

Regulations on the Industrial Property Law

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Transitional Provisions

Title I General Provisions

Chapter I General Provisions

Art. 1. The purpose of this enactment is to regulate the Industrial Property Law. The application and interpretation thereof, for administrative purposes, shall be the responsibility of the Mexican Institute of Industrial Property.

Art. 2. For the purposes of these Regulations, in addition to the definitions given in Article 3 of the Industrial Property Law,

I. "Gazette" means the Industrial Property Gazette referred to in Article 8 of the Law;

II. "Law" means the Industrial Property Law;

III. "Secretariat" means the Secretariat of Trade and Industrial Development.

Art. 3. The Director General of the Institute shall, in a resolution, lay down the rules and specifications that documents containing descriptions, claims, drawings and abstracts have to meet in order to be acceptable.

He may also lay down specific procedures and requirements to facilitate the operation of the Institute and guarantee the legal security of individuals.

Art. 4. For the calculation of fixed periods expressed in months or years as provided in Article 184 of the Law, it shall be understood that the period ends on the day having the same number in the corresponding subsequent month or year. Where a period expressed in months or years would normally expire on a day when the Institute is not open, it shall expire on the first following working day.

The Institute shall publish the days on which it is not open for work in the Official Journal in January of each year.

Chapter II Applications and Submissions

Art. 5. Applications or submissions shall be filed with the Institute itself or with Delegations of the Secretariat, and shall comply with the following requirements:

I. they shall be duly signed on each copy;

II. they shall be filed on the official printed forms approved by the Institute and published in the Official Journal and in the Gazette, in the duly prescribed number of copies and annexes, which shall be filed in due form and, if they are on magnetic carriers, in conformity with the guide issued by the Institute for the purpose.

Where official forms are not required, applications or submissions shall be filed in duplicate, with a mention in the heading of the type of processing sought, and also the particulars referred to in item V of this Article;

III. whatever annexes are necessary in each case shall be included, and they shall be legible and typewritten or printed or their contents recorded by any other means;

IV. an address on the national territory shall be given for hearing and receiving notifications;

V. the number of the application, patent or registration, the publication, statement or record and the date of receipt referred to shall be mentioned, except in the case of initial applications for patents or registrations;

VI. proof of payment of the prescribed fee shall be included;

VII. the appropriate Spanish translation of documents in other languages that are submitted with the application or submission shall be included;

VIII. documents proving the status of successors in title and the legal capacity of representatives or agents shall be included;

IX. documents from abroad shall be authenticated where appropriate.

Applications and submissions shall be filed separately for each affair with the exception of the registration of licenses or transfers under Articles 62, 63, 137 and 143 of the Law, the registration of transfers of rights that have been preceded by unregistered intermediate transfers, or those that relate to the same affair.

Where the applications or submissions do not conform to items I to VI, VIII and IX above, the Institute shall require the applicants or requesting parties to remedy the defects within a period of two months. Where they do not do so, their applications or submissions shall be rejected outright.

Where applications or submissions do not conform to item VII above, the applicants or requesting parties shall, without being required to do so by the Institute, file with the said Institute the appropriate translation of the documents presented within two months following the date on which the applications or submissions were filed. Where the applicants or requesting parties do not present the translation within the period allowed, the applications or submissions shall be rejected outright.

Applications and submissions delivered by mail, courier service or other equivalent means shall be considered received on the date on which they are actually delivered to the Institute.

Applications or submissions may be filed by facsimile transmission, provided that the originals of the application or submission and its annexes, accompanied by proof of payment of the prescribed fee and acknowledgment of receipt of the transmission, are presented on the premises of the Institute itself on the day following the transmission. In that case it shall be sufficient for the facsimile transmission to contain only the application or submission.

Art. 6. The Institute shall provide applicants and requesting parties free of charge with the official forms, which may be reproduced by third parties provided that the copies correspond to the official format.

Art. 7. The Institute shall, on receiving applications and submissions:

I. satisfy itself that the documents and other material listed therein are in fact present, and make the appropriate annotations;

II. mark on each of the copies, using whatever method is appropriate:

(a) the date and hour of receipt;

(b) the serial number of the corresponding receipt;

(c) where appropriate, the pending file number given to them in the case of an application;

(d) the date and hour of filing where the application complies with the provisions of Articles 38bis and 121 of the Law and Article 38 of these Regulations;

III. return to the applicants or requesting parties a stamped copy of the applications or submissions together with such annexes as may be returnable, after the appropriate annotations have been made.

Art. 8. In no event may processing or another procedure be resumed where it was terminated by the abandonment of the application.

Art. 9. The request for registration of a transfer of the rights conferred by a patent, inventor's certificate, registration, authorization or pending application, or for the recording of a change of name or business, change of legal status or merger shall, apart from meeting the requirements referred to in Article 5 of these Regulations:

I. state the name, designation or business style and nationality of the immediately preceding holder of the rights or of the successive previous holders in cases where the transfers or amendments in question have not been previously registered, and also the same particulars of the new holder in addition to the information requested on the official forms;

II. be accompanied by a copy, either certified or with handwritten signatures, of the agreement or other documents evidencing the transfers or amendments of rights, including those relating to transfers of amendments effected previously that have not been registered.

