

Intellectual property right assignments Q&A: Mexico

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This Q&A provides country-specific commentary on the following standard documents:

[Assignment of intellectual property rights: Cross-border.](#)

[Assignment of trade marks: Cross-border.](#)

[Assignment of copyright: Cross-border.](#)

[Assignment of patents: Cross-border.](#)

[Assignment of industrial designs: Cross-border.](#)

[Waiver of moral rights: Cross-border.](#)

[Letter confirming assignment of intellectual property rights: Cross-border.](#)

and forms part of *[Cross-border Intellectual property.](#)*

Key aspects of intellectual property right assignments

Definition of IP rights

1. Does the definition of "Intellectual Property Rights" in *Standard document, Assignment of intellectual property rights: Cross-border: Clause 1.1* include any rights that are not recognised in your jurisdiction? If yes, what are those rights?

All the rights in the definition of "Intellectual Property Rights" in *Standard document, Assignment of intellectual property rights: Cross-border: clause 1.1* are recognised in Mexico.

2. Should this definition be amended to include any additional rights that are recognised in your jurisdiction? If yes, what are those rights?

No amendments are required. In any case, the phrase "and all other intellectual property rights" includes any rights not expressly mentioned.

Assigning the benefit of licences to use IP rights

3. Subject to any restrictions in the terms of the relevant licence, is it possible to assign the benefit of a licence to use IP rights? If yes:

- Are there any restrictions on this (such as on the identity of the assignee or the price of the assignment)?
- Does the assignment have to comply with any particular formalities to be valid and enforceable?
- Does the burden of the licence automatically pass to the assignee along with the benefit?

Under Chapter VI Licences and transmission of rights, especially Article 62 of the Industrial Property Law (Ley de la Propiedad Industrial), it is possible to assign the benefit of a licence to use IP rights conferred by a registration, such as trade marks, software rights, database rights and domain names, among others, or rights deriving from a patent application in progress.

Licences in relation to those rights can be assigned in whole or in part, subject to the terms of the licence and formalities established by common legislation.

Registration of the assignment of the licence with the Institute of Industrial Property (IMPI) is required for all IP rights.

To be valid and binding, a licence must satisfy certain substantive legal formalities, including all of the following:

- Consent of the parties who must have legal capacity.
- In writing and registered with the Institute of Industrial Property, if required. In order for the assignment of rights to be effective against third parties, the assignment must be registered before the IMPI.
- The purpose of the agreement is legal (not unlawful).
- Performance is possible.
- The content of the licence is certain.

Once the agreement is entered between the parties, it has full effects and is enforceable between them, but the parties can register a short version of the agreement in order to produce effects against third parties, that is, the recognition of rights exceeds the scope of the parties.

Assigning future intellectual property rights

4. Is it possible to assign future IP rights? If yes, does an assignment have to comply with any formalities additional to the existing assignment, or do any additional documents need to be entered into, for that future assignment to be valid and enforceable?

It is possible to assign future IP rights by contractually assuming the obligations. According to the Preparatory Agreement provisions, the Civil Code establishes that the parties can assume to be contractually bound to enter into an agreement in the future once the existence of the IP right occurs, or the parties can sign a letter of intent establishing a condition subject to the existence of the IP rights.

For a future assignment to be valid and enforceable, it must be in writing and contain the essential elements of the existing assignment.

These obligations can be assumed by attaching an annex to the existing assignment, subject to conditions.

Implied covenants

5. Do any of the laws applicable to IP assignments in your jurisdiction imply covenants relating to title?

Mexican law does not imply covenants relating to title in relation to IP assignments. Mexican law states that in any agreement, the consent between the parties governs the covenants between them, provided that they cannot be contrary to public order and goodwill.

Right to sue for past infringements

6. Is it possible to assign the right to sue for past infringement or misuse of IP rights? If yes, is this right automatically transferred to an assignee on an assignment of the relevant IP rights, or must it be expressly included in the terms of the assignment?

It is possible to sue for past infringement or misuse of IP rights. It is not a requirement to expressly include this in the assignment, but it is advisable to do so.

7. If it must be expressly included, comment on whether the following clauses are effective to assign the right and, if not, set out below any necessary amendments to make them so:

- *Standard document, Assignment of intellectual property rights: Cross-border: clause 2(c).*
No amendments.
- *Standard document, Assignment of trade marks: Cross-border: clause 2(c).*
No amendments.
- *Standard document, Assignment of copyright: Cross-border: clause 2.*

No amendments.

