

# Mexico

OLIVARES



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## 1 Copyright Subsistence

### 1.1 What are the requirements for copyright to subsist in a work?

In terms of the Mexican Copyright Law (MCL), the sole requirement for a work to subsist is that it is fixed in a tangible medium of expression.

### 1.2 Does your jurisdiction operate an open or closed list of works that can qualify for copyright protection?

In Mexican legislation, article 13 of the MCL establishes a closed list of works.

### 1.3 In what works can copyright subsist?

According to section 13 of the MCL, the works may be:

- I. literary;
- II. musical works with or without lyrics;
- III. dramatic;
- IV. dance;
- V. pictorial or drawing;
- VI. sculptural and plastic;
- VII. cartoon and comic books;
- VIII. architectural;
- IX. film and other audio-visual works;
- X. radio and television programs;
- XI. computer programs;
- XII. photographic;
- XIII. works of applied art that include graphic or textile design; or
- XIV. compilation, consisting of collections of works, such as encyclopaedias, anthologies, and databases.

### 1.4 Are there any works which are excluded from copyright protection?

In Mexican legislation, all works fall within the provisions of copyright; however, the scope of protection may vary when

related to works like traditional culture, expressions, or national symbols.

Nonetheless, concepts, ideas, isolated letters, or digits, among others, are excluded from recognition and protection of the State as they are not considered art works. For example:

- I. ideas, formulae, solutions, concepts, and in general inventions of any kind;
- II. the industrial or commercial exploitation of the ideas embodied in works;
- III. schemes, plans, or rules for performing mental acts, playing games or business;
- IV. letters, digits, or colours individually;
- V. names and titles or individual phrases;
- VI. mere layouts or blank forms for completion with any kind of information, and related instructions;
- VII. unauthorised reproductions or imitations of coats of arms, flags or emblems of any country, State, municipality or equivalent political division, or the names, abbreviated names, symbols, or emblems of intergovernmental or non-governmental international organisations;
- VIII. legislative, regulatory, administrative, or judicial texts, and official translations thereof; nevertheless, protection shall be available for parallel texts, interpretations, comparative studies, annotations, commentaries, and other similar works that involve the creation of an original work;
- IX. the content of news or journalistic information, whereas the form of expression thereof is protected; and
- X. information or phrases from everyday use, such as proverbs, legends, facts, calendars or scales of measurement.

### 1.5 Is there a system for registration of copyright and, if so, what is the effect of registration?

Yes, registration must be carried out before the Mexican Copyright Office (MCO). The registration of the work is merely a declaration and does not in itself constitute a right.

Therefore, the effect of copyright registration is merely to serve as a presumption of rights over the work.

### 1.6 What is the duration of copyright protection? Does this vary depending on the type of work?

The term of protection of economic rights in Mexico is:

- a. For the author's life and 100 years post-mortem. In case of joint authorship, the term will be counted from the death of the last surviving author.
- b. 100 years from its divulgation.

The type of protection will not vary depending on the work; however, there are differences in neighbouring rights, for example for book publishers, there is a protection of 50 years from the first edition of the book, and interpreters or executors have a term of 75 years to exercise their opposition rights.

#### 1.7 Is there any overlap between copyright and other intellectual property rights such as design rights and database rights?

There is a unique right in Mexican Copyright called Reserva Rights. Reserva is an exclusive patrimonial right to authorise the use of titles of publications or broadcasts, names of artists or artistic groups, characters of fictitious or human nature, or so-called publicity promotions. As such, Reserva Rights sometimes overlap with trademarks and with other types of works protected by copyright.

Likewise, a similar figure in both trademarks and copyright is sound. According to section 172 of the Industrial Property Law (IPL), sound may be registered as a trademark and in copyright the protection would be of the phonogram or sound recording.

#### 1.8 Are there any restrictions on the protection for copyright works which are made by an industrial process?

There are restrictions on the industrial or commercial exploitation of the ideas embodied in works.

