Expert Contributor
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Patentability in Mexico: Opportunity and Improvement

When talking about patentability, it first must be considered, that all that can be patentable (with the ability to be patented) according to Mexican Law comes from a human invention, in which the invention can be conceptualized as a novel solution to an existing problem or also as "any human creation that allows the transformation of matter or energy that exists in nature, for its usage by man to satisfy his specific needs," according to Article 46 of the Federal Law for the Protection of Industrial Property (LFPPI), issued in the Official Gazette of the Federation (DOF) on July 1, 2020.

To facilitate the understanding of an invention, Article 47 of the same law mentions eight prongs that are the exceptions to the concept of invention, as follows:

1. Discoveries, scientific theories, or their principles.
2. Mathematical methods.
3. Literary, artistic or any other aesthetic creation.
4. Schemes, plans, rules, and methods for the exercise of intellectual activities, for games or for economic-commercial activities or for conducting business.
5. Computer programs.
6. Forms of presenting information.
7. Biological and genetic material, as found in nature.
8. The juxtaposition of known inventions or combination of known products, except in the case of their combination or fusion that cannot function separately or that the qualities or

characteristic functions of the same are modified to obtain an industrial result or a not obvious use for a technician in the matter.

Based on the above, the LFPPI states that inventions could be patentable. Thus, the ability of an invention to be patented or, better put, the patentability of an invention, will depend on the fulfillment of certain characteristics to obtain said patent. These characteristics are broken down in Articles 48 and 49, as shown below:

Among the characteristics that allow an invention to be patentable are the following:

1. From any field of technology that demonstrates that it is new; in other words, that has not been made public.

2. That is the result of an inventive activity, that is to say, of a mental operation, intellectual effort or labor.

3. That is susceptible to industrial application, feasible to be put into practice.

In addition, the law allows patenting in a particular way to:

1. Inventions whose subject matter is a microbiological procedure or any other technical procedure or a product obtained by such procedures.

2. Biological material isolated from its natural environment and obtained through a technical procedure.

3. A total or partial sequence of a nucleic acid or protein with the objective of industrial application.

While the characteristics to exclude an invention from being patentable are the following:

1. Procedures for cloning human beings and their products.

2. Modification procedures of the germinal genetic identity of the human being and its products when these imply the possibility of developing a human being.

3. The use of human embryos for industrial or commercial purposes.

4. Modification procedures of the genetic identity of animals, which involve suffering for them without substantial medical or veterinary utility for man or animal, and the resulting animals from said procedures.

5. Plant varieties and animal breeds, except for microorganisms.

6. Essentially biological procedures to obtain plants or animals and the products resulting from these procedures.

7. Diagnosis, surgical or therapeutic methods of the human or animal body.

8. The human body in the different stages of its constitution and development, as well as the simple discovery of one of its elements, including the total or partial sequence of a gene.

Therefore, as mentioned above, in the patentability of an invention it is not only necessary to consider that it is novel, coming from an inventive activity and with industrial application, but also that it does not fall under any of the aforementioned prohibitions, established by the LFPPI and inspired by the European Patent Convention of the European Patent Office (EPO).

On the other hand, there is the patentability of inventions together with the process to obtain a patent. During this process, the Mexican Institute of Industrial Property (IMPI) carries out two reviews involving the patentability of the invention in the corresponding patent application.

Once the patent application is filed with the IMPI, the first patentability review filter occurs upon the publication of the patent application. Currently, there is no formal patent opposition system; however, based on Article 109 of the same law, third parties are allowed to submit information about the patentability of an invention during a period of two months after the date of publication of the corresponding patent application.

The second patentability review filter is performed during the substantive examination of the invention in accordance with Article 110 of the law, in which the IMPI determines that the patentability requirements are met so that if the result of the substantive examination is satisfactory, the patent may be granted. The IMPI may issue up to four requirement letters in which the applicant must respond within a maximum period of two months, each one counting from the date of notification.

If there is no response to the letter, the application is considered abandoned. At IMPI's discretion, if the patentability of the invention is not demonstrated after the fourth letter, the granting of the patent will be denied.

To facilitate this process, IMPI uses as support the results of the substantive examination for the same application issued by the main patent offices, such as the EPO, the United States Patent and Trademark Office (USPTO), and the Japan Patent Office (JPO).

Finally, the patentability of inventions in Mexico continues to be strengthened and updated through what the main national patent offices in the world establish, with the purpose of strengthening, aligning and streamlining patent procedures.

Our proposal is an examiner's manual or a similar guide that provides legal certainty to patent applicants with respect to certain general technical issues and at the same time provides examiners with guidelines that keep them from arbitrariness and discretion. The manual can be reviewed and updated periodically or when required, derived from legislative changes, international treaty obligations or judicial precedents.

To conclude, the patent prosecution system in Mexico is healthy, but there are areas of opportunity and improvement. For greater accuracy, an examiner's manual would be useful to provide guidance on topics that may be subject to interpretation or that have a lack of clarity and for the reviewers to unify the review criteria so applicants can have certainty around technical issues.