

International Comparative Legal Guides



Patents 2021

A practical cross-border insight into patent law

11th Edition

Featuring contributions from:

Bird & Bird LLP

Cedar White Bradley IP LLC

Chuo Sogo Law Office, P.C.

CPST Intellectual Property

Daniel Law

DDPV Studio Legale

Duane Morris LLP

Eric Silwamba, Jalasi and Linyama
Legal Practitioners

Gleiss Lutz

Gorodissky & Partners Ukraine

Gowling WLG

Haynes and Boone

Kadasa Intellectual Property
(in association with Rouse & Co. International)

Law Office of KRAdamo

LexOrbis

Mintz

Nestor Nestor Diculescu Kingston Petersen

Ofo Ventura Intellectual Property & Litigation

OLIVARES

Patrinos & Kilimiris

PETOŠEVIĆ Russia

Pham & Associates

Reinhold Cohn Group

Reising Ethington P.C.

Rouse

Setterwalls

Shook Lin & Bok

SyCip Salazar Hernandez & Gatmaitan

TIPLo Attorneys-at-Law

ICLG.com



ISBN 978-1-83918-066-8
ISSN 2044-3129

Published by

glg global legal group

59 Tanner Street

London SE1 3PL

United Kingdom

+44 207 367 0720

info@glgroup.co.uk

www.iclg.com

Consulting Group Publisher

Rory Smith

Publisher

James Strode

Editor

Jane Simmons

Senior Editor

Sam Friend

Head of Production

Suzie Levy

Chief Media Officer

Fraser Allan

CEO

Jason Byles

Printed by

Ashford Colour Press Ltd.

Cover image

www.istockphoto.com

Strategic Partners



International Comparative Legal Guides

Patents 2021

11th Edition

Contributing Editor:

**Katharine Stephens
Bird & Bird LLP**

©2020 Global Legal Group Limited.

All rights reserved. Unauthorised reproduction by any means, digital or analogue, in whole or in part, is strictly forbidden.

Disclaimer

This publication is for general information purposes only. It does not purport to provide comprehensive full legal or other advice. Global Legal Group Ltd. and the contributors accept no responsibility for losses that may arise from reliance upon information contained in this publication.

This publication is intended to give an indication of legal issues upon which you may need advice. Full legal advice should be taken from a qualified professional when dealing with specific situations.

Expert Chapters

- 1** **The Relevance of Compulsory Licensing in the Fight Against the COVID-19 Pandemic**
Neil Jenkins & Georgina Straughan, Bird & Bird LLP
- 4** **A New Fault Line in the Modern Era of U.S. Patent Eligibility**
Corey M. Beaubien, Reising Ethington P.C.
- 8** **Ownership of Patent Rights and Standing to Sue in US Courts**
D. Stuart Bartow, Duane Morris LLP
- 12** **Appealing a PTAB Post-Grant Final Decision: The Need for Standing**
Kenneth R. Adamo & Eugene Goryunov, Law Office of KRAdamo | Haynes and Boone
- 17** **Gulf Co-operation Council Countries – Patent Landscape**
Sara Holder & Mohammad Jomoa, Kadasa Intellectual Property (in association with Rouse & Co. International)

Q&A Chapters

- 21** **Australia**
Bird & Bird LLP: Jane Owen & Rebecca Currey
- 29** **Brazil**
Daniel Law: Rana Gosain & Ricardo Nunes
- 37** **Canada**
CPST Intellectual Property: Anthony Prenol & Brett Slaney
- 45** **France**
Gowling WLG: Céline Bey & Clémence Lapôtre
- 61** **Germany**
Glæss Lutz: Dr. Matthias Sonntag & Dr. Herwig Lux
- 69** **Greece**
Patrinos & Kilimiris: Constantinos Kilimiris
- 75** **India**
LexOrbis: Joginder Singh, Varun Sharma & Rajeev Kumar
- 84** **Israel**
Reinhold Cohn Group: Adv. Eran Bareket & Dr. Ronnie Benschafut
- 93** **Italy**
DDPV Studio Legale: Luciano Vasques & Chiara Sciarra
- 102** **Japan**
Chuo Sogo Law Office, P.C.: Naoko Nakatsukasa
- 110** **Malaysia**
Shook Lin & Bok: Michael Soo & Wendy Lee Wan Chieh
- 117** **Mexico**
OLIVARES: Daniel Sanchez y Bejar & Sergio L. Olivares, Jr.
- 127** **Myanmar**
Rouse: Fabrice Mattei & Moe Mynn Thu
- 134** **Philippines**
SyCip Salazar Hernandez & Gatmaitan:
Vida M. Panganiban-Alindogan & Anna Loraine M. Mendoza
- 142** **Romania**
Nestor Nestor Diculescu Kingston Petersen:
Sorina Olaru, Daniela Savin (Ghervas) & Alina Tace (Dumitru)
- 150** **Russia**
PETOŠEVIĆ Russia: Natalia Osipenko & Mayya Pak
- 157** **Saudi Arabia**
Kadasa Intellectual Property: Mohammad Jomoa & Sara Holder
- 164** **Sweden**
Setterwalls: Martin Levinsohn & Per Lidman
- 171** **Taiwan**
TIPLo Attorneys-at-Law: J. K. Lin & H. G. Chen
- 180** **Thailand**
Rouse: Fabrice Mattei & Manoon Changchumni
- 188** **Turkey**
Ofo Ventura Intellectual Property & Litigation:
Özlem Futman & Yasemin Aktas
- 197** **Ukraine**
Gorodissky & Partners Ukraine: Oleg Zhukhevych & Maksym Bocharov
- 206** **United Arab Emirates**
Cedar White Bradley IP LLC: David Harper
- 212** **United Kingdom**
Bird & Bird LLP: Katharine Stephens & Audrey Horton
- 224** **USA**
Mintz: Michael T. Renaud & Matthew A. Karambelas
- 232** **Vietnam**
Pham & Associates: Pham Vu Khanh Toan
- 240** **Zambia**
Eric Silwamba, Jalasi and Linyama Legal
Practitioners: Joseph A. Jalasi & Andrew Simunyola

