



**REVIEW UNDER ARTICLE 24.2 OF THE APPLICATION OF THE PROVISIONS OF THE
SECTION OF THE TRIPS AGREEMENT ON GEOGRAPHICAL INDICATIONS**

RESPONSES TO THE CHECKLIST OF QUESTIONS¹

Revision

MEXICO

This document contains updated responses to the Checklist of Questions, which the Secretariat received from the delegation of Mexico by means of a communication dated 24 May 2018.

Introduction

A. General

1. Is protection for geographical indications provided through unfair competition law, e.g. passing off, false designation of origin; through a formal procedure for notification/registration before protection is available; or through both? Does the recognition of a geographical indication require registration?

The Industrial Property Act (LPI) is the legal enactment which sets penalties for acts of unfair competition in respect of geographical indications (Article 213.IX.d). No registration of a geographical indication is required in order for the provisions on unfair competition contained in the Act to apply. Protection is also provided by reference to the geographical indication or appellation of origin (Articles 156 to 168), in which case a declaration of protection is issued by the Mexican Industrial Property Institute (IMPI).

2. Is there one single regime of protection of geographical indications for all products? If not, identify the different regimes.

Yes, there is a single regime of protection for geographical indications.

Under the Industrial Property Act, geographical indications may be protected in three different ways:

- (a) by means of the legal formulas "geographical indication" and "appellation of origin" (Articles 156 to 178);
- (b) against acts of unfair competition (Article 213.IX.d);

¹ Documents IP/C/13 and IP/C/13/Add.1. The four questions circulated via document IP/C/13/Add.1 have been added to sections A, B and F of the Checklist, where they appear as questions 7(a), 16(a), 16(b) and 46(a).

- (c) by preventing the registration of marks which mislead the public as to the origin or source of the product or service and of marks purporting to register names of peoples or places characterized by the manufacture of certain products (Article 90.X and XI).

3. Do(es) the regime(s) of protection of geographical indications also extend to services?

No.

4. What provisions of law or regulations are directed to the recognition of geographical indications required by Articles 22.2 and 23.1 of the TRIPS Agreement? Citations to laws should be provided and, if the texts of the laws have not been notified to the WTO, copies should be provided pursuant to Article 63.2.

The Industrial Property Act, most recently amended in 2018, is the relevant legislation for the protection of geographical indications.

In accordance with Article 22.2 of the TRIPS Agreement, Article 213 of the Industrial Property Act sets sanctions for acts of unfair competition. The provision in question defines the following, *inter alia*, as administrative offences:

"IX. In the exercise of industrial or commercial activities, to carry out acts which confuse or mislead the public by creating the unfounded belief or assumption: ..."

(d) That the product in question originates in a territory, region or locality other than the true place of origin, so that the public is misled as to the geographical origin of the product;

XXII. To use a protected appellation of origin or geographical indication without the necessary authorization;

..."

Similarly, Article 165 *bis* 20 of the Act provides that the illegal use of a protected appellation of origin or geographical indication will be penalized, even where it is accompanied by terms such as "kind", "type", "manner", "imitation" or the like, which mislead the consumer or involve unfair competition.

5. If the required recognition of geographical indications is not provided through statutes or regulations, please explain, in detail, the mechanism or mechanisms through which the protection required is provided.

Not applicable. Protection of geographical indications is provided for in the Industrial Property Act.

6. Please provide a few examples of domestic geographical indications protected in accordance with the means discussed above and indicate the means by which such protection is provided.

Mexico has extended protection to the following domestic geographical indications through reference to the appellation of origin:

Appellation of origin	Product	National protection by declaration of protection
Ámbar de Chiapas	Crafts/ Resin	Publication in the Official Journal (<i>Diario Oficial de la Federación</i>) of 31 December 1969
Arroz del Estado de Morelos	Rice	Publication in the Official Journal of 16 February 2012
Bacanora	Spirits	Publication in the Official Journal of 6 November 2000
Cacao Grijalva	Cocoa	Publication in the Official Journal of 29 August 2016
Café Chiapas	Coffee	Publication in the Official Journal of 27 August 2003
Café Veracruz	Coffee	Publication in the Official Journal of 31 December 1969
Charanda	Spirits	Publication in the Official Journal of 27 August 2003
Chile Habanero de la Península de Yucatán	Chilli	Publication in the Official Journal of 4 June 2010
Mango Ataulfo del Soconusco de Chiapas	Mango	Publication in the Official Journal of 27 August 2003
Mezcal	Spirits	Publication in the Official Journal of 28 November 1994

Appellation of origin	Product	National protection by declaration of protection
Olinalá	Crafts	Publication in the Official Journal of 28 November 1994
Sotol	Spirits	Publication in the Official Journal of 8 August 2002
Talavera	Crafts	Publication in the Official Journal of 11 September 1997
Tequila	Spirits	Publication in the Official Journal of 9 December 1974
Vainilla de Papantla	Vanilla	Publication in the Official Journal of 5 March 2009
Yahualica	Chilli	Publication in the Official Journal of 16 March 2018

The mechanism by which such protection is provided is a declaration of protection of an appellation of origin issued by IMPI in accordance with Article 164 of the Industrial Property Act.