The request for registration may be filed by the transferor or his substitute or by the transferee or his substitute.

Art. 10. The request for registration of a license for use in respect of any industrial property right or franchise, in addition to meeting the requirements referred to in Article 5 of these Regulations, shall specify:

I. the names, designations or business styles, nationalities and addresses of the licensor or franchisor and the licensee or franchisee;

II. the term of the agreement;

III. whether the agreement accords the licensor, authorized user or franchisor the right to bring legal action for the protection of the industrial property rights to which it relates;

IV. in the case of a license for the use of a mark, the goods or services for which the license is granted;

V. any other particulars that may be required in the official forms.

The application shall be accompanied by a copy, either certified or with handwritten signatures, of the agreement evidencing the license, authorization of use or franchise. The copy submitted may omit the contractual clauses referring to royalties and other remuneration payable by the licensee, authorized user or franchisee, those that refer to confidential information and methods or means of distribution and marketing of the goods and services concerned, and also any annexes containing technical information that may form part of the said agreement.

The request for registration may be filed by any of the parties.

Art. 11. For the registration of the transfer of ownership or licensing of rights in two or more pending applications, patents or registrations, as provided in Articles 62, 63, 137 and 143 of the Law, the following formalities shall be complied with in addition to the requirements specified in Articles 9 and 10 of these Regulations:

I. two copies, certified or with handwritten signatures, of the agreements or documents evidencing the transfers or licenses concerned shall be shown;

II. each submission shall refer as appropriate to patents or utility model or industrial design registrations either granted or pending, or to granted or pending registrations of marks.

The Institute shall issue a notice containing the decision on the registration applied for, and shall append a copy of it to each file or application.

The applicant or requesting party may request the making of certified copies of the agreement shown, with a view to their inclusion in one or more of the files or applications contained in the said agreement.

Art. 12. The Institute shall rule as appropriate on the applications or requests for registration referred to in the three foregoing Articles within two months following the date of receipt thereof or the date on which any requirements formulated by the Institute have been complied with.

Where the registration requested is not acceptable for want of compliance with a requirement or for any other reason, the Institute shall notify the requesting party, allowing him a period of two months within which to make such observations as may serve his interests.

Chapter III Notifications

Art. 13. Rulings, requests and other acts of the Institute shall be notified to applicants or interested third parties by registered mail with acknowledgment of receipt at the address

specified for the purpose. They may also be notified in person at the address specified, at the Offices or the premises of the Institute or by publication in the Gazette.

The Institute may use other means of notification such as courier services, which shall be charged to the party who requests that they be used.

Notifications in person at the address of applicants, interested third parties or legal representatives shall be ordered and served only, except in the case provided for in Article 72 of the Law, in such cases as the Institute considers appropriate.

Notifications in person at the premises of the Institute may be served where the applicant or interested third party or his agent or person authorized under item V of Article 16 of these Regulations presents himself in person at those premises.

Personal notifications and those served by registered mail with acknowledgment of receipt shall be effective as from the day on which they are delivered to the persons concerned.

Periods shall start to run on the day following that on which the notification becomes effective.

Art. 14. The Gazette is the medium of communication of the Institute, which shall be published monthly and be divided into sections. One section shall be used for publications concerning inventions, utility models and industrial designs, while the other shall be used for those concerning marks, advertising slogans and trade names and appellations of origin.

The Institute shall publish the names and locations of the national institutions, whether public or private, at which the Gazette may also be consulted.

Art. 15. In addition to the instruments, documents and signs that have to be published in accordance with the Law, the Gazette shall publish rulings that affect or modify the industrial property rights protected by the same Law.

Chapter IV Representation and General Register of Powers

Art. 16. The accreditation of the status of agents and representatives shall be subject to the following:

I. the power of attorney referred to in items I and II of Article 181 of the Law, shall give the name, signature and address of two witnesses; the persons concerned may be either nationals or foreigners;

II. general powers of attorney granted for acts of administration or for lawsuits and debt collection shall be recognized as conferring authority to act in administrative proceedings;

III. in the cases provided for in Articles 187 and 200 of the Law, the applicants or requesting parties may attest to their status in the form of a copy of the registration of the power of attorney in question in the General Register of Powers of the Institute, provided that the said power confers the right to engage in lawsuits and debt collection;

IV. special powers shall be recognized for the performance of the acts for which they have been granted;

V. applicants acting in their own right, agents and legal representatives may, in their applications and submissions, authorize other natural persons to hear and receive notifications and documents.

Art. 17. The Institute shall be responsible for the General Register of Powers, in which the originals of powers or certified copies, and where appropriate authenticated copies thereof shall be registered. Registration in the General Register of Powers shall be optional.

It shall be sufficient to include in each application or submission a plain copy of the record of registration in the General Register of Powers.

Chapter V Files

Art. 18. Files may be consulted and shall remain in the archives of the Institute for the duration of the industrial property rights concerned, except in cases where the Institute considers that they should remain for longer.

The situation referred to in Article 186 of the Law shall apply to the files of unpublished patent applications, and those of patents, utility models and industrial designs that have been abandoned or rejected, which may only be consulted by the interested parties or by their legal representatives or agents, or by authorized persons within the meaning of Article 16.V of these Regulations.

