

Patents Quality at IMPI

June 2019



PATENTS QUALITY

The national regulations do not provide a definition of the term “**quality of patents**”, however it is conceived as a means to achieve the public policy objectives underlying the granting of patents.

The Mexican Institute of Industrial Property (IMPI) understands that it is fully-comprehensive term, referring to the set of elements required for the patents that are granted to contribute to promote:

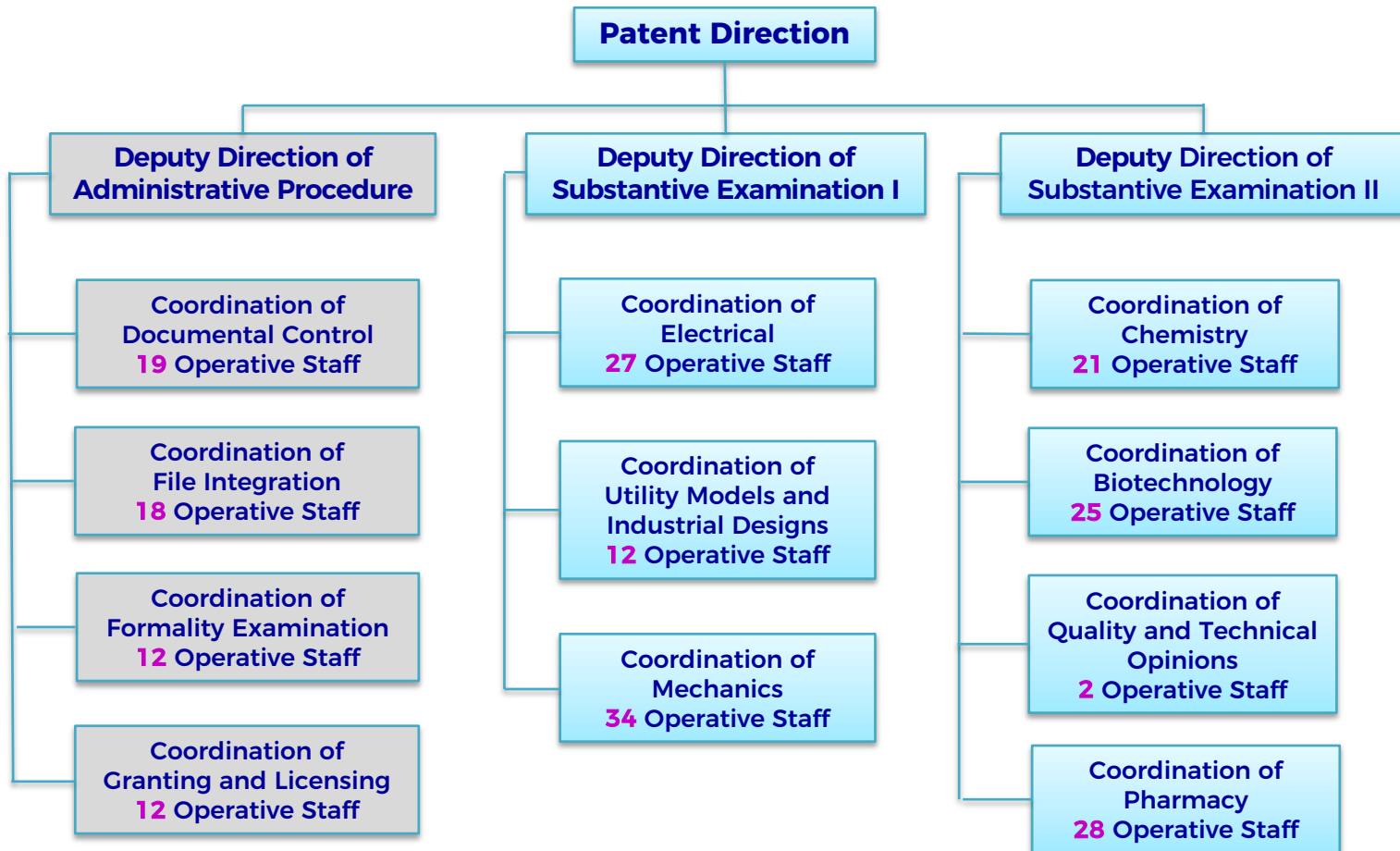
- ❑ Innovation
- ❑ Dissemination and transfer of new technologies
- ❑ Development economic
- ❑ Competitiveness and productivity in the various sectors of the industry

PATENTS QUALITY

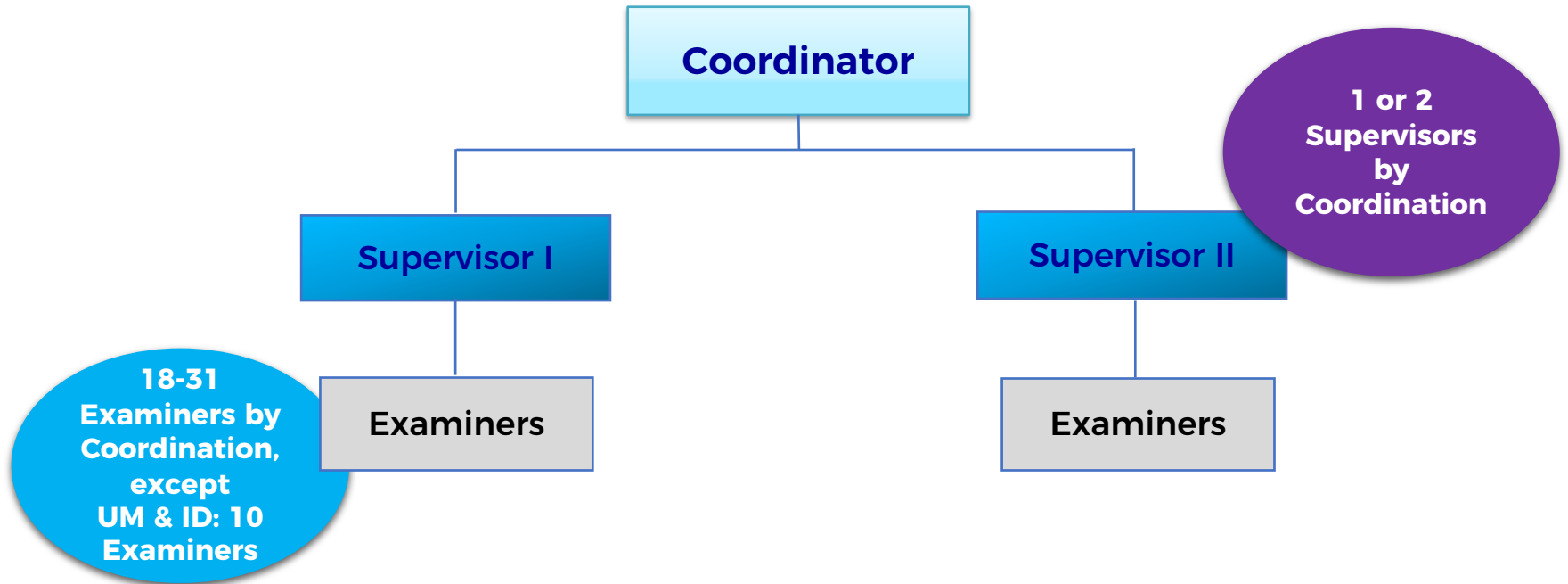
Where these elements include:

- ❑ The normative aspect (A clear legal framework focused on public policies)
- ❑ The human aspect (Trained and function-oriented human resources)
- ❑ The material aspect (Adequate and sufficient material resources)

PD ORGANIZATIONAL CHART



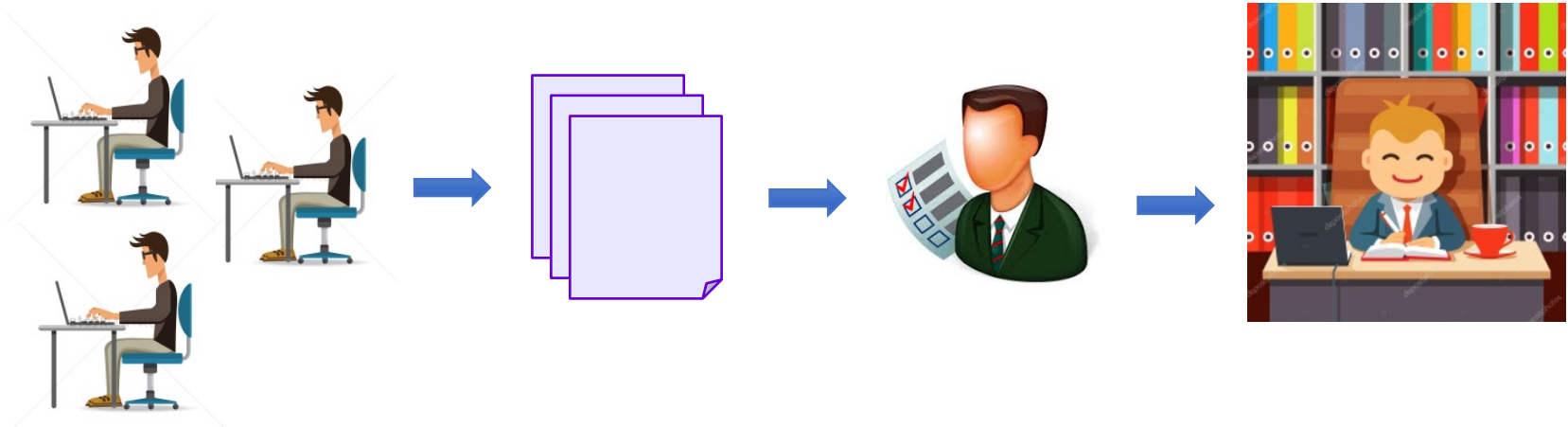
SUBSTANTIVE EXAMINATION COORDINATIONS



Academic degree of Examiners and Supervisors:

Bachelors	89
Masters	29
Doctorate	13
Total	131

WORKFLOW OF EXAMINATIONS



Examiners

(122*)

**Office Actions
(OA)**

(37,772)**

Supervisor

(9)

Coordinator

(6)

* 8 of them are temporary examiners.

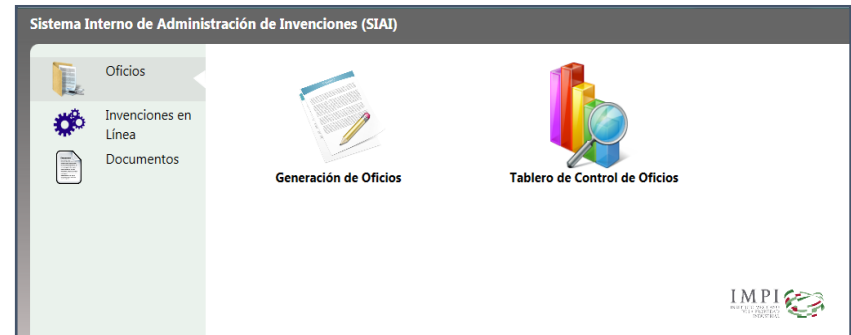
** OA issued from substantive examination coordinations in 2018.

INTERNAL ELECTRONIC MANAGEMENT SYSTEMS



SAGPAT

Automated Patent Management System



SIAI

Internal Patent Administration System



SAGPAT

Automated patent management system

It contains all the information about each application filed at IMPI. In this system, any action in the file is recorded.

□ Coordinators:

- Assign patent applications to examiners
- Check all the history for any file, any examiner
- Check each OA of the history of the file
- See the complete electronic files (PDF)

□ Examiners:

- Perform searches by technical field or general data
- Generate official actions



SIAI

Internal patent administration system

It allows the management of all OA, all observations that are made on it are recorded and auditable.

