

**INTELLECTUAL
PROPERTY**





Intellectual Property

This practice provides advice on IP protection, including consulting, prosecution and litigation of patents, trademarks, industrial designs, utility models and copyrights.

We also provide advisory on all IP related agreements including authorship and related rights, licensing, software development, hosting, outsourcing, distribution, strategic alliances, co-branding and franchising. Additionally,

our IP practice develops tax-efficient IP management strategies and advises clients on the transfer of IP in contracts and in transactions such as mergers, spin-offs, divestitures, and corporate name changes. Our practice also includes advisory on Data Privacy, including the review and audit of policies and data handling procedures, and representation before national authorities.



Industries we serve

The Intellectual Property team serves to companies in the following industries: Life Sciences, Automotive and Autoparts, Manufacturing, Food and Drink, Retail, Leisure and Tourism, Energy, Information, Media and Telecommunications, Services among others.

REPRESENTATIVE EXPERIENCE

- » We have established a legal strategy to represent pharmaceutical companies in interactions with regulatory authorities in drug security cases, including counterfeits, sales of samples and robbery.
- » Our firm analyzed and designed the legal strategy for a joint investment with a major Mexican steel wire manufacturer, which implies the incorporation of a legal entity and the establishment of a manufacturing facility in Mexican territory. This matter has required extensive legal and technical analysis of information technology and technology transfer implications, as well as a very precise strategy for pre-closing and post-closing actions required to protect client know-how and information assets to be segregated and migrated to a shared information environment.
- » Our firm is providing legal advice and representation in related negotiations, to establish a joint investment with a major tequila distributor in Mexico, and secure commercialization rights under strict rules regarding the use of the denominations of origin. This matter represents the final stage of previous and extensive arbitration procedures, in which we assisted client in securing trademark rights over a controversial tequila trademark, and the payment of significant royalties. The joint investment is the result of complex legal analysis, negotiations with client's counterparts, as the best way forward to better exploit a market positioned trademark, and securing required denomination of origin authorizations and distribution rights under the Tequila denomination of origin.
- » Our firm has provided legal advice and representation in negotiations with Federal authorities and big players of the wine industry in Mexico, to secure proper inclusion of legal provisions to protect "Brandy" denomination, in consistency with International treaties and related laws in other jurisdictions (mainly Spain and the EU). This matter implies exhaustive legal and technical analysis of internationally accepted concepts and production rules that enable the use of the "Brandy" denomination, for products of authentic origin (prepared under the traditional method for distillery of 100% grape materials). It also involves strategic legal representation for negotiations with all involved parties in the discussion and drafting of the Official Standard (NOM 199). Our advisory led an approval that does not allow non-traditional producers to apply the "Brandy" denomination to alcoholic beverages that do not comply with international standards, as a misleading practice against authentic producers, denominations of origin and consumers in general.
- » Our firm is currently advising one of the largest telecommunications companies in Mexico and US on the analysis, design and implementation of data protection and information security policies to comply with Mexican law. This matter has involved extensive legal analysis of the

REPRESENTATIVE EXPERIENCE

current data protection platform of the client, applicable international standards, as well as the anticipation of best practices towards future compliance requirements, in light of the announced amendments and enactment of related laws in Mexico. This, especially in regards to the profile and position requirements for a local data protection officer and the internal organization implications thereof, as well as the internal procedures to deal with the exercise of material rights of data subjects and possible official verification procedures.

- » Our firm conducted an extensive legal analysis of the nature and scope of a proposed massive video game competition, to determine if a federal government license was required to host such competition in Mexico City. This matter is relevant because it implied analysis of statutory law, judicial precedents and current government criteria, to protect client activities and provided legal certainty, as the nature of the competition included innovative elements of randomness not recognized in the provisions of Mexican law. The conclusions of this case, along with the query to involved federal authorities, serve as precedent for similar competitions from a regulatory perspective.
- » Our firm is providing legal advice for the analysis, design and implementation of long-term legal strategies to protect client industrial secrets and IP assets to be transferred as consequence of a joint investment with a mayor Mexican concrete manufacturer. This matter is relevant because it requires exhaustive legal analysis and innovative solutions to allow our client to disclose and share technical information and know how, under a legal platform that warrants an organized and controlled environment for a long-term project (construction of the new Mexico City airport).
- » Our firm is providing legal advice for the design and implementation of a legal strategy to protect and register trademark and other IP assets related to an exclusive residential community and resort in Los Cabos, Baja California. This matter is relevant because of the extension of the Project and the investment of the client in the real estate development. This case has proved to be a challenging Project because it requires innovative legal solutions to securing

trademark and other IP registrations, in view of several registration precedents found by the Mexican Trademark Office as impediment. In consequence, our firm is challenging the legal grounds of the trademark examination criteria currently being applied by the authority; with the aim of changing systematic standards that obstruct, rather than encourage, the evolution of the Mexican Trademark System, to meet the requirements of the new trademark context.

