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I. AS FAR AS NATIONAL LAW OR CASE-LAW IS CONCERNED:

1. TO INDICATE IF IN THEIR OWN COUNTRIES THERE IS LEGISLATION, OR OTHER SOURCES OF LAW, TO PROTECT SHAPES OF GOODS, PACKAGES AND OTHER 3D SIGNS AS INDUSTRIAL DESIGNS AND/OR AS TRADEMARKS.

Before addressing the question above, the following reflection can be made:

- Intellectual Property has been regarded as the branch of the law aimed at ensuring protection to human creativity;

- Human creativity can be defined as the capability, skill or quality, that people may have in observing, analyzing, abstracting, communicating, and accordingly, transforming or expressing the environment surrounding them, leading to and resulting in something novel, original or distinctive;

- As a notion, human creativity is certainly very broad. It is unlimited in scope and extent, as it is referred to subject matter that is in a permanent evolution and change. Creativity, and consequently Intellectual Property Law, shall evolve as long as people continue to develop ideas which are novel, original or distinctive;

- Not every form of human creativity can be subject to legal protection, as the concept can be viewed as to also include ordinary creations, without being a result of inventiveness or artistic sensibility. Accordingly, it is not a mere effort that will be protected, regardless how well qualified that effort may be, if it is not supported by a minimum level of ingenuity (novelty), talent (originality) or goodwill (distictiveness).

- Intellectual Property laws in the world have recognized the complex nature of human creativity, and have divided it into three major areas: patents – which stands for creativity in technology, and is based on the principle of novelty-, copyrights – which stands for artistic creativity, and is based on the principle of originality-, and trademarks – which stands for creativity in trade symbols, and is based on the principle of distinctiveness.-

- But the system is not perfect and the forms do constantly overlap. Accordingly, a particular object could at the same time meet the standards of novelty and distinctiveness, for example. This would raise the question whether patent and trademark law would be mutually exclusive or, if to the contrary, protection may complement and "accumulate". It has to be considered that both patents and trademarks, may view a same object from different angles, and may thus grant complementary rather contradictory rights.

- It is a challenge of intellectual property laws finding a balance where confrontation of principles is avoided and if a conflict arises is then resolved.

With the foregoing in mind, the question under I.1 of the AIPPI questionnaire shall now be responded as applied to the Mexican Law on Industrial Property (hereinafter referred to as "LIP").

Shapes of products and of their packaging as well as other 3D signs can certainly be protected through Trademark and Design Law. Protection afforded by both figures is different, but not contradicting. Principles of trademark and design laws may overlap as applied to the same 3D object. However, such principles are not mutually exclusive and rights can perfectly “accumulate” and be complementary. Thus, if a same object qualifying for protection as an industrial design can also function as a source indicator, why should then double protection be refused? Principles of design and trademark law could be compared one to one, without to find that they collapse when applied to the 3D object, or that they trigger a disruption in the harmonic interaction of the figures of IP law.

2. IF SO, WHAT ARE THE CONDITIONS AND MINIMUM REQUIREMENTS TO PROTECT THEM AS:

I) INDUSTRIAL DESIGNS.

First of all, the following provisions of the LIP can be quoted:
“ARTICLE 9.- Any individual who makes an invention, utility model or industrial design, or his assignee, will have the exclusive right of exploiting the same to his benefit, either by himself of by third parties who have his consent, in accordance with the provisions of this Law and its Regulations.”
“ARTICLE 10.- The right referred to in article 9th will be granted be means of a patent, in the case of inventions; and in the case of utility models and industrial designs, by means of registrations”.
“ARTILE 12.- For the purposes of this Title, the following terms shall mean:
I. Novel, anything not found in the state of the art;
II. State of the art, to the aggregate of technical know-how that has been made public by an oral or written description, by the working or by any other medium of dissemination or information locally or abroad;
III. Inventive activity, a creative process, the results of which are not apparent, from the state of the art, to a person with technical knowledge in that field;
IV. Industrial application, to the possibility that an invention may be produced or utilized in any branch of economic activity;
“ARTICLE 13.- Industrial designs that are novel and that are susceptible of