## 2 Ownership

#### 2.1 Who is the first owner of copyright in each of the works protected (other than where questions 2.2 or 2.3 apply)?

The first owner of copyright is the author or authors of the work. The author is the natural person who creates any literary, artistic, or scientific work.

#### 2.2 Where a work is commissioned, how is ownership of the copyright determined between the author and the commissioner?

In case of a commissioned work or a work-made-for-hire, all economic rights, as well as integrity and divulgation rights correspond to the entity or person who commissioned the work; however, the remaining moral rights remain with the author (paternity).

#### 2.3 Where a work is created by an employee, how is ownership of the copyright determined between the employee and the employer?

In the case of work carried out because of an employment relationship established through an individual employment contract in writing, it shall be presumed that the economic rights are divided equally between employer and employee, except as agreed upon by the parties.

The employer may disclose the work without the employee's

authorisation, but not otherwise. In the absence of a written employment agreement, the rights shall be vested in the employee.

#### 2.4 Is there a concept of joint ownership and, if so, what rules apply to dealings with a jointly owned work?

In terms of the MCL, for works of joint authorship, the rights granted by this shall entitle all authors to equal shares, unless otherwise agreed or unless the authorship of each one is specified.

To exercise these rights, the consent of the majority of the authors is required. The minority shall not be obliged to contribute to any costs that might arise, subject to their deduction from any benefits that might be obtained.

When the majority exploit the work, they shall deduct the amount of the expenses incurred from the total proceeds and hand over to the minority the share to which the latter is entitled.

When the contribution made by each of the authors is clearly identifiable, those authors may freely exercise their economic rights.

## 3 Exploitation

#### 3.1 Are there any formalities which apply to the transfer/assignment of ownership?

There are certain formalities including that agreements and contracts by which economic rights are transferred must be registered before the Mexican Copyright Register to be enforceable against third parties.

#### 3.2 Are there any formalities required for a copyright licence?

There are some formalities established in the MCL and as such any licence granted must be onerous and temporal, and almost always in written form.

#### 3.3 Are there any laws which limit the licence terms parties may agree to (other than as addressed in questions 3.4 to 3.6)?

In the absence of any express provision, any transfer of economic rights shall be deemed to be for a term of five years.

Exceptionally, a term of more than 15 years may be agreed upon but only in exceptional cases where the nature of the work or the scale of the required investment justifies a longer term.

#### 3.4 Which types of copyright work have collective licensing bodies (please name the relevant bodies)?

All copyright and related rights work have collective licensing bodies or collective management societies. As such, they are not restricted only to certain works. The most relevant societies in Mexico are:

- Society of Authors and Composers of Mexico (SACM is its Spanish acronym).
- General Society of Writers of Mexico (SOGEM is its Spanish acronym).
- National Association of Interpreters (ANDI is its Spanish acronym).
- Mexican Society of Music Performers (SOMEN is its Spanish acronym).

- Mexican Society of Plastic Arts (SOMAAP is its Spanish acronym).

### 3.5 Where there are collective licensing bodies, how are they regulated?

Collective licensing bodies or collective management societies are regulated by sections 192 to 207 of the Mexican Copyright Law, and sections 115 to 136 of the Regulations of the Mexican Copyright Law.

### 3.6 On what grounds can licence terms offered by a collective licensing body be challenged?

In general, the most relevant argument that may be used to challenge licence terms offered by collective management societies (CMS) is the correct representation of the author. It is quite common for the same work or author to be represented by a different CMS.

Likewise, the Mexican Copyright Law established the concurrence of collective management societies by branch, category works or related rights, which may mean that royalties from one work are paid to two different societies.