□ Examiners:

- Elaborate the office actions
- Correct office actions

□ Supervisors:

- Check all office actions: OK or ask the examiner to correct the office action

□ Coordinators:

- Check all office actions: OK or ask the examiner to correct the office action
- Sign the office actions

SIAI

Internal patent administration system

Examiner

Application number

Supervisor

Version: 1.0.0.0 EFORESL-EDGAR FLORES LARRACILLA

Oficios

Visualizar Bandeja Actualizar Visualizar Oficio Transferecia Colaboración Legal Reasignación Acciones Firmar A Corrección Armar Guardar Refrescar Edición del Oficio Editar Herramientas de soporte Reporte de Búsqueda Anexos Manual de Usuario Ayuda

Crear Modificar Revisar Firmar Estatus del Oficio

Destinatario

Reporte de Búsqueda

Descripción Ubicación

JP 2008-160941 A con fr https://worldwide.espac ...

Anexos

Orden Nombre

Movimientos

Descripción

1 Oficio Generado

CESAR PALMA

Enviar

Destinatarios

CESAR PALMA GONZAGA

Comentario :

1. Es necesario contestar todos y cada uno de los argumentos presentados por el solicitante.

2. Es necesario verificar la fecha de publicación del documento D1.

Aceptar Cancelar

TIPO OFICIO : "4to" Requisito de fondo LPI PCT

MX/a/2014/011941 - MX/2018/046230

IMPI

DIRECCION DIVISIONAL DE PATENTES

SUBDIRECCION DIVISIONAL DE EXAMEN DE FONDO DE PATENTES AREAS MECANICA, ELECTRICA Y DE REGISTROS DE DISEÑOS INDUSTRIALES Y MODELOS DE UTILIDAD

COORDINACION DEPARTAMENTAL DE EXAMEN DE FONDO AREA ELECTRICA

Expediente de Patente PCT fase nacional Capítulo I MX/a/2014/011941

Asunto: 4to Requisito de fondo LPI PCT.

Ciudad de México, a 6 de junio de 2018.

RIL ORTA No. Folio: **46230**

SYSTEME GMBH

DALGO, Distrito Federal, México

Examen de fondo, realizado con fundamento en los artículos 53 de la Ley de la Propiedad Industrial (LPI) y 42 del Reglamento de la Ley de la Propiedad Industrial (RLPI), se le comunica lo siguiente:

El examen fue realizado en base a los siguientes documentos de la solicitud:

Descripción: 1 a la 10, como originalmente fueron presentadas.

Reivindicaciones: 1 a la 7 como fueron presentadas en su escrito No. MX/E/2018/025769 del 16 de Abril de 2018, que da respuesta al oficio de requisitos No. 5698 del 26 de Enero de 2018.

Figuras: No. 1 a la 2 como originalmente fueron presentadas.

En respuesta a su escrito número MX/E/2018/025769 que da respuesta al oficio de requisito número de folio 5698 con fecha del 26 de Enero de 2018, por medio del cual se presentan argumentos técnicos y un nuevo capítulo reivindicatorio que tienen como finalidad superar las objeciones realizadas con respecto a la falta de claridad de las reivindicaciones y a la falta de actividad inventiva de la presente solicitud de patente. Se analizaron sus argumentos técnicos y el nuevo capítulo reivindicatorio y se tiene lo siguiente:

1. En cumplimiento a lo dispuesto por el artículo 17 de la Ley de la Propiedad Industrial el cual se establece que para determinar si una invención es nueva y resultado de una actividad inventiva se considerará el estado de la técnica en

Observations

OA

PERSONS RESPONSIBLE FOR MANAGING EXAMINATION QUALITY

Persons responsible for checking:

☐ Supervisors (Total 9)

- Years of experience as examiners: 10 to 23 years
- Supervisors also conduct examinations

☐ Coordinators (Total 6)

- Years of experience in IP: more than 15 years
- Most of them were examiners

Points to be checked:

- Validity of searches conducted by examiners (some)
- Validity of decisions made by examiners
- Whether OA prepared by examiners are clearly stated for applicants to easily understand the drafting notices

PERSONS RESPONSIBLE FOR MANAGING EXAMINATION QUALITY

Ways for checking:

☐ Supervisors: (Total 9)

- Most of the office actions

☐ Coordinators: (Total 6)

- Notices and decisions are selected by Coordinator
- In each of the Examination Coordinations higher priority can be given by Coordinators:
 - Examinations being conducted by recently recruited examiners
 - Applications whose claims are related to specific technical fields
 - Decisions to grant patent rights immediately without notifying reasons for refusal (without an intermediate office action in substantive examination).

☐ Deputy Directors: (Total 2)

- Specific cases, when the applicant asks a review of final action. (Patent application is denied or abandoned)

ACTIONS TENDING TO ENSURE THE QUALITY OF OUR PRODUCTS

- ❑ Recruitment of professionals with bachelor's, master's or doctoral degrees in different technical areas.

- ❑ Training Program:
 - Initial training course (5 weeks of duration)

 - The new examiner works with supervision by a personal tutor (a highly experienced examiner)

 - Finally, the trained examiner conducts the examination alone

ACTIONS TENDING TO ENSURE THE QUALITY OF OUR PRODUCTS

- Continuous training with face-to-face and online courses:
 - World Intellectual Property Organization (WIPO) Academy.
 - European Patent Academy, European Patent Office (EPO).
 - Center of Distance Education for Economic and Technological Development (CEDDET), Spain.
 - Japan Institute for Promoting Invention and Innovation (JIPII) and Human Resources and Industry Development Association (HIDA), Japan.
 - Global Intellectual Property Academy, United States Patent and Trademark Office (USPTO).

ACTIONS TENDING TO ENSURE THE QUALITY OF OUR PRODUCTS

□ Stays:

- Centre for International Intellectual Property Studies (CEIPI) of the University of Strasbourg, France.
- Spanish Patent and Trademark Office (OEPM) as part of Ibero-American Training in Searches and Technological Information (CIBIT) Program.
- Osaka University as part of activities of Japan International Cooperation Agency (JICA).

