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Design patent applications in Mexico and their new “Play” GAME rules

Ándrés Esteva from Panamericana examines the new changes for design patent applications.

Mexico recently made some changes to its Industrial Property Law, including but not limited to, changes for Design application prosecution trying to bring further clarity to design prosecution.

Patent design prosecution in Mexico is more akin, at least in its prosecution, to US Patent Design prosecution, where substantive examination is carried out. Mexican Law divides patent design applications into industrial drawings and industrial models, the first being a two-dimensional representation of lines, colors and patterns which may be reproduced into a three-dimensional model, whereas the second is the three-dimensional model *per se*. This will play into context later on during this article, when discussing Graphic User Interphase (GUI) designs.

Formerly, our Law defined that design patents needed to be novel and subject to industrial application, wherein novelty being defined as when the designs are of independent creation and differ in significant grade from known designs or combinations of features of known designs.

Further definitions were not provided; the changes to the new Law intend to provide definitions as to what independent creation and significant grade should be.

Independent creation is now defined as when no other identical design has been made public before the filing date of the application or its recognized priority. Identical designs are considered to be those whose features which only differ in irrelevant details.

Significant grade is then defined as the general impression that a design produces to an expert in the field and that differs in the general impression produced by any other design, made public before the filing date of the application

or recognized priority, considering the degree of freedom for the creation that the designer had for the creation of the industrial design.

While the new changes bring clarity to the prior definitions, there are still some undefined parts of the new definitions. For example, what precisely are irrelevant details and who should determine what irrelevant is? It is clear that the relevancy of a design will differ from mind to mind.

Furthermore, it is inferred that the degree of freedom, is defined by the prior art, and therefore similar shapes can be allowed in the realm of designs if there is a prior art over-population, however, what is the degree of freedom and who defines the parameters of the degree of freedom? Again, should it be the skilled person defining those parameters of degree of freedom and how subjective will those parameters be?

While the above-mentioned changes have good intentions, the game rules to be applied to these new aspects of our law remain uncertain. So far, while there have been objections based on these amendments, there has been no punctual statement to these questions by the Mexican Patent and Trademark Office (MXPTO).

What would seem a more innocent change to the Law, and may very well be grounds for a more substantive change, is that design application prosecution is now carried out in view of grounds for utility patent prosecution, except for determined articles of the corresponding Chapters (Chapters II and V).

Among those changes is reference to Article 17, defining that to determine the novelty and inventive activity of an invention, the state of the art on the filing date of the patent application or, in its case, the claimed priority will be considered. Article 17 then goes on to state that to determine if an invention is novel, all patent applications filed in Mexico prior to said date will be considered, which are being pursued, even if the publication is made at a later date.

From the above there are several uncertain aspects:

First, the Law clearly distinguishes inventions (utility patents), utility models and industrial designs (design patents) and article 17 only makes reference to inventions; it is unclear that it applies to design patent applications as well.

Résumé

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Second, Article 17 makes clear reference to inventive activity, and thus the question which arises is, is this the first step towards designs needing inventive activity, i.e. if Article 17 does in fact apply to design patent applications as suggested by including Chapter II as part of the prosecution for designs, then design applications will in fact require inventive activity.

Third, in view of the new interpretation that Article 17 could apply to design applications, then all patent (utility patent applications) applications filed before the filing date of the design application or its claimed priority, will be considered as state of the art. Having said this, it seems that if this latter aspect does apply, design (design patent applications) applications filed before the filing date of the design application or its claimed priority – which are not published – would not apply, since it is not defined by the law. That is, the above article clearly states that it is unpublished utility patent applications filed in Mexico, which will be part of the state of the art, given that design applications are undefined in this article, then all unpublished design applications filed in Mexico before the filing date or its claimed priority, should not be part of the state of the art.

Furthermore, there is reference to Article 19 that defines non-inventions, most relevant for this article, 19.V and 19.VIII comes to attention. Again, given that Mexican Law clearly distinguishes inventions (utility patents) from utility models and industrial designs (design patents), and article 19 only makes reference to inventions, then it is unclear whether or not this Article also applies to design patent applications.

Article 19.V states that the manners for presenting information are not considered as inventions. Why do we consider this to be relevant? Graphic User Interfaces, best known as GUIs, can be objected for being manners of presenting information. After all, what is a GUI but a screenshot of a particular state of a computer program – it should be noted that it is not the computer program as such, but simply a screenshot of the same. Icons can also be categorized as manners of presenting information, so if this Article does in fact apply, this would effectively end protection of GUIs and icons by means of design applications in Mexico. Of course, some of these will have the option of being protected as a trademark, as long as the trademark is not descriptive or evocative.

Article 19.VIII states that the juxtaposition of known inventions or mixtures of known products, its variation of use, form, dimensions

or materials, are not considered as inventions, unless it is clear that its combination or fusion cannot function separately or that its qualities of feature functions of the same be modified to obtain an industrial result or a non-obvious use to a technician in the field.

This article may also be relevant since it could be argued that novel designs are only in fact a variation of form of a prior know design or juxtaposition of designs, which is, after all, the combination of two or more designs – which is akin to inventive activity or obviousness, raising the same question as above, are we seeing the first steps to the fact that design applications will now need inventive activity in Mexico?

It is unclear that these articles will apply to design applications since they clearly state inventions – which are, according to our law different to utility models and designs. All articles in Chapter II in which articles 17 and 19 are found, refer to inventions and patents, ergo it is unclear how any of the articles found in this Chapter can apply to design applications. Having said this, then why make the effort of stating that prosecution and grant of the design applications/ registers respectively, will be carried out in accordance with the Articles of Chapter II? For correct application of the Articles of Chapter II to design applications, then the Articles of Chapter II should have been amended as well.

The game rules are not only unclear they seem to be incorrect.

There are some bright aspects to the amendments of the Mexican law though, and the one that shines most is the increase from 15 to 25 years of design law protection; hopefully designers will take advantage of this. It would also be fantastic to see a similar increase in the number of years a utility patent is in force, after all, the effort that the inventors make to invent is similar, if not greater than the effort a designer made to design. Maybe wishful thinking?

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