## 4 Owners' Rights

### 4.1 What acts involving a copyright work are capable of being restricted by the rights holder?

According to Mexican legislation, the title holders of the economic rights may authorise or prohibit:

- I. Reproduction, publication, editing or material fixation of their work, in any medium, whether existing or devised in the future.
- II. The public communication of the work in any of the following manners:
  - a. public communication, recitation and public performance of the work;
  - b. public exhibit by any means; or
  - c. public access by telecommunication.
- III. Transmission or broadcasting of their works by any process, including the transmission or retransmission of the works by:
  - a. cable;
  - b. optic fibre;
  - c. microwaves;
  - d. satellite; or
  - e. any other known or emerging means.
- IV. Distribution of the work, meaning the physical units or copies of the material medium containing the work.
- V. The importation into the Mexican territory of copies of the work made without authorisation.
- VI. The disclosure of derived works, in any form or manner. The law does not protect against the creation of derived works, only from their disclosure.

### 4.2 Are there any ancillary rights related to copyright, such as moral rights, and, if so, what do they protect, and can they be waived or assigned?

In Mexican legislation, and in accordance with “*droit d'auteur*”, there is a recognition of certain moral rights inherent to authors. As such, the sole, original and perpetual owner of the moral

rights is the author, and said rights are inalienable, non-waivable, imprescriptible, and unseizable.

These moral rights grant the author the power to:

- I. Decide the moment and manner of disclosure of the work.
- II. Demand recognition of authorship in relation to the work or decide that it is to be disclosed as an anonymous or pseudonymous work, colloquially known as a “paternity right”.
- III. Prohibit any distortion or any other modification thereof, or any act or action in relation to the work that might detract from its merit or prejudice its author's reputation, colloquially known as an “integrity” right.
- IV. Amend the work.
- V. Withdraw the work from the market.
- VI. Object to the attribution to the author of a work not created by him.

### 4.3 Are there circumstances in which a copyright owner is unable to restrain subsequent dealings in works which have been put on the market with his consent?

The owners of economic rights may authorise or prohibit the distribution of the work; however, the right of opposition will be considered exhausted on the first sale, meaning they are not able to restrain subsequent dealings of the work.

There is, however, an exception to the exhaustion of said opposition rights which deals with computer works or databases. In accordance with article 107 of the MCL, the owner of the copyright of the computer program or database shall retain the right to authorise or prohibit the rental of such copies even after the sale of the copies.

## 5 Copyright Enforcement

### 5.1 Are there any statutory enforcement agencies and, if so, are they used by rights holders as an alternative to civil actions?

There is primarily a statutory trade-related enforcement agency provided for in the MCL – the Mexican Patent and Trademark Office (IMPI, by its Spanish acronym).

Usually, right holders will use IMPI as a first instance for settling disputes and enforcing copyright infringement, before presenting a civil claims suit before the competent Civil Courts.

Also, the MCL provides for a settlement procedure (*procedimiento de avenencia*) carried out in the MCO.

Finally, civil law and the commercial code also provide alternative methods of dispute resolution through arbitration.

### 5.2 Other than the copyright owner, can anyone else bring a claim for infringement of the copyright in a work?

Any person who has a legal interest in relation to the infringement of copyright may bring forward a claim before the competent authorities. As such, licensees that have an exclusive or non-exclusive licence may sue third parties for copyright infringement and the author's heirs or successors may claim copyright violation.

Finally, the holders of the so-called neighbouring rights, for example performers, book publishers, producers of phonograms and videograms, and broadcasters may claim copyright infringement.

### 5.3 Can an action be brought against 'secondary' infringers as well as primary infringers and, if so, on what basis can someone be liable for secondary infringement?

Mexican law does not differentiate expressly between primary and secondary infringers; however, the law provides for secondary infringements in different sections of the MCL and may be brought forward before the statutory enforcement agencies or before the competent court.

### 5.4 Are there any general or specific exceptions which can be relied upon as a defence to a claim of infringement?

There are several limitations or exceptions provided for in Mexican Law. These limitations derive from the so-called "three-step test" enshrined first in the Berne Convention for the Protection of Literary and Artistic Works and later in Trade-Related Aspects of Intellectual Property Rights and the World Intellectual Property Organization Copyright Treaty.