Art. 19. The owner or his agent may obtain the original documents that accompanied his applications or submissions only for as long as the files are available for consultation. In that case the Institute shall, before releasing the documents, make certified copies thereof at the requester's expense which shall remain in the files concerned in place of the documents that are released.

The release of objects that accompanied applications and submissions may also be obtained during the time indicated in the foregoing paragraph. Where the release of such objects is not requested during that time, they shall be destroyed.

Art. 20. Any person may request and obtain certified copies of documents held in the files which relate to granted rights or registrations, subject to payment of the prescribed fees.

In the case of the files referred to in Article 186 of the Law, certified copies of the documents in those files may only be requested and obtained by the persons mentioned in the said Article.

Art. 21. The Institute shall use any medium, including microfilm, photography or recording on optical discs or magnetic material, for the reproduction of the documents held in the files with a view to facilitating their preservation and consultation and the issue of certified copies.

Title II Inventions, Utility Models and Industrial Designs

Chapter I General Provisions

Art. 22. For the purposes of the provisions in Article 17 of the Law, pending applications for patents and for the registration of utility models that have been filed with the Institute prior to those under substantive examination shall be included in the state of the art.

The contents of an application for a patent or utility model registration that has been rejected, withdrawn or abandoned shall not form part of the state of the art except, in the case of patents, where publication of the application has already taken place.

Art. 23. For the processing and maintenance of the registration of utility models and industrial designs, the provisions of this Title shall be applied as appropriate.

The provisions of Article 18 of the Law shall be applicable as appropriate to utility models and industrial designs.

The provisions of Article 22 of these Regulations shall be applicable as appropriate to the registration of utility models.

Chapter II Patent Applications

Art. 24. The patent application shall, in addition to the particulars specified in Article 38 of the Law and Article 5 of these Regulations, state the date on which the invention was previously disclosed under Article 18 of the Law, with a mention of the medium of communication by which it was made known, the particulars of the exhibition at which it was shown or those relating to the first time that it was put into practice.

In the case of the divisional applications referred to in Article 44 of the Law, the filing date and pending file number of the original application shall be specified.

Art. 25. In patent applications the name or title of the invention shall be short but shall be sufficient in itself to denote the nature of the invention. Fanciful names or expressions, trade information or distinctive signs shall not be acceptable as names.

The application shall contain only the particulars specified on the relevant official form. Nevertheless, the application may be accompanied, on a separate sheet, by whatever clarifications may be considered necessary, the inspection and consideration of which shall remain at the discretion of the Institute.

Art. 26. The Institute may require the applicant to show a specimen or model of the invention for which protection is sought, either in its normal dimensions or to scale, in so far as that is necessary to assist in the understanding of the invention.

Art. 27. The description, claims and abstract

I. must not contain drawings;

II. may contain chemical formulae or mathematical equations; the description may in addition contain instructions for computer programs;

III. the description and the abstract may contain tables; the claims may only contain tables where the subject matter makes their use advisable;

IV. the tables and mathematical or chemical formulae may be arranged horizontally on the sheet if they cannot be readily presented vertically, but in that case they must be presented in such a manner that the upper parts of the tables or formulae appear on the left-hand side of the sheet.

Art. 28. The description shall be drafted according to the following rules:

I. it shall give the name or title of the invention as it appears in the application;

II. it shall specify the field of technology to which the invention relates;

III. it shall mention the anticipations known to the applicant in the state of the art to which the invention belongs, and shall preferably specify the documents that reflect the said state of the art;

IV. it shall describe the invention, as claimed, in clear and accurate terms that permit the technical problem, even where it is not expressly mentioned as such to be understood, and shall give the solution to the problem, explaining the advantages of the invention, if any, over the prior art.

The description must be concise, but as complete as possible, and it must avoid digressions of any kind; the description shall point to the respects in which the invention being disclosed differs from similar inventions that are already known;

V. where the deposit of biological material is required under the provisions of the second paragraph of Article 47.I of the Law, it shall mention that the said deposit has been made and shall state the name and address of the depositary institution, the date on which the deposit was made and the number allocated to it by the said institution, describing also, to the extent possible, the nature and characteristics of the deposited material in so far as they are relevant to the disclosure of the invention;

VI. it shall contain a list of the various figures constituting the drawings, referring to them and to the various parts of which they are composed;

VII. it shall mention the best known method, or the applicant's intended best means, of carrying out the claimed invention; where this is sufficient, the mention shall take the form of practical examples or specific applications of the invention that are not of a nature that is alien to the invention described, and with references to the drawings, if any;

VIII. it shall expressly state, when this is not apparent from the description or from the nature of the invention, the manner in which it may be produced or used, or both.

The description shall be presented in the form and order specified in this Article, except where, owing to the nature of the invention, a different form or order makes for better understanding and more practical presentation.

Each of the chapters of the description referred to in items II to VII above shall be preceded by a heading.

Art. 29. The claims shall be made according to the following rules:

I. the number of claims must correspond to the nature of the invention claimed;

II. where two or more claims are made, they shall be numbered in sequence with Arabic numerals;

III. they must not contain references to the description or drawings, except where absolutely necessary;

IV. they must be drafted according to the technical characteristics of the invention;

V. where the application includes drawings, the technical characteristics mentioned in the claims may be followed by reference marks denoting the parts of the drawings corresponding to those characteristics, if the understanding of the claims is thereby facilitated; the reference marks shall be placed between parentheses;

VI. the first claim, which shall be independent, must refer to the essential characteristic of a product or process for which protection is principally claimed; where the application comprises more than one category of those referred to in Article 45 of the Law, at least one independent claim must be included for each of those categories.

