

Q1. How does your office understand the term “quality of patents”?

National legislation does not provide a definition of the term “quality of patents”. However it is viewed as a means to achieve the public policy objectives underlying the granting of patents. The Mexican Institute of Industrial Property (IMPI) understands that this is an all-encompassing term, referring to the set of elements required for patents granted to promote innovation, dissemination and the transfer of new technologies, economic development and competitiveness and productivity in the various sectors of industry, where such elements include the normative aspect (a clear legal framework focused on public policies), the human aspect (human resources that are trained and function-oriented) and the material aspect (adequate and sufficient material resources).

This is because patents are required to be the result of appropriate public policies and patent granting procedures should afford a wide margin of certainty as to their validity and contribute to their enforcement. Accordingly, there must be good-quality processes for management, search and examination in relation to patents.

In light of these elements, IMPI understands that the national legal framework seeks quality in patents by ensuring that they are granted only when the invention in question contributes to the state of the art and technological development, without being opposed to the public interest. Thus, there are mechanisms, with measure for simplification, to prevent administrative procedures from unnecessarily delaying the granting of patents.

Likewise, regulations establishes clear requirements and criteria for the granting of patents that contribute to their quality, such as: the obligation of the IMPI to carry out a substantive examination to determine patentability; the possibility of taking into consideration information provided by third parties to determine whether the application fulfills the requirements for granting the patent; the concepts of inventiveness and patentability; the accuracy of the material not considered as an invention and of that which is excluded from patentability, making use of the flexibilities established by the TRIPS Agreement; and the requirements to be met by the patent application, including the sufficiency of the description and the drafting of the claims, among others.

It establishes the obligation to have deadlines to process the claims presented, to constantly review the procedures to make the process more efficient and to facilitate access to and knowledge of the system for the general public.

It allows for accepting and requiring the substantive examination carried out by other offices, as well as entering into inter-institutional agreements with other authorities to facilitate the fulfillment of the objectives of the IMPI, in relation to which agreements have been concluded with other patent offices to make it possible to leverage their examinations and searches and to enable applicants to request accelerated examination of applications (PPH Agreements).

As far as human resources are concerned, it is necessary for staff to have sufficient and relevant knowledge to carry out their functions; they should not perform functions outside their field of knowledge; they should have continuous training; and there should be controls that ensure their proper supervision.

Accordingly, in the IMPI, there are previously established professional profiles according to the functions carried out (differentiating administrative support from background examination). Hence, the staff is related to the specific functions identified, without being distracted by the performance of other functions. There is an adequate division of labor. Personal and area work plans have been established to ensure that adequate time is devoted to each step of the

procedure, complying with institutional goals, and clear levels of supervision are in place that allow for homogenizing criteria and reducing omissions.

In addition, human resources are trained prior to beginning their duties, in order to be familiar with the patent system, as well as the national and international legal framework that governs it and the criteria that are applicable at the national level. They are provided with knowledge of the patentability criteria of other offices, which facilitates the use of the work done by those offices, including the work of International Search Authorities and International Preliminary Examinations carried out under the Patent Cooperation Treaty.

As regards material resources, they should be appropriate and sufficient, facilitating the functions of the patent office and the users of the system.

The IMPI has adequate tools to search for relevant patent documents, such as: a database containing national patent applications (SIGA); a database containing all documentation for patent applications already granted (VIDOC); the classification of documentation using the IPC (International Patent Classification) and CPC (Cooperative Patent Classification) systems; EPOQUE, a search engine that allows access to different databases simultaneously; Thomson Innovation's private document database and two monitors for each examiner to facilitate document search and retrieval.

Also, digitization services are available for all documentation that comes to the IMPI itself and is incorporated into the internal management system (SAGPAT) for proper consultation by the examiners.

In addition, the IMPI has face-to-face courses and promotional materials and training for users so that those who submit applications have at least a minimum knowledge of the procedure to be followed and the requirements they must meet, allowing better-quality applications to be submitted with greater likelihood of giving rise to a patent and fewer requirements, avoiding long processing times for applications.

The IMPI provides state-of-the-art search and technology surveillance services, based on technical or bibliographical data, which anyone can request in order to be informed about the existence of documents in the state of the art of a particular technological sector. This makes for a better evaluation of the state of the art and the submission of applications of higher quality.

The submission of applications online has also begun, with the platform being designed to guide users in the proper form of submission of applications.

Q2. What experiences does your office have with respect to cooperation with other patent offices in the area of search and examination?

In the area of search and examination, cooperation is mainly focused on access to databases and resources available in other offices, on in-depth and face-to-face training of examiners, and on shared analysis of searches and examinations.

The IMPI has signed Memoranda of Understanding (MoUs) with other patent offices for cooperation in the field of industrial property, which provides for the exchange of experts, information and technical collaboration on best practices, experiences, knowledge and processing of applications, technical assistance in the examination of patent applications, through the exchange of search reports and patentability opinions (mainly through the implementation of PPHs and CADOPAT), as well as the development of automation, modernization, document and information classification projects, leaving open the possibility to develop other forms of cooperation that contribute to the consolidation of the patent system.

These include MoUs with the European Patent Office; the Spanish Patent and Trademark Office; the Canadian Intellectual Property Office; the United States Patent and Trademark Office; the African Intellectual Property Organization; the State Intellectual Property Office of the People's Republic of China; the Japanese Patent Office; the Intellectual Property Office of the United Kingdom of Great Britain and Northern Ireland; the National Directorate of Industrial Property of the Eastern Republic of Uruguay; the Intellectual Property Office of the Republic of the Philippines; the Intellectual Property Office of Belize; the National Institute of Industrial Property of France; the Intellectual Property Offices of the Pacific Alliance (National Institute for the Defense of Competition and Protection of Intellectual Property of the Republic of Peru, National Institute of Industrial Property of the Republic of Chile and the Superintendency of Industry and Commerce of the Republic of Colombia); the National Institute of Industrial Property of the Argentine Republic; the National Institute of Industrial Property of the Republic of Chile; the National Directorate of Intellectual Property of the Republic of Paraguay; the Administrative Board of the National Registry of the Republic of Costa Rica; the Intellectual Property Registry of the Republic of Guatemala; and other patent offices and international organizations dedicated to the promotion and protection of Industrial Property.

