



Daniel Sánchez



Jorge Juárez

Present and future of industrial design rights in Mexico

Daniel Sánchez and Jorge Juárez, Olivares, investigate industrial design rights in Mexico including looking into laws already in place and those planned for the future.

Protection of Industrial designs (ID) worldwide has become a key issue for companies since ornamental or aesthetic aspects of products make them more attractive to consumers and provide added value from a business perspective.

ID applications in Mexico grew by 7% in 2016, according to the data published by the Mexican Patent Office (IMPI), wherein applications filed by the Mexicans accounted for 38.5%, followed by USA applicants (32%), European applicants (8%) and Japanese applicants (5%)¹.

Due to the importance of ID protection in Mexico for Mexican and foreign applicants, and taking into consideration the international tendency of harmonization of intellectual property rights, the Mexican system has been evolving to offer appropriate protection for designs.

Résumés

Daniel Sánchez, Olivares

Daniel Sanchez joined OLIVARES in 2000 and became a partner in 2011. He has vast experience in the prosecution and litigation of all areas of intellectual property. The broad nature of his background allows him to build enforcement strategies that take on a series of different angles. Mr. Sanchez Co-Chairs at OLIVARES the Litigation team and the Patent team. He chairs the Intellectual Property Committee of the Mexican Bar Association since 2015 and was VP of the Mexican Association for the Protection of Intellectual Property (AMPPI 2013-2016). He is also member of INTA, BIO, AIPPI and participates as observer in APAA.

Jorge Juárez, Olivares

Jorge has been in the IP field since 2006 and works in the patent department of Olivares. His primary area of practice is related to the fields of Industrial Designs, Electronics, Electricity, Software, Mechanical and Information Technologies (IT), wherein he provides specialized advice related to patent prosecution including technical and legal consultancy in substantive examination matters, patent searching, and patent drafting. He also supports the patent litigation team providing technical options. He co-chairs the Patent Subcommittee of Industrial Designs and Mechanical and Electronic Inventions of the Mexican Association for the Protection of Intellectual Property (AMPPI).

Present: How industrial designs are currently protected in Mexico?

Definition

In Mexico, the Industrial Property Law provides that industrial designs include both industrial drawings and industrial models.

Industrial drawings are defined as any combination of figures, lines or colors that are incorporated into an industrial product for ornamentation purposes and which give it a specific appearance so that industrial drawings protect two-dimensional (2D) designs. On the other hand, industrial models are defined as any three-dimensional shape that serves as a model or pattern for the manufacture of an industrial product that gives it special appearance as long as it does not involve any technical effects, in such a way that industrial models encompass three-dimensional (3D) designs.

These definitions provided by our law have been useful for protecting different kind of designs, including those resulting from new technologies such as Graphical User Interfaces (GUIs) or other elements in the digital environment which are currently protected as Industrial Drawings in our country.

Requirements concerning views

The Mexican law does not specify the number the views needed for each design; however in practice, for industrial drawings, a single view is considered enough, whereas for industrial models, it is common to include seven figures, a perspective view, front view, rear view, left side view, right side view, top view, and bottom view. Nevertheless, it is not mandatory that an industrial model application includes all of the said views, as long as the filed views allow a clear comprehension of the intended protection.

Even though our law does not contemplate the use of broken lines, in practice broken lines are accepted; however, it is suggested to include a disclaimer within the description of the application specifying that the broken line disclosure is only for illustrative purposes and it does not form part of the claimed design.



Prosecution: Registration requirements

Once the application is filed, a formal examination is performed by the IMPI and then it is turned to the substantive examination department. It is not necessary to request examination of design applications since said examination is automatically carried out by the IMPI on a chronological basis.

Only industrial designs having novelty and industrial application can be registered in Mexico. This means that the Mexican Patent Office carries out a substantive examination for assessing said requirements as opposed to other foreign offices.

A 12-month grace period for previous disclosing is provided by the Mexican law for the registration of the design. Thus, the disclosure of a design within said period or, where applicable, the recognized priority date, will not prevent it from continuing to be considered novel. Nevertheless, in order to get this benefit, our law requires that the applicant must declare in the application papers the disclosure date and submit documentary evidence of such disclosure when filing the application in Mexico.

As opposed to the novelty requirement for patents wherein it is only necessary that the claimed invention is not found in the prior art, the Mexican Law provides a particular definition of novelty for IDs which tends to be more similar to the inventive step requirement for patents. Specifically, our law provides that “designs that are of independent creation and which differ significantly from known designs or combinations of known features of designs shall be considered as novel...”

Said definition includes some drawbacks such as the subjective interpretation of some ambiguous terms included therein, e.g. the interpretation of the Examiner of “independent creation” or “differ significantly” could be different from that of the applicant in such a way that the prosecution could become complicated when a design application receives a novelty objection.

Another important issue assessed during the substantive examination is whether or not the claimed designs share a single inventive concept, i.e. whether there is unity of invention. Indeed the lack of unity of invention is the most common objection raised for ID applications in Mexico during the substantive examination. The necessary

divisional applications can be filed at said stage in order to protect all the designs originally pursued.

When an objection regarding the lack of unity is raised and the applicant wishes to file divisional applications, it is recommended to file them along with the response to said office action objecting the unity of invention. Nevertheless, voluntary divisional applications are accepted at any time during prosecution, but before paying the issue fees of the parent case if it is allowed or before receiving a final rejection.

An application may receive two substantive office actions in order to meet the registration requirements. Then, the application could receive either the Notice of Allowance or a Final Rejection. In this latter case, an appeal before the specialized IP Court of the Federal Administrative Court may need to be filed.

If the application receives the Notice of Allowance, the registration fees and the first five annuities computed from the filing date in Mexico have to be paid. It is not necessary to pay annuities due during the prosecution period.