- *Standard document, Assignment of patents: Cross-border: clause 2(e).*

No amendments.

- *Standard document, Assignment of industrial designs: Cross-border: clause 2.*

No amendments.

Right of priority

8. Do applicants for registered IP rights have the right to seek a priority date for their applications? If yes, is it possible to assign that right of priority along with the IP right to which it relates? Are there any formal requirements for a valid and enforceable assignment of the right of priority?

Applicants for registered IP rights have the right to claim a priority date. This right is automatically assigned along with the assignment of the IP right and does not need to be expressly included in the terms of an assignment.

Tax considerations

9. What tax charges and tax considerations typically arise on an assignment of IP rights? Do these vary depending upon:

- the type of IP right being assigned; and/or
- whether the assignor or assignee is an individual or corporation; and/or
- whether the assignor or assignee is tax-resident?

If yes, explain those variations.

Income tax

Income tax is payable on taxable profits derived from an assignment of IP rights, except that authors do not pay income tax on an assignment of their work protected by copyright.

The income tax rate varies from 11% to 35% for companies.

If the assignor or assignee of an IP right is not tax-resident in Mexico, withholding tax is payable on an assignment of IP rights, and certain international treaties relating to the avoidance of double taxation may also apply.

Royalties and technical assistance are taxable in IP assignment transactions, under the Tax Code of the Federation (Tax Code), the Income Tax Law and the Value Added Tax Law (VAT law).

The tax authorities consider as royalties any payments made upon any agreement or transaction for the use and/or distribution of any IP right, including IP licences and assignments. This includes amounts paid for the transfer of technology or information relating to industrial, commercial or scientific experience, or other similar rights or property (for example, know how).

Technical assistance means the provision of services by independent personnel involving non-patentable knowledge and not involving confidential information related to industrial, commercial or scientific experience, obliging the borrower to intervene in the application of this knowledge.

Under the Income Tax Law, royalties and technical assistance payments are tax-deductible.

Value added tax (VAT)

VAT is payable on an assignment of IP rights, except that authors do not pay VAT on an assignment of their work protected by copyright.

The VAT rate in Mexico is 16%.

10. Set out below any amendments necessary to the following standard documents to reflect tax charges and considerations arising in your jurisdiction:

- *Standard document, Assignment of intellectual property rights: Cross-border.*
No amendments.
- *Standard document, Assignment of trade marks: Cross-border.*
No amendments.
- *Standard document, Assignment of copyright: Cross-border.*
No amendments.
- *Standard document, Assignment of patents: Cross-border.*
No amendments.
- *Standard document, Assignment of industrial designs: Cross-border.*
No amendments.

Power of Attorney

11. Is it common practice for an assignee to seek to include a power of attorney in an assignment of IP rights? If yes, comment on whether *Standard document, Assignment of intellectual property rights: Cross-border: clause 7.2* is sufficient to grant a valid and enforceable power of attorney. If not, set out below any necessary amendments to make it so.

It is possible for an assignee to seek to include an irrevocable power of attorney in an assignment of IP rights, in order to allow the assignor or its designees to cancel the recordal of the assignment agreement before the IMPI.

Standard document, Assignment of intellectual property rights: Cross-border: clause 7.2 is sufficient to grant a valid and enforceable power of attorney in Mexican law, but in practice the authors would add the following:

- That the power of attorney will be as broad as may be required by law.
- That the representatives can exercise the power of attorney, jointly or separately.

Assistance with future proceedings

12. Is it usual for an assignor to be obliged to assist the assignee in obtaining, defending and enforcing the assigned rights, and to assist with any proceedings that relate to them after completion of an assignment (see for example *Standard document, Assignment of intellectual property rights: Cross-border: clause 7.1(b)*)?

It is usual for an assignor to be obliged to assist the assignee in obtaining, defending and enforcing the assigned rights, and to assist with any proceedings that relate to them after completion of an assignment.

Perfecting the assignment

13. Does either party have to take any additional steps after execution of an assignment for an assignee to receive and enjoy the full benefit of an assignment? If yes, briefly describe those additional steps, and whether they vary depending on the IP right being assigned.