industrial application may be registered.
Deemed as novel are designs that are independently created and that are significantly different from known designs or from known combinations of characteristics of designs.
The protection granted to an industrial design will not include the elements or characteristics that are dictated solely for technical considerations or for the performance of a technical function and that do not include any arbitrary contribution of the designer; nor those elements or characteristics whose exact reproduction is necessary so that the product that embodies the design can be mechanically mounted or connected with another product or which it is an integral part or piece; this limitation will not apply in the case of products in which the underlying design is a form designed to allow the mounting or multiple connection of the products of their connection within a modular system.
An industrial design will not be protected when its aspects includes only the elements or characteristics referred to in the preceding paragraph."
"ARTICLE 32.- Industrial designs include:
I.- Industrial drawings, which are all combinations of figures, lines or colors that are incorporated in an industrial product for ornamental purposes and that give it a special aspect of its own; and
II.-Industrial models, constituted by every tridimensional 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".
"ARTICLE 36.- Registrations of industrial designs will be effective for fifteen years, unextendable, starting from the filing date of the application, and will subject to payment of the respective fee".
From the above rules, it can be obtained that the standards of protection of industrial designs are basically novelty and industrial application. In accordance with the LIP they differ from general "utility patents", in that for patents the law imposes standards of novelty (article 12 (I) and (II) of the LIP). By the way, the notion of "novelty" that is used in article 31 of the LIP is not consistent with the definition given in article 12 (I) of the same statute.
The expression "independently created" has been related to the concept of "originality", and not "novelty". In addition, the idea of "significant differentiation" as a requirement of industrial design registrability is confusing which, if interpreted literally, may lead to the conclusion that the LIP is imposing burdensome requirements of protection. However, for the purpose of this

questionnaire the standards of protection of industrial designs will be “novelty” and “industrial applications”

II) TRADEMARKS

Hereunder we are quoting provisions of the LIP expressly mentioning 3D trademarks. Obviously, general provisions on prosecution, licensing, maintenance, enforcement and the like, are applicable to 3D marks as they are to any other trademark formats protected by the LIP:
“ARTICLE 87.- Industrialists, merchants, or service providers may use trademarks in industry, in commerce or in the services they render; nevertheless, the right to their exclusive use is obtained through their registration with the Institute.”
“ARTICLE 88.- Understood as a trademark is every visible sign that distinguishes products or services from others of their same kind or class in the market”.
“ARTICLE 89.- The following signs may constitute a trademark:
II. Tridimensional forms:
“ARTICLE 90.- Not registrable as trademarks are:
I.- Animated or changing denominations, figures or tridimensional forms expresses dynamically, even though they are visible;
III.- Tridimensional forms which are a part of the public domain or which have become of common use, and those that lack sufficient originality to easily distinguish them, as well as the normal and ordinary form of products or that imposed by their nature or industrial function;
IV.- Names, figures or tridimensional forms which, considering the aggregate of their characteristics, are descriptive of the products or services they purport to protect as a trademarks. Included in the above hypotheses are descriptive or indicate words which in trade are used to designate the species, quality, quantity, composition, end use, value, place of origin of the product or production era;
XIV.- Denominations, figures or tridimensional forms that could deceive the public or lead to error; understood as such as those that constitute false indications about the nature, components or qualities of the products or services they purport to protect;
XV.- Names, figures or tridimensional forms, equal or similar to a trademark which the Institute considers to be notoriously known in Mexico, to be applied to any products or service.

It will be understood that a trademark is notoriously known in Mexico when a particular sector of the public or of the trade circles in the country know the trademark as a result of commercial activities developed in Mexico or abroad by a person who uses this trademark in connection with its products or services, as well as knowledge of the trademark in the territory resulting from its promotion or advertising.

In order to demonstrate the notoriety of the trademark, all evidentiary media allowed by this law may be used.

