



**Asia-Pacific
Economic Cooperation**

2021/CTI/WKSP2/015

Day 2 Session 1

Protection of Trademark Rights in Digital Commerce

Submitted by: Mexico



**Workshop on Protection of Intellectual
Property Rights in Digital Content Trade
20-21 April 2021**

Protection of Trademark Rights in digital commerce

Aldo Fragoso Pastrana



ECONOMÍA
SECRETARÍA DE ECONOMÍA



IMPI
INSTITUTO MEXICANO
DE LA PROPIEDAD
INDUSTRIAL



DUAL COMPETITION

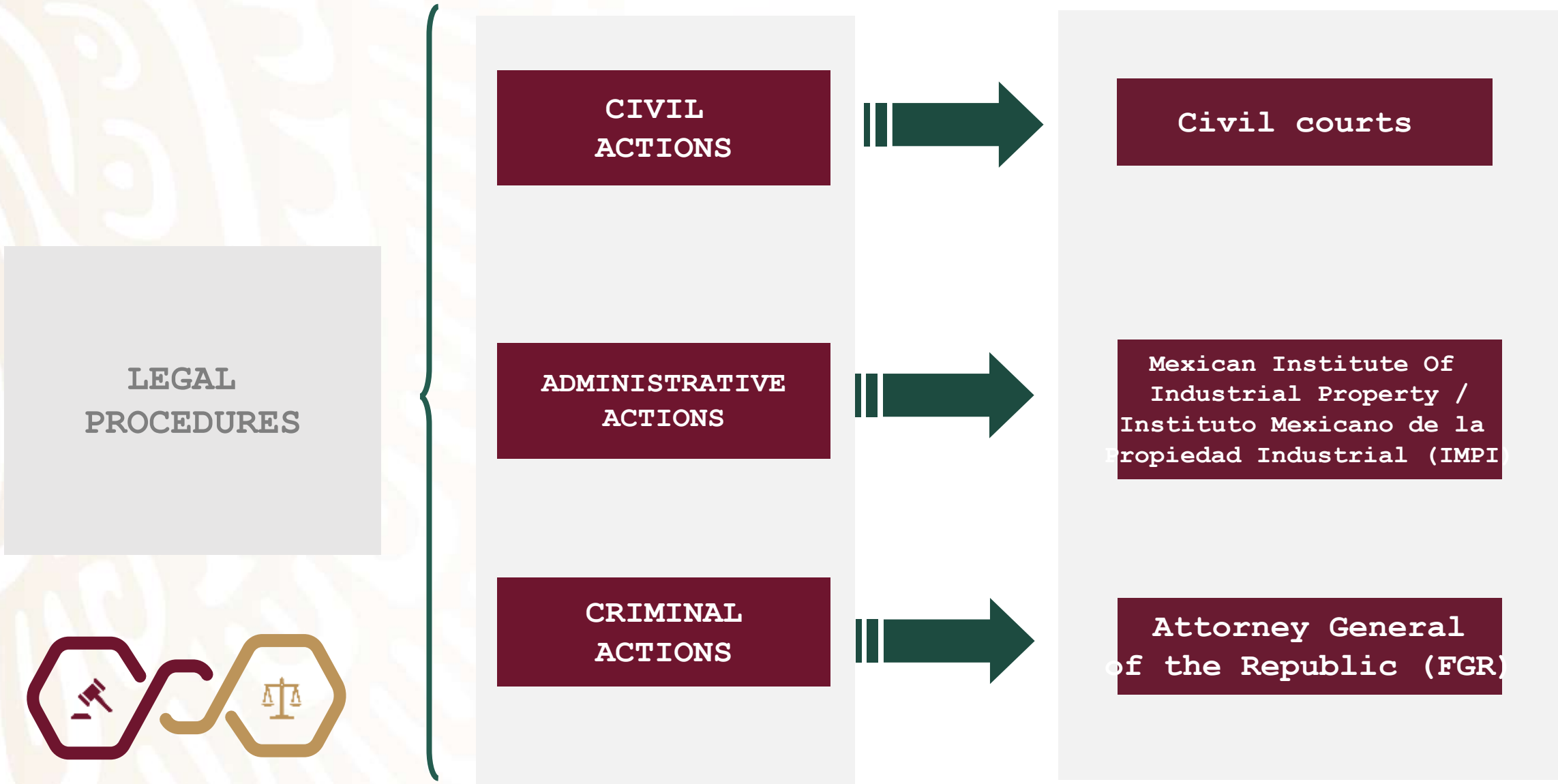
- Through the granting of patents, utility models, industrial designs, trademarks, trade names, commercial notices, appellations of origin and trade secrets. **Formally and materially administrative acts**.
- Nevertheless, through the Divisional Direction of Protection of Intellectual Property, it also **issues formally administrative and materially jurisdictional acts**, because it settles disputes between individuals.
- This is through what is called **administrative declarations** (of nullity, expiration, cancellation, infringement and infringement in trade matters).