It is not mandatory to record the assignment, but it is recommended to record a public summary version before the IMPI or the relevant authority to have protection against third parties. The IMPI does not require a prescribed format. Usually, the summary version contains essential elements such as the parties, purpose, terms, scope of the obligations and rights, and peculiarities of the transaction if not confidential, among others, given that the purpose of the summary version is to keep the sensitive data in the agreement confidential.

Depending on the terms of the assignment, for example if there are payment obligations in which the beneficiary is the assignor, then he must notify all the service providers or clients of the assignment agreement and that the assignee is the new beneficiary of the IP rights. This notice of assignment must be made referring to the assignment and the date in which the assignment is in force.

Liability

14. Is it possible for an assignor to seek to limit or exclude all liability that might arise after execution of an assignment in relation to the assigned rights (see for example [Standard document, Assignment of intellectual property rights: Cross-border: clause 9](#))?

The assignor can execute a general release of its liability in a manner satisfactory to the assignee, effective as of the date of the assignment of the IP rights. The release must be by written consent of both parties, and is usually included in the assignment agreement. In practice, the assignee will want to limit the scope of this clause.

15. Is it possible to limit or exclude liability for death and personal injury under particular circumstances?

It is possible to limit or exclude liability for death and personal injury resulting from negligence and for other loss or damage resulting from negligence, but the assignee's consent is required and this is usually included in the assignment agreement.

Guarantor

16. Is it possible for a third party to guarantee the obligations of an assignor in an assignment of IP rights? If yes, is it usual for the guarantor to be made a party to the assignment and/or does a separate guarantee agreement need to be entered into by the parties?

It is possible for a third party to guarantee the obligations of an assignor in an assignment of IP rights. The guarantor can be a party to the assignment agreement or the guarantee can be executed in a separate guarantee agreement.

Formalities for assignment

17. Does an assignment of intellectual property (IP) rights have to comply with any particular formalities to be valid and enforceable (including in relation to format, language and execution)? If yes, describe briefly what these are for each type of IP right.

An assignment of all types of IP rights must comply with the following requirements:

- Signed by an authorised representative of both parties (assignor and assignee).
- The right being assigned must be expressly stated in the agreement or set out in a schedule (for example, patent or trade mark number).
- The full name of the registrant of any registered IP right being assigned must be set out in the assignment as it appears on the title or certificate of registration.
- An original assignment agreement, or a certified copy of it duly legalised by an apostille or before the Mexican consulate.

18. If some form of consideration has to be transferred between the parties for an assignment to be valid and enforceable, is a nominal sum acceptable, or must it be an amount that reflects the current market value of the IP rights being assigned, whether for tax reasons or otherwise?

No form of consideration has to be transferred between the parties for an assignment to be valid and enforceable.

There is no need to mention the consideration or market value of the assigned rights in the agreement. The Industrial Property Law expressly states that redacted versions of assignment agreements or confirmatory assignment agreements can be filed to avoid disclosing confidential information, including details of the consideration paid.

Compliance with local law and practice

19. Are any of the terms in the following standard documents invalid, unenforceable or contrary to standard practice in your jurisdiction? If yes, set out below any necessary amendments to make those terms valid, enforceable and reflective of standard practice.

- *Standard document, Assignment of intellectual property rights: Cross-border.*
None of the terms of this document are invalid, unenforceable or contrary to standard practice in Mexico.
- *Standard document, Assignment of trade marks: Cross-border.*
None of the terms of this document are invalid, unenforceable or contrary to standard practice in Mexico.
It is possible to assign trade mark registrations, and they can be transferred in whole or part. The concept of goodwill cannot be split and a trade mark transfer implicitly includes it.
- *Standard document, Assignment of copyright: Cross-border.*
Clause 6: moral rights cannot be assigned or waived under Mexican Law. Therefore, the clause is invalid.
Clause 2(b): Mexican Law does not recognise a sui generis database right. Databases are protected as compilations.
Save for the above amendments, none of the other terms of this document are invalid, unenforceable or contrary to standard practice in Mexico
- *Standard document, Assignment of patents: Cross-border.*
None of the terms of this document are invalid, unenforceable or contrary to standard practice in Mexico
Patents, can be assigned, partially or totally, under the Industrial Property Law.
- *Standard document, Assignment of industrial designs: Cross-border.*
None of the terms of this document are invalid, unenforceable or contrary to standard practice in Mexico
Industrial designs can be assigned, partially or totally, under the Industrial Property Law.