The IMPI uses the search and examination results of other offices through PPH Agreements signed with: the Austrian Patent Office (APO); the Industrial Property Offices of the Pacific Alliance (Colombia, Chile and Peru); the National Industrial Property Institute of Portugal (INPI); the European Patent Office (EPO); the Canadian Intellectual Property Office (CIPO); the State Intellectual Property Office of the People's Republic of China (SIPO); the Spanish Patent and Trademark Office (OEPM); the Japanese Patent Office (JPO); the United States Patent and Trademark Office (USPTO); the Korean Intellectual Property Office (KIPO), and the Intellectual Property Office of Singapore (IPOS).

The IMPI has access to the various public databases of different offices in the United States, Europe, Japan, Korea, Germany and elsewhere. Licenses have also been acquired in order to be able to use the EPOQUE search engine of the European Patent Office. In-depth examiners have received face-to-face and distance training in the search for and retrieval of documents as well as substantive patent issues, mainly through WIPO, the World Trade Organization (WTO), the SPTO, the JPO and the EPO.

Since 2007, the IMPI has been assisting Belize, Colombia, Costa Rica, Cuba, Ecuador, El Salvador, Guatemala, Honduras, Nicaragua, Panama, Paraguay, Dominican Republic and the African Regional Intellectual Property Organization (ARIPO), through the "Support System for the Management of Patent Applications for Central American Countries and the Dominican Republic", in two ways: for patent applications filed in these offices that have a patent application related to the same family of patents in Mexico, a report is provided on the substantive examination of the Mexican application, and for those who do not have an application belonging to the same patent family in Mexico, a patentability opinion is provided on their own patent application. In both cases the documentation that supports the work is provided and, where appropriate, a search report and even the claims granted in Mexico are also sent. It should be noted that it is for the purposes of this assistance that the CADOPAT system was developed. It is an electronic platform that facilitates the exchange of information, serving as a database of all the answers provided, with minimum requirements for its operation and at no cost to beneficiary offices. Following the various MoUs, the IMPI participates in forums and seminars by providing training to examiners from other offices.

Q3. When performing on-line prior art search, patent examiners prepare a set of search queries to find relevant prior art. Does your office share (for example, via an official website), or exchange, such search queries with other offices?

Patent examiners prepare strategies and search terms that allow them to find the relevant state of the art, particularly by using keywords and symbols from the CIP and CPC classifications. However, the IMPI only shares the terms used and the results of the search carried out through the CADOPAT platform with the beneficiary offices in the context of the assistance provided to them.

Q4. In order to facilitate the cooperation, what kinds of platforms and tools to share information on search and examination are available in your office? Such platforms and tools include, for example, WIPO CASE, databases allowing other offices to retrieve information and external databases used to retrieve information.

(i) Platforms and tools provided by your office

(ii) Platforms and tools used by your office

To facilitate the exchange of information within the framework of the Patent Application Support System for the Central American Countries and the Dominican Republic, the IMPI developed a specific platform (CADOPAT) to which only authorized users of the beneficiary offices and the IMPI have access. It should be noted that although the assistance is provided individually to each office, once the IMPI publishes a response, it can be consulted by the other beneficiary offices.

Q5. What are the impacts of such cooperation to your office? If your office has different types of cooperation and each type of cooperation has different impacts, please indicate them separately.

Access to documents and databases and to resources available in other offices enables the IMPI to efficiently perform its functions by requiring less time for searches and thus fostering the rational use of human and material resources. The searches improve in quality, since the results obtained are complemented by the information available by other means; these are specialized databases that facilitate the searches of relevant documents, and this makes it possible to homogenize criteria within the IMPI regarding search strategies and the use of work carried out by other offices.

The training of substantive examiners enables them to discover different perspectives of the work they do, so that they can improve their functions and be prepared to solve of future problems, as well as allowing them to share their knowledge and experiences with other examiners and, in general, IMPI staff, leading to the adoption of best practices within the office. IMPI's sharing of search and examination results requires the allocation of trained human resources to the work in support of other offices, such as human resources for the development of administrative activities for the proper processing of applications, but above all, human resources for the implementation of the substantive activities, which currently involves all substantive examiners of the IMPI.

Q6. What kinds of capacity building and trainings are required for cooperation between patent offices in search and examination? Please indicate any specific capacity building needs to conduct such cooperation successfully.

It is indispensable to have more human resources in general, but above all people with specialized technical training to carry out a substantive examination. They must be highly qualified, and not only in the area of patents, for which it is necessary to have training, which in turn requires examiners to update their knowledge in their respective technical fields; develop linguistic skills, such as mastery of other languages; and gain knowledge of other areas of intellectual property, given the relevance of their work and the interrelationship of patents with

other intellectual property rights, for example with traditional knowledge, plant varieties and industrial secrets, and with procedures for the commercialization of products (e.g. pharmaceuticals).

In this regard, it is important to consider that the strengthening of these capacities, and ensuring that they truly contribute to the fulfillment of the objectives of cooperation activities, is related to the financial capacities of the patent offices, since they must have the economic resources for the development of cooperation activities, training activities and courses, and the purchase of licenses for the use of specialized platforms (generally at prices not accessible to any office).

[End of Questionnaire]