



PATENT PROSECUTION REVIEW 2024

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Mexico: Bridging National Industrial Design Protection with International Practices

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In summary

In this article, we will explore the primary challenges and opportunities associated with protecting industrial designs in Mexico. We will discuss the current scenery and the emerging trends, emphasising Mexico's decisive actions to harmonise the protection of industrial designs.

Discussion points

- 2018: a turning point for industrial design protection in Mexico
- The 2020 legislative update for industrial designs
- Mexico and the Hague System: an analysis of industrial design protection trends

Referenced in this article

- Industrial Property Law
- Hague Agreement for the International Registration of Designs



The landscape for protecting industrial designs is constantly evolving owing to the changing demands of national and international regulations. These demands are mainly driven by rapid advancements in technology. As new technologies emerge, they redefine how we conceive, implement and protect designs across different countries. For designers, industries and IP professionals, understanding this landscape is crucial to effectively protect their intellectual property worldwide.

In this article, we will explore the primary challenges and opportunities associated with protecting industrial designs in Mexico. We will discuss the current scenery and the emerging trends, emphasising Mexico's decisive actions to harmonise the protection of industrial designs.

2018: a turning point for industrial design protection in Mexico

In 2018, Mexico took a significant step to harmonise its legislation on the protection of industrial designs with international standards by introducing a reform to the prevailing Industrial Property Law. This reform brought fundamental changes to align it with international practices.

Evolution of protection terms

A notable example of this effort was the modification of the protection duration for industrial designs. Before 2018, a design was protected for 15 years. With the reform, this duration was shortened to five years, but with the option to renew it every five years, reaching a maximum of 25 years from the filing date in Mexico. This change was implemented to align Mexico's regulations with international standards, mainly those of the European Union Intellectual Property Office (EUIPO).

When this reform was implemented on 27 April 2018, a 30-business-day period was granted for those with pending industrial design applications. They could request the Mexican Patent Office (IMPI) to apply the new provisions to their applications instead of the rules that were in place at the time of their application.

For applications submitted after the reform's implementation, IMPI automatically applied the new rules. This was irrespective of whether they were divisional applications or whether a request to apply the new provisions had been made. Consequently, this led to design families wherein some designs had a validity of 15 years (those that did not adopt the reform provisions) and others, originated from the same applications, had a validity of five years, renewable up to 25 years.

Clarifying novelty requirement

In Mexican legislation, industrial designs that are considered novel and have industrial application are eligible for registration. Regarding novelty, the 2018 reform introduced definitions for the terms 'independent creation' and 'significant degree'. Consequently, a design is recognised as novel when it arises from an



independent creation and differs in significant degree from known designs. Although the introduction of these definitions aimed to provide greater clarity to novelty assessment, in practice, it still leads to subjectivity during analysis. These definitions are also similar to those of the EUIPO.

A step towards openness: publication of applications

Another significant change brought by the reform, which offers greater legal certainty to the industrial property system, was the provision that industrial design applications and divisional applications, would be published in the Official Journal of the Federation and subject to public inspection upon the completion of the formal examination. Prior to this reform, these applications were only made public once they had been granted.

The 2020 legislative update for industrial designs

Later, on 5 November 2020, Mexico took an additional step forward in its industrial design legislation with the promulgation of a new law. This regulation aligns the country with international standards and brought about other significant advances in the field of industrial designs. These changes, which will be discussed below, were motivated by the entrance into force of the United States–Mexico–Canada Agreement.

Unity of design

One of the most notable and innovative elements of this legislation is the introduction of the concept of 'unity of design'. Unlike other jurisdictions, Mexico carries out a substantive examination of industrial design applications. In this process, the novelty of the design in question is evaluated, as well as its unity.

To meet the unity requirement, when an application encompasses several designs, they should have the same name, share novel features and produce the same overall impression. However, the interpretation of the unity criterion can be subjective, leading to complications in the examination process. It is common for design applications to be objected to owing to a lack of unity, requiring the division of the application and submission of divisional applications for the non-elected designs.

It is crucial to bear in mind that if an application receives an objection owing to lack of unity, the corresponding divisional applications must be submitted along with the response to such objection.