Some of these limitations are:

- Citation of texts.
- Reproduction of works, photographs, and illustrations of current events.
- Private copies for personal use.
- Reproduction of a single copy for the purpose of preserving it.
- Reproduction for judicial or administrative means.
- Reproduction of works visible from public spaces.
- Publication of non-profit artistic and literary work for people with disabilities.

### 5.5 Are interim or permanent injunctions available?

Yes, there are certain injunctions available to any party claiming copyright infringement.

Among said injunctions are:

- a. The withdrawal of infringing goods from circulation.
- b. A prohibition on selling and marketing infringing goods.
- c. Securing and seizing of alleged infringing products.
- d. A prohibition on continuing to market or exploit advertisements, signs or anything similar.

### 5.6 On what basis are damages or an account of profits calculated?

In accordance with section 216 *bis* of MCL, compensation shall not be, on any account, less than 40% of the public sale price of the original product or of the original rendering of any type of service which involves infringement.

### 5.7 What are the typical costs of infringement proceedings and how long do they take?

The costs and time frame of infringement proceedings will vary on a case-by-case basis. Usually, for the first instance of the procedure, the costs will be from USD 8,000 to USD 20,000 depending on the complexity of the case.

As for the time frame, civil proceedings vary from 16 to 36 months. Administrative proceedings usually take longer, varying from 24 to 72 months.

### 5.8 Is there a right of appeal from a first instance judgment and, if so, what are the grounds on which an appeal may be brought?

Yes, there are several rights to appeal a first instance judgment. There are, in general, three methods to appeal the decision. These are as follows:

1. The option to review the decision before the same enforcement agency within 15 business days of the judgment. Usually, the grounds brought forward are related to omissions of the arguments filed before the authority in the case.
2. A Nullity Trial before the Specialized Intellectual Property Court which must be within 30 business days of the judgment. This trial is brought forth on the grounds of certain deficiencies of the authority concerning the administrative elements of the case.
3. An Amparo Trial (constitutional appeal), this appeal would be carried out against the sentence by the Specialized Intellectual Property Law for violations against the rights enshrined in the Constitution. This appeal is resolved by Federal Courts and must be filed within 15 business days of the judgment by the Specialized Intellectual Property Court.

### 5.9 What is the period in which an action must be commenced?

Although there are no exact or specific provisions in which, regarding copyright infringement, a claim must be commenced, there is the general rule in the Federal Civil Code that it must be brought within two years from the time the plaintiff is aware of the infringement.

## 6 Criminal Offences

### 6.1 Are there any criminal offences relating to copyright infringement?

Yes, the Federal Penal Code establishes the copyright offences applicable. These offences are generally punishable by imprisonment, as well as financial fines.

### 6.2 What is the threshold for criminal liability and what are the potential sanctions?

Criminal behaviour in relation to copyright is linked to copyright privacy, infringements and evasion of technological protection measures.

According to the Federal Criminal Code, articles 424 to 429, the sanctions will vary depending on the specific illegal activity, as follows:

1. A prison sentence of six months to six years and a fine equal to 300 to 3,000 days of minimum wage will be imposed on:
  - I. anyone who speculates in any way with the free textbooks distributed by the Ministry of Public Education;
  - II. publishers who knowingly produce more copies than is authorised of a work protected by the MCL; and
  - III. whoever intentionally uses, for profit and without the corresponding authorisation, works protected by the MCL.
2. A prison sentence of between three and 10 years will be imposed and a fine equal to 2,000 to 20,000 days of minimum wage for anyone:

- I. who produces, reproduces, stores, transports, distributes, sells, or leases copies of works, phonograms, audio-visual works protected by MCL. The same sanction shall be imposed on anyone who knowingly contributes or provides in any way raw materials or supplies intended for the production or reproduction of the works; or
  - II. who makes for profit a device or system for the purpose of deactivating the electronic protection devices of a computer program.
3. Imprisonment will be imposed for a period of between six months and six years and a fine equal to 5,000 to 30,000 days of minimum wage, to those who sell to any final consumer on the road or in public places, for the purposes of commercial speculation, reproductions of works, phonograms, audio-visual works, or books. If the sale is made in a commercial establishment, or in an organised or permanent manner, the sanction established in the previous paragraph shall apply.
  4. A prison sentence of between six months and two years or a fine equal to 300 to 3,000 days of minimum wage will be imposed on anyone who knowingly and without right exploits an interpretation or execution for profit.
  5. Imprisonment will be imposed for a period of between six months and four years and a fine of 300 to 3,000 days of minimum wage, in the following cases:
    - I. whoever manufactures, imports, sells, or leases a device or system to decrypt an encrypted satellite signal, without authorisation of the legitimate distributor of said signal; and
    - II. whoever performs for profit any act with the purpose of deciphering an encrypted satellite signal or carrier of programs without authorisation from the legitimate distributor of said signal.
  6. Imprisonment shall be imposed from six months to six years and a fine equal to 300 to 3,000 days of minimum wage for those who knowingly publish a work substituting the author's name for another name.

Additionally, in July 2020 several dispositions (section 427 *Bis*, 427 *Ter* and 427 *Quarter*) were included to criminally prosecute the following:

1. Whoever knowingly and for profit circumvents without authorization any effective technological protection measure used by phonogram effective technological protection measures shall be punished with imprisonment from six months to six years and a fine of five hundred to one thousand days.
2. Whoever, for profit, manufactures, imports, distributes, rents or in any way commercializes devices, products, or components of any kind, or commercializes devices, products or components intended to circumvent a technological measure of effective protection, shall be sentenced to six months to six years imprisonment and from five hundred to one thousand days fine.
3. Any person who, for profit, provides or offers services to the public aimed principally at circumventing an effective technological protection measure, shall be sentenced to six months to six years' imprisonment and a fine of 500 to 1,000 days' imprisonment.

4. Whoever knowingly, without authorization and for profit, suppresses or alters, by himself or by means of another, any information on rights management, shall be sentenced to six months to six years of imprisonment and from 500 to 1,000 days' fine. The same penalty shall be imposed on anyone who for profit:
  - I. Distributes or imports for distribution rights management information, knowing that it has been suppressed or altered without authorization.
  - II. Distributes, imports for distribution, transmits, communicates, or makes available to the public copies of works, performances, interpretations, or other works/performances.

The pecuniary sanctions provided for in this title shall be applied without prejudice to the damage repair, which, as stated in question 5.6 above, shall not be less than 40% of the public sale price of the original product.

## 7 Current Developments

### 7.1 Have there been, or are there anticipated, any significant legislative changes or case law developments?

Yes, several bills were passed in 2020, the principal aim of which was to comply with the United States-Canada-Mexico Agreement. A new industrial property law was passed which changed several rules. Likewise, in copyright the most relevant bill passed regulates safe harbours, Technological Protection Measures, a notice, and takedown procedures, as well as the right of performers to authorize or prohibit the public communication of their performances.

### 7.2 Are there any particularly noteworthy issues around the application and enforcement of copyright in relation to digital content (for example, when a work is deemed to be made available to the public online, hyperlinking, in NFTs or the metaverse, etc.)?

In the bill mentioned in the previous paragraph several changes were implemented to regulate and establish a clear notice and takedown procedure, safe harbours, and technological protection measures. Although the system was *de facto* in place before this reform, the changes stipulate clear rules in Mexican legislation.

No relevant or noteworthy issues related to the metaverse or NFTs have been discussed.

### 7.3 Have there been any decisions or changes of law regarding the role of copyright in relation to artificial intelligence systems, including the use of copyright in those systems and/or any work generated by those systems?

In Mexico, there are not yet any judicial decisions nor proposed bills to reform the law related to Artificial Intelligence or the use of copyright generated by such systems.





**Luis Schmidt** joined OLIVARES in 1991, became a partner in 1995, and has almost 40 years of legal experience, with a specialization in copyright in the business of entertainment and culture. He has represented the world's leading companies in the music, film, television, book publishing, fine art, design, folklore, and software.

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