- » Our firm represented a client in a series of administrative litigation actions aiming to cancel a copyright registration certificate covering folkloric works of art of indigenous cultures from Mexico's southern region. The copyright certificate was being used by the opposing party to claim counterfeiting against client in a fraudulent criminal investigation. This matter is relevant because of the analysis and legal investigation required to support the folkloric nature of the works of art involved, since such are not clearly identified or documented in Mexico, and there are very few court precedents involving defence and free use of folkloric elements of Mexican culture. The corresponding administrative court has issued a decision that sets a very important precedent on the matter because it sets out the guidelines to show that a third party is wrongfully misappropriating folkloric works of art (as proprietary rights) to private exploitation, as well as applicable criteria for the free use of such works of art. This matter substantially modifies the Mexican Copyright Office's rules for the examination and granting of copyright certificates.
- » Our firm represents client in negotiations with a major US Company who has granted an IP license to a joint venture vehicle for the manufacturing of gypsum boards in Mexico. We have conducted an exhaustive assessment of intellectual property used by the joint venture vehicle (including novelty of related inventions) to determine the real grounds to justify extension of the granted license, as well as amount to be paid as royalties. This matter is important because the outcome of our legal assessment in regards to the nature and use of licensed IP will determine if client continues with the joint venture, and under which conditions.



Our Experts in Intellectual Property

The Intellectual Property team is conformed by attorneys with extensive experience in Intellectual Property matters, with due support by experts on technical fields such as chemistry, biology and automotive engineering.

Juan Luis Serrano-Leets

Juan Luis heads the IP Practice. He has more than 14 years of experience working on a combination of Intellectual Property and Life Sciences cases, both in top law firms and as the former legal director of the Mexican division for a multinational pharmaceutical company. He leads our IP/Data Privacy team, with a strong involvement in the Life Sciences Practice Group. Juan Luis has acted as counsel in cases which have shaped the current landscape regulating interactions between IP and Regulatory authorities in Mexico, on issues such as linkage and regulatory exclusivity. Juan Luis also has broad experience advising companies and industry associations on issues of Intellectual Property and Regulatory policy, acting as main point of contact with relevant authorities. He has also led several litigation strategies to enforce patents, trademarks and other forms of IP rights. He has also led efforts to harmonize global data privacy policies with local law requirements, and provides general advisory on these issues. As main representative cases, Juan Luis has acted as counsel for several multinational companies in litigation actions to obtain regulatory data exclusivity for small molecule and biologics products based on international treaty provisions, acting before Federal Courts.

He also drafted the first constitutional actions to secure inclusion of formulation use and polymorph patents in the Mexican Linkage Gazette, which eventually led to a Supreme Court review of the issue.

Juan Luis represented a large multinational fast food chain in several litigation cases to enforce trademark rights and managed to overturn a long standing criterion by the trademark office on similarity.

In addition, he filed a successful challenge to a determination by the General Health Council regarding the rules of acquisition for certain gastro-intestinal drug products.

Contact

Juan Luis Serrano-Leets – Partner
jserrano@sanchezdevanny.com

Who we are

Sánchez Devanny is a leading Mexican law firm that provides full-service legal advice both to Mexican and international clients.

More than attorney-client services

We build enduring client relationships that go beyond individual service contracts because we make every effort to understand our clients' businesses and expectations, to serve as an ally, and to provide complete, accessible and personalized advice. As a testament to these efforts, we continue to advise clients today who have trusted us with their legal matters since the firm was founded in 1996.

Experience and creativity

Throughout the firm, we take pride in serving our clients with a combined approach of experience and creativity because we recognize that when you know how things are done it is easier to think outside the box. Our partners offer a wealth of experience, including in prior roles as in-house counsels at global companies and government agencies, and key roles within international law firms.

With offices in Mexico City, Monterrey, and Querétaro, as well as several strategic alliances worldwide, the firm is well-positioned to quickly and efficiently represent and respond to clients' needs, shortening the distance between us and our clients. Our services are delivered in an efficient, professional, cost effective and timely manner, keeping always in mind that, as lawyers, we are business facilitators for our clients and must maintain a proactive and preventive approach.

Location

México City:

Av. Paseo de las Palmas #525 Piso 6
Col. Lomas de Chapultepec, 11000
Ciudad de México
T. +52 (55) 5029 8500

Monterrey:

José Clemente Orozco #335 Piso 4
Despacho 401 Col. Valle Oriente, 66269
San Pedro Garza García N.L.
T. +52 (81) 8153 3900

Querétaro:

Av. Antea #1090 Piso 2 Int 206
Col. Jurica
Querétaro, Qro
T. +52 (442) 296 6400



www.sanchezdevanny.com

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Sánchez Devanny provides legal services in the areas of Corporate and M&A; Corporate and Project Finance; International Trade and Customs; Real Estate, Infrastructure and Hospitality; Tax; Labor, Social Security and Immigration; Corporate Governance and Regulatory Compliance; Energy and Natural Resources; Environmental; Life Sciences; Intellectual Property, Entertainment and Sports Law; Litigation and Alternative Dispute Resolution; Antitrust; Capital Markets; Private Wealth Management and Estate Planning; Administrative Strategic Litigation and Data Privacy and Information Technology to both public and private clients, especially in the automotive, retail, pharmaceutical, manufacturing, real estate and energy industries among others.