7. Is the higher level of protection required for wines and spirits under Article 23.2 of the TRIPS Agreement provided for any other product? If so, please specify such products and the law under which they are protected.

Mexico does not make a distinction among different types of products with respect to the level of protection.

The Industrial Property Act protects any product against registration of a trademark referring to a geographical indication. Under Article 90, the following may not be registered as marks:

"X. Geographical, proper or common names, maps, and names and adjectives of origin, when they indicate the source of the products or services and may be confusing or misleading with regard to that source;

XI. Names of peoples or places characterized by the making of certain products, when used to cover such products, except for the names of places under private ownership, when they are specific and unmistakable and the owner's consent has been given."

However, the Industrial Property Act acknowledges that the Government of Mexico may recognize geographical indications pursuant to international treaties (Article 166). The level of protection will be that indicated in the relevant treaty.

7(a). Does your economy's industrial property law and/or related law prevent the use of geographical indications identifying wines or spirits against products not originating in the place indicated by the geographical indication, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like?

No (see reply 4).

[Reply 4:

The Industrial Property Act, most recently amended in 2018, is the relevant legislation for the protection of geographical indications.

In accordance with Article 22.2 of the TRIPS Agreement, Article 213 of the Industrial Property Act sets sanctions for acts of unfair competition. The provision in question defines the following, *inter alia*, as administrative offences:

"IX. In the exercise of industrial or commercial activities, to carry out acts which confuse or mislead the public by creating the unfounded belief or assumption:..."

(d) That the product in question originates in a territory, region or locality other than the true place of origin, so that the public is misled as to the geographical origin of the product;

XXII. To use a protected appellation of origin or geographical indication without the necessary authorization;

..."

Similarly, Article 165 *bis* 20 of the Act provides that the illegal use of a protected appellation of origin or geographical indication will be penalized, even where it is accompanied by terms such as "kind", "type", "manner", "imitation" or the like, which mislead the consumer or involve unfair competition.]

B. Definition and criteria for recognition

8. How are geographical indications defined?

Article 157 of the Industrial Property Act defines a geographical indication as "... the name of a geographical area or containing said name, or another well-known indication referring to said area, that identifies a product as originating in that area, where a given quality, reputation or other characteristic of the good is fundamentally attributable to its geographical origin".

9. Would such a definition comprise geographical indications identifying products of a certain quality or reputation, which are indirectly linked to a specific region?

No.

10. In determining whether recognition should be given a geographical indication, what criteria are considered?

The criteria to be considered for purposes of an application for protection of an appellation of origin or geographical indication are listed in Article 165 *bis* of the Industrial Property Act. They include the following in particular:

III.- An indication of the appellation of origin or geographical indication;

IV. A detailed description of the finished product or products, including their characteristics, components, mode of extraction, production or preparation processes and use in trade;

V. The Mexican Official Standards to which the product, its mode of extraction, its preparation or production processes and its packaging, as applicable, will be subject;

VI. The criteria setting out the characteristics and specifications that the product must meet in its production, packaging and marketing, in the case of a geographical indication;

VII. The place or places of extraction, production or preparation of the product to be protected and the delimitation of the territory or geographical area, with reference to the geography and political boundaries;

VIII. A detailed description of the relationship between the appellation, the product, the territory or geographical area and the natural or human factors, when the application relates to an appellation of origin;

IX. A technical study issued by a public or private authority or institution that supports the information referred to in points IV, VII and VIII of this Article; ..."

In the case of recognition of a geographical indication protected abroad, the applicant must at least submit the document pursuant to which protection was extended to the appellation of origin or geographical indication in the country of origin, indicate the product or products protected and note (if applicable) its Spanish translation or transliteration (Article 167 of the Act).

11. Is there any human creativity involved in the making of specific products under protection by the system of geographical indications? If so, how much? And do these products involve any human factors?

Human factors are considered in the definition of the appellation of origin but not in that of the geographical indication. With respect to appellations of origin, the techniques and methods used by the inhabitants of the region in order to make a specific product give that product a high degree of distinctiveness (see definition under reply 16(a)).

[Reply 16(a):

Article 156 of the Industrial Property Act defines an appellation of origin as "... a geographical area or containing said name, or another well-known appellation referring to said area, that serves to designate a product as originating in that area, where the quality or characteristics of the product are due exclusively or essentially to the geographical environment, including natural and human factors".

Article 157 of the Industrial Property Act defines a geographical indication as "... the name of a geographical area or containing said name, or another well-known indication referring to said area, that identifies a product as originating in that area, where a given quality, reputation or other characteristic of the good is fundamentally attributable to its geographical origin".

An indication of source is defined in accordance with the Paris Convention for the Protection of Industrial Property.]

12. Are there any other intellectual property rights involved, such as patents for example?

The types of protection available for geographical indications are set out in reply 2.

[Reply 2:

Under the Industrial Property Act, geographical indications may be protected in three different ways:

(a) by means of the legal formulas "geographical indication" and "appellation of origin" (Articles 156 to 178);

(b) against acts of unfair competition (Article 213.IX.d);

(c) by preventing the registration of marks which mislead the public as to the origin or source of the product or service and of marks purporting to register names of peoples or places characterized by the manufacture of certain products (Article 90.X and XI).]