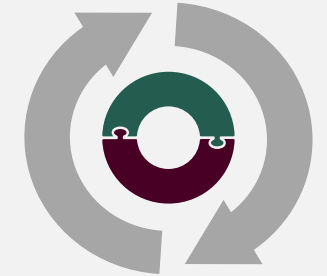
ENFORCEMENT ACTIVITIES

- Another of its functions is to prevent acts that violate intellectual property or that constitute unfair competition, and to sanction such activities.

PROTECTION OF INTELLECTUAL PROPERTY RIGHTS IN MEXICO



PROCEDURES



ADMINISTRATIVE DECLARATION PROCEDURE

INFRINGEMENT

TO INDUSTRIAL
PROPERTY RIGHTS

TO COPYRIGHT IN THE
MATTER OF TRADE

INDUSTRIAL PROPERTY PROCESSES

NULLITY

EXPIRATION

CANCELATION

MAIN ACTIONS

DIVISIONAL DIRECTION OF PROTECTION OF INTELLECTUAL PROPERTY

YEAR	2019			2020		
Requests	3,440			2,100		
Resolutions	3,290			1,487		
Inspection Visits	4,676			1,352		
Insured Merchandise						
Products	2,240,650			558,644		
Amount of the merchandise	\$18,869,329			\$11,308,324		
Commercial Amount	427,599,104			\$76,624,084		
Total fines:	Fines	UMA	Amount	Fines	UMA	Amount
	584	1,433,500	\$110,157,427	229	547,200	\$44,400,211
Closures	20			3		



**Legal Reform for the Protection
of the Intellectual Property
Rights**

01 Electronic Notifications.

Hybrid procedure aimed at one as electronic as reality deserves.

02 Provisional Measures in the Digital Environment.

Acts of IPR protection according to reality.

03 Provisional Measures in Transshipment.

Legal certainty in the acts of the IMPI in defense of IPR.

04 Sanctions increasement.

High financial penalties in order to generate a dissuasive effect for future infractions.

05 Conciliation Procedure.

First Alternative Means of Dispute Resolution provided in Mexican legislation on Industrial Property. Administratively, a civil law is regulated.

06 Study to order and to impose provisional measures.

From a review of requirements to a legal study of minimum evidentiary requirements.

07 Damages.

Provenance assumptions are expanded, conditioning factors are eliminated and specific parameters are offered to obtain compensation.

08 Destruction of goods.

Agility in the process.

09 Nullities and partial expiration dates.

Regarding the products or services.

10 Technological Protection Measures.

Legal layer that prevents the use of a work without authorization of the owner.

11 Notice and Take Down.

Internal guidelines of digital platforms.



Protection of the Rights in the Digital Environment

Intellectual Property in the digital age



Relevant cases / Lessons learned

Request for provisional measures online

Copyright protection was requested against the owner or person in charge of several websites.

Problematic

The imposition of measures by IMPI was contested by the **Internet Access Providers**, who considered that the principle of neutrality of the networks was attacked.

Decisions of the SCJN (Supreme Court)

