

INVENTIVE STEP

I. Definition of a person skilled in the art

Article 12 of the Law on Industrial Property (LPI) does not define a **person skilled in the art**. It only refers to a person skilled in the art when defining inventive step.

According to IMPI practice, a person skilled in the art is a person who has ordinary knowledge and know-how in the technical field of the invention.

It is, therefore, on the strength of his knowledge that he assesses the fulfilment of the inventive step requirement.

II. Evaluating inventive step

In line with IMPI practice, the evaluation of inventive step starts with its definition as set forth in Article 12.3 of the LPI: *the creative process leading to results that are not obvious from the state of the art to a person skilled in the relevant art*.

Accordingly, an invention is not *stricto sensu* entitled to protection if it can be executed by a skilled person with average knowledge in the technical field using information disclosed in the prior art and his ordinary professional skills.

This definition makes unpatentable anything that does not really constitute an invention and does not represent technological progress.

Therefore an invention lacking inventive step is one which can be deduced directly from the state of the art by a *person skilled in the art*.

Inventive step can be influenced by a single document of the state of the art or by a combination of many documents.

Inventive step is evaluated using the problem-solution method:

- Firstly, determine the elements of the invention, i.e., its essential components and technical characteristics, and assess the technical contribution of the invention to the knowledge of the technical field and the technical solution to the problem raised.
- Identify the technical field of the invention and in so doing establish the identity of the person skilled in the art.

- Identify the document/s composing the closest prior art, i.e., those that disclose the majority of the essential characteristics of the invention or those closest to it.
- Identify characteristics undisclosed by the prior art, i.e., those which grant novelty to the invention.
- Hence, determine whether the persons skilled in the art could directly deduce the foregoing characteristics from the information in the prior art, using his normal professional skills.

III. Level of inventive step

“Level of inventive step” and “inventive level” are included neither in the LPI nor in Mexico’s substantive examination practices. If, after the application of the problem-solution method, the person skilled in the art cannot directly deduce an invention from the prior art, then the invention does involve an inventive step and does fulfil the patentability requirement. Levels of inventiveness do not therefore exist; either the requirement is fulfilled or it is not.

SUFFICIENCY OF DISCLOSURE

- I. Enabling disclosure requirement
- II. Support requirement
- III. Written description requirement

We consider that these three questions are addressed with the following information:

Article 43.1 of the LPI stipulates that the description of the invention shall be sufficiently clear and complete to be fully understood and, where appropriate, to serve as a guide for its execution by a person with average knowledge and know-how in the art.

It shall also mention the *best method known* to the applicant of executing the invention when this is not clear from the description.

Under this provision, the claimed invention must be sufficiently disclosed in its description for it to be executed, and examples or an embodiment must be included to demonstrate or substantiate the claims.

Where an invention involves biological material that is difficult to characterize in a description – such as microorganisms, cell lines, hybridomas in the case of monoclonal antibodies – to ensure the reproducibility of the invention, it is not only necessary to describe it as amply as is possible, but also to file a **biological material deposit** at a depositary institution recognized under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purpose of Patent Procedure, to which Mexico is a

signatory as of 21 March 2001.

The deposit of biological material is necessary where the subject claimed cannot be sufficiently described. This allows it to be adequately differentiated from the state of the art. A deposit must also be made where bacteria are used in a fermentation process to ensure its reproducibility. This allows for repetitions of the invention to use only bacteria having the claimed qualities (see also Article 28, paragraphs IV, V, VII and VIII of the LPI Implementing Regulations).

In response to the request to indicate sources of information, including the electronic addresses of legislation, manuals and guidelines considered relevant, the National Legal Framework can be found on the IMPI webpage at the following address: http://www.impi.gob.mx/TemasInteres/Paginas/marco_juridico_nacional_v2.aspx where the aforementioned information can be consulted.

It must also be noted that the patents division (*Dirección Divisional de Patentes*) of the IMPI is not conversant in legal decisions relating to these elements. It is not, therefore, competent to quote legal decisions. Nevertheless, as can be noted from the webpage of the World Intellectual Property Organization, in the section "Internet Sources for Intellectual Property Case Law", at the following address http://www.wipo.int/enforcement/es/case_law.html, the sources of case law for Mexico are the Supreme Court and the Federal Fiscal and Administrative Court, the web addresses of which are as follows <https://www.scjn.gob.mx/Paginas/Inicio.aspx> and <http://www.tff.gob.mx/> respectively. These addresses are reproduced here to elucidate the issues at hand.