Mexico



Daniel Sanchez y Bejar



Sergio L. Olivares, Jr.

OLIVARES

1 Patent Enforcement

1.1 Before what tribunals can a patent be enforced against an infringer? Is there a choice between tribunals and what would influence a claimant's choice?

In Mexico, the problem of selecting the competent Judge or choosing jurisdiction is minimal. Indeed, the only venue to enforce a patent is through administrative proceedings (infringement action) before the Mexican Patent Office (IMPI), which is not a Court of Law, but a federal administrative entity. IP enforcement is federal law; no state law is available. The decisions of this agency on patent infringement cases can be appealed by any one of the intervening parties, thus bringing the matter up before a single specialised IP Court. The decision issued by a specialised IP court could be appealed before 20 Federal Circuit Courts in Mexico City; however, the case is turned randomly by a computer system. By territorial jurisdiction, IP matters are mainly decided in Mexico City.

As of November 5, 2020, a new patent and trademark law, called the Industrial Property Protection Law (IPPL), will enter into force. This law allows patent owners to go directly to a Civil Court, either federal or local, to collect damages for patent infringement, without having to exhaust the abovementioned administrative venue.

This civil venue, however, will be stayed if an administrative invalidity action is filed against the enforced patent. In this case, the Civil Court will have to wait until an unappealable decision is reached before continuing the complaint for damages.

The civil venue will coexist, as of November 5, 2020, with the administrative venue.

1.2 Can the parties be required to undertake mediation before commencing court proceedings? Is mediation or arbitration a commonly used alternative to court proceedings?

Currently, there is a provision in the supplementary provisions to the Mexican Industrial Property Law (MIPL) establishing that prior to the issuance of the decision in the administrative proceeding at the first stage, when acting as a Judge in solving disputes, the IMPI has the prerogative to invite the parties to reach an amicable settlement.

As of November 5, 2020, a whole new chapter for a conciliation proceeding will be introduced in the IPPL. Conciliation may be requested by any party of an existing litigation with the IMPI and, if the counterpart accepts, two conciliation meetings will be started, in which the IMPI will try to “conciliate”

the parties' positions, without expressing any possible decision about the merits of the case, to reach a settlement.

Any settlement will have to be formalised with the IMPI, and in such case, the settlement agreement will be enforceable. Conciliation proceedings will not stop the litigation, which will continue normally.

While this option has been poorly explored by patent infringement parties, we will have to see how this new set of conciliation rules will be received.

1.3 Who is permitted to represent parties to a patent dispute in court?

At the first stage before the IMPI, there is no legal requirement to represent individuals or companies in patent disputes, other than the formalities of the corresponding Power of Attorney, but there is no registration at the Bar or certifications required to represent a party in patent litigation at the first stage of the administrative proceedings before the IMPI, namely: infringement; and invalidity actions.

However, at the further two appeal stages, the nullity trial before the Federal Court for Tax and Administrative Affairs (FCTAA) and the Amparo suit before the Circuit Courts, the lawyers representing the parties are required to be attorneys at law, qualified at a federally licensed law school.

1.4 What has to be done to commence proceedings, what court fees have to be paid and how long does it generally take for proceedings to reach trial from commencement?

Traditionally, the Mexican Courts do not address the existence of patent infringement, as in accordance with the MIPL, such cases must be filed and prosecuted with the IMPI. Arguments should be filed in writing and follow applicable procedural rules to commence the procedure.