Brexit

20. Are any amendments required to the following standard documents to reflect the fact that the UK is preparing to leave the EU; and/or will have left the EU after March 2019? If yes, set those amendments out below and, if necessary, briefly explain them (and where no amendments are necessary, insert "no amendments").

- *Standard document, Assignment of intellectual property rights: Cross-border*
No amendments.
- *Standard document, Assignment of trade marks: Cross-border.*
No amendments.
- *Standard document, Assignment of copyright: Cross-border.*
No amendments.
- *Standard document, Assignment of patents: Cross-border.*
No amendments.
- *Standard document, Assignment of industrial designs: Cross-border.*
No amendments.

Registration and recordal aspects of intellectual property right assignments

Registrable intellectual property rights

21. Which intellectual property (IP) rights are registrable in your jurisdiction? Provide a link to the website of the relevant registry in each case.

Patents, utility models, industrial designs, integrated circuit designs, trade marks, service marks, slogans, business names and indications of origin can be registered. See the Institute of Industrial Property website, at www.impi.gob.mx.

Copyright can be registered, see the Copyright office website, at www.indautor.gob.mx.

Assignment recordal / registration

22. Can an IP assignment be recorded at the IP registry in your jurisdiction? If yes, is this optional or a statutory requirement? If the position varies depending on the IP right being assigned, explain those variations.

All assignments of IP rights must be recorded for them to have effect against third parties and to properly enforce the rights derived from them, avoiding possible obstacles in the enforcement of such rights. There is no timeframe to do so (the sooner the better). The associated costs can be the responsibility of either party as agreed between them.

23. Is it usual to include a mechanism in the terms of an assignment to ensure that the assignor satisfies its obligation to record the assignment, or that the assignee is able to take action if the assignor fails to do so?

The terms of the assignment usually specify which party is responsible for recording the assignment. If not, the assignee can file for recordation.

Warranties and indemnities in intellectual property right assignments

Express warranties from assignor

24. Is it usual for an assignee to seek certain express warranties from an assignor in an IP assignment? If yes, comment on whether the following clauses reflect the scope of express warranties typically given by an assignor and, if not, set out below any necessary amendments so that they do (where no amendments are necessary, insert "no amendments").

The specific warranties given by an assignor will depend on a number of factors including the IP rights being assigned and the bargaining position of each of the parties; however at the very least it is common for an assignor to warrant that it owns the IP right it is assigning.

- *Standard document, Assignment of intellectual property rights: Cross-border: clause 4.*
No amendments.
- *Standard document, Assignment of trade marks: Cross-border: clause 4.*
No amendments.
Standard document, Assignment of copyright: Cross-border: clause 4.
No amendments.
- *Standard document, Assignment of patents: Cross-border: clause 5.*
No amendments.
- *Standard document, Assignment of industrial designs: Cross-border: clause 4.*
No amendments.

Implied warranties from assignor

25. Is it usual for certain warranties to be implied into the terms of an IP right assignment in your jurisdiction? If yes, briefly describe what those implied warranties are; which types of IP assignments they apply to (if not all); and whether their application can be excluded from the terms of an assignment. State any relevant legislation.

There are no implied warranties in Mexico and it is important that any warranties are expressly stated in the assignment. Mexico is a civil law jurisdiction and the principle of freedom of contract is followed and applied consistently.

Assignor indemnity

26. Is it usual for an assignee to seek an indemnity from an assignor? If yes, comment on whether the following clauses reflect standard practice in your jurisdiction and, if not, set out below any necessary amendments so that they do.

It is usual for an assignee to seek an indemnity from an assignor in the terms of an IP assignment.

- *Standard document, Assignment of intellectual property rights: Cross-border: clause 5.*
No amendments.
- *Standard document, Assignment of trade marks: Cross-border: clause 5.*
No amendments.
- *Standard document, Assignment of copyright: Cross-border: clause 5.*
No amendments.
- *Standard document, Assignment of patents: Cross-border: clause 6.*
No amendments.
- *Standard document, Assignment of industrial designs: Cross-border: clause 5.*
No amendments.

27. Does an assignee have a general obligation at law to mitigate any loss that it may suffer or incur as a result of an event that would give rise to a claim under an indemnity? State any relevant legislation.