This impediment will be appropriate any time that the use of the trademark by the person who requests its registration may create confusion or a risk of association with the holder of the notoriously known trademark, or when it constitutes a utilization that causes a loss of prestige of the trademark. Said impediment will not apply when the applicant of the registration is the holder of the notoriously known trademark.

XIV.- A trademark that is identical or confusingly similar to another pending registration that was filed at a prior time or to a registered and effective trademark, applied to the same or similar products or services. Nevertheless, a trademark that is identical to another already registered trademark may be registered if the application is filed by the same holder to apply it to similar products or services, …"

"ARTICLE 95.- A registration for a mark will be effective for ten years from the filing date of the application, and it may be renewed for equal periods of time."

Also, the Regulations to the LIP state as follows:

"Article 53. For the purpose of what stated in Article 84 (II) of the LIP, it shall be considered as tridimensional form the wrappers, packaging, bottles, shape or presentation of a product".

From the foregoing, it is clear that product and container shapes, among other three-dimensional forms, are protectable under the LIP. The limitations in article 90 (III) are crucial in determining the scope of protection of three-dimensional marks in the LIP. The four basic standards shall be mentioned hereunder followed by comments on each of the points:

(1) That the three-dimensional marks are not part of the public domain.

(2) That the three-dimensional marks have not become of common use.

(3) That the three-dimensional marks lack sufficient originality to be easily distinguished.

(4) That the three-dimensional marks represents the ordinary shape of the

product or that imposed by their nature or industrial function.

- Public domain

There is not a clear and uniform criterion of what the Trade Mark Law should understand as “public domain”. However, it appears that the meaning implies a patent connotation. In accordance to Mexican Patent Law, protection is available for designs that are novel and that are applied to industrial products, devices, containers or any other kind of forms. Novelty is restricted to the industrial forms not found in the state of the art anywhere in the world.
An industrial design may fall into the public domain if no proper and timely registration is sought therefore before it is used in commerce, in accordance with the Patent Laws and Regulations. Also, it can fall into the public domain after the term of protection of the industrial design, which in Mexico is of 15 years.
From a practical standpoint, one should be very careful to know whether the three-dimensional device has been already exploited and whether patent protection has already been sought therefore. In the affirmative, it should be taken into account whether the corresponding industrial design registration has expired. The filing of a three-dimensional trademark application should not necessarily require that an industrial design application is simultaneously or previously filed. Protection afforded by trade marl and industrial design is alternative, therefore, it is important that the three-dimensional mark “has not fallen into the public domain”.
Notwithstanding the above, for a theoretical point of view, Congress should re-examine the “public domain” requirement, as it clearly contradicts principles of trade mark law. Inventions and designs that are used or exploited prior to the filing of an application lose novelty and fall into the public domain. It would be difficult to say that marks that were used prior to registration also fall into the public domain. Distinctive marks used prior to registration trigger-not lose-rights in accordance with trade mark law. Therefore public domain is not an appropriate concept for trademarks, as it is contradictory to established

principles under trade mark law.

- Common use

Mexican trade mark law will require that the mark meets a minimal level of uniqueness, and not be reputed or recognized as of common use. Forms and shapes in general that are too simple or that have served as containers or the shape or products, or that have in general been extensively used shall definitively not be protected.

- Distinctiveness

As explained above, this represents a basic principle of Mexican trade mark law. Accordingly, the following will have to be considered:
That the three-dimensional mark shall not be confusingly similar to pre-existing ones.
It also shall not be generic, or descriptive as regards the products or services to which it will be applied.

- Originality

The word “original” is vague and cannot be used in the context of three-dimensional trademark protection or even trade mark protection in general, as it is exclusively related to copyright law. As the concept is so imprecise, it could be concluded that works of authorship that are original are entitled to

protection, which probably would go too far in terms of haw the scope of three-dimensional trade mark protection should be determined.

