

Trademarks and Patents Mexico

DUMONT BERGMAN BIDER
DB

Taking a final look at the world of Trademarks and Patents, we turn to Mexico and speak to Laura Collada, Managing Partner of Mexico law firm, Dumont Bergman Bider & Co.

If you are able to do so, please detail any significant clients/cases your firm undertaken by your firm in the past year.

Case 1:

One of our clients filed a cancellation action on grounds of lack of use with the MPTO against a third party's TM registration. Unfortunately, the MPTO issued a decision rejecting the cancellation. Thus, we appealed this case before the Federal Court of Tax and Administrative Affairs (FCTAA), arguing that all the invoices provided as evidence by the defendant to prove the effective use of its trademark were faked according to the results obtained from the verification website of the Mexican Tax Revenue Office (MTRO).

The relevance of this case relies on the fact that the MPTO as well as the FCTAA have never admitted as evidence the prints obtained from the verification website of the MTRO.

Notwithstanding, after a complex trial before the FCTAA, such Court ruled in favour of our client stating forth that the information provided by the Mexican authorities through their websites is official for legal effects. Thus, if the MTRO's verification website pointed out that the relevant invoices were faked; it is a fact that the counter party could not prove the use of its trademark therefore the same shall be cancelled.

Case 2:

In 2003, Mexico began linking sanitary registrations for pharmaceutical products, issued by the Federal Commission for Protection against Sanitary Risks (COFEPRIS), to pharmaceutical patents granted by the MPTO.

The Mexican Industrial Property Law (MIPL) Regulations requires the MPTO to keep "a list of products that may be the subject of industrial protection in accordance with their active substance or ingredient..."

When a patent holder covering a pharmaceutical composition files a request for its inclusion in the Gazette, the MPTO rejects it indirectly by not publishing it. Our client's patent covers a suspension and was rejected in this manner. We submitted an Amparo appeal before the District Courts arguing that the Supreme Court's jurisprudence applied: patents referring to allopathic medicines or their claims that do not correspond to production processes or formulation of medicines and that their pharmaceutical composition include a substance or active ingredient, should be published in the Gazette. The District Court issued a decision in the Amparo Appeal ruling that said Patent was illegally excluded from the Gazette and thus the MPTO was compelled to include it.

Case 3:

An office action during substantive examination rejecting patentability of a computer implemented invention to a method of generating building instructions for a building element model was raised. It is broadly known how patentability issues on this field are problematic not only in Mexico but around the world.

The Examiner pointed out that, by the time the MX Examination begun, he was aware of the granting of the corresponding US and EP Patents, but he still considered that if the claims granted abroad were submitted in Mexico his objections would still apply.

We argued that the instructions were generated from a digital representation of a building element model and that said instructions were ultimately to be applied to building elements. This feature was argued to provide technical character to the invention. We argued the invention should not be considered to claim pure software because the instructions generated by the claimed method were to be applied directly to building toy sets to create building element models.

After the proposed argument; we obtained a patent on a computer-implemented invention.

What are the common challenges faced by your clients when involved in trademarks and patents law – e.g. wrongful or groundless threats of infringement, limits and defences to claims of infringement, international registration or enforcement of trademark rights, counterfeiting etc.

There are several issues that our clients shall face concerning the enforcement and prosecution of IP rights in Mexico.

Regarding the enforcement of IP rights, the MPTO as well as the Federal Courts have had several problems to understand the legal scope of international treaties, mainly: their application and adherence to the Mexican legal system.

As consequence, this issue has forced our clients to challenge the criterion held by our administrative/judicial authorities concerning the applicability of a given treaty by means of federal trials.

Moreover, we have seen in the past that such authorities have had some problems to understand the principals concerning the protection and enforcement of IP rights in general terms.

Another problem that our clients face constantly is to understand the complexity of the Mexican legal system. Unfortunately, although there are several legal venues to protect and enforce all forms of IP rights in our country, such venues turn out to be -in most of the cases- in long and expensive trials.

On top of that the criterion of our authorities is not always consistent and equivalent in cases sharing the same concepts and such inconsistency creates uncertainty in our foreign and domestic clients.

The World Intellectual Property Indicators 2012 report indicates a growing trend in intellectual property filings worldwide, is this something you would agree with? If so, to what do you attribute this rise?

Yes. I believe that such tendency obeys - in most part- to a growing intention of foreign and domestic companies to do business in different jurisdictions. From the Mexican market stand point of view; this tendency relies on the fact that most of the companies have realized now the importance and value of the IP and how easy such rights can be affected, infringed or challenged by third parties – whether in Mexico or abroad-.

The District Court issued a decision in the Amparo Appeal ruling that said Patent was illegally excluded from the Gazette and thus the MPTO was compelled to include it.

What are the main types of litigation/arbitration to arise within the trademark and patent sector in your jurisdiction?

The MPTO hears three different types of disputes, mainly: (i) nullity actions (when a trademark or patent was granted against the principles provided by the MIPL), (ii) infringement actions (when a third party infringes a given trademark or patent) and (iii) cancellation actions (when a given trademark or patent has not been used according to the provisions contained in the MIPL).

What are the future aspirations and direction for your company? How do you see your practice area progressing for 2013?

2013 has been great year for Dumont. We have obtained important awards and nominations in several categories including an award for our "Quality System". The firm has also grown promoting as new Partner to Jorge Gomez who heads the Trademarks and Litigation practice. Since 2010, the firm introduced -with great results- Regulatory Services associated with the "IP practice" (such as Data Protection and Consumer Protection policies). Such Regulatory Services have created a real experience of a "one stop shop" and value added services to our clients. On the Patent side, the Firm hired Karla Islas who has boosted the excellence and responsiveness of our services.

With no doubt, Dumont will continue earning our clients' confidence and satisfaction becoming the best option for IP legal services. **LM**

Contact:

Laura Collada

Managing Partner

DUMONT BERGMAN BIDER & CO., S.C.

Avenida Insurgentes Sur 1898 Pent Office
21 Floor, Colonia Florida C.P. 01030, Del.
Álvaro Obregón. Mexico City, MEXICO.

Tel: (52) (55) 5322-6230

Fax: (52) (55) 5661-3056

Email: lcollada@dumont.com.mx

Website: www.dumont.com.mx