13. What authority, if any, may define the geographic region or area for which rights are claimed and on what basis is such definition made?

The area is defined by the same geographical conditions which determine the quality, reputation or characteristics of the product.

IMPI is the authority with power to delimit the geographical area of a geographical indication. This power is established in Article 165 *bis* 10 of the Industrial Property Act: "... The declaration will definitively determine the particulars of the protected appellation of origin or geographical indication, specifying in detail: (...) III. – The delimitation of the protected territory or geographical area."

14. Does your legislation contain criteria for homonymous geographical indications for wines?

Homonymous geographical indications may be protected (regardless of the product) through a resolution issued by IMPI that allows the names to coexist:

"Article 163. The following may not be protected as appellations of origin or geographical indications:

I. A name that is identical or confusingly similar to a protected appellation of origin or geographical indication, or to one stated in an application for protection already submitted and under review, and that is applied to the same or similar products, unless a resolution issued by IMPI permits said names to coexist; (...)"

15. Does your national legislation provide for recognition and protection of geographical indications or appellations of origin of foreign countries?

Yes, under Article 166 of the Industrial Property Act. The Act also provides that a geographical indication may be recognized and protected pursuant to an international treaty between Mexico and a trading partner.

16. Is there any specific prohibition in the legislation/regulations/rules/procedures covering geographical indications not protected in the country of origin? If so, please specify the relevant statutory provision.

In order to register a geographical indication protected abroad, one of the requirements is to submit the "document pursuant to which protection was extended to the appellation of origin or geographical indication under the applicable laws of the country of origin or in accordance with the International Treaties" (Article 167.II). According to Article 178 of the Industrial Property Act, the registration of the recognition of a geographical indication protected abroad will be cancelled if "the document referred to in Article 167.II ceases to have effect in the country of origin".

16(a). Is there a clear distinction among the terms "geographical indications", "appellations of origin" and "indications of source" in your economy's industrial property law and/or related law, or are there any substantive criteria to distinguish these terms?

Article 156 of the Industrial Property Act defines an appellation of origin as "... a geographical area or containing said name, or another well-known appellation referring to said area, that serves to designate a product as originating in that area, where the quality or characteristics of the product are due exclusively or essentially to the geographical environment, including natural and human factors".

Article 157 of the Industrial Property Act defines a geographical indication as "... the name of a geographical area or containing said name, or another well-known indication referring to said area, that identifies a product as originating in that area, where a given quality, reputation or other characteristic of the good is fundamentally attributable to its geographical origin".

An indication of source is defined in accordance with the Paris Convention for the Protection of Industrial Property.

16(b). Does your legislation contain criteria for homonymous geographical indications for wines and spirits?

See reply 14.

[Reply 14:

Homonymous geographical indications may be protected (regardless of the product) through a resolution issued by IMPI that allows the names to coexist:

"Article 163. The following may not be protected as appellations of origin or geographical indications:

I. A name that is identical or confusingly similar to a protected appellation of origin or geographical indication, or to one stated in an application for protection already submitted and under review, and that is applied to the same or similar products, unless a resolution issued by IMPI permits said names to coexist; (...)"]

C. Procedure for recognition

17. With respect to any formal system for recognition of geographical indications, must the applicant be a governmental organization or can a private entity own the rights to a geographical indication?

Under Article 165 of the Industrial Property Act, an appellation of origin may be declared protected *ex officio* or at the request of whoever demonstrates a legal interest. With respect to recognition of

geographical indications protected abroad, the application for entry in the relevant register must be submitted by the holder of the geographical indication.

18. What are the competent authorities where the protection of a geographical indication can be obtained?

IMPI is the authority competent to issue a declaration of protection of an appellation of origin or geographical indication (Article 159 of the Industrial Property Act).

At the same time, in accordance with the various forms of protection provided for in the Act (see reply 3), recourse may be had to IMPI or to the federal courts (Articles 156 to 168, 151 to 155, 187 to 199 *bis* 8 and 213 to 229 of the Act).

19. Do the procedures which lead to the recognition of a geographical indication take place *ex officio* or must they be based on the initiative of an entity or person?

See reply 17.

[Reply 17:

Under Article 165 of the Industrial Property Act, an appellation of origin may be declared protected *ex officio* or at the request of whoever demonstrates a legal interest. With respect to recognition of geographical indications protected abroad, the application for entry in the relevant register must be submitted by the holder of the geographical indication.]

20. What, if any, fees are involved in the application and maintenance of rights in a geographical indication?

Payment of the applicable charge.

21. If criteria must be set out in an application for recognition of a geographical indication, are those criteria purely geographic in nature?

The application for protection of an appellation of origin must include, in addition to the geographical criteria, a detailed description of the product or products, including their characteristics, components, mode of extraction, production or preparation processes and use in trade, as well as criteria regarding the characteristics and specifications that the product must meet in its production, packaging and marketing and its methods of packaging, together with any other criteria considered relevant by the applicant (Article 165 *bis* of the Industrial Property Act).

