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Current patent challenges in Mexico

Sergio L. Olivares, Jr., and Mauricio Sámano from Olivares discuss the Mexican patent scenario, considering the aspects that work well and those that need more development to be able to protect inventors.

The patent scenario in Mexico has faced many challenges in recent years. In this paper we will address those that are becoming more relevant for applicants who seek to protect their inventions in Mexico. Specifically, the most relevant challenges that we are now facing in Mexico are the following: voluntary divisional applications, lack of support objections, medical use, claim drafting, and post-grant amendments.

The gaps in Mexican domestic law and the lack of specific guidelines for the Examiners have contributed in great measure to this situation. The eventual signature of the TPP was an excellent opportunity to address these issues, since our domestic law would have been revised

and modified in order to be in line with the intellectual property chapter of the TPP. However, since the TPP is no longer a possibility, we expect that our law modernizes in order to be harmonic with the day-to-day practice.

Voluntary divisional applications in Mexico

Voluntary divisional applications are a good strategy for obtaining protection for specific embodiments of an invention that were not granted in a certain parent case and that are of commercial interest for the applicant. In this sense, it is important to clarify that Mexican Industrial Property Law does not have a specific provision that contemplates the possibility of filing voluntary divisional applications. Mexican domestic Law only contemplates the possibility of filing a divisional application when a lack of unity objection is raised, as mentioned in articles 43 and 44 of our domestic law, which read as follows:

Article 43. *The application for a patent shall refer to a single invention, or to a group of inventions so related to each other that they constitute a single inventive concept.*

Article 44. *If the application does not meet the provisions of the previous Article, the Institute shall notify the applicant in writing so that, within a period of two months, he may divide it into several applications, retaining as the date of each one that of the initial application and that of any recognized priority. If, on expiration of the period allowed, the applicant has not divided the application, it shall be considered abandoned.*

Where the applicant complies with the provisions of the previous paragraph, the divisional applications shall not be published as provided for in Article 52 of this Law.¹

¹ In view of the underlined section of article 44, when a lack of unity objection is raised, the criteria applied by the Mexican Patent Office is that the time limit for filing a divisional application is along with the response to the office action that issued with respect to the parent case.

Résumés

Sergio L. Olivares, Jr.

Sergio joined Olivares in 1987, becoming a partner in 1994 and Chairman of the Management Committee in 2009. He leads the firm with strength and a commitment to transparency, client satisfaction, and personal service.

Mr. Olivares' work at Olivares is extensive, and he has vast experience in the prosecution and litigation of intellectual property rights, particularly trademarks, copyrights, patents and unfair competition. He has specialized his practice in all types of intellectual property law, but works closely with the Patent group. He is highly recommended by leading industry titles and rankings as a leader in IP.

Mauricio Sámano

Mauricio works in the patent department of our firm. His work in Olivares mainly focuses in prosecuting chemical, biotechnological and pharmaceutical patent applications, as well as in providing technical opinions regarding patent infringement. He has experience in conducting state of the art searches and drafting patent, utility model and industrial design applications. Additionally, he has participated in interviews with examiners of the Mexican Institute of Industrial Property (IMPI) and the United States Patent and Trademark Office.

However, even though our domestic law does not specifically contemplate voluntary divisional applications, in the practice, Mexican Examiners accept the filing of voluntary divisional applications at any time during the prosecution of the parent application and before the payment of the final fees of the parent case. The legal support for this criteria lies in article 4-G(2) of the Paris Convention Treaty² which states that the applicant may also, on his own initiative, divide a patent application and preserve the date of each divisional application, the date of the initial application, and the benefit of the right of priority, if any. It is also important to contemplate that if the applicant has not decided the matter he wishes to pursue in said voluntary divisional application, it is possible to file the original PCT set of claims in said divisional and, afterwards, once he has defined the matter he seeks to pursue, he can file said matter by means of a voluntary amendment before the issuance of the first office action. Typically, the first office action for a divisional application issues about 8 to 14 months after the filing date of said divisional and thus, the applicant has plenty of enough time to define the matter they seek to pursue in said voluntary divisional application. In this sense, especially in the Chemical and Pharmaceutical/Biotech cases, when drafting the claims for a voluntary divisional application, it is necessary to avoid any type of overlapping matter with that of the parent case in order to avoid a future double patenting objection.