Disclaiming parts of a design

Disclaiming parts of a design has become clearer in the new legislation regarding how to distinguish elements that are not part of the claimed design.



In the past, although using broken lines to depict unclaimed portions of a design was common practice, the law did not explicitly support this practice.

With the recent changes, the legislation expressly stipulates that components not claimed should be represented using broken lines. While this method is preferred, the law also allows alternative techniques, such as blurring, shading or outlining contours, provided the distinction between claimed and unclaimed design elements is clear.

However, certain practical challenges remain. For instance, when illustrating a partial design using broken lines, IMPI often requires a name change for the design. Imagine an applicant claiming a bottle design, with parts represented by broken lines to illustrate they are not claimed. In these situations, IMPI generally requires adjusting the design's title to 'portion of a bottle' instead of simply 'bottle'.

The implications of these changes are relevant. For example, within a single application, if one design illustrates an entire bottle with solid lines, and another only the top with broken lines (and the rest in solid lines), labelling the latter as 'portion of a bottle' creates a discrepancy in the unity of design. This is because the designs are not recognised under the same name, leading to potential lack of unity based on differing titles.

These details highlight the importance of accuracy and consistency in naming industrial designs, ensuring clarity and facilitating the IMPI registration process.

Animated graphic interfaces

The new regulations also addressed another critical aspect: the protection of animated sequences and graphic interfaces.

A few years ago, when designers sought protection for these sequences or interfaces, they often faced unity objections asking to divide the application, focusing on a single view of the sequence in each submission. This approach posed not only an economic challenge for applicants, as it required multiple registrations for a single interface, but it also misrepresented the dynamic nature of these designs.

It became essential to understand that animated graphical interfaces, especially those within digital applications and platforms, cannot be reduced to individual static views without losing their essence. What makes an animated sequence or interface special is precisely the movement and progression it presents, and it is that dynamic characteristic that requires protection.

Fortunately, current legislation has recognised this need and has evolved to allow the protection of these sequences as industrial designs. This protection is viable as long as the representation provides a clear understanding of the movement or progression. This legislative advance not only benefits creators



and developers, but also ensures that design innovations, particularly in the digital environment, get the recognition and protection they sought.

Prior disclosure

The evolution of industrial designs regulations in Mexico has addressed several key points, one of which is prior disclosure. The earlier Mexican legislation stated that if the inventor or their assignee disclosed an industrial design within the 12 months preceding the application filing or the claimed priority, this disclosure would not compromise the design's novelty.

The new law introduces additional clarification regarding disclosures that are not considered as part of the prior art. Specifically, in addition to disclosures made by the inventor or their assignee within this 12-month time frame, disclosures from third parties who acquired the information directly or indirectly from these primary sources are also considered under this benefit.

However, Mexican legislation specifies publications made in an application, patent or registration by IMPI or any foreign patent office are exempted from this grace period's advantage. This provision reinforces the priority timelines set by the Paris Convention.

Mexico and the Hague System: an analysis of industrial design protection trends

At the international level, Mexico has taken measures to strengthen the protection of industrial designs. Specifically, in 2020, Mexico joined the Hague Agreement for the International Registration of Designs, also known as the Hague System. Since 6 June 2020, applicants have been able to use this system to protect their designs in Mexico and other member countries of the system with a single international application. As of now, there are 79 members.¹

Despite initial expectations that Mexican designers would frequently use the system, it appears underutilised by national applicants. Of the 3,534 industrial design applications submitted in Mexico in 2022, approximately 28 per cent came from national applicants.² However, the number of international applications originating from Mexican designers remains strikingly low. In contrast, according to the most recent yearly review of the Hague System in 2022, Mexico ranks among the top 20 countries³ with the most designations.

Therefore, it is crucial for users of this system to understand the particulars when designating Mexico in an international application.

1 https://www.wipo.int/wipolex/en/treaties/ShowResults?search_what=C&treaty_id=9.

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

3 Hague Yearly Review 2023 – published by the World Intellectual Property Organization: <https://www.wipo.int/edocs/pubdocs/en/wipo-pub-930-2023-en-hague-yearly-review-2023.pdf>.