See also reply 10. In the case of an application for recognition of a geographical indication protected abroad, the requirements set forth in Article 167 of the Industrial Property Act must be satisfied.

22. What other criteria, if any, must be set out in an application for recognition of a geographical indication?

See replies 10 and 21.

[Reply 10:

The criteria to be considered for purposes of an application for protection of an appellation of origin or geographical indication are listed in Article 165 *bis* of the Industrial Property Act. They include the following in particular:

"III. An indication of the appellation of origin or geographical indication;

IV. A detailed description of the finished product or products, including their characteristics, components, mode of extraction, production or preparation processes and use in trade;

V. The Mexican Official Standards to which the product, its mode of extraction, its preparation or production processes and its packaging, as applicable, will be subject;

VI. The criteria setting out the characteristics and specifications that the product must meet in its production, packaging and marketing, in the case of a geographical indication;

VII. The place or places of extraction, production or preparation of the product to be protected and the delimitation of the territory or geographical area, with reference to the geography and political boundaries;

VIII. A detailed description of the relationship between the appellation, the product, the territory or geographical area and the natural or human factors, when the application relates to an appellation of origin;

IX. A technical study issued by a public or private authority or institution that supports the information referred to in points IV, VII and VIII of this Article; ..."

In the case of recognition of a geographical indication protected abroad, the applicant must at least submit the document pursuant to which protection was extended to the appellation of origin or geographical indication in the country of origin, indicate the product or products protected and note (if applicable) its Spanish translation or transliteration (Article 167 of the Act).]

[Reply 21:

The application for protection of an appellation of origin must include, in addition to the geographical criteria, a detailed description of the product or products, including their characteristics, components, mode of extraction, production or preparation processes and use in trade, as well as criteria regarding the characteristics and specifications that the product must meet in its production, packaging and marketing and its methods of packaging, together with any other criteria considered relevant by the applicant (Article 165 *bis* of the Industrial Property Act).

See also reply 10. In the case of an application for recognition of a geographical indication protected abroad, the requirements set forth in Article 167 of the Industrial Property Act must be satisfied.]

23. What information must be supplied in an application for rights in a geographical indication?

Under Article 160 of the Industrial Property Act, appellations of origin and geographical indications are the property of the Mexican State.

Article 68 of the Regulations under the Act provides that the applicant for an authorization to use an appellation of origin must furnish the following information:

"I. Name, nationality and address of the applicant;

II. Location of the industrial establishment where the product covered by the appellation of origin will be produced;

III. A statement from the competent local authority certifying that the industrial establishment is situated within the territory specified in the declaration;

IV. A statement from the Ministry to the effect that the interested party complies with the official quality standard, where one exists;

V. The original or a certified copy of the power of attorney, if the application is submitted by an authorized representative."

24. Must the goods or services with respect to which a geographical indication is claimed be set out?

Samples are not required as part of the application, but a detailed description of the product covered by the geographical indication must be provided, in accordance with Article 165 *bis* of the Industrial Property Act:

"Article 165 bis. An application for a declaration of protection of an appellation of origin or geographical indication must contain the following information and be submitted to IMPI in writing, together with supporting documents:

-
- I. The name and address of the applicant;*
- II. The type, legal status and principal activities of the applicant, using the terms of the preceding article;*
- III. An indication of the appellation of origin or geographical indication;*
- IV. A detailed description of the finished product or products, including their characteristics, components, mode of extraction, production or preparation processes and use in trade;*
- V. The Mexican Official Standards to which the product, its mode of extraction, its preparation or production processes and its packaging, as applicable, will be subject;*
- VI. The criteria setting out the characteristics and specifications that the product must meet in its production, packaging and marketing, in the case of a geographical indication;*
- VII. The place or places of extraction, production or preparation of the product to be protected and the delimitation of the territory or geography, with reference to the geographical characteristics and political boundaries;*
- VIII. A detailed description of the relationship between the appellation, the product, the territory or geographical area and the natural or human factors, when the application relates to an appellation of origin;*
- IX. A technical study issued by a public or private authority or institution that supports the information referred to in points IV, VII and VIII of this Article;*
- X. Proof of payment of the applicable charge, and*
- XI. Any other information the applicant may deem necessary or pertinent."*

25. What mechanisms are provided to oppose the recognition of a geographical indication? How is an investigation conducted after such a complaint?

Upon receipt of an application for a declaration of protection of a geographical indication which satisfies the legal requirements, IMPI will publish an extract of the application in the Official Journal and will grant a period of two months for any third party with a documented interest to oppose the application and make comments or raise objections regarding its compliance with the provisions of Articles 163 and 165 *bis* of the Industrial Property Act.

IMPI will notify the applicant of the oppositions entered and grant the applicant a period of two months to respond to the opposition, comments or objections and, if applicable, present evidence.

Before making a declaration, IMPI may carry out any investigations it considers relevant and gather the information it considers necessary.

26. Who can oppose the recognition of a geographical indication?

Any person with a documented interest (Article 165 *bis* 5).