ACTIONS TENDING TO ENSURE THE QUALITY OF OUR PRODUCTS

- More than 90 percent of our applications constitute the national phase of Patent Cooperation Treaty (PCT) applications, so we make extensive use of International Search report (ISR), International Preliminary Examination Report (IPER) and International Preliminary Report on Patentability (IPRP).
- For national applications, the search of prior art is done using EPO Query Services (EPOQUE) and DERWENT INNOVATION (Clarivate Analytics), in addition to the public databases of patent offices.

ACTIONS TENDING TO ENSURE THE QUALITY OF OUR PRODUCTS

- For all applications the search is also done in the national database Comprehensive Information System of the Industrial Property Gazette (SIGA).
- Extensive use of databases: Public Patent Application Information Retrieval (PAIR, USPTO), EPO Register (EPO), Advanced Industrial Property Network (AIPN, JPO), PATENTSCOPE (WIPO), etc.



ACTIONS TENDING TO ENSURE THE QUALITY OF OUR PRODUCTS

- ❑ Substantive examination is mandatory for all applications: patents, utility models and industrial designs
- ❑ Procedure for filing observations to the patentability for third parties pre-granting as to whether the application complies with articles 16 and 19 of the Mexican Industrial Property Law
- ❑ The office actions are checked by Supervisors and Coordinators
- ❑ If the applicant does not agree with a final official action, he may request a review with the superior authority, in this case one of the Deputy Directors
- ❑ User satisfaction surveys

PATENTABILITY REQUIREMENTS



- ✓ Novelty
- ✓ Inventive Step
- ✓ Industrial Application
- ✓ Clarity
- ✓ Complete disclosure of the invention
- ✓ Unity of Invention

LEGAL FRAMEWORK

□ International legislation

Mexico is part of the different treaties and agreements on Industrial Property at the international level, for example:

- Paris Convention
- Patent Cooperation Treaty (PCT)
- Strasbourg Agreement Concerning the International Patent Classification
- Budapest Treaty
- Agreement on Trade Related Intellectual Property Rights (TRIPs)
- TRIPS-Plus provisions in Free Trade Agreements
- Etc.

LEGAL FRAMEWORK

□ National legislation

Ley de la Propiedad Industrial, LPI
(Industrial Property Law)

Mexican law of IP

Reglamento de la Ley de la Propiedad Industrial
(Regulation of LPI)

It contains the corresponding rules of the Industrial Property Law.

Manual de Procedimientos
(Manual of Procedures)

Describes step by step each one of different procedures during the prosecution of the applications in the PD.

Acuerdo que establece las reglas para la presentación de solicitudes ante el Instituto Mexicano de la Propiedad Industrial
(Agreement that establishes the rules for filing applications before IMPI)

A guide for the applicants about how they should draft the applications.

LEGAL FRAMEWORK

□ National legislation (continuation)

Acuerdo por el que se establecen reglas y criterios para la resolución de diversos trámites ante el IMPI.

(Agreement that establishes the rules and criteria for resolving several procedures before IMPI)

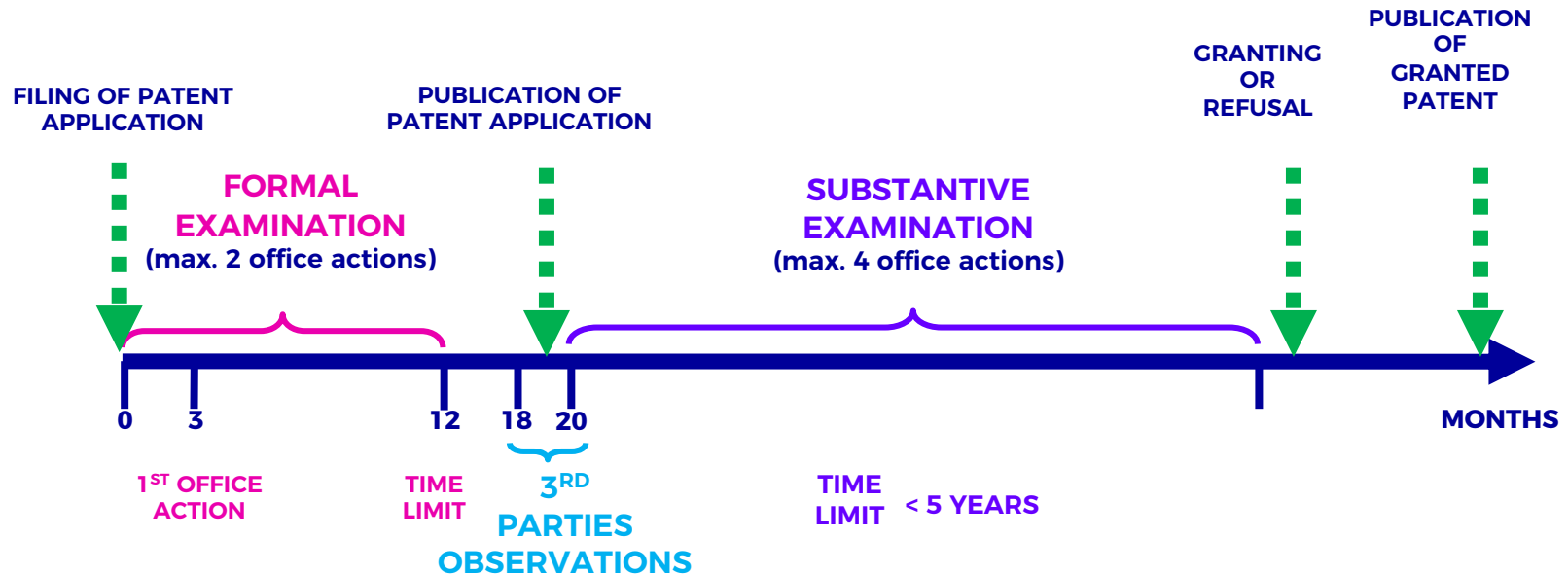
It establishes time limits for the different stages of the processing of applications.