Priority recognition in Mexico: challenges and perspectives

One of the most critical details to note when designating Mexico in an international application is the recognition of priority. According to Mexican law, when a priority is claimed, it is mandatory to submit a certified copy of the priority document, pay the required official fees for its recognition and provide a translation in Spanish within three months of its publication in the International Design Bulletin. If these requirements are not fulfilled, the claimed priority will not be recognised by Mexico.

Although IMPI participates in the Digital Access Service system (DAS), only patent offices have access to this system to obtain the certified copies. However, even when the DAS code is indicated in the international application, it remains pending to make the necessary payment for the official priority fees and to provide the translation of the priority document into Spanish.

Failing to meet these requirements has resulted in the loss of priority rights. Consequently, any document published before the filing date of international application, including the potential publication of the application that was claimed as priority, is considered part of the prior art. As a result, several designs have been rejected in Mexico for lacking novelty.

On the other hand, even though most applications in Mexico are now submitted online due to the impacts of the covid-19 pandemic, applications originating from an international designation are still processed physically. This means that if the agent in Mexico doesn't already have a power of attorney, both the certified copy of the priority and a physical power of attorney must be submitted within the three-month term following the publication in the International Bulletin. This introduces an additional layer of complexity to the process, emphasising the need for applicants to be fully informed and prepared when seeking priority recognition in Mexico.

Meeting Mexican requirements has become challenging because of the difficulties in sending and receiving hard copy documents in the digital age. However, there is hope on the horizon: IMPI has recently indicated that it is developing a strategy to prosecute such applications online in the near future, which will be a positive step towards simplifying the process.

International applications under IMPI substantive emanation: from notices to divisional filings

Another critical aspect of the international design application process pertains to the notifications of refusal issued by IMPI. First, these notifications are sent by IMPI to the WIPO so the applicant (or appointed representative) of an international application receives this notice through the International Bureau, not from their agent in Mexico. This same procedure applies to notices of



allowance and design certificates, even when an agent in Mexico has already attested its personality for that application with IMPI.

Consequently, upon receiving a notification of refusal, the applicant or their representative must coordinate with an agent in Mexico to respond it timely and appropriately. If the Mexican agent has not yet attested its personality before IMPI, they must do so to be able to respond to the refusal.

In contrast to design applications submitted directly to IMPI, where up to two office actions related to the result of the substantive examination can be issued, only one notification of refusal is permitted for international applications. This means that if the grounds for refusal are not overcome in the response, the industrial design application would be denied, forcing applicants to appeal the decision in a separate venue.

The primary objection issued by IMPI for international applications refers to the lack of unity of design. Given what was previously detailed about the requirements that designs must satisfy to be considered under the same design concept, most applications pursuing two or more designs will be rejected owing to lack of unity.

Consequently, when facing this objection, it is necessary to divide the application and submit divisional applications for the non-selected designs. These divisional applications must be filed directly to IMPI, not to WIPO. In this context, unlike the international application, all notifications regarding these divisional applications will be sent to the agent in Mexico rather than the International Bureau, marking a significant shift in the communication and tracking procedure.

Visual perspectives: the unwritten rules of industrial design in Mexico

Another challenge in harmonising criteria for design protection relates to the number of views presented. Although Mexican law does not establish a specific number of views that must be included, some international applications have been rejected because the provided views do not offer a comprehensive understanding of the intended design. This can create confusion and complications for applicants, especially if they are unfamiliar with the unwritten expectations prevailing in Mexico.

For industrial drawings (designs in two dimensions), a single view is often sufficient to provide an adequate understanding of the design. However, for industrial models, which refer to three-dimensional designs, it is more common to present up to seven different views: perspective, front, back, left, right, top and bottom. These views, by offering a representation from various angles, allow for a more complete and detailed understanding of the design in question.

Therefore, when designating Mexico in international applications, applicants should take this into account to avoid unnecessary objections.



Decoding Mexico's design protection: the implication of product identification

Finally, another important consideration when designating Mexico in an international application is that Mexican legislation requires the title of the design to indicate the product to which it is applied. This requirement has led to the rejection of some applications, especially those pursuing two-dimensional designs.

For instance, designs under class 32 of the Locarno classification, which pertain to graphic symbols, logos and surface patterns, have often been rejected because they do not specify the product to which the design is applied.