27. If your national legislation provides for recognition and protection of geographical indications or appellations of origin of foreign countries, what is the procedure that has to be followed in order to obtain such recognition and consequent protection?

The holder of the foreign geographical indication must submit to IMPI an application for registration that fulfils the following requirements: (Article 167 of the Industrial Property Act)

"I. Indicate the name, nationality and address of the applicant;

II. Submit the document pursuant to which protection was extended to the appellation of origin or geographical indication under the applicable laws of the country of origin or in accordance with the International Treaties;

III. Indicate the protected product or products and the territory or geographical area where they are extracted, produced or prepared;

IV. Indicate the Spanish translation or the transliteration in the modern international Latin script of the protected appellation of origin or geographical indication, if applicable;

V. Submit proof of payment of the applicable charge, and

VI. Any other requirements set forth in the regulations implementing this Act."

It should be pointed out that Mexico is a party to the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration.

D. Maintenance

28. How long does recognition for a geographical indication continue?

The period of validity of a declaration of protection of an appellation of origin or geographical indication issued by IMPI is determined by the continued existence of the conditions on which it was based, and the declaration will only cease to have effect when revoked by another declaration issued by IMPI (Articles 161 and 165 *bis* 26 of the Industrial Property Act).

With regard to the period of validity of the authorization to use an appellation of origin, see the reply to the following question.

29. If recognition of a geographical indication must be renewed or reaffirmed, what information must be provided in order to effect such a renewal or reaffirmation? Specify any fees involved in renewal or reaffirmation.

It is possible to renew an application for authorization to use a designation of origin or geographical indication. The authorization is valid for ten years from the date of submission of the application and may be renewed for identical periods. There is a fee for the procedure.

30. Must a geographical indication be used in order to maintain rights? If so, how is such use determined?

Yes. After three years of non-use, the authorization for use ceases to be valid. The authorized user must use the geographical indication in the manner stipulated in the declaration of protection or in the Industrial Property Law, and must apply the wording "Protected Appellation of Origin" or "Protected Geographical Indication" or abbreviation "PAO" or "PGI", as appropriate, to the protected products.

See also reply 23.

[Reply 23:

Under Article 160 of the Industrial Property Act, appellations of origin and geographical indications are the property of the Mexican State.

Article 68 of the Regulations under the Act provides that the applicant for an authorization to use an appellation of origin must furnish the following information:

I. Name, nationality and address of the applicant;

II. Location of the industrial establishment where the product covered by the appellation of origin will be produced;

III. A statement from the competent local authority certifying that the industrial establishment is situated within the territory specified in the declaration;

IV. *A statement from the Ministry to the effect that the interested party complies with the official quality standard, where one exists;*

V. *The original or a certified copy of the power of attorney, if the application is submitted by an authorized representative."*]

31. Is there a specified limit for non-use before rights in a geographical indication cease and, if so, what is that limit?

The Industrial Property Act provides that an authorization to use a protected geographical indication can (a) be nullified (Article 165 *bis* 27), (b) be cancelled (Article 165 *bis* 28), or (c) expire (Article 165 *bis* 29).

32. Who monitors the use of geographical indications to determine if the criteria identified in the application continue to be met?

The authorized user of an appellation of origin is required to use it exactly as it is protected in the declaration of protection (Article 173 of the Industrial Property Act). IMPI, as the authority charged with administering the Act, monitors matters relating to appellations of origin (Article 6.3 of the Act). Also involved in the monitoring are the Directorate-General of Standards and the bodies responsible for conformity assessment as provided for in the Federal Law on Metrology and Standardization.

See also reply 31.

[Reply 31:

The Industrial Property Act provides that an authorization to use a protected geographical indication can (a) be nullified (Article 165 *bis* 27), (b) be cancelled (Article 165 *bis* 28), or (c) expire (Article 165 *bis* 29).]

33. If a government entity is responsible for monitoring the use of geographical indications, what are its procedures for doing so?

See replies 31 and 32.

[Reply 31:

The Industrial Property Act provides that an authorization to use a protected geographical indication can (a) be nullified (Article 165 *bis* 27), (b) be cancelled (Article 165 *bis* 28), or (c) expire (Article 165 *bis* 29).]

[Reply 32:

The authorized user of an appellation of origin is required to use it exactly as it is protected in the declaration of protection (Article 173 of the Industrial Property Act). IMPI, as the authority charged with administering the Act, monitors matters relating to appellations of origin (Article 6.3 of the Act). Also involved in the monitoring are the Directorate-General of Standards and the bodies responsible for conformity assessment as provided for in the Federal Law on Metrology and Standardization.]

34. Are there means by which interested parties may request termination of a geographical indication based on non-use or failure to maintain the criteria identified in the application? Describe the procedure.