Government fees to commence a proceeding (patent infringement or invalidity) before the IMPI are around US\$73. The proceeding before the IMPI usually lasts two years. This is the first stage; at least two additional stages are applicable.

1.5 Can a party be compelled to disclose relevant documents or materials to its adversary either before or after commencing proceedings, and if so, how?

The IMPI may obtain all the evidence deemed as necessary for the verification of facts that may constitute a violation of one or more of the rights protected by this Act or the administrative declaration procedures.

When the owner concerned or the alleged infringer has submitted sufficient evidence to reasonably have access to support its claims and has specified evidence relevant to the substantiation of its claims that is under the control of the opposing party, the IMPI may order the presentation of such evidence during the proceedings and, where applicable, this authority should ensure the conditions for the protection of confidential information.

1.6 What are the steps each party must take pre-trial? Is any technical evidence produced, and if so, how?

All pieces of evidence should be filed or announced with the original infringement claim or with the invalidity action before the IMPI.

The applicable regulations do not contemplate a pre-trial stage; therefore, there is no evidence produced in such a stage, but its preparation may be necessary.

1.7 How are arguments and evidence presented at the trial? Can a party change its pleaded arguments before and/or at trial?

Arguments should be filed in writing and follow applicable procedural rules. All arguments and evidence must be filed along with the initial brief requesting the infringement action, with an exception being provided for supervening evidence. The general rule is no, parties cannot change their pleaded arguments, unless there are supervening or unknown facts.

1.8 How long does the trial generally last and how long is it before a judgment is made available?

The initial stage before the IMPI of a patent infringement action usually takes two years. Once the IMPI issues a decision, two further stages of appeals before Courts, lasting no less than three further years, are expected.

1.9 Is there any alternative shorter, flexible or streamlined procedure available? If so, what are the criteria for eligibility and what is the impact on procedure and overall timing to trial?

There is no alternative procedure for patent enforcement at this point in time; however, as mentioned at question 1.1 above, a new civil venue for collecting damages will be available in the coming months. As to the timeline for this new venue, we will have to wait at least a year to have information. Also, the conciliation proceeding mentioned in question 1.2 above will be available.

1.10 Are judgments made available to the public? If not as a matter of course, can third parties request copies of the judgment?

The IMPI does not make the judgments of patent infringement trials or any proceeding available to the public until they are final and beyond shadow of appeal, and some information regarding the decision remains confidential, especially if the parties request it.

1.11 Are courts obliged to follow precedents from previous similar cases as a matter of binding or persuasive authority? Are decisions of any other jurisdictions of persuasive authority?

Only jurisprudence is mandatory for Courts. In fact, as the IMPI is an administrative authority, it is not part of the judiciary, thus they are not bound to follow jurisprudence. Briefly speaking, jurisprudence is construed by five rulings issued unanimously by the same Court or by the Supreme Court *en banc*, but this jurisprudence is mandatory for lower Courts from the judiciary. The IMPI has stated that as it is an administrative authority, jurisprudence and judicial precedents are not compulsory for them when deciding the administrative proceedings, but only persuasive. Legally speaking they are right; however, as they are acting as Judges when deciding contentious cases, ethically and as a matter of principle they should observe binding jurisprudence, as the higher appeal Courts will do so; otherwise, they would only be delaying the application of the binding jurisprudence.

On the other hand, Civil Courts are bound to follow legal precedents. This will be an important issue in future civil actions as mentioned in question 1.1 above.

1.12 Are there specialist judges or hearing officers, and if so, do they have a technical background?

The IMPI is considered the only authority to solve patent enforcement proceedings in the first instance. As of November 5, 2020, the new IPPL will allow Civil Judges, either federal or local, to decide on damages without exhausting the patent infringement proceeding, which will force them indirectly to rule on the infringement.

In January 2009, a specialised IP Division at the Federal Administrative Courts began operating. This Division has jurisdiction to review all cases resolved by the IMPI and based on the IPL, the Federal Copyright Act, the Federal Law of Plant Varieties and other IP-related provisions. The creation of this Division should help improve, in general terms, the applicable criteria for IP cases, but the three Magistrates forming this tribunal have no technical background.

The last appeal stage is formed by Federal Circuit Magistrates; although they are highly capable in legal issues, they do not need to have IP or technical backgrounds.

These two last authorities will not review the decision of the Civil Courts. In those cases, the Superior Civil Tribunal and finally the Federal Civil Circuit Courts will decide on the appeals filed.

