

Copyright infringement in Mexico

✓ Background

Iguana Ltd. is a UK-based communication agency that was willing to renew the corporate identity of *Guanajuates*, a client in Mexico. As a first step, they decided to redesign the company's logo of the Mexican enterprise.

Tired of unsuccessful, time consuming exchange of drafts that largely exceeded what was budgeted, the CEO ordered the graphic designer of the European SME to stop spending additional time on the design, as it would be impossible to charge the customer for it.

The Mexican company was sent a final version of the logo, which included a fancy font that was finally accepted.

⚙️ Actions taken

A few months later, Guanajuates contacted Iguana Ltd. requesting a copy of the font's licence in order to submit it to Enzo Pirlo, its author, who sent the Mexican company a C&D letter claiming, among other things:

1. removal of all the products marked with the logo
2. and damages for unauthorised use of its copyright protected work

Otherwise, Mr. Pirlo would start legal actions and oppose to the ongoing Trademark application before the Mexican Trademark Office (IMPI).

Upon expert consultation and internal research, the European SME figured out that:

- the graphic designer used a font, which was freely available under personal use licence
- the Italian author's font was protected by Copyright, even outside his country

In the view of that, Iguana Ltd. contacted the font's author, explained the situation and tried to solve it in an amicable way.

📊 Outcome

After long negotiations, both parties reached an agreement, by which:

- The English company would buy the font (exclusive license) in order to freely use it for commercial purposes, including modifications of the font; and launch an ad campaign giving proper credit to the author.
- The font's author committed not to start any legal actions.
- Guanajuates will be able to obtain trademark protection

Besides, Iguana Ltd.'s CEO organized a training on IP awareness and protection in collaboration with the Latin America IPR SME Helpdesk for their staff to prevent further problems.

📖 Lessons learned

- Seek IP professional advice in advance to avoid infringing third parties' rights.
- Artistic works, such as fonts can be protected by Copyright.
- All IPRs are territorial, but some can be enforced abroad due to the signature of International Treaties (e.g. Berne Convention for copyright protection).
- Train your own staff and have clear IP policies, including warranties as part of the agreements to be signed with the customers.
- Most of the royalty-free resources available on the Internet are subject to certain terms of use, which are explained either in the websites' terms of use or in the resource's license (e.g. author mention). You can find the author's contact details in the license and ask him/her for authorization.
- Similarly to Europe, in Mexico, parties can oppose Trademark applications based on prior IP Rights, including Copyright.