The Industrial Property Act provides for nullity, cancellation and expiry procedures, both in regard to the processing of an application for a declaration of protection of an appellation of origin or geographical indication, or to authorizations for the use of an appellation of origin or geographical indication:

"Article 165 bis 8 – The Institute shall suspend the processing of an application for a declaration of protection of an appellation of origin or geographical indication in the following cases:

I. Where the application encounters one of the impediments referred to in Article 163.IV and V and a request is filed for an administrative declaration of nullity, expiry or cancellation in respect of the registered trademark, or of cessation of the effects of a published trade name. Suspension shall occur ex officio or at the request of any of the parties to the administrative declaration procedure and shall be lifted once said procedure has been settled by the Institute, and

II. By order of the jurisdictional or administrative authority."

"Article 178 – The registration of recognition of an appellation of origin or geographical indication that is protected in other countries shall cease to have effect in the following circumstances:

I. Nullity, in either of the following cases:

(a) Where it has been granted in violation of the provisions of this Act, and

(b) Where it has been granted on the basis of false information and documents.

II. Cancellation, where the document referred to in Article 167.II ceases to have effect in the country of origin.

The declaration of nullity or cancellation of the registration shall be made administratively by the Institute ex officio, at the request of a party or at the request of the Federal Attorney-General's Office in cases where the Mexican State has any interest in the matter."

"Article 165 bis 27 – The authorization to use a protected appellation of origin or geographical indication shall be null where it is granted:

I. in violation of the provisions of this Act, or

II. on the basis of false information or documents."

"Article 165 bis 28 – An authorization for use of a protected appellation of origin or geographical indication shall be cancelled where:

I. the authorized user uses it in a manner other than that specified in the declaration of protection or in this Act, or

II. the authorized user fails to apply the wordings or abbreviations referred to in Article 165 bis 18."

"Article 165 bis 29 – An authorization for use shall expire:

I. where it is not used during the three years immediately preceding the request for an administrative declaration of expiry, unless the Institute deems there to be good cause for resolving otherwise, or

II. upon completion of its period of validity."

See also reply 31.

[Reply 31:

The Industrial Property Act provides that an authorization to use a protected geographical indication can (a) be nullified (Article 165 bis 27), (b) be cancelled (Article 165 bis 28), or (c) expire (Article 165 bis 29).]

35. Do the procedures which lead to forfeiture of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?

IMPI may, ex officio or at the request of an interested party, suspend the process of application for a declaration of protection of an appellation of origin or geographical indication (Article 165 bis 8 of the Industrial Property Act).

In cases where the registration of recognition of a protected appellation of origin or geographical indication in other countries is nullified, the corresponding procedure may be carried out *ex officio* by IMPI, at the request of an interested party or at the request of the Federal Attorney-General's Office in cases where the Mexican State has any interest in the matter (Article 178).

E. Scope of rights and use

36. May anyone who meets the criteria submitted to obtain recognition of a geographical indication use that geographical indication after recognition is given or must additional criteria or procedures be followed by that party before use is permitted?

Once the declaration of protection of an appellation of origin or geographical indication has been issued, the interested party or parties must obtain an authorization to use the appellation by submitting a request to IMPI. Such authorization will be granted to any individual or corporate body fulfilling the following requirements (Article 165 *bis* 14 of the Industrial Property Act):

- I. Direct engagement in the extraction, production or preparation of the products protected by the appellation of origin or geographical indication;
- II. Engagement in such activity within the territory or geographic area specified in the declaration;
- III. Compliance with the applicable official Mexican standards as applied to the products involved; and
- IV. Any other requirements specified in the declaration.

37. Who makes the determination regarding use of a geographical indication by particular parties, the entity responsible for the recognition or the entity that obtained the recognition?

The entity responsible for issuing the declaration of protection of an appellation of origin or geographical indication and for authorizing its use is IMPI.

38. Are there fees involved in receiving authorization to use a particular geographical indication, and, if so, what are those fees and how are they established?

Payment of a fee is required to obtain authorization to use or renew a geographical indication, in accordance with Article 165 *bis* 16 of the Industrial Property Act and with the Agreement modifying the provision specifying the fee charged in respect of the services provided by IMPI (26 April 2018).

39. If there is a dispute regarding use of a geographical indication by a particular party, what procedures are followed to resolve it?

Any party with a legal interest and valid claim may submit a request to IMPI for initiation of the procedure for administrative declaration of nullity, cancellation or administrative infringement under the Industrial Property Act. IMPI may initiate such procedures *ex officio*. Such requests will be substantiated and decided upon on the basis of Title Six, Chapter II of the Act.

40. Must individual authorized users of a geographical indication use that geographical indication continually to retain their right to use it and, if so, how is their use determined and how long will disuse be permitted?

Although the Industrial Property Act does not require authorized users of a geographical indication to use that geographical indication continually, its non-use over three consecutive years may result in its expiry.

41. If there is a dispute over continuity of use by a particular party, how is it resolved?

Pursuant to Article 187 of the Industrial Property Act, requests for administrative declaration of expiry "shall be substantiated and decided in accordance with the procedure set out in this chapter

and with the formalities foreseen under this Act, with supplementary application, insofar as no conflict arises, of the Federal Code of Civil Procedure."

42. Does the regime for protection of geographical indications allow geographical indications to be licensed and, if so, what conditions are imposed on such licences? If such conditions are not met, what is the effect on the geographical indication?

