



Ernesto M. Meade

# Find and share the knowledge: Mexico

Uthhoff, Gomez, Vega + Uthhoff's Ernesto M. Meade details everything you will ever need to know about patent law and processes in Mexico.

## The court system

### 1. When are disputes heard by the national patent office?

The Mexican Institute of Industrial Property (IMPI) is the first stage in all patent proceedings in Mexico. It is in charge of studying and resolving patent infringement actions, as well as patent invalidation/cancellation actions.

The decision of the IMPI could be contested through a Review Recourse before a higher ranked officer of the same IMPI, but in more than 90% of the cases, this officer confirms the prior decision.

The Review Recourse is not mandatory, so the losing party could appeal the decision directly through a nullity petition.

Against the IMPI's decision (in a patent infringement/invalidation action and/or during the Review Recourse) the losing party could file a Nullity Petition to be studied and resolved by the Specialized IP Chamber of the Federal Court for Tax and Administrative Affairs (TFJFA).

Finally, the ruling issued by the TFJFA could be contested through an Amparo Appeal before the Federal Circuit Court (FCC).

### 2. Where are the trial courts?

The IMPI's main office is located in Mexico City. The institute also has five regional offices in Monterrey, Guadalajara, León, Mérida and Puebla. These regional offices just provide legal advice on IP matters and work

as offices for receipt writs of the parties involved, but all the proceedings are studied and resolved in the main office in Mexico City.

The TFJFA and the FCC are also located in Mexico City.

### 3. Are validity and infringement trials heard together?

It is very common that defendants in an infringement action (as a defense strategy) contest the validity of the patent through an invalidation action. In these cases, the validity and infringement actions are studied together.

**“ Mexican IP law states that the plaintiff may request the IMPI to implement preliminary measures against the defendant, such as the temporary seizure of the alleged infringing products. ”**

### 4. What is the composition of the trial panel?

Cancellation and infringement actions are resolved by the legal area of the IMPI, but it usually requests the technical assistance of the patents area. Therefore, the technical part of the decision is issued by specialists in the different fields of science and industry.

The TFJFA and the FCC are formed by three magistrates each. They all have a law degree, but it is not mandatory for them to have a specialization in IP matters, nor do they need to have a technical background or expertise.

The decisions of the courts are issued in a collegiate manner.

## Résumé

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**5. Where are the appeal courts?**

The TFJFA and the FCC are also located in Mexico City.

**Pre-action**

**1. Are there pre-action procedures for seizure and/or inspection of allegedly infringing products?**

Yes. Mexican IP law states that the plaintiff may request the IMPI to implement preliminary measures against the defendant, such as the temporary seizure of the alleged infringing products and/or to order the defendant to temporarily suspend the production and commercialization of the alleged infringing products and any other conducts which may possibly constitute patent infringement.

Also, the plaintiff could request the IMPI to conduct a visit of inspection at the defendant’s premises, in order to confirm the infringer conduct and to collect evidence of it.

**2. Are there pre-action procedures for obtaining information regarding alleged infringers?**

During the inspection of the defendant’s premises, the IMPI officers could ask the infringer to provide certain information.

Additionally, the plaintiff could request the IMPI to issue an official letter requesting the defendant and/or third party information regarding alleged infringers.

**3. Is there any obligation to try to resolve a dispute before bringing proceedings?**

No. Mexican IP law allows for the possibility that the parties may resolve the conflict in an amicable manner, but it is not mandatory to do so.

**4. Are there any provisions to curb groundless threats of patent infringement proceedings?**

No.

**IMPI proceedings**

**1. How are infringement proceedings started?**

Infringement proceedings start when the plaintiff files the infringement action before the IMPI.

According to article 189 of the ILP, the infringement action shall contain the following particulars:

- I. The name of the requestor and its legal representative if any;
- II. The address for the service and receipt of notifications;
- III. The name and address of the other party or of its legal representative;
- IV. The subject of the request, expressed in clear and precise terms;
- V. An account of the facts; and
- VI. The underlying legal grounds.