There is no obligation for the assignee to mitigate loss or damage, but the offender or liable party will have a right to claim direct damages. In the assignment agreement, the parties can establish that in case of any infringement, threatened infringement, controversy, litigation, claim or dispute in connection with the IP rights, the assignee will provide the necessary information and assistance to mitigate the loss or damage.

Likewise, the parties will establish who will be authorised to perform all acts and take all necessary legal actions to protect and preserve the IP rights.

Assigning specific types of intellectual property rights

TRADE MARKS

Partial assignment

28. Is it possible to make a partial assignment of a registered trade mark?

It is not possible to make a partial assignment of a registered trade mark. The trade mark owner can license (not assign) the right to use its trade mark in relation to certain goods and services.

Goodwill

29. What is understood by the term "goodwill" in your jurisdiction?

The term goodwill originally meant a privilege of trading as the successor to a well-established business. Today it refers to an intangible and saleable asset arising from the reputation of a business, due to its relations with customers, banks and suppliers, and quality of products and services and way of doing things.

It can be considered an intangible asset that can be bought and sold, because customers continue to use the same sites where the business is carried out under a particular name, or where the goods are sold or offered under a commercial name, so that there are prospects of continuous income and acceptable earnings.

It is also the cumulative value assigned to a company due to its IP rights, intangible assets, clients, credit records, and so on.

30. Is goodwill automatically transferred to the assignee of a trade mark, or must it be expressly included in the terms of an assignment (see for example [Standard document, Assignment of intellectual property rights: Cross-border: Clause 2\(b\)](#) and [Standard document, Assignment of trade marks: Cross-border: Clause 2\(b\)](#))? Does this depend upon whether the trade mark is registered or unregistered?

Once the trade mark is assigned, the goodwill is automatically transferred to the assignee of a registered trade mark.

Co-ownership

31. Is it possible to co-own trade marks? If yes, are co-ownership agreements used to formalise the terms upon which the parties agree to co-own trade marks?

It is possible to co-own trade marks. Co-ownership agreements are used in Mexico and must be filed with the assignment agreement with the Institute of Industrial Property.

Copyright in trade marks

32. Under what circumstances might a trade mark also be protected by copyright? Is there anything additional that an assignee must do to ensure that copyright in a trade mark is transferred to it by the terms of an assignment?

Some design marks and 3D marks can also be considered as visual works of art with copyright protection. However, they have different forms of protection. Trade marks are protected under the Industrial Property Law and must be registered with the Institute of Industrial Property. Works of art are protected under the Federal Copyright Law and registered with the Copyright Office. An assignment of a work in which both trade mark rights and copyright subsists must be registered separately with these two offices.

Acquiescence

33. If a registered trade mark owner has acquiesced in the use of a later trade mark whilst being aware of such use, is the owner prevented from applying for a declaration that the later trade mark is invalid, or from opposing the use of the later trade mark? If yes, how long must the period of acquiescence be before this rule applies, if at all? Are there any exceptions to this rule?

Acquiescence is not recognised in Mexico. Even if the trade mark owner has acquiesced in the use of a later trade mark while being aware of such use, the trade mark owner can file an infringement action against the third party using the mark.

No period has been established to file an infringement action, so it can be filed at any time.

COPYRIGHT

First owner of copyright work

34. Is the general rule that the author of a copyright work (the person who creates it) is the first owner of that work? Are there any exceptions to this rule? If yes, briefly describe them.

The general rule is that the author of a copyright work is the first owner of that work, but the Copyright Law includes the following exceptions:

- If the work was created under a work made for hire provision, the first owner is the entity that commissioned the copyright work.
- If the author has created the work in the course of their employment and the employment contract complies with the formal legal requirements, ownership of the work is split equally between the employer and employee according to Article 84 of the Copyright Law unless otherwise agreed. If it does not, the employee retains full copyright ownership.
- Copyright ownership subsists under the agreed terms regardless of the validity term of the employment contract. Mexican labour law compels employers to formalise employment relationships in written agreements, and it is common practice to include a work made for hire provision so that the employer obtains full copyright ownership of any works created by the employee during the course of their employment.
- The producer of an audio-visual work is the owner of exclusive rights to the work, unless otherwise agreed in accordance with Article 97 of the Copyright Law. Patrimonial rights are the equivalent of exclusive rights in the Copyright Law, in contrast to moral rights.

