeit goods from entering Mexico.
- If you believe your IP rights are being infringed upon in Mexico, you should consult a lawyer licensed to practise in Mexico or an IP professional to discuss the next steps.
- Since both Mexico and Canada are members of the North American Free Trade Agreement (NAFTA), IP disputes involving parties from both countries may be resolved through the dispute resolution mechanisms outlined in NAFTA.
- It is important to understand that the Canadian government generally cannot enforce IP rights owned by private individuals in Mexico. It is the responsibility of the rights holders to register, protect and enforce their rights and, where relevant, retain counsel and advisors.
- IP disputes may be brought before the IMPI, the INDAUTOR and the federal and civil authorities in Mexico. Infringement of IP rights may lead to civil and/or criminal charges, depending on the type and severity of the charges.
- If you believe your IP rights are being infringed upon, you may choose to begin legal proceedings. Mediation and arbitration, which are generally more informal, less adversarial, cheaper and settlement-focused, can also be used as alternatives to going to court.
- If you suspect infringement, your lawyer can send a “cease and desist” letter to the alleged infringer informing them that you believe they have infringed on your IP rights and advising them to refrain from committing the infringement.
- If you choose to enforce your rights through formal court proceedings, be aware of the costs and time associated with this adversarial route. Mexican courts can award varying remedies in IP disputes, including damages, punitive damages, a temporary or permanent injunction, an order prohibiting the importation, delivery or destruction of all infringed articles or an account of all profits made by the infringer. If you pursue a legal battle and win, there is always a chance that you will receive less money than you could receive through settlement proceedings.



# Tips: Important notes

- IP rights are important, so take the time to determine what IP can be registered and what rights can be enforced.
- Remember that the protection of IP rights (such as patents, trademarks, industrial designs and copyrights) registered in Canada does not extend to Mexico.
- Align your IP strategy with your business strategy. Identify business goals, protectable IP, regional requirements, potential partners and the capacity to expand into your target markets.
- Routinely monitor the marketplace for unauthorized use of your IP.
- Before proceeding with any of the enforcement methods outlined above, consider contacting a qualified legal representative to discuss options, including a “cease and desist” letter.

## For more help

- For information about IP protection in Mexico, please see the IMPI website at [www.gob.mx/impi](http://www.gob.mx/impi) (in Spanish only) and the INDAUTOR website at [indautor.gob.mx](http://indautor.gob.mx) (in Spanish only).
- For material relating to the export of goods to Mexico, please see the Canadian Trade Commissioner Service website at [tradecommissioner.gc.ca](http://tradecommissioner.gc.ca).
- Visit the Global Affairs Canada website at [international.gc.ca](http://international.gc.ca) for more information about doing business in Mexico.
- For IP tools, resources and information for businesses, visit [Canada.ca/ip-for-business](http://Canada.ca/ip-for-business).
- For more information on going global with your IP, visit [Canada.ca/export-ip](http://Canada.ca/export-ip).
- Find more programs and support for Canadian businesses and innovators at [innovation.canada.ca](http://innovation.canada.ca).

\*The information provided above is meant as an educational resource only and should not be construed as legal advice.

**Canada.ca/export-IP**