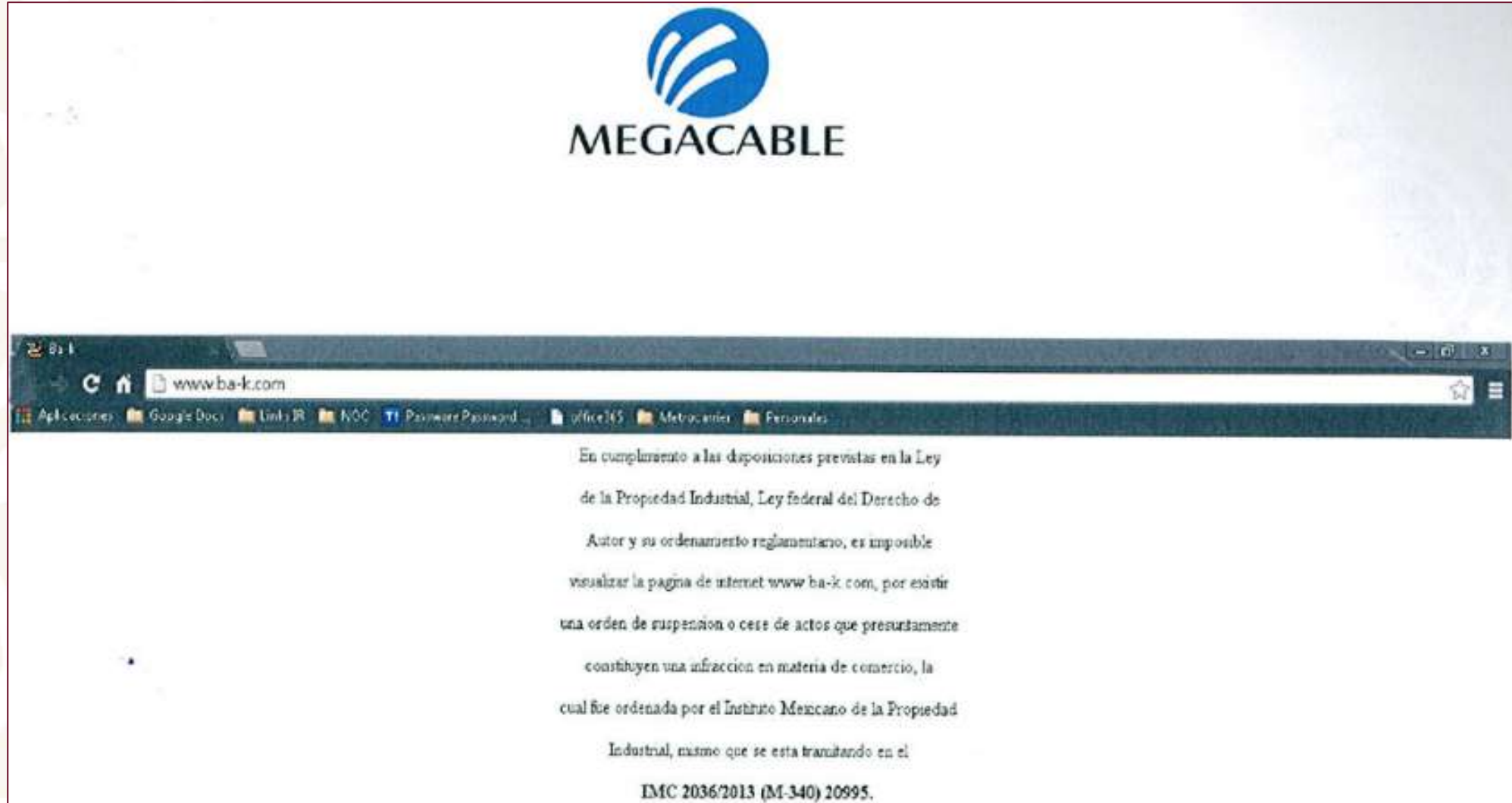
The SCJN defined the guidelines regarding the **proportionality** of the measure, considering the following:


- The IMPI, has among its powers, to order **provisional measures to PAI to block the content on the web pages.**

According to the SCJN, for provisional measures to be in accordance to the parameter of constitutional regularity, they must:

- 01 BE PROVIDED IN LAW.** Now they will be expressly.
- 02 BE BASED ON A LEGITIMATE PURPOSE.** To carrying out the study of the appearance of good law that shows the intellectual property rights are protected.
- 03 NECESSARY AND PROPORTIONAL.** With the lessons learned, absolute blocking orders are not envisaged, but orders proportional to the protected right.

Blocked Content




MEGACABLE

En cumplimiento a las disposiciones previstas en la Ley de la Propiedad Industrial, Ley federal del Derecho de Autor y su ordenamiento reglamentario, es imposible visualizar la página de internet www.ba-k.com, por existir una orden de suspensión o cese de actos que presuntamente constituyen una infracción en materia de comercio, la cual fue ordenada por el Instituto Mexicano de la Propiedad Industrial, mismo que se está tramitando en el

IMC 2036/2013 (M-340) 20995.

NEW VISION IN THE PROTECTION OF RIGHTS IN THE DIGITAL AGE

Provisional Measures in the Digital Environment.

Article 332.- In the procedures related to the alleged violation of any of the rights protected by this Law, the Institute may adopt the following measures:

*VII.- Order the **alleged offender or third parties** to suspend, **block, remove content** or cease acts that constitute a violation of this Law **through any virtual, digital or electronic means**, known or to be known,*

Inspections in virtual establishments.

*Article 347.- **Inspection visits** are those carried out in the places where products are manufactured, stored, transported, sold or marketed or where services are provided, in order to examine the products, the conditions of provision of the services and documents related to the activity in question, **whether in physical or virtual establishments.***

FINAL REFLECTIONS



Important References

- INDIA
- OMAN
- NORUEGA
- PERU

FINAL REFLECTIONS

INDIA – KEEP THE PIRATES IN LINE



NORWAY – AWARENESS ABOUT COUNTERFEIT ONLINE AND ON HOLIDAYS



OMAN – SCHOOL CONTEST ON RESPECT OF COPYRIGHT



PERU – I DECIDE, I RESPECT. RESPECT FOR IP AND REJECTION OF SMUGGLING.