Recognition of moral rights

35. Does your jurisdiction recognise moral rights, or any equivalent or similar rights that accrue to the author of a copyright work? If yes, provide a brief overview of those rights.

The Copyright Law recognises moral rights attached to the author that are inalienable, indefeasible, non-seizable and unwavering. They are listed in Article 21, that is, to:

- Determine whether a work of authorship is to be published or remain unpublished (right to publication).
- Claim authorship of a copyright work and decide whether the work will be published anonymously or the author will be identified under a pseudonym (right of paternity).
- Oppose unauthorised modification of the work, and derogatory treatment of the work or damage to the author's reputation (right to integrity).
- Modify their work (Mexican law is imprecise about this right, because the right to transform the work is also a patrimonial right).
- Retrieve their work from commerce. In principle, the author has the right to withdraw their work from the market/commercial exploitation but not the works to which they are fixed, or material supports such as phonograms or books, protected by neighbouring rights independent of copyright protection. The authors are not aware of relevant cases in Mexico involving the exercise of this particular moral right.
- Oppose a false attribution of authorship of someone else's work (right to object to false attribution).

Only the rights listed in the first four bullet points above can be inherited. They are personal to the author, so they preserve their non-assignable nature once inherited. The state can only exercise the rights listed at points three and four regarding copyright works to which it retains ownership. The Mexican state only benefits from those two rights, and from none of the others listed.

36. Set out below any necessary amendments to *clause 6* in each of the following standard documents to reflect the typical approach to moral rights (or the equivalent rights) in your jurisdiction:

- *Standard document, Assignment of intellectual property rights: Cross-border.*
- *Standard document, Assignment of copyright: Cross-border.*

Moral rights cannot be assigned or waived, under Article 19 of the Copyright Law. Therefore, the approach followed by both documents is invalid under Mexican Law. However, if a work is created under a work made for hire agreement, publication and integrity moral rights belong to the commissioner of the work. Both rights preserve their non-assignable and non-waivable nature, regardless of their origin under a work made for hire provision.

Assertion of moral rights

37. Do some or all moral rights have to be asserted by the author before they apply, or do they take effect immediately upon creation of a copyright work?

Moral rights take effect immediately on creation of a copyright work.

Assignment and waiver of moral rights

38. Can moral (or similar) rights be assigned and/or waived? Is the author the only one entitled to assign and/or waive them, or can an assignee of the works to which they relate also assign and/or waive them?

Moral rights cannot be waived or assigned. However, if the work was created under a work made for hire provision, publication and integrity rights belong to the entity that commissioned the work rather than the author of the work. Both rights preserve their non-assignable and non-waivable nature, regardless of their origin under a work made for hire provision.

39. Comment on whether *Standard document, Waiver of moral rights: Cross-border* is valid and enforceable in your jurisdiction and, if not, set out below any necessary amendments to make it so, and briefly explain your reasons.

Standard document, Waiver of moral rights: Cross-border is not valid or enforceable under Mexican Law because the waiver of moral rights is prohibited.

Exceptions to moral rights

40. Are there any particular types of works that moral rights do not apply to?

Moral rights do not apply to sound recordings, broadcasts, programme carrying signals or published editions.

Database right

41. Under what circumstances might the subject matter comprised in a copyright work also be protected by database right? Is there anything additional that an assignee must do to ensure that rights to use the database are transferred to it by the terms of the assignment?

Mexican law does not make specific provision for a sui generis database right, and currently databases enjoy protection under the Copyright Law as compilations in accordance with Articles 13, section XIV and 107 of the Copyright Law.

Protection does not cover data that creates the database in itself. Only the database as a whole is protected, not the individual segments of data that, together, make up the database, under Article 107 of the Copyright Law.

Under Article 110 of the Copyright Law, the owner of exclusive rights to a database can authorise or prohibit the following:

- Its reproduction, whether permanent or temporary, and total or partial, by any means or form.
- Its translation, reorder or any kind of modification.
- Its communication to the public.
- The reproduction, distribution or communication to the public of the results of the operations referred in the second bullet point above.

There are no additional requirements for the assignment of copyright in a database other than those for other kinds of works.

First owner of database

42. Is the general rule that the maker of a database (the person who creates it) is the first owner of the database right in it? Are there any exceptions to this rule? If yes, briefly describe them.

In Mexico, a database is classified as a compilation under the Copyright Law. The author of the database is the person who first makes or creates the work.