The dependent claims must include all the characteristics of the claims on which they depend, and specify the additional characteristics that bear a congruent relation to the related independent or dependent claims.

The dependent claims of two or more claims may not serve as the basis for any other that it itself dependent on two or more claims.

VII. Any dependent claim shall include the limitations contained in the claim or claims on which it depends.

Art. 30. The drawings shall be governed by the following rules:

I. where the patent application is not accompanied by drawings, and drawings are necessary for the invention to be understood, the Institute shall call upon the applicant to submit them within a period of two months; where he does not do so, the application shall be considered abandoned;

II. if drawings are mentioned in the application, description or claims and have not been submitted together with the application but in fact are not required for the invention to be understood, the Institute shall call upon the applicant to submit them within a period of two months.

Where the applicant does not comply with the above request, the mention of the drawings shall be deemed not to have been made;

III. where drawings are submitted after the filing date of the application in response to a requirement to do so, the Institute shall recognize, as the filing date, the date on which the amended drawings were submitted, and shall not recognize the filing date that the applicant had already been accorded previously if the amended drawings add material that is new in relation to the original drawings;

IV. graphs, diagrams of the stages in the process and other illustrative material shall be regarded as drawings;

V. the drawings shall be presented in such a way that the invention is perfectly understood; they shall always contain the characteristics or parts of the invention that are claimed;

VI. photographs may be submitted in place of drawings only where the latter would not be sufficient or suitable for illustrating the characteristics of the invention.

Art. 31. When they accompany the application, the drawings may be submitted provisionally without compliance with the requirements set forth in the guide issued by the Institute under Article 3 of these Regulations, but the applicant must, without being required to do so by the Institute, submit to it final drawings that duly meet the prescribed requirements within two months following the date on which the patent application is filed. If the final drawings are not presented within the period specified, the application shall be considered abandoned.

The final drawings presented within the period allowed must not add material that is new in relation to the drawings presented provisionally; if they do, the Institute shall recognize the date on which those drawings were presented to it as the filing date of the application.

Art. 32. For the purposes of Article 47.II of the Law, it shall be assumed that drawings are always necessary for the understanding of utility models and industrial designs submitted for registration.

Art. 33. The abstract shall be drafted according to the following rules:

I. it must comprise:

(a) a summary of the disclosure contained in the description, claims and drawings; that summary shall identify the sector of technology to which the invention belongs and must be so drafted as to permit understanding of the technical problem, the essence of the solution to that problem offered by the invention and the main use or uses of the invention;

(b) where applicable, the chemical formula which, among all those appearing in the description and claims, best characterizes the invention;

II. it must be as concise as the disclosure permits, but its length must preferably not be less than 100 or more than 200 words;

III. it shall not contain statements regarding the supposed merits or value of the claimed invention, or on its proposed application;

IV. every main technical feature mentioned in the abstract and illustrated by a drawing may be accompanied by a bracketed reference mark; the abstract must refer to the drawing that best illustrates the invention.

Art. 34. The record of deposit of biological material referred to in the second paragraph of Article 47.I of the Law shall be submitted within six months following the date on which the

applicant files the corresponding patent application, and the said applicant shall retain the right to the recognition by the Institute of the date and hour of the handing over of the application as the date and hour of filing, provided that the record of deposit shows that the deposit occurred prior to the date and hour of the handing over of the application, failing which the date on which the record was shown to the Institute shall be recognized as the filing date of the application.

Where the applicant fails to show the record in the specified period, the application shall be considered abandoned.

Art. 35. For the purposes of the second paragraph of Article 47.I of the Law, the Institute shall accord recognition to institutions that have the character of international depository authorities for biological material, and also to national institutions, in accordance with internationally recognized criteria and rules.

The Institute shall publish a list of the institutions recognized under this Article in the Official Journal.

Art. 36. For the priority referred to in Article 40 of the Law to be recognized, the applicant shall meet the following requirements:

I. he shall state in the application, where it is known or available, the number of the application filed in the country of origin whose filing date is claimed as the priority date;

II. he shall submit proof of payment of the prescribed fee;

III. he shall submit, within three months following the filing of the application, a certified copy of the application filed in the country of origin, and where appropriate a translation thereof; where this requirement is not met, priority shall be regarded as not having been claimed.

Art. 37. For the purposes of the second paragraph of Article 47.I of the Law, a record of the deposit of biological material shall be required in the following cases:

I. where a microorganism is claimed in itself;

II. where the biological material referred to in the application is not publicly available;

III. where the description that has been given of the biological material is insufficient for a person skilled in the art to reproduce it.

Art. 38. The Institute shall recognize the date on which a patent application is handed over to it by the applicant as the date and hour of its filing, provided that the said application complies

with the requirements laid down in Articles 47.I to III, 179 and 180 of the Law, and also with the provisions of Article 5.III and VII of these Regulations.