- Ordinary industrial function

The present requirements are related to the previous three. However, in this case the law is intended to ensure that ordinary forms or functionality features of products, devices, containers, packages and other three dimensional forms, are not exclusively appropriated by single entities, which would be detrimental to third parties. Thus, the shape of the three-dimensional product, container, etc. will have to be dintict and unrelated to its ordinary form or function if trademark protection is intended to be made available thereto. Non-functional devices or features of products or packages, boxes or containers will represent the most adequate forms of protection in accordance to trade mark law.

- Additional comments/Regulations of 1994

In accordance with the Regulations of 1994, wrapper, packages, containers and the form of presentation of products have been expressly considered three-dimensional lforms for the purposes of the LIP. This regulatory provision has given a more precise understanding of that term, making clearer that product shapes can function as three-dimensional marks. Needless to say that they have to comply with the LIP requirements explained above. Notwithstanding the foregoing, it has been the Trade Mark Office's interpretation that shapes of products cannot represent three-dimensional marks, which is obviously wrong, and attempts against the principles of the LIP and regulations as well as NAFTA and TRIPS.
It is worth mentioning, again, that the LIP does not confer protection on descriptive marks regardless of how widely they have been used and how much

consumer recognition they posses. This has a particular importance in cases of "three-dimensional marks", considering that products and container shapes may not be inherently distinctive. Frequently, it is not only the non-functional feature of the shape, wrapper, package, bottle or container, that applicants wish to protect, but additionally some features that may be not registrable or that may at least not be considered inherently distinctive. Other times, a dividing line between functional and non-functional, useful and useless, art and industry is just impossible to be drawn.

The lack of an acquired distinctiveness doctrine makes it more difficult for many three-dimensional marks to become registered under Mexican Law. Patent and Copyright Laws may not offer much additional assistance as well. However, the Trade Mark Office has generally taken a flexible approach in conducting registrability exams and a positive view in protecting these forms of marks.

3. IS THERE A SPECIFIC RULE THAT PRECLUDES TRADEMARKS PROTECTION FOR A SHAPE OF AN OBJECT PROTECTED OR PREVIOUSLY PROTECTED, AS AN INDUSTRIAL DESIGN OR UNDER ANOTHER MODALITY OF INDUSTRIAL PROPERTY (E.G., UTILITY MODELS OR PATENTS)?

Yes, as mentioned above, article 90 (III) requires that three dimensional shapes and objects cannot be part of the "public domain", and although that said legal provision has not defined what an be understood for "public domain", it has been interpreted through the case law and doctrine that the term refers to "public domain" in the Patent Law, which would be equally extended to other patent-like formats as utility models and industrial designs (drawings and models). As mentioned, the "public domain" requirement is burdensome and restrictive, and creates confrontation of principles or trademark and patent law. As a result, many good and potentially valid 3 D trademarks would be blocked from adequate protection –by the via of registration-, by the fact that the object which they embody pertains to "public domain", from a patent stand point obviously.

The question would arise if that 3D object that has fallen into "public domain", would be protected through the laws of unfair competition. The answer is maybe, but on the other hand, nothing is clear cut in this regard.

Rules on unfair competition dictate that:
"ARTICLE 213.- The following constitute administrative infringements:
I.- To carry out acts contrary to good use and customs in industry, commerce and services, that imply unfair competition and that relate to the subject matter governed by this Law;
IX.- To perform, during the exercise of industrial or commercial activities, acts which confuse or lead the public to confusion, error or deceit, by making it believe or presume, without and foundation:
a) The existence of a relationship or association between one establishment and that of a third party;
b) That products are manufactured under specifications, licenses or the authorization of a third party;
c) That services are provided or products are sold under the authorization, licenses or specification of a third party;
d) That the product in question originates in a territory, region or locality other than the true place of origin in such manner as to induce the public to error as to the geographic origin of the product;"
From the foregoing, it can be noticed how broad can be the scope of sections I and IX of article 213 of the LIP. The fundamental standard is that i) unfair competition is related to the rights in the LIP and that there is an attempt against "good customs" or "practices in trade", or ii) a competitor acts unfairly by inducting consumers into a false believe about the existence of a relationship (license, etc.) between infringer and the party whose rights have been affected. If the foregoing is met, notwithstanding the fact that the infringing competitor relies on a 3D object, which is distinctive (related to a particular source), protection by these rules should be afforded to the affected party, regardless if the 3D object pertains to the "public domain", and even perhaps if it is functional.