Therefore, unless one of the exceptions to the ownership of copyright applies (see [Question 34](#)), the author of the database is the first owner of the copyright subsisting in it.

PATENTS

First owner of invention

43. Is the general rule that the inventor is the first owner of an invention, and entitled to the rights in any patent granted in respect of that invention? Are there any exceptions to this general rule? If yes, briefly describe them.

The rule is that the inventor is the first owner of an invention. An exception is if the inventor created the invention in the course of their employment, in which case the employer is usually the first owner of the invention.

Divisional applications

44. Do patent applicants have the right to file "divisional patent applications"? If yes, is it possible to assign that right, along with the patent to which it relates? Are there any formal requirements for a valid and enforceable assignment of the right to file divisional applications, other than listing it in the manner shown at [Standard document, Assignment of patents: Cross-border: clause 2\(a\)\(ii\)](#)?

Applicants do have the right to file divisional applications and it is possible to assign this right along with the parent or related patent. There are no formal requirements for a valid and enforceable assignment of the right to file divisional applications and *Clause 2 (a)(ii)* is sufficient.

Improvements

45. Briefly describe any potential issues that the obligation in *Standard document, Assignment of patents: Cross-border: clause 3* might give rise to, including in relation to competition law, and set out below any necessary amendments to address them.

No amendments are necessary.

INDUSTRIAL DESIGNS

First owner of industrial design

46. Is the general rule that the designer is the first owner of any design right in a design? Are there any exceptions to this rule? If yes, briefly describe them.

The response to *Question 43* for patents also applies to industrial designs and utility models.

Registered and unregistered

47. Do both registered and unregistered design rights subsist in your jurisdiction? State any relevant legislation.

Only registered designs have exclusive rights. Unregistered designs may have protection under unfair competition law.

48. How is the territorial scope of each type of design right determined?

All IP rights have federal protection.

49. Do both types of design right protect the same aspects of a design? What are those aspects for the respective rights?

Both types of design right protect the same aspects of a design.

50. Do both types of design right give the proprietor the same duration of protection, and scope of rights, for their design? What are the respective periods of protection and scope of the rights?

Only registered designs give exclusive rights to:

- Industrial drawings, which are all combinations of figures, lines or colours incorporated in an industrial product for ornamental purposes that give it a special aspect of its own.
- Industrial models, consisting of a three-dimensional form that serves as a sample or pattern for the manufacture of an industrial product, which give it a special appearance, insofar as it does not imply technical effects.

The duration of protection of registered rights is five years from the filing date, renewable for periods of five years to a maximum of 25 years.

As unregistered rights do not have exclusive rights, they do not have duration of protection as such, therefore they should be analysed on a case-by-case basis.

51. Are any particular features or types of design excluded from protection under the registered and/or unregistered design right regimes?

The protection granted to an industrial design does not include:

- Elements or characteristics dictated solely for technical considerations or for the performance of a technical function and that do not include any arbitrary contribution of the designer.
- Elements or characteristics whose exact reproduction is necessary so that the product can be mechanically mounted or connected with another product of which it is an integral part or piece. This does not apply where the underlying design is a form designed to allow the mounting or multiple connection of the product or its connection within a modular system.

Confirmatory assignments of intellectual property rights

52. Under what circumstances are confirmatory assignments of intellectual property (IP) rights used in your jurisdiction, if at all (see [Standard document, Letter confirming assignment of intellectual property rights: Cross-border](#))?

It is very common to file confirmatory assignment agreements. The Industrial Property Law expressly states that confidential information can be left out of an agreement to be filed with the Institute of Industrial Property, and so parties to an assignment typically file confirmatory assignments as a way of avoiding public disclosure of the confidential details of their transaction.

53. Does a confirmatory assignment of IP rights have to comply with any particular formalities to be valid and enforceable?

As long as a confirmatory assignment expressly mentions the IP rights to be assigned and is signed by both parties, it will be suitable for recordation. The original must be filed, or a certified copy of it duly legalised by apostille or before the Mexican consulate.

54. Set out below any necessary amendments to make *Standard document, Letter confirming assignment of intellectual property rights: Cross-border* valid and enforceable in your jurisdiction, and briefly explain your amendments.

No amendments, but make that the signature of both parties and the IP rights to be assigned is included (see [Question 53](#)).

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END OF DOCUMENT

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