In accordance with article 190 of the IPL, originals or duly certified copies of the documents and statements on which the action relies shall be submitted with the suit, and the corresponding evidence shall be offered. Evidence submitted later shall not be allowed unless it has the character of supervening evidence.

**2. Who can bring infringement proceedings?**

According to article 188 of the IPL, the IMPI may initiate the infringement action procedure *ex officio* or at the request of any person who has a legal standing therein and provides grounds for its claim.

Similarly, article 68 of the IPL states that the person to whom a license has been granted shall, unless stipulated otherwise, be entitled to institute legal proceedings in defense of the patent rights as if it was the actual patent owner.

Mexican IP law does not state any provision regarding co-ownership.

**3. Are declarations of non-infringement available?**

No. Mexican legislation does not contemplate the possibility of obtaining a declaration of non-infringement.



**4. Are there formalities for starting a case seeking a declaration of non-essentiality?**

No.

**5. How is the validity of a patent challenged?**

The validity of a patent can be challenged through an invalidation/cancellation action which should be studied and resolved by the IMPI.

The validity of a patent challenged should be considered in force and in full effect until a decision from the IMPI declares it to be invalid.

**6. Who can challenge the validity of a patent?**

According to article 188 of the IPL, the IMPI may initiate an invalidation action procedure *ex officio* or at the request of any person who has a legal standing therein and provides grounds for its claim.

It is very common for defendants in an infringement action to contest the validity of the patent through an invalidation action.

In addition, an objection from a competent authority against a patent application, sanitary authorization and/or other authorization based on the patent could be used to demonstrate the proper legal standing.

**7. Can other types of proceedings be brought too?**

No. Mexican IP law does not cover other types of proceedings.

**8. Is it possible to check at court or on a register whether a patent is being litigated?**

No. The information of pending invalidation patent proceedings before the IMPI is kept confidential until a decision is issued.

**9. If a European patent is opposed are national proceedings on it stayed?**

A patent infringement action must be filed based on a granted Mexican patent. The invalidation of the European patent should not be an obstacle to continue with the proceeding.

In this case, the defendant could try to contest the validity of the Mexican patent, filing as evidence the decision issued in the European procedure.

**Interim injunctions**

**1. Are interim injunctions available in your country?**

If the patent owner files a patent infringement action before the IMPI against any third party, then it could request the IMPI to implement preliminary measures against the defendant, such as the temporary seizure of the alleged infringing products and/or to order the defendant to temporarily suspend the production and commercialization of the alleged infringing products and other conducts that may possibly constitute patent infringement.

It is very common for the patent owner to request the implementation of these measures.

“ Mexican legislation does not contemplate the possibility of obtaining a declaration of non-infringement. ”

**2. Can interim injunctions be obtained ex parte?**

Yes. The IMPI carries out the implementation of the preliminary measures and, if applicable, the inspection of the infringer’s premises, without prior notice.

Once the IMPI carries out the implementation of the preliminary measures and the visit of inspection, the defendant is served with a copy of the infringement action, granting them a term of ten days to file the corresponding brief of response.

**3. What protective steps can be taken by a party that fears an interim injunction application?**

To collect and store the infringing products in a domicile different to the legal one, in order to avoid their seizure. Also, it could gather all the information and documents related to the infringing products.

**4. How does the IMPI decide whether to grant/refuse an interim injunction?**

According to article 199 bis.1 of the IPL, before ordering the implementation of these measures, the IMPI shall call upon the plaintiff to comply with the following requirements:

- I. Prove ownership of the rights and any of the following circumstances:
    - (a) The existence of an infringement of its rights;
    - (b) The imminence of the infringement of its rights;
    - (c) The existence of the possibility of irreparable damage being sustained; and
    - (d) The existence of a justified fear that evidence might be destroyed, concealed, lost or altered.
  - II. Provide sufficient guarantees to cover any damages that might be caused to the person against whom the measure is sought.
  - III. Provide the necessary information for the identification of the goods, services or establishments with which or in which the infringement of industrial property rights has been committed.
- If the plaintiff complies with the mentioned requirements, the IMPI should grant the requested measures.

**5. Does a party awarded an interim injunction have to provide a bond or undertaking?**

Yes. This provides a sufficient guarantee to cover any damages that might be caused to the person against whom the measure is implemented. In fact, this is one of the legal requisites stated in the IPL.

