Obvious Improvements: How to protect them in Mexico?

In the course of business activities, many inventors and applicants face the need of disclosing information to third parties before completing the invention in order to raise capital for the development of the related technology. In most cases such task is not only helpful, but necessary to stimulate innovation.

Due to the inherent risks of disclosing information regarding inventions to third parties, it is a standard position held by most experts to file patent applications covering the main features of their inventions before entering in any kind of negotiations. These filings are especially relevant to establish an order of precedence for the examination and entitlement to the invention.

This issue is addressed in other jurisdictions such as in the United States, where it is possible to file provisional applications to establish a perceived ownership over the invention or else, to file a continuation-in-part application, allowing the applicant to add matter not disclosed in an earlier non-provisional application.

In turn, in many countries where the filing of provisional applications is not a possibility, this may result in rush filings in which the patent application covers the main features of the invention, but not all the possible and desired embodiments. Even more, the characteristics of the final invention may not match the disclosure made in the patent specification and thus the eventual patent will not cover the product of real interest.

Another point worth mentioning is that most of the patent legislations do not allow the inclusion of additional embodiments into the specification after the filing date. This means that if all the embodiments of the invention were not specified in the first filing, they cannot be added later on and thus, the applicant can no longer seek protection.

Therefore, applicants and inventors face the problem of deciding between anticipating the filing of the patent application to accelerate the monetization of the invention or filing the patent application on a later stage of the development of the invention in order to cover all the possible features and embodiments of the final invention.

Mexican domestic law does not allow the filing of provisional applications - which has proven to be a powerful tool in other jurisdictions- and does not include express provisions allowing the applicant to file continuation-in-part applications during the lifetime of a patent application. The range of possibilities for applicants in Mexico is limited to the filing of divisional applications, but in these cases, the embodiments of the divisional application must have been originally disclosed by the parent application and supported in the specification.

As a matter of principle, in order to obtain protection through patents in Mexico, all inventions must comply with the patentability requirements of novelty, inventive step and industrial application. Therefore, a second filing for the same invention with additional embodiments usually results in objections based on lack of inventive step.

However, an interpretation of the provisions of the Mexican domestic Law may result in the possibility of subsequent independent filings to cover the same invention plus additional embodiments that do not necessarily comply with the inventive step requirement versus the previously filed application.

The Mexican Law defines prior art as the body of technical knowledge that has been made public by an oral or written description, by use or by any other means of dissemination or information, within the country or abroad.

Furthermore, the domestic Law provides that in order to determine whether an invention is new, the prior art shall include all pending patent applications filed in Mexico prior to the filing or priority date, even if the publication of such prior applications occurs at a later date. The main purpose of this provision is to avoid double patenting and thus, it is reasonable that it only includes the concept of novelty but not the concept of inventive step.

In this regard, an earlier filed but later published applications will be considered as “conflicting applications”. It is worth noting that if such an application is filed but then dismissed, withdrawn or abandoned before it´s publication, it will not be considered as prior art for a later application.

The whole content of a conflicting application will be considered as prior art for the purpose of assessing novelty of the later filed application, but not for purposes of the examination of the inventive step.

The provisions of the Mexican Law correctly limit the evaluation of non-published earlier filings for purposes of the novelty requirement by tacitly excluding the inventive step evaluation, as it would be impossible for the second applicant to have knowledge of said “secret prior art” when filing the application.

Therefore, a non-published earlier filing will be considered as prior art for purposes of assessing the novelty, but not for the examination of inventive step; such treatment of conflicting applications in Mexico is congruent with most of the jurisdictions operating under first to file principles.

The wording and strict interpretation of the provisions of the Law allows the same applicant to file a first patent application covering the main features and embodiments of the invention and later on -but before its publication- to file a second independent application covering additional embodiments or improvements that were not originally devised and thus, were not included in the earlier filing.

The new application would not be objected due to lack of novelty, as it will include additional embodiments that were not disclosed by the earlier filing. Furthermore, the Examiner would be prevented from citing the earlier filing to object the inventive step of the application, due to the fact that non-published earlier filings or conflicting applications are not considered as prior art for purposes of assessing of such patentability requirement.

Considering that the publication of patent applications in Mexico takes place after the expiration of a period of 18 months as of the filing or priority date, the possibility of a second filing allows the applicant to continue developing the invention and within such term, to protect additional embodiments without the problem of facing the earlier filing as prior art for purposes of the inventive step examination.

Even though this strategy would involve maintaining two applications and thus, increasing the cost for patent protection, it is an option available to protect embodiments that were not originally included in the earlier-filed application.

There are some issues to take in consideration for applications filed in Mexico claiming priority under the Paris Convention and national phase applications filed under the Patent Cooperation Treaty (PCT).

This strategy would not be available for applications wherein the first patent application is a PCT national phase and at the time of filing the second independent application, the related PCT application was already published. As to direct application claiming foreign priorities under the Paris Convention, the second application could only be filed before the publication of the priority application. Otherwise, the priority application and the PCT application will be considered as prior art for the second independent filing.

Another option to bear in mind is that in Mexico it is possible to protect product improvements through utility models, which only require novelty and industrial application in order to be eligible for registration.

However the Mexican Law defines utility models as *"objects, utensils, apparatuses or tools that, as a result of a change in its arrangement, shape, structure or form, show a different function with respect to its component parts or advantages in terms of its usefulness".* Therefore, in order to assess the possibility of protecting innovation improvements as utility models in Mexico, it is important to determine if such definition is complied with. For instance, under said definition, processes, pharmaceutical and chemical formulations cannot be protected as utility models. Indeed, due to the definition provided by the MX Law, utility models are commonly used for innovations related to the mechanical area.

Furthermore, the downside of this option will be that the protection term for utility models in Mexico is only of ten years instead of the twenty years of a patent. Therefore, the protection term of the additional embodiments would be shorter than the protection term granted through the first patent.

The interpretation of the domestic Law regarding second filings by the same applicant to cover obvious additional embodiments has not been addressed through case law in our country, which difficult its use for second filings for the protection of additional embodiments.

However, we consider that there are legal basis to allow these kind of filings, without jeopardizing the patentability of additional embodiments due to lack of inventive step forefront a non-published earlier filing from the same applicant. In any case, we consider that the strict and literal interpretation of the law should prevail and thus, the conflicting application should not be considered as prior art for assessing inventive step, but only for the purpose of assessing novelty.

In any case, an amendment to the Mexican Law is desirable in order determine the treatment of conflicting applications filed by the same applicant and to provide applicants with a wider spectrum of possibility for the protection of industrial property assets, as the current law does not seem to catch up with the evolution of commerce and technology.

Title. **Obvious Improvements: How to protect them in Mexico?**

Daniel, Jorge and Manuel analyze the alternatives to protect additional embodiments that were not included in a first patent application in Mexico, as well as the inventive step requirement of such embodiments versus "conflicting applications".

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