Where the application does not comply with one or other of the legal and regulatory requirements specified in the foregoing paragraph, the Institute shall recognize only, as the date and hour of its filing, except in the case referred to in Article 180 of the Law, the date and hour of receipt of the submission by which the applicant complies with the requirements specified in the first paragraph above that were not complied with in the application, or otherwise remedies the failure to comply with the said requirements.

Art. 39. The publication in the Gazette of the pending patent application shall contain the bibliographic data included in the application filed, the abstract of the invention and, where appropriate, the drawing that best illustrates the invention or the chemical formula that best characterizes it. Where the Institute considers that no drawing is of any use for the understanding of the abstract, the publication shall not be accompanied by any drawing when it takes place.

There shall be no publication of applications that have not passed the examination as to form, those that have been abandoned or rejected or those in respect of which amendments have been filed after the completion of the examination as to form.

Art. 40. The early publication of a patent application shall be effected in the issue of the Gazette that corresponds to the period in which the request is made, provided that the application has passed the examination as to form, or in the issue of the Gazette that corresponds to the period during which the application passed the examination as to form.

Art. 41. Where the applicant converts an application for registration of a utility model or industrial design into a patent application or vice versa as provided in Article 49 of the Law, the converted application shall retain the filing date of the original application.

Where an application is converted, the Institute shall inform the applicant of the new file number assigned to it.

Art. 42. The purpose of the substantive examination, in addition to that mentioned in Article 53 of the Law, shall be to determine whether the invention meets the requirements and conditions laid down in Articles 4 and 43 of the Law.

When conducting the substantive examination of the application, the Institute shall consider only that which is contained in the description, the claims and the drawings if any.

If the Institute, on carrying out the substantive examination, establishes that, if it were to decide to grant the patent, there might be an adverse effect on third-party rights under a pending patent application having an earlier date and hour of filing, it shall notify accordingly the applicant whose application it is examining in order that the latter may make such statement as may serve his interests in accordance with the provisions of Article 55 of the Law.

Art. 43. For the purposes of the provisions of Articles 54 and 55 of the Law, those offices shall be considered foreign examining offices that have the character of International Preliminary Examining Authorities within the meaning of the Patent Cooperation Treaty.

The report accepted or required by the Institute on a substantive examination conducted by a foreign examining office may be either that which the latter carries out on an international application filed under the Patent Cooperation Treaty or the report that it issues on applications filed under their legislation.

Art. 44. The report on the substantive examination conducted by a foreign examining office shall be regarded by the Institute as a technical reference document for the purpose of determining whether the invention for which a patent is sought is new, involves an inventive step and is industrially applicable.

The applicant may, instead of the aforementioned documents, submit a copy of the corresponding patent that has been granted by the foreign industrial property office in question, together with a Spanish translation thereof.

Art. 45. If it emerges from the substantive examination that the invention is not new or does not involve an inventive step, the Institute shall inform the person concerned in writing of the examination finding, mentioning the similarities to the prior art cited and references encountered, so that, within a period of two months, he may make such observations as may serve his interests and where appropriate show the differences between his invention on the one hand and the cited prior art and references on the other, or alternatively give reasons for which he insists on the patentability of the invention, or, if he so chooses, amend the claims filed.

Where the applicant does not act on the above invitation within the period allowed, his application shall be considered abandoned.

Art. 46. The date on which the Institute grants the patent and issues the corresponding title shall be that on which payment of the prescribed fee is made, provided that the payment is made to the Institute within the periods specified in Articles 57 and 58 of the Law.

When payment has been made for the issue of the patent or title of registration, the applicant shall submit three copies on art paper of the drawings, chemical formulae or nucleotide or amino acid sequences which, in the opinion of the Institute, are representative of the invention. The

specifications regarding the presentation of the copies in question shall be laid down by the Director General of the Institute as provided in Article 3 of these Regulations.

Art. 47. Publication of the patent shall where appropriate include, in addition to the information specified in Article 60 of the Law, the most representative drawing, the main chemical formula of the patented invention or the nucleotide or amino acid sequence specified by the Institute.

Where the applicant has amended the claims, the Institute shall call upon him to file the abstract with the corresponding corrections.

Art. 48. In order to authorize the changes to the patent referred to in Article 61 of the Law, the Institute may request the applicant to submit the corresponding amendments to the description, claims, drawings or abstract within a period of two months. Where the applicant does not comply with the request within the time allowed, the submission concerned shall be considered abandoned.

Art. 49. In addition to the owner of the patent, any of the licensees may seek reinstatement of the patent under Article 81 of the Law, except where agreed and specified otherwise in the license concerned.

Chapter III Compulsory Licenses and Licenses in the Public Interest

Art. 50. Where a compulsory license is applied for, and the applicant has proved to the Institute that he has the technical and economic ability referred to in Article 71 of the Law, the owner of the patent shall be allowed to inspect the application in order that he may, within the two months following the notification, make such observations as may serve his interests.

If the owner opposes the grant of the compulsory license, the applicant shall be allowed to inspect the said opposition in order that he may, within a period of 15 working days, make such observations as may serve his interests. On expiration of the period set for the inspection, the Institute shall settle the matter in the light of the statements made by the applicant and the owner and the evidence submitted.

Art. 51. The declaration referred to in Article 77 of the Law shall be made by the Institute subject to agreement between the Secretary of Trade and Industrial Development and the incumbent of the Federal Executive.