Notwithstanding, according to the same article 199 bis.1 of the IPL, the person against whom the measure has been granted may provide a counter-guarantee to cover any damages that might be caused to the party seeking it, with a view to having it lifted.

**6. After an interim injunction application do the parties have to go on to a full trial?**

Yes. If the plaintiff decides to request the implementation of the preliminary measures before filing the infringement action, it must file it within a period of 20 days beginning from the day when the measures are implemented.

On the contrary, the plaintiff shall be liable for the payment of damages caused to the infringer resulting from the implementation of the measures.

The IMPI shall, in the final resolution on the infringement procedure, decide on the lifting or confirmation of the measures adopted.

**7. How is an injunctioned party compensated if wrongfully injunctioned?**

The plaintiff shall be liable for the payment of damages caused to the infringer if the final decision finds that there has been no infringement or threat of infringement of the patent.

## Procedural steps to trial

### 1. Does the IMPI set a timetable for steps in the case to trial?

No. However, the IPL states the following terms for the parties:

- Ten working days for the defendant to file the brief of response to the infringement action.
- Ten working days for the defendant to file the brief of manifestations to the inspection visit and the implementation of preliminary measures.
- Three working days for the plaintiff to file the brief of manifestations to the counterpart's briefs of response.
- Ten working days for the parties to file the brief of final allegations.

### 2. Is it possible to amend a patent during proceedings?

Article 61 of the IPL states that amends in the text or drawings of the patent may be allowed only to correct any obvious errors or errors in the form, and to limit the scope of the claims.

If the patent is used as the basis of an infringement action, the amendments should be made before filing the action.

In case that the validity of the patent is contested through an invalidation action, the amendments could be done during the proceeding.

### 3. Do parties have to provide discovery/disclosure of documents to the other side?

No.

### 4. Are witnesses deposed?

In accordance with article 192 of the IPL, all types of evidence shall be allowed in the patent infringement procedure, with the exception of testimonials and personal statements, unless the testimonial or personal statement is in documentary form.

### 5. Can facts in a case proven by experiments?

Experiments could be filed in documentary form or in a video. In order to provide the video with more probative value, it would be useful to attest the contents of the same by means of a notary witness.

### 6. Are expert witnesses used?

Yes, but the expert witnesses should be submitted in documentary form.

Additionally, the legal area of the IMPI usually requests the technical assistance/opinion of the patents area.

### 7. Is written expert and fact evidence exchanged before trial?

No.



### 8. Can some matters be addressed by the IMPI separately before trial?

No.

### 9. How is the confidentiality of the information and documents maintained?

Article 186 of the IPL states that the staff of the IMPI who intervene in the infringement procedure shall be bound to observe absolute secrecy regarding the contents of pending files, failing which they shall be punished in accordance with the Federal Law on Accountability of Public Servants, regardless of whatever sanctions may be appropriate in such cases.

The staff of public or private bodies that may be privy to said contents in dealings with the IMPI in the course of their duties shall be bound by the same obligation.

During the proceedings, the counterpart could have access to the confidential information, in order to know it and to object it, but it cannot obtain copies of the documents containing said information.

## Trial

### 1. How long does it typically take to get to trial from the start of proceedings?

Between a year and a half and two years.

### 2. Is expert and fact evidence given orally?

No. That kind of evidence should be submitted in documentary form.

### 3. Are witnesses cross-examined?

No.

### 4. Is video evidence used in IMPI and, if so, when?

The parties have to submit the video as evidence along with the suit or the brief of response.

The IMPI schedules a hearing with the parties, in order to watch the video. The IMPI takes notes from the video and its contents, and the parties are then allowed to make statements regarding the video and its contents. Such statements are included in the notes.

### 5. How long does a trial last?

Between a year and a half and two years.

### 6. Are these trials open to the public?

No.

### 7. Is it possible to obtain copies of documents referred to in IMPI?

Yes. The only restriction is in cases where the information contained in the documents is considered confidential.

