

THE END OF PIPELINE PATENTS IN MEXICO

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Almost 19 years ago, a new concept for providing a so-called 'pipeline protection' was incorporated in the new Law of Industrial Property, in force as of June 28, 1991. It stated that all applications covering inventions that were not patentable under the prior law and that had been filed in a member country of the Patent Cooperation Treaty (PCT) prior to the date of enactment of the new law could be subject to the filing of a valid patent application in Mexico, with recognition of convention priority on the first application filed in any one of said countries and regardless of prior disclosure, provided that the following conditions, disclosed in Article 12 transitional, were met:

- The corresponding Mexican patent application was filed within 12 months of the enactment of the law; the application should be filed by the first applicant of the corresponding foreign application or by the assignee thereof
- The applicant could prove to have filed the application in any of the member countries of the PCT or could prove to have obtained the corresponding patent, and
- The exploitation of the invention, or the import on a commercial scale of the patented product or of the product obtained by the patented process, had not been initiated by any person in Mexico prior to the filing of the application in Mexico.

The timescale for filing these kinds of patent applications in Mexico was from June 29, 1991 to June 30, 1992.

On the other hand, the last paragraph of the relevant transitional article read:

"The term of the patents granted under this Article shall cease on the same date in which it ceases at the country where the first application was filed, and in no case said term shall exceed 20 years counted as of the date of filing of the patent application in Mexico."

According to the above, for some patents granted under this provision, it was possible to adapt in Mexico the life term that they were initially granted, with the proviso that an official letter was filed in Mexico, certifying that the life term of the original patent had been extended according to the reasons allowed in the country of origin. These were known then as 'pipeline' patents.

However, this criterion was conflicting and despite the fact that it was possible to extend the term of several pipeline patents filed within the above mentioned timescale in recent years, the Mexican authorities have completely refused to grant any more extensions, because there have been many third-party conflicts. Eventually, no more adaptations to the new life term were granted at all.

After all these problems, in two years' time, we will be at the end of any

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possible life term granted for pipeline patents which "in no case...shall exceed 20 years counted as of the date of filing of the patent application in Mexico, which term will end on June 30, 2012".

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