Lack of support objections

This subject has been addressed by our law firm in previous occasions and is becoming more and more of an issue in Pharma and Biotech cases, since the criteria that most Examiners are applying nowadays is to request literal support in the examples of the patent application for the scope that is sought to be protected in the claims.

The legal basis for a lack of support objection may be found in fractions I and III of article 47 of the Mexican Industrial Property Law and fraction VII of article 28 of the Regulations under the Mexican Industrial Property Law. Fractions I and III of article 47 of the Mexican Industrial Property Law mention the following:

Article 47: *The patent application shall be accompanied by:*

“I. A description of the invention, which shall be sufficiently clear and complete to be fully understood and, where appropriate, to serve as a guide for a person with average skill in the art to make it; it shall also mention the best method known to the applicant of carrying out the invention, when this is not clear from the description of the invention.

In the case of biological material where the description of the invention cannot itself be sufficiently detailed, the application shall be completed with a record of the deposit of the material at an institution recognized by the Institute, in accordance with the provisions of the Regulations under this Law...

“ The applicant may also, on his own initiative, divide a patent application and preserve the date of each divisional application, the date of the initial application, and the benefit of the right of priority. ”

III. one or more claims, which shall be clear and concise and may not exceed the contents of the description...”

Furthermore, fraction VII of article 28 of the Regulations under the Mexican Industrial Property Law specifies that the applicant must indicate the best known method for carrying out the invention and, when appropriate, said indication must be made by means of practical examples or specific applications of the invention.

In spite of the above criteria, in practice, Mexican Examiners accept the submission of additional experimental evidence as long as said additional experimental evidence can be derived by the originally filed specification and is not incorporated into the description. Said additional experimental evidence can be filed as an annex to the response of an office action, and IMPI does not request a specific format for the submission of said additional experimental evidence. This practice is becoming more and more common in IMPI and represents a clear advantage for the applicant.

Medical use claim drafting

According to fraction VII of article 19 of our domestic law, methods of surgical, therapeutic, or diagnostic treatment that are applicable to the human body and relative to animals are not considered patentable subject matter. However, in practice, in order for treatment method claims to be acceptable, they must be redrafted as Swiss type claims (Use of Compound/Composition X for the manufacture of a medicament for treating Y), or as EPC 2000 claims (Compound/composition X for use in treating Y). In this respect, please note that currently there is an absence of criteria and guidelines in the Mexican Institute of Industrial Property (IMPI) about which medical use claims can be accepted, since some Examiners accept both EPC2000 and Swiss type claims.

Please note that the patentability of medical use claims is not expressly recognized in our domestic law. However, Swiss type claims are accepted in Mexico because they are interpreted as process claims and EPC 2000 claims are more closely interpreted as product claims.

Post-grant amendments

The Mexican Industrial Property Law states that amendments in the text of a patent are allowed only to correct evident or formal errors or to limit the scope of the claims. However, our domestic law is silent about post-grant amendments for those patents under litigation. There are no court precedents yet in this regard to rely on. In this sense, Olivares has fashioned strategies in Mexico that allow patent holders to shape the scope of their patents under litigation, instead of getting their rights assessed in a non-proper way. These strategies have provided positive results but are still under test. We hope this serves as a basis for future amendments to our law or for the development of specific Examiner guidelines in order to provide more certainty to patent owners on this matter.

Conclusions

Indeed, the Mexican Industrial Property Law still has many gaps and grey areas that need to be clarified. However, we are confident that lobbying efforts along with the resolutions of Mexican courts will help to shed a light on these issues and will bring more certainty to patent owners and applicants.

² Due to a reform made on June 10, 2011 on Mexico's Constitution, Human Rights International Treaties, have a superior hierarchy than domestic laws. Since Mexico's Supreme Court considered that Intellectual Property treaties are Human Right treaties, Intellectual Property treaties such as Paris Convention or the PCT have a superior hierarchy than our domestic laws.