1.13 What interest must a party have to bring (i) infringement, (ii) revocation, and (iii) declaratory proceedings?

- (1) Any patentee or licensee (unless expressly forbidden from doing so) has the right to prosecute a suit against a third party infringing his or her rights. A distributor may not bring a suit for infringement.
- (2) An accused infringer may counterclaim patent invalidity under formal or technical considerations, upon receiving the infringement suit before the IMPI, but it is not possible to request an additional judicial ruling or declaration.
- (3) Cease and desist letters provide the required legal standing to initiate invalidity actions. If pertaining to a specific industrial or commercial activity (i.e. the pharma industry), to provide legal standing, this is subject to debate and the Courts are divided.

- (4) Amendments to the patent law allow anyone to request the IMPI to officially initiate the cancellation proceeding against patents.
- (5) Simple legal standing, namely the mere business or commercial activity to challenge the validity of a patent, is under test before the Courts.

1.14 If declarations are available, can they (i) address non-infringement, and/or (ii) claim coverage over a technical standard or hypothetical activity?

In Mexico, non-infringement declarations are not available.

1.15 Can a party be liable for infringement as a secondary (as opposed to primary) infringer? Can a party infringe by supplying part of, but not all of, the infringing product or process?

There is no specific provision in the IP Law relating to the doctrine of contributory infringement, inducement to infringe or any other indirect type of infringement. There is some room, however, to argue in favour of this doctrine; however, it has not been tested before the IMPI or the Courts. Actions may be brought against distributors of an infringing product, and provisional injunctions may be imposed on third parties to some extent.

1.16 Can a party be liable for infringement of a process patent by importing the product when the process is carried on outside the jurisdiction?

Yes, the infringement of a patent in Mexico includes the commercialisation and importation of a product derived from a patented process even if it is carried on outside Mexico.

1.17 Does the scope of protection of a patent claim extend to non-literal equivalents (a) in the context of challenges to validity, and (b) in relation to infringement?

For many years, it has been interpreted that only literal infringement is recognised under the current IP Law. Infringement under the doctrine of equivalents is not expressly provided in the law; a broader interpretation of the patent law to explore the doctrine of equivalents is required.

Nevertheless, recently a Circuit Court in Mexico ruled on behalf of a pharmaceutical company, considering the peripheral interpretation method as a precedent, since it is not mandatory.

The Circuit Court considered that, according to the Mexican rules and regulations, the intention of the legislator to grant the claim a fundamental role in the definition of the subject matter of the patent is very clear, since this rule allows the State to protect the industrial property to a greater extent and to prevent actions affecting such exclusivity or that constitute unfair competition and, if applicable, eradicate this practice by means of the imposition of the corresponding sanctions.

Therefore, the level of a possible infringing action shall be decreed based on the identification with the scope of protection of the claims that shall determine the existence of an eventual infringement due to identity or equivalence.

Although this ruling does not exactly implement the U.S. doctrine of equivalence, this is a positive start. Concerning challenges to validity, there is no precedent that establishes that the scope of protection of a patent is extended to non-literal equivalents. Further, the law does not expressly recognise equivalents. However, from a broad interpretation of the patent law, it might be possible to raise an argument in favour of the applicability of the doctrine of equivalents in regard to invalidity actions.

There is again no express provision in the new IPPL. An in-depth analysis is necessary to conclude whether there is room for this doctrine or not.

1.18 Can a defence of patent invalidity be raised, and if so, how? Are there restrictions on such a defence e.g. where there is a pending opposition? Are the issues of validity and infringement heard in the same proceedings or are they bifurcated?

Although the issues of infringement and validity are prosecuted in different filings, they are decided at the same time, especially if the invalidity action is filed as a counterclaim; specifically, filed at the same time as the response to the infringement action is filed. This administrative venue will continue.

As the same time, a civil venue will be opened in November 5, 2020 (see question 1.1 above), which will allow patent owners to claim damages directly without waiting for an administrative decision. In this venue, in case an invalidity action is filed, the IMPI will be the only one entitled to rule over it and the civil case will be stayed until a decision is reached.

1.19 Is it a defence to infringement by equivalence that the equivalent would have lacked novelty or inventive step over the prior art at the priority date of the patent (the "Formstein defence")?

As explained before, the doctrine of equivalence is still developing in Mexico. The law does not expressly provide a defence to infringement by equivalence. However, the interpretation of the law provisions concerning patentability conditions and patentable subject matter, enable the application of the "Formstein defence".

1.20 Other than lack of novelty and inventive step, what are the grounds for invalidity of a patent?

According to the IP Law, patents are valid unless proven otherwise. Thus, the IP Law establishes several grounds upon which a patent can be invalidated:

- (1) When it was granted in contravention of the provisions on requirements and conditions for the grant of patents or registrations of utility models and industrial designs.
- (2) When it was granted in contravention of the provisions of the law in force at the time when the patent or registration was granted. The nullity action based on this section may not be based on a challenge of the legal representation of the applicant when prosecuting and obtaining a patent or a registration.
- (3) When the application is abandoned during its prosecution.
- (4) When granted by error or serious oversight, or when it is granted to someone not entitled to obtain it.