The challenge posed by the digital sphere is particularly interesting, as a specific design might be applied to a physical product, but the applicant may also wish to protect that design in the digital environment. As in other countries, to protect a digital design, it is necessary to specify a physical product to which it is applied, such as a display screen or another tangible article.

Therefore, although it might seem that one solution could be to specify in the design title that it is applicable to different products, IMPI's position is that the design can only specify its application to a single product.

A consequent question is: what about designs intended for products not explicitly mentioned in the title? Would they receive implicit protection when registered for other products?

According to Mexican law, infringement arises when an industrial design is used that either does not differ to a significant degree from a protected design or utilises combinations of characteristics from such a protected design.

Therefore, we believe that as this provision is not narrowed down to the Locarno classification or any other statement made in the application papers, the specification in the title of the product to which the design will be applied should not be viewed as the boundary of industrial design registrations.

In spite of these challenges, the Mexican industrial design system remains resilient. We are confident that, with the evolution of new technologies, Mexican legislation will continue to define new regulations and criteria to adapt to them, offering the best protection for industrial designs.

Mexico's commitment to industrial design protection is evident through its alignment with key international systems, including the Hague System. While there is always room for improvement in the field of industrial property, especially given the constant evolution of new technologies and products, the current framework effectively safeguards intellectual assets. For those looking to protect their designs, Mexico stands as a strategic option, offering both efficiency and robustness in design protection.

**Daniel Sanchez**

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Daniel Sanchez joined OLIVARES in 2000 and became a partner in 2011. He is one of the leading intellectual property and administrative litigators in Mexico and is recognised by industry rankings and publications.

Mr Sanchez's work is extensive, with experience in prosecution and litigation across all areas of IP, including trademarks, copyrights, patents and unfair competition. His broad background allows him to tailor enforcement strategies to a range of needs. His practice is focused in litigation and regulatory matters, with a specialisation in life sciences and technology. Mr Sanchez co-chairs OLIVARES' litigation team, the patent team and the IT industry group. His team is focused on litigation before the Mexican Institute of Industrial Property (IMPI) and the federal courts and in patent prosecution before IMPI. As one of the few regulatory and administrative litigation experts in Mexico, Mr Sanchez guided the development and implementation of a revolutionary and proprietary software system that replicates the drug naming and labelling approval process within COFEPRIS, Mexico's health ministry. This drastically improves the accuracy of advice about whether clients marketing authorisations can and will be approved. He also has led OLIVARES' team in obtaining alcoholic beverage advertisement approvals from COFEPRIS.

Mr Sanchez has authored various articles on IP and life sciences-related matters and he has lectured on IP topics in both national and international forums. He chaired the Intellectual Property Committee of the Mexican Bar Association from February 2015 to July 2017 and was vice president of the Mexican Association for the Protection of Intellectual Property (AMPPI) 2014–2016. He is also a member of INTA, BIO and AIPPI, and has participated as an observer in APAA at various meetings.

**Jorge Juárez**

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Jorge Juárez is a mechatronics engineer specialising in computerised manufacturing. He has been working in intellectual property since 2006, and he focuses his practice on the technical-legal analysis of patents, utility models and industrial designs, advising national and foreign clients about the protection



of their inventions in Mexico and abroad. He joined OLIVARES in 2016, where he supervises the patent team in charge of the filing and prosecution of applications in the mechanical, electrical, utility models and industrial design areas.

Jorge is the current president of the Patent Committee of the Mexican Association for the Protection of Intellectual Property (AMPPI), where he has held various positions since 2007, including coordinator of the Patents Committee, as well president of the Subcommittees of Mechanics-Electricity/Electronics-Industrial Designs, and Selected Topics of Industrial Property.

Jorge has written numerous articles for national and international publications and taught different courses related to the legal figures of industrial property.



OLIVARES is determined to provide an innovative approach to solving complicated legal challenges in Mexico on behalf of clients. The firm aims to utilise every available resource to help clients achieve optimum results, protecting their business interests, intellectual property and other rights at every level and through the applicable administrative or judicial venue, in order to maximise successful outcomes – all while maintaining an overarching goal of contributing to Mexico's broader stance in the global economy and for the greater good of the Mexican people.

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