4. IF THERE IS NO SPECIFIC LEGAL DISPOSITION UNDER 3., CAN IT BE UNDERSTOOD FROM NATIONAL CASE LAW THAT THIS POSSIBILITY IS EXCLUDED?

There is a limitation for "public domain", so this question is non -applicable.

5. IS IT POSSIBLE TO ACCUMULATE PROTECTION ON THE SAME SHAPE AS AN INDUSTRIAL DESIGN AND AS A TRADEMARK?

Yes, although "accumulation" is limited due to the pitfalls in the LIP. Accumulation triggers by the mere fact that, as it has been extensively discussed above, certain 3D objects can be viewed as trademarks and designs. And as trademark and industrial design law afford protection as they look at the object from different angles, and as they rely on different principles and rules of protection, those of patent laws not being contradictory to those of trademark law, it can be concluded then that "accumulative" protection is possible.

6. IS IT POSSIBLE TO CLAIM PRIORITY OF AN INDUSTRIAL DESIGN IN A TRADEMARK APPLICATION OR VICEVERSA, CAN PRIORITY OF A TRADEMARK APPLICATION BE CLAIMED IN AN INDUSTRIAL DESIGN APPLICATION?

No, the LIP refers in particular to how rules of priority apply to trademarks and patents.

7. CAN A SHAPE OR PACKAGING USED IN COMBINATION WITH A WORD MARK ACQUIRE DISTINCTIVENESS THROUGH USE TO BE PROTECTED AS A 3D TRADEMARK WITHOUT THE WORD MARK.

Two things have to be considered here:

- LIP does not recognize acquired distinctiveness as a source of trademark rights.

Thus the above question can be answered as non-applicable.

- Even if it is assumed that UP would recognize the doctrine of acquired distinctiveness, this would not be automatically applicable to any 3D form, regardless if it is used in combination with a word mark. That would be true, if for example, in addition to being an non-inherent distinctive 3D form it would be functional.

8. IS THERE ANY DISTINCTION BETWEEN THE PROTECTION AFFORDED BY A TRADEMARK AND BY A DESIGN? IN PARTICULAR:

8.1. IS THERE A DISTINCT ON WHAT CONSTITUTES AN INFRINGEMENT AND IN THE REMEDIES AVAILABLE?

Enforcement of trademark and design rights is essentially not different. In both cases, actions are administrative, and are handled through the Mexican Institute of Industrial Property (IMPI). This is true both, as regards cancellation and infringement actions. Proceedings are thus quite similar as well as sanctions and remedies, which are fundamentally administrative (i.e.: injunction, fines, shut down of premises, and the like), with the possibility of further civil action for damages.
However, trademark actions are different from design actions (and patent actions in general), if they are considered specifically. This is due again to the particular nature of patent and trademark law. Whereas trademark actions commonly look at issues such as "confusion", "association", and "dilution", among others, design and other patent-like actions focus at the "making", "using" and "selling" of patented products or designs.
Criminal remedies would be available in the case of counterfeiting of products.

8.2 IS IT POSSIBLE TO FORBID THE TWO DIMENSIONAL REPRODUCTION OF A 3D OBJECT PROTECTED BY AN INDUSTRIAL DESIGN OR TRADEMARK REGISTRATION OF SUCH A 3D OBJECT?

Not really concerning design law, specially if a 3D object is then made part of a

drawing. Three-dimensional reproduction of the two dimensional design could possibly become infringement, although this is not clear, and there are no legal precedents in this regard that could give support to either direction. The case of trademark law may be different, if it is shown that consumer public could fall into confusion by the fact that a 3D mark has been used bi-dimensionally or the other way around. However, if trademark infringement is not possible, it would be expected that the rules on unfair competition would grant a solution.