The nullity actions mentioned under (1) and (2) may be filed at any time; the actions under (3) and (4) must be filed within five years, counted from the date on which the publication of the patent or registration in the Gazette becomes effective.

Now, in accordance with the IPPL, a patent can be only declared invalid:

- (1) when subject matter is not considered an invention, or in case of non-patentable subject matter, lack of novelty, inventive step or industrial applicability;
- (2) due to lack of disclosure;
- (3) due to lack of support;
- (4) in case of divisional applications, when granted against new rules for them;

- (5) when broadening the scope of protection originally allowed during a correction proceeding;
- (6) due to mistakes recognising priority rights that otherwise could result in lack of novelty or inventive step;
- (7) in double patenting cases; and
- (8) when granted to a person that was not entitled to apply for it.

None of these actions have statutes of limitations.

The first set of invalidity actions mentioned above will be applied only for patents granted before November 5, 2020. Any patent granted after that date may only be challenged using the second set of invalidity actions.

1.21 Are infringement proceedings stayed pending resolution of validity in another court or the Patent Office?

The general rule is to decide linked cases' invalidity and infringement simultaneously in the administrative venue. As to the new civil venue, please see question 1.1 above.

1.22 What other grounds of defence can be raised in addition to non-infringement or invalidity?

The basis of this defence is that the proper interpretation of the patent claim does not catch the alleged infringing product or process. Neither the MIPL nor the IPPL contemplate affirmative defences such as laches.

Challenging the validity of patents

Under the MIPL and the IPPL, patents are valid until the contrary is proven.

One of the most common defences in patent litigation in Mexico is to attack the validity of the allegedly infringed patent. As the patent exists, an administrative resolution is required to declare its annulment. This defence must be alleged when replying to the plaintiff's claim, by means of a counterclaim. The IMPI will give notification of the counterclaim to the party who filed the original complaint. Both the infringement claim and the counterclaim should be resolved simultaneously to preclude the possibility of contradictory outcomes. The grounds for invalidating a patent are mentioned in question 1.15.

Fair or experimental use

This refers to the non-profit use of the patented invention.

Roche Bolar exception

The IPPL provides that any third party will be entitled to use, import, manufacture, or offer for sale a patented invention for the purpose of getting a marketing authorisation for human use medicines. This defence has no statute of limitations.

1.23 (a) Are preliminary injunctions available on (i) an *ex parte* basis, or (ii) an *inter partes* basis? In each case, what is the basis on which they are granted and is there a requirement for a bond? Is it possible to file protective letters with the court to protect against *ex parte* injunctions? (b) Are final injunctions available? (c) Is a public interest defence available to prevent the grant of injunctions where the infringed patent is for a life-saving drug or medical device? (Please cross-refer to your answer to question 3.2 if compulsory licensing may be available in this scenario).

The Mexican Patent and Trademark Law, provides so-called provisional injunctions whereby the IMPI can take certain

important measures against infringers. The requirements to get the injunctions are:

- (1) Proof of a valid right.
- (2) Presumption of the violation of the patent.
- (3) Postage of a bond to guarantee damages.

If the plaintiff chooses to ask the IMPI for a provisional injunction, a bond will be fixed to warrant possible damages to the defendant. This injunction is to be petitioned in writing and, within a term of 20 days from its execution, the plaintiff is required to file a formal written claim infringement. Failure to do so will cause the plaintiff to lose the bond in favour of the defendant. Preliminary injunctions are available on an *ex parte* basis. However, once the injunctions have been notified to the defendant, this party has the right to place a counter-bond to have the effects of the provisional injunction stopped. The defendant has the right to allege whatever he may deem pertinent with respect to the provisional injunctions within a term of 10 days from the day of the execution.

Once the case is resolved by the IMPI and infringement is found, definitive injunctions are imposed on the infringer. It is possible to file a constitutional trial (Amparo) before the Federal District Courts to try to stop the imposition of preliminary injunctions. However, the admissibility and likelihood of success of such an action has to be assessed on a case-by-case basis.

There is no specific remedy to prevent an injunction in the case of life-saving drugs or medical devices, however, compulsory licences are available in Mexico. Please see question 3.2.

1.24 Are damages or an account of profits assessed with the issues of infringement/validity or separately? On what basis are damages or an account of profits assessed? Are punitive damages available?

