Víctor Garrido of **Dumont Bergman Bider & Co** explores patent utility issues in Mexico within the context of global harmonisation

Difficulties in the harmonisation process

Patent law harmonisation has been one of the most significant international issues in recent years; it has the potential to create a range of advantages, including reduction of costs and increase of efficiency in the patenting process. Considerable efforts have been made to try to reach compromises to enable countries to build similar patenting standards. To attain harmonisation, not only the law but its practical application needs to be considered.

The utility requirement has proven difficult to harmonise because each country, whether intentionally or not, has developed its own utility standard, and Mexico is not the exemption.

Patent utility is so closely related to industrial applicability, sufficiency of description, enablement and best mode, that it is not always easy or even possible, to discern among them. This, of course, depends on each law, but it is evident that the Mexican one is not particularly friendly on the matter.

According to the Mexican Constitution, privileges granted to authors (inventors) for the temporarily exclusive use of their inventions are not regarded as monopolies. Therefore, patent utility, at least as a concept for granted patents, has constitutional grounds in the local law as patents (privileges) are granted to inventions which are useful.

On the other hand, Mexico has signed various international agreements containing implications for patent utility, including the Paris Convention (addressing IP rights in the context of industry), the Patent Cooperation Treaty (which specifically deals with the industrial applicability requirement and guidelines for determining an invention to be industrially applicable if it has specific, substantial, and credible utility), TRIPs and the North American Free Trade Agreement (which both indicate that patents should be available for any inventions, whether products or processes, in all fields of technology, provided they are new, involve an inventive step and are capable of industrial application).

The Industrial Property Law

None of these legal backgrounds impose utility standards beyond those considered in the harmonisation efforts mentioned at the beginning of this article. Nor do they suggest applying different criteria for certain technological fields. Complexity comes about when analysing the Mexican Industrial Property Law (IPL) and its practical application.

Article 47 section I states that a patent application should be accompanied by a description of the invention which should be clear and complete enough to allow suitable comprehension of it and to guide a skilled person to put the invention into practice. Likewise, this section requires the description to include the best mode known by the applicant to carry out the invention when it is is not clearly implied from the description, and any information exemplifying the industrial application of the invention. This Article contains the obligation to submit a complete description, which should comply with at least the following requirements: clarity, enablement, best mode, and utility. Apart from its confusing language, this article might be inter-

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preted by the MIIP (Mexican Institute of Industrial Property), as has been the case for certain technological fields, to contain a high patent utility standard. The practical implications depend on what is deemed to mean "exemplifying information" and "industrial application".

Article 12(IV) of the Industrial Property Law (IPL) defines "industrial application" as "the possibility that an invention has practical utility or can be produced or used in any branch of economical activity, for the purposes described in the application". This generally means that "industrial application" is not so different from the commonly known industrial applicability requirement or the specific utility requirement, for which it is enough that the description discloses sufficient information about the invention so that its application is immediately apparent to those familiar with the technological field, with the additional formality that the description must indicate the purposes to which the invention is aimed (which in practice does not usually impose any hurdles). In fact, the definition of "invention" provided by Article 15 is consistent with this requirement, as it defines that an invention is any human creation allowing the transformation of matter or energy existing in nature, for human profit and for satisfaction of human concrete necessities. Moreover, Article 16 requires that for an invention to be patentable it must be novel, the result of an inventive step and susceptible to industrial application (clearly meaning industrial applicability, as industrial application is already a mere possibility by definition).

An initial, positive, interpretation of Article 47(I) would be the need to include information exemplifying the possibility that the invention has industrial application. Since "exemplifying information" is a very broad term and is not limited by the IPL, any information related to the possible application of the invention (whether actually tested or not) would be enough to fulfil this requirement (for example, in certain cases, the mere description of specific embodiments of the invention, or the same information that complies with the enablement requirement). The interpretation would become still more positive for applicants if the exemplifying information relates to the original description and claims, and not to the claims as amended during examination.

Mexico has signed various international agreements containing implications for patent utility

On the other hand, it should be taken into account that the exemplifying information requirement was introduced in a law amendment passed in 2010, from a bill with the intention of raising the Mexican utility standard to demonstrate actual industrial application of the invention in the description. The original proposal would have introduced a utility standard higher than the Canadian one, if approved.

In this context, a second interpretation would indicate a requirement for the text of the description to include information about the actual industrial application of the invention. The utility standard would become still higher if the invention is considered to be the subject matter in the claims, not only at the filing date, but as amended during examination. This second interpretation, although not always addressed as such in office actions, has actually been used for

certain cases by the pharmaceutical, biotechnological and chemical departments of the MIIP, and more specifically for human health related patent applications. As generally the specification cannot be amended to include the exemplifying information, the MIIP requires limiting the scope of the claimed invention to only exemplified embodiments. In a less strict position, the MIIP has allowed the submission of post-filing experimental data to provide the exemplifying information, especially when said data is also considered useful for demonstrating inventive step.

It is common to equate the requirement for industrial applicability with the requirement of patent utility

It is regrettable that when passing the law amendment it was not taken into account that under Article 38 Bis of the IPL, compliance with Article 47(I) is necessary for the recognition of the patent filing date in Mexico. Fortunately, the MIIP has never connected patent utility requirements with the recognition of filing date. A review of this artificial legal connection should be carried out in order to clarify the issue, not only during prosecution, but in litigation, as failure to comply with Article 47 is a specific cause of patent invalidation under Article 78 of the IPL.

Clarification needed

It is common to equate the requirement for industrial applicability with the requirement of patent utility, and certainly, there might be jurisdictions where both requirements have the same or similar implications. In Mexico, at least from a legal point of view, this does not happen. We may theorise that the IPL contains two requirements: industrial application (as defined in Article 12 section IV) and patent utility (as mentioned and interpreted under Article 47 section I).

International patent applicants should be aware that despite harmonisation efforts, there are jurisdictions that develop their own standards. These are to be construed not only on the basis of law drafting but also on their practical applications some of which can undermine harmonisation efforts, which is not really advisable for a country with more than 90% of patent filings coming from abroad (specifically, from jurisdictions committed with patent practice harmonisation). A review of the Mexican utility standard and its implications seems necessary in order to at least clarify not only the country's position on the matter but the day-to-day practice, since it is clear that leaving open interpretation of law statements to the MIIP might lead to confusing and diverging criteria. This could lead to singling out inventions in certain fields, which might even go against signed international agreements containing non-discrimination statements.