Acuerdo por el que se establecen lineamientos en materia de servicios electrónicos del Instituto Mexicano de la Propiedad Industrial, en los trámites que se indican

(Agreement that establishes guidelines on electronic services of the Mexican Institute of Industrial Property, in the procedures indicated)

It establishes the rules for submitting applications and promotions by electronic means.

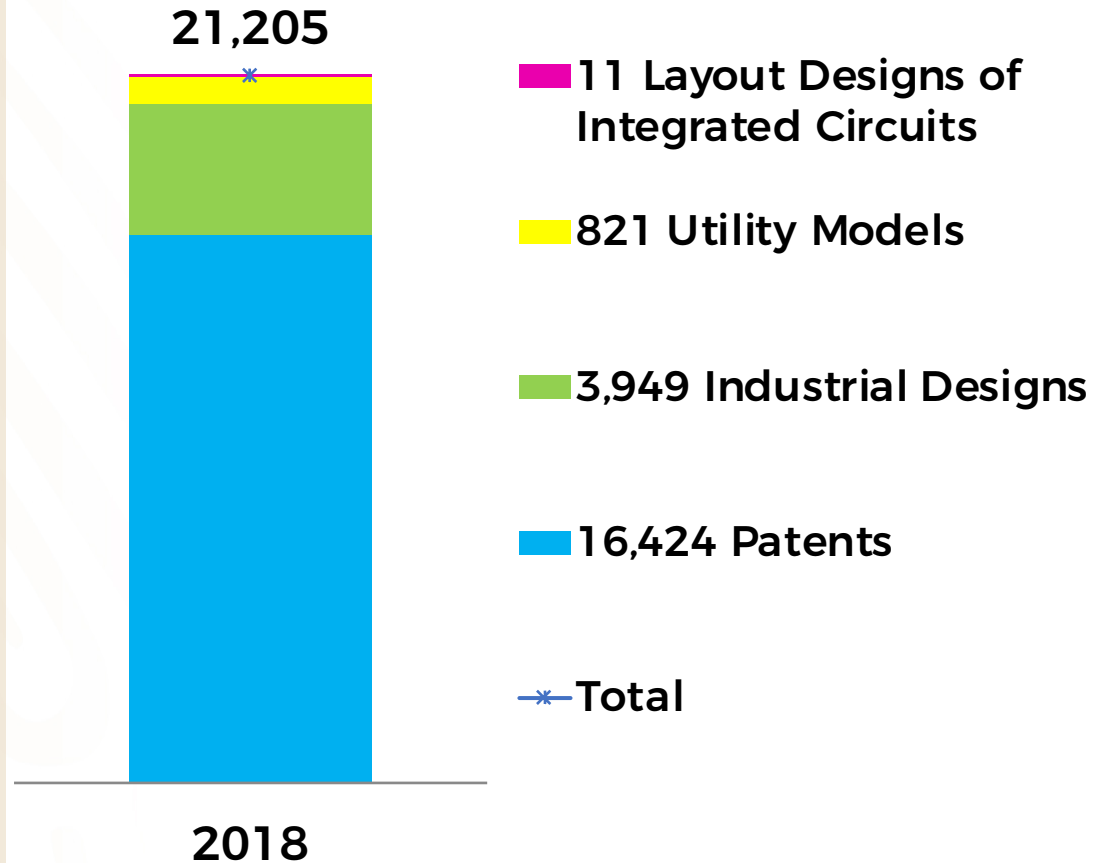
TIMELINE OF PROCEDURE FOR PATENT APPLICATIONS



Agreement that establishes the rules and criteria for resolving several procedures before IMPI (August 9, 2004).

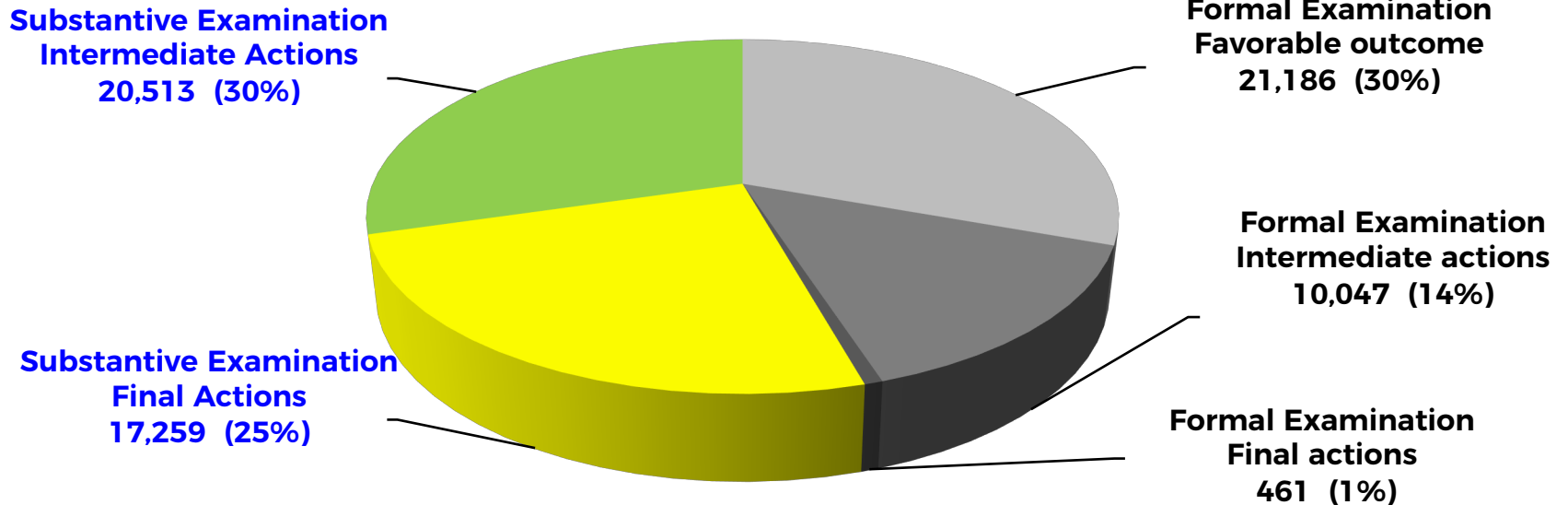
APPLICATIONS 2018

21,205
applications for
protecting
inventions were
received:



OFFICE ACTIONS ISSUED IN 2018

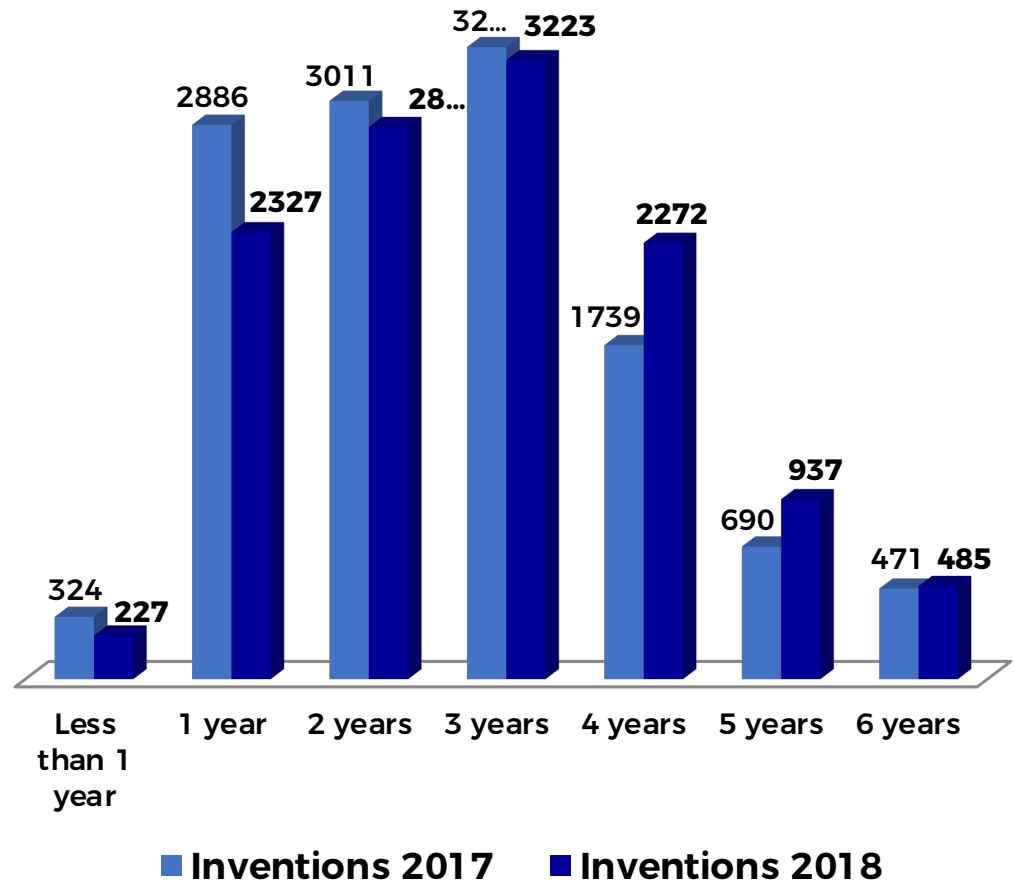
A total of **37,772** office actions were issued from substantive examination coordinations:



APPROXIMATE TIME OF GRANTING

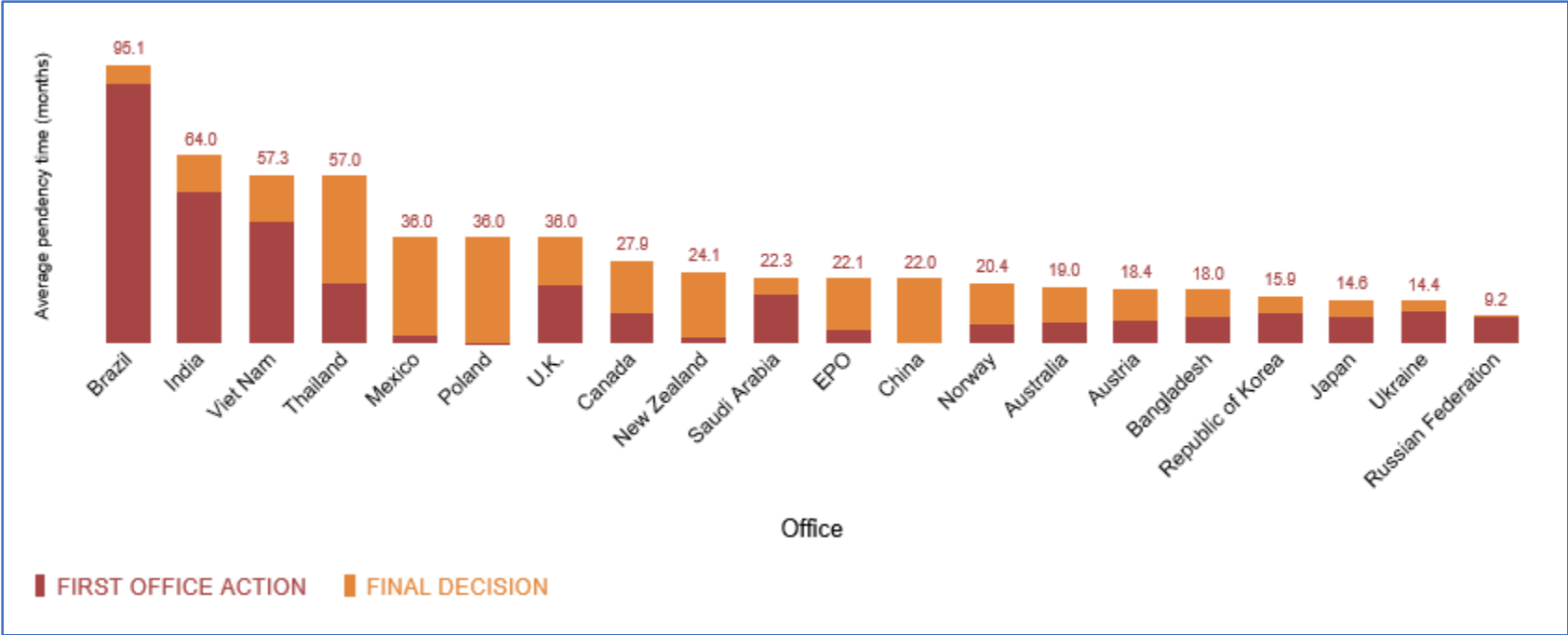
Applications granted in 2017 and 2018:

More than 70% of the applications that were granted had an estimated processing time of 3 years.



AVERAGE PENDENCY TIMES FOR FIRST OFFICE ACTION AND FINAL DECISION AT SELECTED OFFICES, 2017

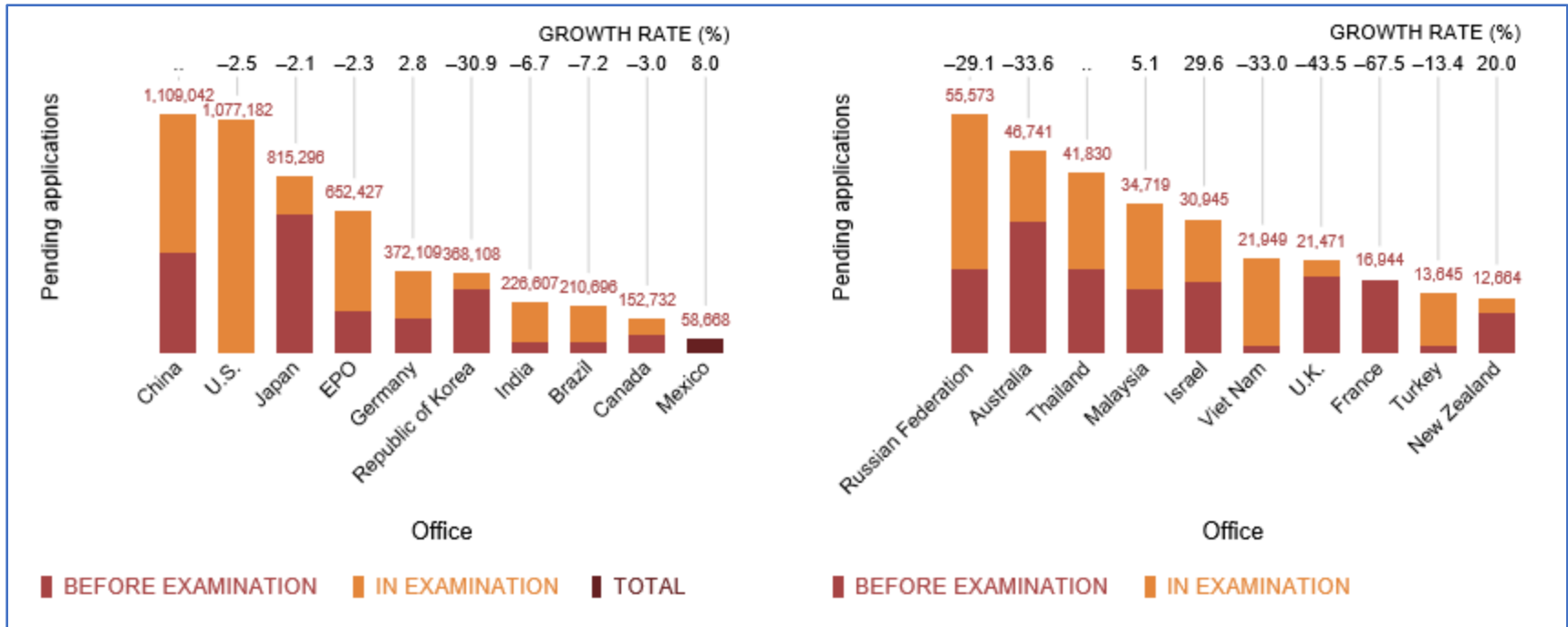
World Intellectual Property Indicators 2018