In April 2018, the Mexican Supreme Court published its final written decision, which was preliminarily issued at the end of 2017, relating to the interpretation of the so-called 40% rule for calculating damages. The Court examined whether this rule is appropriate and how it should be applied to the calculation of damages derived from violations of rights protected under the Mexican Industrial Property Law (IPL) covering patents, trademarks and designs (copyrights are governed by a different law and rules).

In summary, the 40% rule establishes that compensation derived from the violation of industrial property rights shall in no case be less than 40% of the sales of the infringing product at the price of sale to the consumers. The Supreme Court addressed the following questions: i) whether it was necessary to prove the "causal nexus" between the illicit act and the damage or harm to the plaintiff; ii) if the 40% rule is to be applied automatically and as a minimum floor to calculate damages; iii) whether the administrative decision of infringement *per se* – in this case, based on unfair competition – was enough to prove the harm and damage to the plaintiff; iv) if the IP law establishes a compensation for material (economic) and immaterial (moral-reputation) violations; v) whether compensation derived from acts of an unfair competition action needs to be proven by actual damages; and vi) what type of evidentiary items are appropriate to prove damages for compensation under the 40% rule, and whether this rule should be applied only as a method of quantifying compensation, or as a type of punitive damages.

Ruling

- (i) The decision expressly establishes that the validity and constitutionality of the provision establishing the 40% rule, and the rule itself, is not questioned by the Supreme Court, but the ruling establishes that the concept of damages is separate from the amount of the compensation.

- (ii) The administrative declaration of infringement based on unfair competition is evidence of the illicit act, but not of the damages caused to the plaintiff.
- (iii) Unfair competition, defined as an act to induce the consumer to error or deceit, does not necessarily constitute direct economic harm to the plaintiff.
- (iv) The plaintiff is required to prove on a case-by-case basis, evidence of actual harm, material and immaterial.
- (v) In the specific case of unfair competition at hand, the plaintiff did not offer evidence of actual damages or harm and the infringement decision did not relieve the plaintiff from that burden.
- (vi) The 40% rule is a mechanism to establish the amount of compensation, but not the damages caused by the illicit act – in this case, unfair competition activity.
- (vii) The 40% rule is a pre-established method of quantifying the compensation, once all the prongs to claim damages are met.
- (viii) In general terms, the causes of infringement in the IPL do not contemplate presumption of damages.

Conclusions

- (i) This was a not a unanimous decision. It was a divided two-to-three decision, of one of the Benches of the Supreme Court. It was not an *en banc* decision by the two Benches, nor did it constitute jurisprudence; therefore, it is not binding.
- (ii) Notwithstanding, as a precedent, it is highly persuasive and if lower Courts issue decisions that differ in the matters of law, such decisions will have to provide strong and lawful arguments to persevere.
- (iii) The decision does not question the validity of the 40% rule to quantify damages but imposes the burden to prove “causal nexus” on a case-by-case basis.
- (iv) We tend to believe that civil cases claiming damages derived from clear-cut instances of trademark and patent infringement may be decided differently; however, after the decision under comment, in addition to the evidence to prove the sales of the infringing product, an accurate analysis of the evidence to prove damages should be taken into consideration on a case-by-case basis.
- (v) The 40% rule is no longer considered a punitive damage only. The 40% rule is considered a relief for plaintiffs and a means of compensating for the long term of litigation in Mexico by circumventing the high burden to prove actual damages, lost profits, and other damages subject to compensation. This decision does not reject the formula, but accuracy in the evidence of filing civil actions claiming damages derived from the violation of IP rights will be mandatory for plaintiffs.

The 40% rule will be kept in the IPPL and will apply for civil trials, as mentioned in question 1.1 above. Also, in case a patent owner chooses the administrative venue, once a final, unappealable decision is reached, a proceeding to declare damages can be started with the IMPI. Again, the 40% rule is available in this circumstance.

1.25 How are orders of the court enforced (whether they be for an injunction, an award of damages or for any other relief)?

In the event of a second or subsequent offence, the fines previously imposed on the offender shall be doubled. A second or subsequent offence refers to every subsequent infringement of one and the same provision, committed within the two years following the date on which the ruling on the infringement was handed down.

Likewise, closures may be ordered in the decision that rules on the infringement, in addition to a fine or without a fine having been imposed. There shall be grounds for permanent closure when the establishment has been temporarily closed twice within a period of two years if, during said period, the infringement is repeated regardless of whether the location thereof has changed.

Criminal actions for patent infringement are available for reoffence cases. In accordance with the provisions of our IP Law, re-offence is found when a party infringes a patent after a final and beyond-shadow-of-appeal decision from the IMPI declaring the infringement. This re-offence is considered a felony that can be pursued *ex officio* or *ex parte* through the Federal District Attorney Office (PGR). This felony can be punished with up to six years of imprisonment and a fine.

1.26 What other form of relief can be obtained for patent infringement? Would the tribunal consider granting cross-border relief?

