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Mexico: How The PCT Has Influenced The Mexican Patent System

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The enforcement of the Patent Cooperation Treaty (PCT) in Mexico will celebrate 14 years next year.

As of June 1995, when filing of patent applications under the PCT officially took off, the PCT system has proven to be an efficient and useful tool for the filing of patent and utility model applications in Mexico. In fact, the number of patent applications in Mexico has been steadily rising year after year, and an important percentage of these applications have been filed under the PCT system.

The LPI does not mention any specific provision for filing national phase applications in Mexico. Considering that there is no link between many of the provisions of the LPI and the PCT, and since the PCT, as an International Treaty, is above the LPI, many of the provisions for filing the formal requirements of national phase applications are taken directly from the PCT. These PCT provisions have become a normal practice for filing the formal requirements of a national phase application in Mexico, which the Authorities from the Mexican Institute of Industrial Property (IMPI in Spanish) accept. It is important to remark that to date, these legal loopholes have caused no serious problems regarding the validity of a national-phase patent application under a practice, instead of a duly regulated provision.

Despite all of the above, the implementation of the PCT system has simplified the filing formalities of national-phase patent applications, significantly reducing their formal examination period. Currently, a duly filed national-phase patent application will be published within the following 6 months of its filing date.

For those national-phase patent applications filed with one or more formalities missing, the official letter that requires such missing documents or information is issued by the IMPI, in average, within the two following months of the filing date of the application. Consequently, most of these national-phase patent applications will be published within the following six to eight months of their filing date.

Contrary, to the formal examination, no significant time reduction is appreciated in the substantive examination stage. Pursuant to article 53 of the LPI, the substantive examination should be carried out once a patent application has been published. However, it is currently apparent that applications of recent filing are being examined prior to applications which were filed more than 6 years ago. In the opinion of the author, this has led to increase to increase the Institute's historical backlog even more.

It is important to comment that a proper International Search Report and, where applicable, the *International Preliminary Report* on Patentability conducted by International Search Authorities, do not guarantee that the substantive examination in Mexico – although mainly based on the results of the above reports – will turn out favorably.

As mentioned above, even though such International Search Reports and *International Preliminary Report* on Patentability lay the foundations for the substantive examination of national-phase patent applications, the Mexican examiners frequently question their results although the international patentability criteria are applicable to all members of the PCT.

Thus, for the national-phase patent applicant it is hard to understand why documents quoted as irrelevant by an

International Search Authority are requested during the national phase prosecution in Mexico, as such request brings about additional expenses because, according to Article 179 of the IPL these documents must be filed with their translation into Spanish. To comply with requirements such as the one above results in the unnecessary issue of more than one official action letter for a case in particular, significantly delaying the substantive examination..

There are features in the LPI which are similar to the international patentability criteria applied by the International Search Authorities. However, as mentioned hereinabove, the favorable outcome of the *International Preliminary Report* on Patentability does not mean that the result in Mexico will turn out the same. In some particular cases, depending on the nature of the invention, the criteria used by our authorities tend to differ substantially from other regions' criteria, thereby causing the issuance of several official action letters until the applicable patentability criteria of Mexico are met.

It is difficult to explain why the IMPI, on the one hand, implements mechanisms to simplify and expedite the formal examination of national-phase patent applications and, on the other, does not put into practice the necessary mechanisms to facilitate the substantive examination thereof. It is important to point out that streamlining the substantive examination stage does not mean the Mexican authorities will override the LPI provisions. They are directly responsible for their enforcement and for overseeing compliance thereof by the users of the Mexican patent system.

However, harmonisation of the LPI provisions with those contained in the PCT would result in a significant improvement of the services offered by the IMPI and, therefore, in the guarantee of a proper protection of industrial property rights in Mexico.

Although the scenario above is contradictory in certain aspects, we must recognize that the lack of clear rules for national-phase patent applications in the LPI has not resulted in the loss of industrial property rights for any of the holders thereof. There is no doubt, however, that a patent system with clear rules duly supported by their accompanying law offers real certainty to patent owners.

We are confident that, in the near term, the IMPI authorities will fill this void currently existing, so that Mexico can move forward and join the group of nations regarded as having a high degree of industrial property culture.

The content of this article is intended to provide a general guide to the subject matter. Specialist advice should be sought about your specific circumstances.

Specific Questions relating to this article should be addressed directly to the author.



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