

The Patent Lawyer

September/October 2019

GLOBAL REACH, LOCAL KNOWLEDGE

www.patentlawyermagazine.com

Can Artificial Intelligence be an inventor?

Malcolm Dowden, Legal Director of Womble Bond Dickinson, examines the far-reaching implications for patent law and beyond.

CONFERENCE
SEASON
SPECIAL



CTC Legal Media

PLUS

The doctrine of equivalents in the UK, France and Germany, global trends in plant variety protection, and innovation in 3D NAND Technology.

• IP innovation in Sweden • Cannabis reform in Mexico • Industrial Designs in Russia



Your trusted IP advisor
in Mexico

**YOUR IDEAS.
OUR BUSINESS.**

dumont.com.mx

Unity of invention in Mexico

Edith Rivero from the IP firm Dumont comments on current Mexican practice regarding unity of invention for patents.



To be patentable, an invention must comply with the universal requirements - namely novelty, inventive step and industrial applicability - but also with some others, such as unity of invention. Depending on the jurisdiction, the guidelines for determining whether a patent application fulfils such requirements might be established in the law, or in secondary regulations, or be left to practice, which, in turn, might be standardized or not.

Unity of invention could be an extensive topic, since it is related to other requirements such as the mentioned novelty and inventive step, or even clarity of the claims. As discussed below, Mexico is one of the jurisdictions where there is no clear framework for determining unity of invention.

Legal framework

Mexican law states that a patent application shall refer to a single invention, or to a group of inventions so related to each other that they constitute a single inventive concept; otherwise, the applicant is to be notified to divide the application into one or several applications, which will retain, as the filing date, that of the initial parent application. However, the law and any other secondary regulation are totally silent about a clear



Edith Rivero

“Mexico does not have clear guidelines for determining unity of invention.”

definition of “inventive concept” and how to assess it during examination.

On the other hand, arguably without the intention to regulate the unity of invention requirement, the same law indicates that a single application may comprise: claims to a product and claims relating to process specially devised for the manufacture or use of said product; claims to a process and claims relating to an apparatus or means specially devised for the application of said process; and claims to a product and claims relating to a process specially devised for the manufacture of said process, and to an apparatus or means specially devised for the

Résumé

Edith Rivero

Edith is technical sub-manager at Dumont. She holds a BS in pharmaceutical biological chemistry and has been practicing patent law since 2012. Her practice focuses on patent drafting, prior art searches, and particularly in the prosecution of patent applications on the chemical, biological and pharmaceutical areas.

application of said process. However, as we will see below, all these and other combinations can be encompassed by a more general conception of the unity of the invention requirement as interpreted in the Mexican jurisdiction.

A general interpretation

In practice, to try to maintain two or more inventions in the same patent application, it should be demonstrated that they are related by an essential technical feature. Certainly, there is no definition of “essential technical feature”, nor the way it should relate to the claimed inventions in this context. Nonetheless, there is a consensus that an essential technical feature is one to which novelty and inventive step is attributable. This means that a novel feature not contributing to the inventive step should not qualify as an essential technical feature, and that the study of the unity requirement is to be performed after assessing novelty and inventive step.

On the other hand, there is a plurality of manners that an essential technical feature can relate to two or more inventions. For the sake of simplicity, the following comments are made considering the case of two inventions contained in two corresponding independent claims.

Cases in which the essential feature is shared by the inventions

In these cases, the essential technical feature is present in both studied inventions, and the respective claims usually mention it. For example, a compound and a composition comprising the same; a new compound and a polymorph thereof; an apparatus and a machine incorporating the same; or two processes to manufacture two embodiments of a product, wherein the processes share relevant steps.

Cases in which the essential feature of one invention derives from that of another

Usually, in these cases, the inventions tend to pertain to different categories, and the patentability of one heavily depends on the patentability of the other. For example, a process and the product thereof, including the process-by-product scheme; a compound and the use thereof as a medicament; a computer-implemented method and a computer-readable medium carrying the computer program associated to the method; or in certain cases, a machine and a product manufactured using the same.

Cases in which the essential feature of one invention is implied in another

In these cases, the inventions are related to the same essential feature, without one of them necessarily physically comprising it. For example, a process and a physical configuration to carrying it out, such a computer-implemented method and a system

“Mexico is one of the jurisdictions where there is no clear framework for determining unity of invention.”

implementing it, including the means-plus-function scheme; the use of a compound in a dosage regime and a medicament (product) adapted to be administrable in accordance to such dosage regime; a chemical compound and an intermediary thereof with respect to its method of synthesis; different forms of a known chemical compound such as polymorphs thereof, so that the compound's structure or its general chemical activity is not the essential feature; two parts of an apparatus or machinery both comprising means specifically designed to be coupled to each other, or to work together to achieve a common technical purpose.

As can be inferred, the presence of a plurality of inventions is not forbidden. Moreover, in case of objections, the applicant is allowed to expose reasons why two or more inventions are linked by an essential feature, without facing the risk of losing rights over any invention unless several office actions are raised focusing on the same issue. Importantly, even if the practice is similar to the European one, this is one of the aspects in which the Mexican Patent Office does not seem to stick to foreign criteria, especially not that of the USA. There might be the case that, either because of a misinterpretation or error by the examiner or because of a convincing argument from a creative patent attorney, a patent comprising inventions not complying with the unity of invention requirement might be granted. This is not a fatal flaw because non-compliance with unity is currently not a cause of patent invalidation in Mexico.

Final thoughts

Mexico does not have clear guidelines for determining unity of invention. Depending on familiarity with the system, this allows for an advantageous flexibility for applicants, as there is a plurality of schemes that would permit maintaining two or more inventions in the same patent application, provided it is shown that, somehow, they relate to an essential technical feature. Applicants are advised to consider a suitable drafting reflecting the relationship discussed above, making it as evident as possible for examiners, with the aim of minimizing objections or divisions during prosecution.

Contact: Dumont

Address: Avenida Insurgentes Sur 1898

– Pent Office 21 Floor

Col. Florida, CP 01030, alc.ía Álvaro Obregón,
Mexico City, MEXICO

Tel: +52 (55) 5322 6230

Fax: + 52 (55) 5661 3056

Email: erivero@dumont.com.mx

Website: www.dumont.mx/