Other forms of relief are orders to stop the infringement activity, fines and closure of the facilities where the infringement activities take place. Costs and attorneys’ fees can be recovered in a civil claim for damages and lost profits. This takes place after the IMPI has declared the administrative infringement. The civil Courts follow a specific scheme for reasonable attorneys’ fees, regardless of whether this table reflects the actual fees charged.

Criminal sanctions in the event of recidivism are also contemplated in the IP Law.

1.27 How common is settlement of infringement proceedings prior to trial?

It is very unusual to settle cases before the decision is reached, because there are very few incentives for both parties to settle; that is because contingency derived from the infringement proceedings requires a final decision and this would be a long period of time, therefore neither plaintiff nor defendant would face the corresponding recovery/contingency of damages as an actual or imminent situation. A new conciliation proceeding is provided in the IPPL; please see question 1.2 above.

1.28 After what period is a claim for patent infringement time-barred?

The IMPI’s current criterion is that the time limit for seeking a remedy is during the life term of the patent. Once the patent has expired, an action may not be brought for events that took place before the end of the life term. A defence of laches has not been tested before the Courts; therefore, legally speaking, a specific time limit exists in the IP Law to bring an infringement action during the life term of the patent.

However, there is a two-year limitation period to pursue a civil action for damages; therefore, this statutory term to claim damages should be taken into consideration when looking at the timing to file infringing actions.

1.29 Is there a right of appeal from a first instance judgment, and if so, is it a right to contest all aspects of the judgment?

Appeals against the IMPI can be brought either before the specialised IP Division of the Federal Administrative Court,

or before the IMPI itself through a review recourse. Decisions by either Court can be appealed in a final stage before Federal Circuit Courts.

Appeals against Civil Courts can be brought with the Superior Civil Tribunal and its decisions can be appealed before the Federal Civil Circuit Courts.

1.30 What are the typical costs of proceedings to a first instance judgment on (i) infringement, and (ii) validity? How much of such costs are recoverable from the losing party?

Government fees are minimal in the administration of patent infringements and there are no government costs in the subsequent appeal stages.

Costs and attorneys' fees may be recovered in a civil claim for damages and lost profits.

1.31 For jurisdictions within the European Union: What steps are being taken in your jurisdiction towards ratifying the Agreement on a Unified Patent Court, implementing the Unitary Patent Regulation (EU Regulation No. 1257/2012) and preparing for the unitary patent package? Will your country host a local division of the UPC, or participate in a regional division? For jurisdictions outside of the European Union: Are there any mutual recognition of judgments arrangements relating to patents, whether formal or informal, that apply in your jurisdiction?

Needless to say, Mexico is not part of the European Union but, as a clarification, there is no binding mandatory provision in the Mexican legal system that would oblige the IMPI and the Mexican Courts to recognise foreign judgments related to patents; this applies to infringement and validity rulings abroad. However, those decisions in jurisdictions abroad would be evaluated and can be persuasive as documentary evidence.

In some cases, if the factual pattern and evidence are very similar to the case under review in Mexico, the case ruled in another jurisdiction may have relevant weight when the case is decided in Mexico.

Mexico will not host a local division of the UPC or participate in a regional division.

2 Patent Amendment

2.1 Can a patent be amended *ex parte* after grant, and if so, how?

According to Article 61 of the MIPL, the text or drawings of a granted patent may only be amended by the patent owner in the following circumstances:

- (1) to correct any obvious or form errors; and
- (2) to limit the scope of the claims.

The authorised changes shall be published in the Official Gazette.

An amendment after allowance is requested in writing to the Mexican Patent Office, briefly explaining the reasons underlying the errors that are being corrected or the limitations being introduced to the claims.

This provision will apply for patents granted before November 5, 2020. After this date, the new IPPL will also provide the same possibility, including a more detail proceeding; however, when an invalidity action has already been filed, any amendment petition will be dismissed. This was a trend (see question 8.3) in patent litigation that now is forbidden by the new law.

2.2 Can a patent be amended in *inter partes* revocation/invalidity proceedings?

In an invalidity action requested by a third party, which may result in a partial nullity of the patent, limiting the scope of the patent, a voluntary amendment would be allowed in an *inter partes* proceeding if both parties agree and if the general rules of the civil law should be followed.

2.3 Are there any constraints upon the amendments that may be made?

The amendments are restricted to correcting any obvious or form errors, and to limiting the scope of claims, on case-by-case basis; it is generally advisable to review how the patent to be limited was enforced. Also see question 2.1 above.

3 Licensing

3.1 Are there any laws which limit the terms upon which parties may agree a patent licence?

It is possible to record a licence either onto a granted patent or in a pending application, so that the same may be opposed against third parties.

