

PUT QUALITY BEFORE COST

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The difficult economic climate has forced all sectors to minimise costs. And that is also true in terms of intellectual property, particularly in the context of new foreign patent applications being filed in Mexico.

Due to the potential problems of prosecuting an application to register intellectual property, no one with a strategic vision would normally opt for cost over quality. Such a decision could mean hefty expenses in the long term. Although it is true that expensive things are not always the best, it is also true in law that the least expensive things can turn out to be the costliest.

To start with some basics: applicants can avoid unnecessary expense for late filing of documentation by filing, from the beginning, applications that comply with the Mexican formal requirements. It is also worth checking whether the applicant is entitled to claim small entity status under Mexican regulations, which gives applicants 50 percent off the official fees.

Regarding the prosecution of Patent Cooperation Treaty (PCT) applications, it is crucial to check the necessary information before filing an application. For instance, the official fees for a Chapter I or II application differ. If applications need correcting, the corresponding official fee is increased. The more detailed an order letter, the fewer expenses will be incurred in future.

Formal drawings are an essential filing requirement. Mexican law and practice demand high-quality drawings—a poor-quality drawing can jeopardise the rights sought to be protected.

Drawings must be black and white, in lasting, well-defined and sufficiently inked lines, and involve traits that can be reproduced directly by photograph, electrostatic procedures, offset and microfilm as many times as necessary.

If a photograph or drawing does not have legible letters, lines and/or numbers, if its quality is so poor that references are not clear, or if the drawing does not fulfil its illustrative objective as detailed or intended in the specification, it may be rejected. Also, if colour photographs are submitted, drawings may be rejected. Additionally, the formal drawings must not include new matter (i.e. matter that was not included in the provisional drawings), but this is determined by individual examiners and is highly subjective.

Mexican IP law allows applications to be filed with provisional drawings. Formal drawings must be submitted within two months of the filing date. If they are not submitted within this deadline, the application may be

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abandoned; however, Mexican practice is relatively lenient in this respect. Where formal drawings are not submitted, the examiner will normally issue an official letter requesting them.

The Mexican Institute of IP, according to the law, will recognise the date of submission of the formal drawings as the new filing date of the application and therefore the applicant loses its priority rights. Although Mexican practice is somewhat flexible in this regard and the initial filing date will be kept in certain cases, we recommend fulfilling what is required by law whenever possible.

Last, but not least, are translation issues. These can be the 'Achilles heel' of many applications due to the high costs and risks involved when an application is based on a poor translation. It usually takes considerable effort and additional expense to prove translation errors. Despite translation of applications being a requirement that must be fulfilled during the formalities stage, the translation may still be rejected and requested again by official letter during substantive examination if the examiner determines that it is not adequate for a full understanding of the invention.

It should also be noted that any information missing in the provisional drawings may be rejected and considered to be new matter if added after filing, even if a voluntary amendment to correct such errors is submitted.

Finally, the advice of an IP agent is always recommended since this gives certainty to the prosecution strategy of a patent application. Formality requirements are different in every Latin American country. Therefore, contacting your patent agent is highly recommended in order to avoid unnecessary expense and time.

Following these easy measures today, despite the additional cost, could mean a substantial saving tomorrow.

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