The Industrial Property Act makes no provision for the user to "license" the authorization to use an appellation of origin or geographical indication, because he is not the owner. However, under Article 165 *bis* 24 of the Act, the authorized user of a protected appellation of origin or geographical indication may, by agreement, permit its use by those, and only those, who distribute or sell the products covered by the appellation of origin or geographical indication. Such agreement must be registered with IMPI and must include a clause establishing an obligation upon the distributor or marketer to fulfil the requirements of Article 165 *bis* 14 (III and IV) and those foreseen in the Regulations implementing the Act. Failure on the part of the distributor or marketer to meet this obligation will result in cancellation of the registration.

43. How is "grandfathered use" of a geographical indication, under Article 24.4 of the TRIPS Agreement, applied in your country?

This provision remains in effect, inasmuch as Article 1 of the Industrial Property Act states that: "The provisions of this Act are public order provisions enforceable throughout the Republic, without prejudice to the terms of the international treaties to which Mexico is a party..."

However, we have to date not identified any particular case in which the scenario provided for in Article 24.4 of the TRIPS Agreement materialized.

F. Relationship to trademarks

44. What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.1 of the TRIPS Agreement are not nullified and impaired?

Article 90 of the Industrial Property Act prohibits the trademark registration of:

"X. Proprietary or common geographic areas, maps, names of towns, and names and adjectives of origin, when they indicate the source of the products or services and may be confusing or misleading with regard to that source. This includes those that are accompanied by expressions such as "kind", "type", "manner", "imitation", "produced in", "manufactured in", or other similar terms that create confusion in the mind of the consumer or imply unfair competition in relation to source.

XI. Names of peoples or places characterized by the making of certain products, when used to cover such products, except for the names of places under private ownership, when they are specific and unmistakable and the owner's consent has been given; ..."

It is also possible to invalidate a trademark that has been registered. In this connection, Article 151 of the Act provides *inter alia* that "the registration of a trademark shall be void when it has been granted in contravention of the provisions of this Act or of the legislation in force at the time of its registration".

The aforementioned provisions of the Industrial Property Act do not distinguish whether geographical indication identifies wines or spirits, or any particular product.

45. What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.2 and 16.3 of the TRIPS Agreement are not nullified and impaired?

The Industrial Property Act is applied without prejudice to the international treaties to which Mexico is a party. Consequently, the protection granted to geographical indications must not impair rights in a known trademark, as provided in TRIPS Article 16.2 and 3.

46. What procedures are foreseen in case of a conflict of a geographical indication with a trademark?

In addition to what is stated in reply 44 above, Article 163.IV of the Industrial Property Act states that it is not possible to protect, as an appellation of origin or geographical indication, "that which is identical or confusingly similar to a previously-submitted trademark registration application or trade notice in the course of being processed, or to a registered and valid trade notice, applying to the same or similar products or services".

Indeed, this is one of the criteria whereby third parties having a duly substantiated interest can submit an objection to the protection of a geographical indication (Industrial Property Act, Article 165 *bis* 5).

46(a). Does your economy's industrial property law and/or related law provide the refusal or invalidation of a trademark registration, which consists of or contains geographical indications identifying wines or spirits with respect to such wines or spirits not originating in the indicated territory?

See reply 44.

[Reply 44:

Article 90 of the Industrial Property Act prohibits the trademark registration of:

"X. Proprietary or common geographic areas, maps, names of towns, and names and adjectives of origin, when they indicate the source of the products or services and may be confusing or misleading with regard to that source. This includes those that are accompanied by expressions such as "kind", "type", "manner", "imitation", "produced in", "manufactured in", or other similar terms that create confusion in the mind of the consumer or imply unfair competition in relation to source.

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The aforementioned provisions of the Industrial Property Act do not distinguish whether geographical indication identifies wines or spirits, or any particular product.]

G. Enforcement**47. How are rights in the geographical indication enforced? Are provisions available under unfair competition law? Trademark law? Other laws? Provide citations to the laws and, if they have not been notified under Article 63.2 of the TRIPS Agreement, please provide copies.**

See reply 4.

[Reply 4:

The Industrial Property Act, most recently amended in 2018, is the relevant legislation for the protection of geographical indications.

In accordance with Article 22.2 of the TRIPS Agreement, Article 213 of the Industrial Property Act sets sanctions for acts of unfair competition. The provision in question defines the following, *inter alia*, as administrative offences:

"IX. In the exercise of industrial or commercial activities, to carry out acts which confuse or mislead the public by creating the unfounded belief or assumption: ..."

(d) That the product in question originates in a territory, region or locality other than the true place of origin, so that the public is misled as to the geographical origin of the product;

XXII. To use a protected appellation of origin or geographical indication without the necessary authorization;

..."

Similarly, Article 165 *bis* 20 of the Act provides that the illegal use of a protected appellation of origin or geographical indication will be penalized, even where it is accompanied by terms such as "kind", "type", "manner", "imitation" or the like, which mislead the consumer or involve unfair competition.]

48. Who has the right to enforce a geographical indication?

According to Article 160, appellations of origin are owned by the Mexican State and may be used only under an authorization issued by IMPI.