Mexico
36
months

POTENTIALLY PENDING APPLICATIONS AT THE TOP 20 OFFICES, 2017

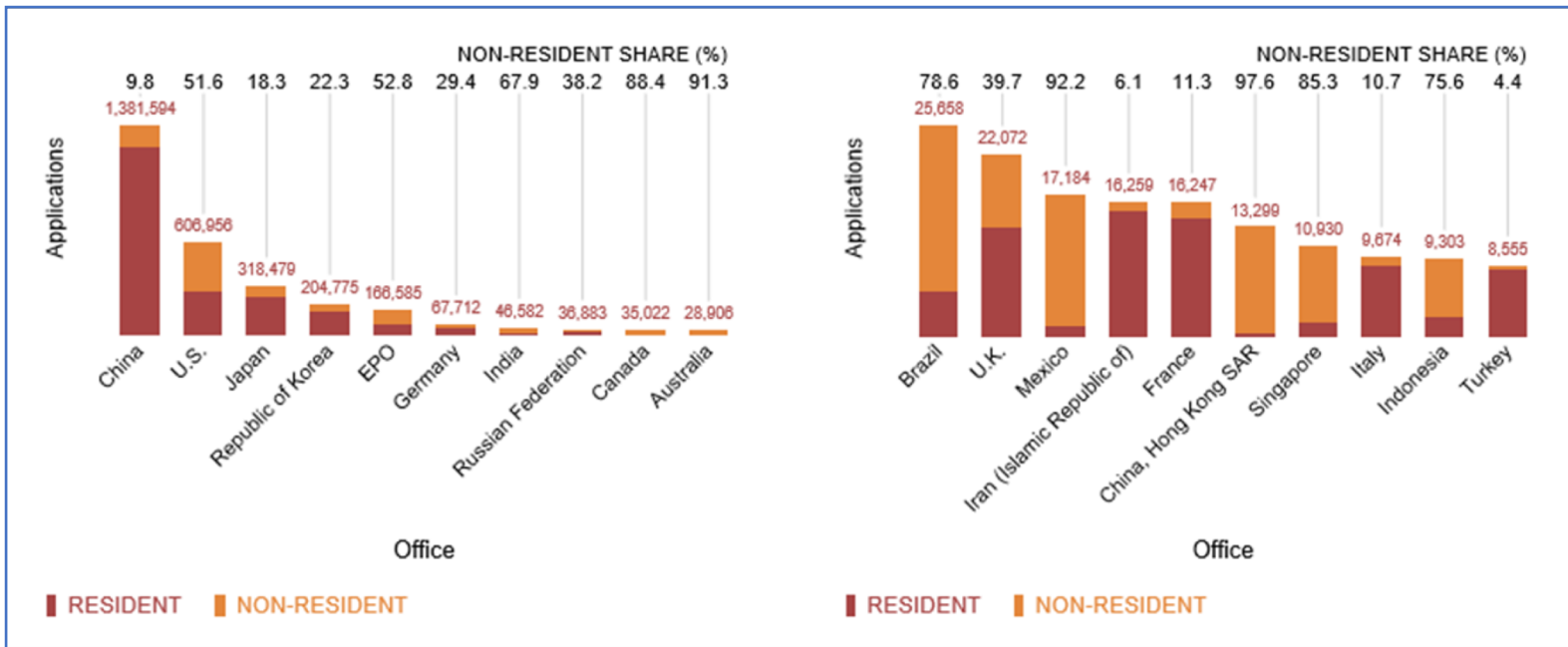

World Intellectual Property Indicators 2018



Mexico
56,668

PATENT APPLICATIONS AT THE TOP 20 OFFICES, 2017

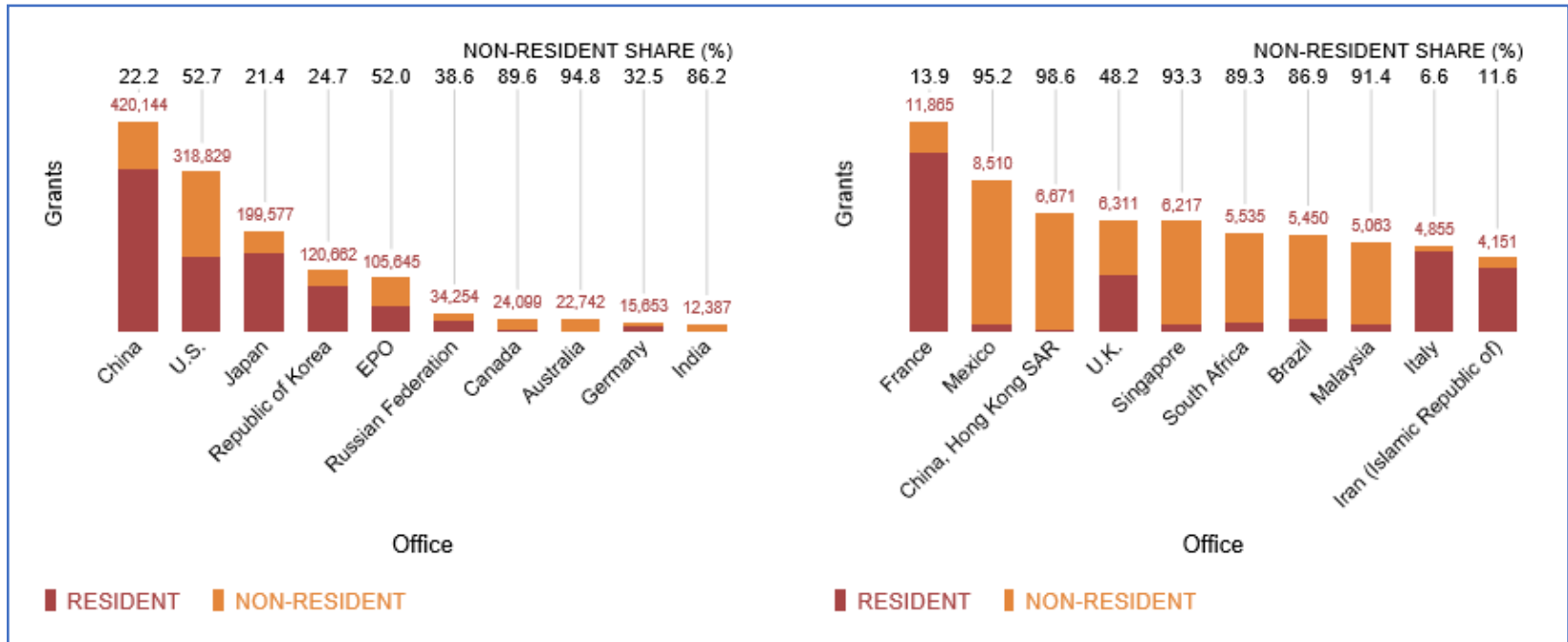
World Intellectual Property Indicators 2018

Mexico
13th
place

PATENT GRANTS AT THE TOP 20 OFFICES, 2017

World Intellectual Property Indicators 2018




Mexico
12th place

CONCLUSIONS

The **quality of patents** is a very important and necessary subject as part of the work of any Industrial Property Office, in this sense the experiences and good practices shared by other offices are very valuable because they allow us to know the different approaches and procedures that are used to ensure the quality of patents granted, which could enrich the practice within our offices.

Thank you!

<https://www.gob.mx/impi>

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Xochimilco, México D.F. 16020**