### 8. When does the IMPI issue its decision?

Once the IMPI admits the briefs of final allegations of the parties and the technical opinion from the patents area of the institute, it starts the study of the case and the drafting of the decision. After that, the IMPI will issue the corresponding decision.

## Remedies available from the court

### 1. Is the sum payable by an infringer decided at trial or in a separate hearing?

According to article 214 of the IPL, patent infringements shall be punished as follows:

- I. A fine of up to 20,000 days of the general minimum salary (around \$100,000);



- II. An additional fine of up to 500 days of the general minimum salary for each day that the infringement persists;
- III. Temporary closure for up to 90 days;
- IV. Permanent closure;
- V. Administrative detention for up to 36 hours.

Once the IMPI's decision is declared final and conclusive, the patent owner could claim compensation for damages through a civil action.

**2. How is sum payable by an infringer calculated?**

In accordance to article 221 bis of the IPL, compensation for material damages or indemnification for damages and harm due to violation of the patent rights shall in no case be less than 40% of the public sale price of each infringer product.

**3. Are all infringers enjoined?**

No, in case that the plaintiff does not comply with the requirements stated in article 199 bis.1 of the IPL or if the defendant posts a counter-guarantee, the preliminary measures are imposed.

**4. What orders are made regarding infringing products?**

The IMPI orders the destruction of the products.

**5. Is revocation of a patent stayed pending appeal?**

If the defendant files as counter-claim an invalidation action against the patent, the IMPI resolves firstly the invalidation action and subsequently, the infringement action.

If the IMPI decides to invalidate the patent, it consequently declares the infringement action unfounded.

On the contrary, if the IMPI rejects the invalidation of the patent, then it studies the merits of the case in the infringement action. The IMPI's decision could declare the infringement or reject it.

The losing party could appeal the unfavorable decision through a nullity petition.

**6. Is it necessary to get the IMPI's permission to appeal?**

No.

**Appeal**

**1. How much time does an appellant have to file an appeal after IMPI's decision?**

The appellant has a term of 45 working days to file the nullity petition before the TFJFA.

**2. How long does it take from filing an appeal to the appeal hearing?**

Once the TFJFA admits the appeal, it grants to the IMPI (as the defendant) and the counterpart (as the third interested party) a term of 45 working days to file their respective briefs of response.

Then, the TFJFA grants to the appellant a term of three working days for filing manifestations against the responses of the other parties.

After that, the TFJFA grants the parties a common term of 15 days to file final allegations and pleadings.

Afterwards, the TFJFA studies the merits of the case and issues the respective ruling.

**3. Is the appeal a de novo hearing or a review for errors of law?**

In the nullity petition, the TFJFA studies the legality of the decision issued by the IMPI, based on the arguments and evidence submitted before such authority.

The parties may allege in the appeal the wrong interpretation of the law, the wrong valuation of the evidence and violations to the due process of law.

The ruling of the TFJFA could confirm the IMPI's decision or declare it null, ordering the IMPI to issue a new one following specific lineaments or amending the violations of the due process of law.

**4. How long does it take the appeal court to write its decision?**

Around a year and a half.

**5. How often do patent appeals progress beyond the appeal court to the very highest court?**

Very often. It is very common that the losing party in the nullity petition appeals the ruling through an Amparo Appeal before the FCC.

This is because once the decision in the infringement action has been made final, the patent owner is entitled to claim for damages.

**The cost of litigation**

**1. Is the winner in an application to court entitled to recover its costs?**

Yes, but in order to recover its costs, the winner party needs to file a civil action.

**2. Is the winner at trial entitled to recover its costs?**

Yes, but in order to recover its costs, it needs to file a civil action.

**3. When are costs assessed and how?**

The Civil Court studies the merits on the civil action, taking into account the costs and expenses disbursed by the winner party.

**4. What are the typical ranges of costs of trial on a single patent?**

There are no typical ranges of costs for this kind of procedures. It is decided on a case by case basis.

**Litigation statistics**

**1. Approximately how many cases are started per year?**

According to the last IMPI Annual Report, around 70 patent infringement actions are started each year.

**2. How many cases go to trial per year?**

Around 80% of the decisions issued in patent infringement actions are appealed by the parties.



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