

Mexico moves towards a new patent system

Hector Chagoya of **BC&B** analyses changes to Mexico's patent landscape, including the ability to file and manage applications online, new rules around the publication of applications as well as changes to the term of protection and fees

Much like 27 years ago, it is no surprise that trade agreement negotiations are leading to significant changes in the intellectual property system in Mexico. Particularly in relation to inventions, there have been several legal and administrative changes that are reshaping the patent prosecution landscape. Yet more changes are expected as the provisions of the new trade agreement between the USA, Mexico and Canada (USCMCA) are implemented in the next five years.

The system for the protection of inventions in Mexico includes patents, utility model registrations and design registrations.

Online system

The administrative changes to the prosecution of rights related to inventions started with the implementation in 2016 by the Mexican Institute of Industrial Property (IMPI) of the so-called "inventions online" system, whereby patents could be filed electronically. At this stage, the main drawback of the system was that the filing was done electronically but the rest of the prosecution was done on paper, from formalities to maintenance. By April 2017, this had changed and a second version of the system made it possible to file and prosecute electronically in full. The implementation of the system necessitated the issuance of decrees governing the rules for electronic systems, including rules for receiving notifications through such a system in order to provide all users with legal certainty.

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Inventors can no longer be anonymous

The most significant changes to the system were enacted this year. They were published on March 13 2018 and have been in force since April 27 2018 with complementary reforms issued in May 2018 and enacted in August 2018.

Regarding inventors, the law was changed in order to remove a former right given to inventors which allowed them to remain anonymous. The reason for this change is unclear, but as of April 27 2018 all inventors must be mentioned in a patent application and cannot be omitted. Although this provision is generally seen as empowering inventors, it remains uncertain whether inventors actually want to be mentioned in a patent application and if such an obligation violates fundamental rights or not. This is inconsistent with copyright law, where authors still have the right to remain anonymous.

Changes to term for submission of information

There was also a change in the term for submission of information affecting patentability requirements by third parties. The term used to be six months from the date of publication. However, according to the IMPI, the number of submissions was extremely low and it was decided that the term should be reduced to two months from the date of publication. This is the applicable term currently for submitting information on patentability against a patent application of interest.

Rules around publishing and availability of prosecution history

Another change relates to the publication of certain applications that were not previously published. Design register applications, utility model applications and all divisional applications (patents, design registration and utility model registration) filed as of April 28 2018 will be published as soon as possible after completion of formalities. Such applications were not published before.

Along with the publication of all applications, another significant change was made whereby the prosecution history of all applications will be made available to the public as of the date

of publication. This change will make it easier to identify the events occurring during the prosecution history of a patent application. Access to office actions created another change in the way patents are prosecuted in Mexico. This will be described further below.

Design registration law

Definitely the most dramatic changes occurred in relation to design registration law. The changes were intended to prepare Mexico to become a signatory to the Hague Agreement and to clarify certain concepts that sometimes affect examination of design applications in Mexico.

The current definition of novelty used for design registration applications in Mexico includes the concepts of "independent creation" and "significant degree". These were not expressly defined elsewhere. As well as this, Mexican law did not provide robust support for examiners amending the title of the design to make it more specific.

The definitions of both terms were included in order to match the current practice of the IMPI. Furthermore, clearer specifications and limitations for products to be protected by the design register were provided as part of the changes in the law.

Term of protection

Regarding the term for protection, the system changed to renewals every five years up to a maximum of 25 years. This is in contrast to the former system based on annuities of up to 15 years. Voluntary application of the new law to design register applications undergoing prosecution was possible to request prior to June 11 2018. Granted designs will be renewed if the petition is made prior to the end of the first 15 year period and will be available for two five year periods.

Fees

The biggest change to administrative procedures concerns the official fees for prosecuting patents, design register applications and utility model applications. A new official fee has been added per page in excess of 30 for patents and utility models and for each additional embodiment in the case of designs. Even though the decree that enacted the new fees along with other fees related to trade marks and new geographic indications was very confusing at the beginning, a later clarification issued and in force from August 2018 made it clear that the count of sheets for determining the payable government fees will be only the first two of the official format, the specification, claims and drawings, and when submitted in paper, sequences of nucleotides or amino acids.

Notification of office actions

Finally, the last change related to patent prosecution under the new law concerns notification of substantive examination office



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He started practising in the area of patents in 1997 and since then, has acquired vast experience as a consultant in the analysis, prosecution and use of patents in industrial fields such as polymers, biotechnology, pharma and electronics, among others. At BC&B he has been an expert witness in litigation cases and been recognised for his knowledge of patent matters in Mexico and abroad. He has also been noted for his expertise in intangible assets valuation, contracts and technology transfers, as well as his negotiation skills.

actions. According to a reform published in May 2018, notification of office actions and requirements from the IMPI for all published applications, including those of inventions, will be made only through the official gazette and personal notifications will not be available any more for such published files. The first gazette with these notifications has not been published at the time of writing but is expected to issue in late October or early November 2019. The frequency of publication for inventions is expected to be weekly and IMPI authorities have said that they intend to issue the patents gazette every week.

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The future

The Mexican IP system has evolved again as a result of negotiations concerning free trade agreements. The patent prosecution landscape has changed dramatically in recent months.

The changes are a message from policymakers that there is a firm intention to modernise and move the Mexican patents system forward for better and efficient protection. However, at the same time the changes have been implemented within a very tight timeframe. The rush created has put a lot of pressure on applicants and patent practitioners in Mexico.

Hopefully the changes that need to be implemented in the months and years to come as a result of the enactment of the USMCA, such as changes to patent term adjustments for prosecution or regulatory delays will be made in a more orderly fashion, and such changes will further clarify the amendments already made.

More than ever, a good selection of patent professionals with experience in prosecuting cases in Mexico will be essential for keeping a patent portfolio in good shape. Continuing efforts will need to be made in relation to electronic filing systems in order to perfect the flaws that are still present. This will be extremely important for certainty in the years to come.



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