8.3 CAN THE USE OF A SIGN AS AN INDUSTRIAL DESIGN LEAD TO THE LOSS OF DISTINCTIVITY OF THIS SIGN AS A TRADEMARK, SO THAT THIS SIGN COULD NO LONGER BE REGISTERED AS A TRADEMARK I), IF REGISTERED, CAUSE THE REGISTERED TRADEMARK TO BECOME INVALID?

The following points need to be considered here:

- First of all, it would be difficult to contemplate how a "sign" can be "used" as an "industrial design". In line with IP principles trademarks can be "used" in connection with products or services, and products covered by patents, or designs can be "made" and/or "sold". The "making" 2 of a product covered by an industrial design, can not lead to loss of distinctivity, even if at the same time, the shape of the product is being "used" as a trademark.

- In order for a trademark to lose distinctivity and thus be subject to cancellation actions, shall occur only to the extent that, as the cancellation rules of the LIP dictate, the trademark would be used as a generic and the consumer relates the shape to the ordinary form of the product and not a distinctive feature thereof. This may of course happen, but in any event would not be the consequence that the 3D shape is being covered and protected by a design registration. The same could

occur if the 3D shape is not protected by an industrial design registration. Lose of distinctiveness is a trademark and not a patent question.

8.4 WHAT KIND OF MEASURES CAN BE TAKEN BY THE PROPRIETOR TO AVOID THAT A SIGN LOSES ITS DISTINCTIVE CHARACTER AS AS CONSEQUENCE OF THE USE OF THE CORRESPONDING DESIGN MADE BY THIRD PARTIES?

[/vc_column_text][/vc_column_inner][/vc_row_inner][/vc_column][/vc_row][vc_row][vc_column][vc_row_inner][vc_column_inner el_class="post-sec-bg-color" width="1/2"][vc_column_text css_animation="left-to-right"]SUMMARY.- SHAPES OF PRODUCTS AND THEIR PACKAGING AS WELL AS OTHER 3D SIGNS CAN CERTAINLY PROTECTED THROUGH TRADEMARK AND INDUSTRIAL DESIGN LAW. WHEREAS STANDARDS OF PROTECTION FOR INDUSTRIAL DESIGN LAW ARE "NOVELTY" AND "INDUSTRIAL APPLICATION", FOR THREE DIMENSIONAL TRADEMARKS IT WILL BE DISTINCTIVENESS, AND THAT THE 3D MARK IS I) NOT IN THE PUBLIC DOMAIN; II) IT HAS NOT BECOME OF COMMERCE USE; AND III) IS NOT FUNCTIONAL. UNDER THE MEXICAN LAW ON INDUSTRIAL PROPERTY PROTECTION BY TRADEMARK AND INDUSTRIAL DESIGN LAW MAY ACCUMULATE. THERE IS ON BURDENSOME AND RESTRICTIVE LIMITATION FOR REGISTRABILITY OF 3D TRADEMARKS: THAT THE OBJECT DOES NOT PERTAIN TO PUBLIC DOMAIN. HOWEVER, THE LIMITATION HAS BEEN REGARDED as unfair as it creates a contradiction between the principles of patent and trademark law. Measures that can be taken by the proprietor of a 3D trademark registration avoid that the sign loses its distinctive character as a consequence of the use of the corresponding design made by third parties, would include: *i)* a strict licensing policy with strict requirements stated upon licenses not to use the mark, or advertise it as generic; *ii)* impose obligations upon licensees to employ pertinent marking and *iii)* if the third parties are not licensees, then take proper infringement actions to avoid non-authorized use of the trademark.

8.5 ANY OTHER COMMENT YOU WOULD LIKE TO MAKE IN CONNECTION WITH THIS MATTER, NOT COVERED ABOVE.

The issues arising of confronting 3D trademarks and copyrightable works of authorship is also very interesting, but as they are not part of Q148, we shall not cover them.