The registration term for industrial designs is 15 years from the filing date in Mexico, and industrial designs are only published once granted.

Enforcement

Once the industrial design has been registered, the registration holder enjoys an exclusive right to prevent others from manufacturing, using, selling, offering for sale, or importing the registered design without his consent. Industrial Designs may be enforced against the reproduction or imitation thereof so that the scope of protection goes beyond the specific figures granted in the registration. However, there is no jurisprudence or regulations about the standard of “imitation” which is decided on a case by case basis.

Future of industrial design rights: Is Mexico following the foreign tendencies of protection?

During the last few years, the Mexican government has been involved in the Trans-Pacific Partnership (TPP) negotiations with 12 countries. Said Treaty was particularly attractive for Mexico since the total

gross domestic product (GDP) of the TPP parties comprised about 40 percent of global GDP and one-third of world trade.

Among the negotiations of said Treaty, there was a specific chapter related to Intellectual Property rights, including the IDs protection. Said agreement included a specific provision stating that “The Parties recognize the importance of improving the quality and efficiency of their respective industrial design registration system [...]... including giving due consideration to ratifying or acceding to the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs, done at Geneva, July 2, 1999.”

Hague Agreement Concerning the International Registration of Industrial Designs in an international registration system that allows protection in multiple jurisdictions by filing a single design application requesting protection for up to 100 designs. Although it provides a simplified filing procedure, the substantive law of each designated Contracting Party still applies.

Upon the result of said negotiations, the IP legal framework in Mexico related to the protection of Industrial Designs has been reviewed to prepare our country for the possible accession of Mexico to the Hague Agreement.

On the other hand, the Mexican Government is now negotiating with Europe a possible modernized EU-Mexico Association agreement wherein it seems that the implementation of the Geneva (1999) Act of the Hague Agreement is also an important issue. Nevertheless, it is not yet defined if it would be mandatory from said EU-Mexico Agreement whether or not Mexico should accede to the Hague Agreement.

Proposed amendments to IP Law regarding industrial designs

Among the main changes related to industrial designs, the amendments propose to define the ambiguous terms with respect to the requirement of novelty for IDs, such as the terms “independent creation” and “significantly”, when referring to the requirement that designs must differ significantly from known designs or combinations of known features of designs in order to be considered as novel.

In this regard, the proposed amendment defines “independent creation” as “when no identical design has been made public before the filing date or the recognized priority. Industrial designs differing only in irrelevant details will be considered as identical”.

As to the term “significantly”, the proposed amendment defines said term as “the general impression produced by the industrial design in a person skilled in the art, differing from the general impression produced by any other industrial design made public before the application filing date or the recognized priority, taking into consideration the degree of freedom of the designer for the creation of the industrial design”.

Nevertheless, although said definitions try to provide clarity to the assessment of the novelty requirement, from our point of view it adds

“The Mexican Patent Office carries out a substantive examination for assessing said requirements as opposed to other foreign offices.”

other ambiguous terms such as “irrelevant details” or “degree of freedom” so that it could not satisfy the deficiencies of the current definition at all.

Another important difference is that the protection term for designs would be modified to a term of 5 years, with five possible renewal periods, to a total protection term of 25 years from the filing date of the application. Although the Mexican law already contemplates a protection term of 15 years which is in line with the 15 years provided by The Hague Agreement, the proposed amendment seems to be congruent with the term granted by the European Union for Community Designs.

Also, contrary to the correct practice, the proposed amendment provides the publication of design applications after the formal examination has concluded. The same proposal applies to design divisional applications. This amendment seems to be in line with the Hague Agreement which provides the publication of international registrations, whether the pre-grant opposition available in the law would apply to the designs is yet to be addressed.

Finally, the amendment proposes to make available to public inspection the design applications records once published. This amendment would be positive since it would allow knowing pending IP rights providing certainty to the Mexican IP system.

The proposed bill is pending of discussion in the Mexican Congress and it is expected that said discussion will take place this year.

Conclusions

In general terms, we consider that the proposed amendment to the Mexican law opens the possibility for Mexico of acceding to the Hague Agreement Concerning the International Registration of Industrial Designs, which also could be useful during the negotiations of the modernized EU-Mexico Association Agreement held currently by the Mexican government, following the tendencies of international harmonization related to IP rights. Indeed, the Hague Agreement seems to be important for EU since applicants from countries located on the European continent accounted for 71.9% of all designs under the Hague System in 2016².

Nevertheless, in spite of the amendments being discussed in the Mexican Senate, if Mexico accedes the Hague System, applicants interested in protection designs in Mexico should consider that there are some disadvantages when filing applications through said Agreement because although it could facilitate the filing process in multiple countries, it does not implement uniform drawing standards so that if an international application does not satisfy each countries’ requirements, a risk of losing some rights would be faced. Likewise, although an International Application can include up to 100 designs belonging to the same Locarno Classification, due to a requirement of unity of invention in Mexico, it is very likely that applicant would need to file multiple divisional applications during prosecution.

Finally, even though it could be considered that acceding to the Hague Agreement could be beneficial for Mexican applicants interested in protecting their designs abroad, currently there are no clear statistics about the impact of said Agreement in developing countries; however it is clear that the future of industrial design rights in Mexico follows the international harmonization standards and that the possible accession of Mexico to the Hague Agreement has become a political tool for negotiating international treaties.

¹ <https://www.gob.mx/imp/imp/documentos/instituto-mexicano-de-la-propiedad-industrial-en-cifras-imp-en-cifras>

² *Hague Yearly Review 2017* – published by the World Intellectual Property Organization: http://www.wipo.int/edocs/pubdocs/en/wipo_pub_930_2017.pdf