Within two months following the date of publication in the Official Journal of the declaration provided for in Article 77 of the Law, the owners of patents that have been declared available for licensing in the public interest may submit to the Institute such observations as may serve their interests regarding that declaration. Once those observations have been made, the Institute shall make a final ruling either confirming or revoking the declaration as appropriate, and shall order its publication in the Official Journal.

The Institute shall publish in the Official Journal the ruling declaring the end of the emergency or national security issue that caused the declaration referred to in Article 77 of the Law to be made.

Art. 52. The working of a patented invention by a person holding a license in the public interest shall not be considered done by the owner of the corresponding patent.

When a license in the public interest is granted, the Institute shall impose a period on the licensee for the start of the exploitation of the patented invention, and shall declare failure to

exploit the invention to be a cause of revocation of the license. That period may not exceed one year following the date of grant of the license.

When the Institute, either at the request of the owner of the patent or *ex officio*, rules that the compulsory license or license in the public interest should be revoked, it shall call upon the licensee and where appropriate the owner of the patent to make such observations as may serve their interests and submit any elements of proof that they may consider appropriate.

Title III

Sole Chapter: Trademarks, Advertising Slogans and Trade Names

Art. 53. For the purposes of the provisions of Article 89.II of the Law, the wrappers, packaging, containers, shape or presentation of goods shall be considered three-dimensional shapes.

Art. 54. For the purposes of the provisions of Article 92.II of the Law, it shall be presumed, among other things, that imported goods are legitimate where they meet the following requirements:

I. the introduction of the goods to the market of the country from which importation takes place must be done by the person who in that country is the owner or licensee of the registered mark;

II. the owners of the mark registered in Mexico and in the foreign country must, on the date on which the importation of the goods takes place, be the same person or members of the same joint economic interest group, or their licensees or sub licensees.

Art. 55. For the purposes of the provisions of subparagraph II of the foregoing Article, two or more persons shall be regarded as forming part of the same joint economic interest group where, among other situations, they are interrelated by direct or indirect control, exercised by one of them over the other or others within their decision-making or administrative bodies or in the taking of their decisions.

For the purposes of the provisions of the foregoing paragraph, control shall be understood to mean the power to take general corporate decisions or administrative decisions in the day-to-day operation of the legal entities concerned. This definition shall include indirect control exercised by an intermediary or a succession of intermediaries.

It shall be presumed that control in terms of the first paragraph above exists in the following cases among others:

I. where a person holds or owns corporate stocks or shares, with full voting rights, representing more than 50 per cent of the corporate capital of another person;

II. where a person holds or owns corporate stocks or shares, with full voting rights, representing less than 50 per cent of the corporate capital of another person if there is not another stockholder or partner of the latter who himself holds or owns corporate stocks or shares, with full voting rights, representing a proportion of the corporate capital equal to or greater than that represented by the corporate stocks or shares that the first person holds or owns;

- III. where a person has the right to direct or administer another by virtue of a contract;
- IV. where a person has the power or right to designate the majority of the members of the board of directors or equivalent body of another;
- V. where a person has the power or right to designate the director, manager or chief executive of another.

Art. 56. In the application for registration of a mark, in addition to the particulars mentioned in Article 113 of the Law, the following shall be specified:

- I. when it is known, the number of the class to which the goods or services for which registration is sought belong according to the classification established in these Regulations;
- II. the wordings and figures appearing in the design of the mark whose use is not reserved.

It shall be understood from the mere fact of the filing of the application for registration that the applicant reserves the exclusive use of the mark as appearing in the

representation thereof that is affixed to the application itself, with the exception of the wordings and figures referred to in subparagraph II above. In the case of word marks, it shall be understood that the applicant reserves the exclusive use of the mark in any typeface or letter size.

The application shall be filed in three copies. The handwritten signature of the applicant shall appear on all copies.

Where appropriate, a representation of the mark shall be affixed to each of the copies of the application.

III. The location of the establishments or businesses associated with the mark.

Art. 57. The designation of the goods or services for which registration of the mark contained in the application is sought shall be subject to the following rules:

- I. only goods or services belonging to one and the same class may be specified;
- II. the goods or services must be identified by the names or designations that they are given in the alphabetical list of the classification and the rules for the publication of the said classification, which are published in the Gazette.

Art. 58. The rules referred to in Article 116 of the Law shall be settled by written agreement between the applicants.

The rules must likewise include stipulations on the limitation of goods or services, licensing, cancellation as referred to in Article 154 of the Law and common representation.

Art. 59. The classification of goods and services referred to in Article 93 of the Law shall be the following:

I. Goods

Class 1. Chemicals used in industry, science, photography, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.

Class 2. Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.

Class 3. Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery; essential oils, cosmetics, hair lotions; dentifrices.

Class 4. Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles, wicks.

Class 5. Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

Class 6. Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; metal goods not included in other classes; ores.

Class 7. Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs.

Class 8. Hand tools and implements (hand-operated); cutlery, side arms; razors.

Class 9. Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire extinguishing apparatus.

Class 10. Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials.

Class 11. Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.

Class 12. Vehicles, apparatus for locomotion by land, air or water.

Class 13. Firearms; ammunition and projectiles; explosives; fireworks.

Class 14. Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.