In the case of administrative procedures, IMPI is the authority empowered to enforce the provisions of the Industrial Property Act with regard to protection of geographical indications (Article 90.X and XI, Articles 156 to 178, Chapter II, Title VI, Articles 213 to 222). With respect to civil and criminal proceedings, the federal courts have jurisdiction (Articles 223 to 229 of the Act).

49. What judicial or administrative bodies have jurisdiction over enforcement actions related to geographical indications? Are there fees involved and, if so, what are those fees?

In the case of administrative procedures, IMPI is the authority empowered to enforce the provisions of the Industrial Property Act with regard to protection of geographical indications (Article 90.X and XI, Articles 156 to 178, Chapter II, Title VI, Articles 213 to 222). With respect to civil and criminal proceedings, the federal courts have jurisdiction (Articles 223 to 229 of the Act).

Where services provided by IMPI in relation to appellations of origin and geographical indications are concerned, payment of the corresponding fees will be required, in accordance with the *Agreement modifying the provision specifying the fee charged in respect of the services provided by IMPI* (26 April 2018).

The fees payable are those set out in by the Decree establishing tariffs for the services provided by the Mexican Industrial Property Institute, as published in the Official Journal on 23 August 1995 and in force since 1 September 1995, together with any subsequent modifications and/or updates that may be published.

50. Must the public be notified of the existence of a geographical indication and, if so, how and how often?

The declaration of protection of a geographical indication is published in the Official Journal once only. Moreover, Article 164 of the Industrial Property Act specifies that: "In addition to the publications provided for in this Title, the declarations made and authorizations granted by the Institute shall be published in the Official Gazette, together with any measure terminating rights granted in respect of appellations of origin or geographical indications." The Official Gazette is the official publication organ of IMPI.

51. Is unauthorized use of a geographical indication subject to criminal action and, if so, describe the procedures. If the law has not been notified pursuant to Article 63.2 of the TRIPS Agreement, please provide a copy.

The Industrial Property Act classifies the following conduct as an offence: "Producing, storing, transporting, distributing or selling products of domestic origin which do not have the corresponding certification in conformity with the appellation of origin or geographical indication and corresponding Mexican Official Standard, for the purpose of obtaining economic benefit for oneself or for a third party." It further states that "the foregoing shall include engaging in any act of customs clearance before the competent authorities for introduction into the country or export

therefrom". Finally, the same article establishes an exception: "There shall be no criminal liability where the corresponding Mexican Official Standard is not in force or where the relevant conformity assessment body has not been accredited, in accordance with the applicable legislation." Offences of this nature shall be prosecuted when a complaint is lodged by the aggrieved party.

The procedure is as follows: the authorized person submits a request to IMPI, which in turn carries out an investigation and issues a technical opinion without prejudice to any civil or criminal actions that may be called for. The Institute submits its technical opinion to the Attorney-General's Office which refers it to a federal criminal judge for an appropriate ruling. The authorized user may refer the matter directly to the federal courts which must request a technical opinion on the subject from IMPI, while the process described above continues (Articles 225 to 227 of the Industrial Property Act).

Furthermore, Article 228 provides that, in judicial proceedings in respect of offences covered by the Act, the judicial authority may adopt the measures foreseen in the Act and in the international treaties to which Mexico is a party.

H. International agreements

52. Is your government party to an international, including bilateral or plurilateral, agreement for the notification and/or registration of geographical indications? If so, please name the international agreement and explain the relationship between it and your national legislation.

Mexico is a party to the following agreements on the subject:

Lisbon Agreement for the Protection of Appellations of Origin and their International Registration.

The Industrial Property Act provides for the protection of appellations of origin in accordance with the above-mentioned Agreement.

Agreement between the European Community and the United Mexican States on the mutual recognition and protection of designations for spirit drinks. A schedule annexed to the Agreement sets out the designations for spirit drinks of both parties for purposes of adequate protection.

The Industrial Property Act provides for compliance with international treaties containing provisions relating to intellectual property. Article 1 states that: "The provisions of this Act are public order provisions enforceable throughout the Republic, without prejudice to the terms of the international treaties to which Mexico is a party."

53. What other international agreements, if any, have been entered into? What do these agreements provide?

Mexico has signed various free trade agreements containing chapters on intellectual property, which include specific provisions to ensure mutual protection of geographical indications between the parties. The agreements concerned are the following:

- North American Free Trade Agreement between Canada, the United States and Mexico, Chapter XVII, in force since 1 January 1994.
- Mexico-Japan Economic Partnership Agreement
- Mexico-Panama Free Trade Agreement
- Mexico-Uruguay Free Trade Agreement (ACE 60)
- Mexico-Israel Free Trade Agreement
- Free Trade Agreement between the Government of the Republic of Chile and the Government of the United Mexican States
- Colombia-Mexico Free Trade Agreement (ACE 33)

- Agreement between the United Mexican States and the Federative Republic of Brazil for the Mutual Recognition of Tequila and Cachaça as Geographical Indications and Distinctive Products of Mexico and Brazil, respectively.

An agreement in principle has recently been reached on Modernization of the Free Trade Agreement between Mexico and the European Union. It contains the chapter on intellectual property, and provisions relating to the recognition and protection of geographical indications with standards of protection similar to those of Article 23 of the TRIPS Agreement.
