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Mexico: Voluntary Amendments In Mexico

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Article by Nallely Castillo

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In recent years, many questions have arisen concerning Voluntary Amendments.

To commence, we could say that a Voluntary Amendment is an action where a modification is made to either the form or the substance of the description, claims or, summary of an invention, which is then voluntarily submitted to the Mexican Institute of Industrial Property (IMPI). .

Being a Voluntary Amendment, it is important to stress that these changes to the text of the specification are not required by the authority in the form of an Official Action. They emanate directly from the applicant's decision.

Filing a Voluntary Amendment

There may be many reasons to submit a Voluntary Amendment to the IMPI, some of which are analyzed below:

- **Errors when drafting the Claims**

When the claims of a patent application are being drafted, sometimes essential characteristics of the matter to be protected, which is disclosed in the description, are omitted. Thus, its protection is incomplete. These errors are very common and constitute a key factor when drafting the text in order to fully protect the matter described in a patent application. .

- **Unclear Description and Claims**

In this regard, article 47, section I of the Industrial Property Law indicates that the description of the invention must be sufficiently clear and complete to allow full understanding of the same and to guide a person who possesses medium expertise and knowledge in the subject to execute the invention.

Additionally, section III indicates that the claims must be clear, concise, and that they cannot exceed the content or scope of the description.

In some occasions, the information in the description is so extensive and poorly drafted from the technical point of view, that it is possible to lose sight of the matter intended to be protected. Consequently, the claims will probably also be poorly drafted, and will not comply with the provisions of the law failing to fully protect the matter disclosed in the description. Additionally, when the claims include matter that is not disclosed in the description, they are exceeding its content and they are not complying with Article 47 of the Law. They are protecting additional matter. In order to comply with the provisions of said Article 47, it is advisable to develop the description and claims at the same time.

- **To adapt the Mexican Patent Application to Patents granted in other offices**

In some cases, patent offices in other countries grant patents of equivalent applications before the Mexican

Patent Office does. The applicants would probably wish to adapt the Mexican patent application to the patent or patents granted in said foreign offices in order to expedite the process in our country. In this case, it is of utmost importance to firstly verify that the subject matter of the Patent granted in the other country is equivalent to the Mexican Application. Otherwise, when filing the corresponding Voluntary Amendment, you could be limiting, that is, reducing the scope of the Mexican Application and obtain an undesired protection of the matter in our country..

Things to remember when filing a Voluntary Amendment

The above could be some of the reasons to file a Voluntary Amendment in Mexico. Now then, when filing a Voluntary Amendment, we must remember, in accordance with Article 55 bis of the Mexican Law, to verify that the amended text to be submitted must not contain additional material or claims that give the application a greater scope to that contained in the original application considered as a whole.

In this regard, it is advisable to determine what the Law means by "**the original application considered as a whole**". From my personal point of view, this jointly refers to the description, claims, summary and drawings because article 47 of the law together with article 28 of the Regulations, establish that these are the elements that must accompany the application.

The second paragraph of article 55 bis of the law establishes the maximum time in which a Voluntary Amendment may be submitted:

"Voluntary amendments will be accepted only prior to the issue of the resolution regarding the denial or the grant of a patent".

However, article 61 of the Law indicates that "**Changes in the text or drawings of the Letters Patent** are only permitted in the following cases:

I To correct evident or format errors

II To limit the extent of the claims.

The authorized changes shall be published in the Mexican Patent Office Gazette".

In relation with Article 61, article 48 of the Regulations of the Industrial Property Law stipulates: "*In order to authorize **the changes in the Letters patent** referred to in article 61 of the Law, the Institute may require the applicant to file, within a period of two months, the corresponding modifications to the description, claims, drawings or summary. If the applicant does not comply with these requirements within the period indicated, the action in question shall be taken as abandoned*".

From the above, it could be said that regarding the prosecution of a patent application, the best time to submit a Voluntary Amendment would be before the Substantive Examination, since, at this point, the description, claims and summary would be already amended by the applicant. This would be in total accordance with article 42 of the Regulations, which reads: "*When the Institute carries out the substantive examination of the application, it will only consider what it is contained in the description, claims and, if applicable, the drawings*".

When a patent is granted, it is still possible to amend errors in the text, but this must be limited to the form. In case the claims need to be amended, it will only be possible to reduce its scope.

In conclusion, a Voluntary Amendment could be a valuable tool to correct errors in the text of a patent application, to seek protection of subject matter that was originally mentioned in the description but not in the claims, and even in some cases, to facilitate the process of the substantive examination. Nevertheless, it is advisable that you seek advice from your patent attorney, since he will have the expertise to design a strategy in order to file it.

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.