Class 15. Musical instruments.

Class 16. Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paintbrushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks.

Class 17. Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.

Class 18. Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags, umbrellas, parasols and walking sticks, whips and saddlery.

Class 19. Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.

Class 20. Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother of pearl, meerschaum and substitutes for all these materials, or of plastics.

Class 21. Household or kitchen utensils and containers, not of precious metal or coated therewith; combs and sponges, brushes (except paintbrushes); brushmaking materials; articles for cleaning purposes; steel wool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

Class 22. Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.

Class 23. Yarns and threads, for textile use.

Class 24. Textiles and textile goods, not included in other classes; bed and table covers.

Class 25. Clothing, footwear, headgear.

Class 26. Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.

Class 27. Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).

Class 28. Games and playthings, gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

Class 29. Meat, fish, poultry and game; meat extracts, preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats.

Class 30. Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces, condiments; spices; ice.

Class 31. Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.

Class 32. Beers, mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

Class 33. Alcoholic beverages (except beers).

Class 34. Tobacco; smokers' articles; matches.

II. Services

Class 35. Advertising; business management; business administration; office functions.

Class 36. Insurance; financial affairs; monetary affairs; real estate affairs.

Class 37. Building construction; repair; installation services.

Class 38. Telecommunications.

Class 39. Transport; packaging and storage of goods; travel arrangements.

Class 40. Treatment of materials.

Class 41. Education; providing of training; entertainment; sporting and cultural activities.

Class 42. Providing of food and drink; temporary accommodation; medical, hygienic and beauty care; veterinary and agricultural services; legal services; scientific and industrial research; computer programming; services that cannot be classified in other classes.

The Institute shall publish the alphabetical list of goods and services in the Gazette, with a mention of the class in which each product or service is placed.

The goods and services included in the alphabetical list of the classification shall be considered as types. It shall be understood that the enumeration of goods and services in a given class is not exhaustive.

The Institute shall lay down criteria for the interpretation and application of the classification.

Art. 60. For the priority referred to in Article 117 of the Law to be recognized, the applicant for registration of a mark shall meet the following requirements:

I. he shall mention in the application, when he knows it, the number of the application for registration of the mark, filed in the country of origin, the filing date of which is claimed as the priority date;

II. he shall submit proof of payment of the prescribed fee;

III. within three months of having filed the application, he shall submit a certified copy of the application for registration of the mark filed in the country of origin, with a translation where appropriate, where this requirement is not complied with, the right of priority shall be regarded as not having been claimed.

Art. 61. Where the applicant, after having filed the application for registration, amends the distinctive sign, increases the number of goods or services for which registration is sought or replaces or changes the goods or services specified in the application, the latter shall be treated as a new application and made subject to a new procedure, with the prescribed fee having to be paid and the applicable legal and regulatory requirements having to be met. In that case the filing date of the submission by which the applicant amended the original application shall be considered the filing date of the amended application.

Art. 62. For the purposes of Article 130 of the Law, among others, it shall be understood that a mark is in use when the goods or services that it distinguishes have been placed on the market or are available on the market under that mark within the country and in the quantities and form that correspond to custom and practice in trade. It shall also be understood that the mark is in use when it is affixed to goods intended for export.

Art. 63. The Institute may require ratification of the request for cancellation of the registration of a mark where:

I. the registered mark concerned is jointly owned;

II. collective marks are involved.

Art. 64. The goods sold or the service establishment in connection with which a registered mark is used, under either a license or a franchise, shall specify the following particulars in addition to those provided for in Article 139 of the Law:

I. name and address of the owner of the registered mark;

II. name and address of the licensee or franchisee of the mark;

III. the fact that the registered mark is being used under license.

Art. 65. For the purposes of Article 142 of the Law, the owner of the franchise shall provide those interested, after entering into the appropriate agreement, with at least the following technical, economic and financial information:

- I. name, designation or business, address and nationality of the franchisor;
- II. description of the franchise;
- III. age of the original franchising company and, where appropriate, main franchisor in the franchise transaction;
- IV. intellectual property rights involved in the franchise;
- V. amounts and purposes of the payments to be made by the franchisee to the franchisor;
- VI. types of technical assistance and services that the franchisor has to afford the franchisee;
- VII. definition of the territorial area of operation of the business that uses the franchise;
- VIII. right of the franchisee to grant or not to grant sub-franchises to third parties, and where appropriate the requirements to be met in order to do so;
- IX. obligations of the franchisee regarding information of a privileged character supplied to him by the franchisor;
- X. in general, the obligations and rights of the franchisee that derive from the conclusion of the franchise contract.

Art. 66. For the purposes of Article 102 of the Law, the classification provided for in Article 59 of these Regulations shall be applied as appropriate. However, one and the same application may include goods or services from two or more classes.

Art. 67. The provisions of these Regulations on marks shall be applicable as appropriate to advertising slogans and trade names where not otherwise provided for.

Art. 68. For the purposes of Article 169 of the Law, the person concerned must file an application with the Institute specifying and where appropriate submitting the following:

- I. the name, nationality and address of the applicant;
- II. the location of the industrial establishment in which the product covered by the appellation of origin is produced;
- III. a certificate from the competent local authority attesting that the industrial establishment is located within the territory specified in the declaration;
- IV. a certificate from the Secretariat attesting that the person concerned meets the official quality standard, where such a standard, exists. The certificates referred to in items III and IV above shall have been issued within the six months prior to the date on which the request for authorization is filed.
- V. the original or a certified copy of the power of attorney, where the application is filed by an agent.

Title IV Procedure

Chapter I Administrative Procedures

Art. 69. The request for an administrative declaration in the case of an administrative offense shall mention, in addition to the particulars referred to in Article 189 of the Law, the location of the business or business dealings or of the establishments in which the goods or services in relation to which the offense reported is allegedly being committed are manufactured, distributed, marketed or stored, or rendered, as the case may be.

Art. 70. Any submission related to any of the proceedings referred to in Article 187 of the Law shall be accompanied by a copy which shall be sent to the other party.

Chapter II Inspection and Monitoring

Art. 71. Inspection tours shall be governed by the following rules in addition to the provisions of Title VII, Chapter I of the Law:

I. the inspector shall identify himself by showing valid credentials, with a photograph, issued by the competent authority that attest his entitlement to carry out the duties in question;

II. the inspector shall have been provided with an inspection warrant with a handwritten signature issued by the competent authority, which shall specify the address or addresses of the establishments in which the inspection is to be conducted, the purpose

of the inspection, the area that it has to cover and the legal provisions on which it is based;

III. the owner of an industrial property right protected by the Law who applies to the Institute for an investigation of acts in violation of the said Law or of his rights may attend the corresponding inspection tour either in person or through an agent, and may make observations which shall be entered in the record;

IV. the person on whom the inspection tour is imposed shall have the right to make such observations as he considers appropriate, and also to submit evidence in the course of the tour, or make use of the same right within the following ten working days.

Art. 72. The seizure of goods shall be governed by the following rules in addition to the provisions of the Law:

I. for the purposes of the provisions of Article 211 of the Law, the person on whom the inspection order is served shall be considered the head of the establishment if the owner or his representative is not present;

II. the depositary shall be under an obligation, with respect to the goods seized, to keep them at the address at which the service took place, or where appropriate a place designated for the purpose; they shall not be at his disposal, and he shall keep them at the disposal of the Institute;

III. property seized that has to be kept at the Institute shall be stored in a room specially provided for the purpose by, and under the responsibility of, the Institute itself or the competent delegation of the Secretariat;

IV. the inspector may make whatever arrangements are necessary for the issue of the order and for the carrying out of the seizure; he may also seek the assistance of the forces of law and order or the intervention of the Federal Public Prosecutor where he considers such a step appropriate.

Art. 73. The seizure of property shall be lifted where:

I. the Institute ruling declaring that no administrative infringement of the Law has been committed becomes final;

II. the corresponding administrative sanction imposed by the Institute is declared without foundation or is invalidated by virtue of a court order;

III. the property is placed at the disposal of the Federal Public Prosecutor;

IV. a court order so decrees.

Art. 74. The Institute may require the requesting party to increase the amount of the security referred to in item II of Article 199bis.1 of the Law where it becomes clear in the implementation of the measure that the security originally set is insufficient to cover any damages and prejudice that might be suffered by the person against whom the measure was sought.

Chapter III Sanctions

Art. 75. The amount of the fines referred to in item (I) of Article 214 of the Law shall be calculated according to the general minimum daily wage applicable in the Federal District on the date on which the infringement concerned was committed. In the event of several instances of infringement the amount shall be that applicable on the day on which the Institute had knowledge of the infringements.

Art. 76. An order of temporary or permanent, total or partial closure shall be imposed, and in implementing it the authorized official shall proceed to take a detailed record of the measure, observing where appropriate the formalities laid down in Articles 208, 209 and 212 of the Law.

Art. 77. Temporary closure shall be carried out subject to the following rules:

I. where there are perishable goods in the establishment, they shall be removed under the responsibility of the owner or the person responsible for the establishment;

II. where the goods referred to in item I above constitute the subject matter of the sanctioned administrative offense, the owner of the establishment or of the goods concerned may only remove them if he provides prior security that is sufficient, in the judgement of the Institute, to ensure compensation for damages and prejudice inflicted on the owner of the industrial property

rights affected by the administrative infringement, or third parties, in which case the infringing distinctive signs shall be removed;

III. the seals used for the closure shall be numbered consecutively and shall refer to the act concerned;

IV. at the end of the temporary closure, the Institute shall order the removal of the seals in a proceeding of which a written record shall be taken.

Art. 78. The additional fine referred to in item II of Article 214 of the Law shall be imposed in the event of persistence in the administrative infringement after notification of the ruling condemning the said infringement and expiration of the period allowed by the Institute for the infringer to show that he has ceased the infringement.

Art. 79. The Institute shall authorize its staff to undertake inspection tours or verifications of facts against payment of the appropriate fee.

Transitional Provisions

First. These Regulations shall enter into force 15 days following their publication in the Official Journal.

Second. The regulations under the Law on Inventions and Marks, published in the Official Journal on August 30, 1988, are repealed.

Third. Until such time as the Institute publishes the official forms, those previously used shall continue to be used.

Fourth. Business that was in progress on the entry into force of these Regulations shall be governed by and shall proceed according to the provisions of these Regulations in so far as acquired rights are not thereby prejudiced.