The term of the licence may not exceed the natural term of the patent itself and may not be recorded when a patent has already elapsed.

Patent owners may grant further licences unless expressly agreed to the contrary.

Licensees may exert defensive rights over the patent, unless specifically accorded, while working by licensee inures to the benefit of the licensor.

Finally, in regard to the cancellation of the licence recordal, the Industrial Property Law establishes that the cancellation occurs when:

- (1) the same should be requested by both the licensee and the licensor jointly;
- (2) the patent lapses or is declared null; or
- (3) there is a Court order.

3.2 Can a patent be the subject of a compulsory licence, and if so, how are the terms settled and how common is this type of licence?

After three years starting from the date of grant of the patent, or four years from the filing date, whichever is later, anyone may request from the IMPI the grant of a compulsory licence when it has not been used, except if it duly justifies an exit.

It is also provided that there will be no grant of a compulsory licence when the holder of the patent or a licensee has been carrying the importation of the patented product or the product obtained by the patented process. Furthermore, the working of a patent by a licensee will be deemed to be worked by its holder, provided that the licence was recorded with the IMPI. The party applying for a compulsory licence shall have the technical and economical capacity to efficiently work the patented invention.

On the other hand, before the grant of the first compulsory licence, the IMPI will provide the patentee with the opportunity to begin working the patent within a term of one year from the date of personal notification given to him. Following a hearing with the parties, the IMPI will decide on the grant of a

compulsory licence, and if the IMPI decides to grant it, it will set forth its duration, conditions, field of application and amount of royalties that correspond to the holder of the patent.

We are not aware that any compulsory licence has been granted in recent years. In any event, the royalties are established by the IMPI after a hearing with the parties and they should be fair and reasonable.

4 Patent Term Extension

4.1 Can the term of a patent be extended, and if so, (i) on what grounds, and (ii) for how long?

The MIPL does not establish the possibility of patent life term extensions. However, it is important to mention that NAFTA established the possibility, but not the obligation, of patent life term extensions when the Health Authority delays the process to obtain a marketing authorisation for a patented product. But Mexico did not adopt the patent life term extensions in its domestic law until 2020.

In accordance with the USMCA (NAFTA 2.0), all parties should provide the opportunity to apply for patent terms extensions, either for delays in the granting of patents or delays in the granting of marketing authorisations. In both cases, delays must have been caused by the authorities rather than the parties.

As of November 5, 2020, patent owners may request from the IMPI complementary term certificates for patents applications that were granted after five years of prosecution, when the delay is imputable to the IMPI. Such petition must be filed before paying the issuance fees and the IMPI will grant one day for each two days' delay imputable to them. Any automatic term extension provided by law taken by the applicant will be subtracted from the five-year term.

As to extensions related to delays in the granting of marketing authorisations for pharmaceutical products, the USMCA rule will not enter into force in Mexico until 2024.

5 Patent Prosecution and Opposition

5.1 Are all types of subject matter patentable, and if not, what types are excluded?

The following subject matter is not patentable in Mexico:

- (1) essentially biological processes for obtaining, reproducing and propagating plants and animals;
- (2) biological and genetic material as found in nature;
- (3) animal breeds;
- (4) the human body and the living matter constituting it; and
- (5) plant varieties.

On the other hand, the following subject matter is not considered an invention in Mexico:

- (1) theoretical or scientific principles;
- (2) discoveries that consist of making known or revealing something that already existed in nature, even though it was previously unknown to man;
- (3) diagrams, plans, rules and methods for carrying out mental processes, playing games or doing business, and mathematical methods;
- (4) computer programs;
- (5) methods of presenting information;
- (6) aesthetic creations and artistic or literary works;
- (7) methods of surgical, therapeutic or diagnostic treatment applicable to the human body and to animals; and

- (8) juxtaposition of known inventions or mixtures of known products, or alteration of the use, form, dimensions or materials thereof, except where in reality they are so combined or merged that they cannot function separately or where their particular qualities or functions have been so modified as to produce an industrial result or use not obvious to a person skilled in the art.

5.2 Is there a duty to the Patent Office to disclose prejudicial prior disclosures or documents? If so, what are the consequences of failure to comply with the duty?

There is no duty to disclose prejudicial prior art or documents.

5.3 May the grant of a patent by the Patent Office be opposed by a third party, and if so, when can this be done?

In a period of two months after the publication of the patent application, information related to patentability of an invention can be filed before the IMPI by a third party. It is worth mentioning that there is a project to amend the Patent Law to reduce the six-month period to two months, in order to speed up the procedure. If filed, the information may be considered at the Examiner's discretion and it will not suspend the application process. The person filing the information will not be considered a party and will not have access to the patent file or immediate legal standing to challenge a granted patent.

After a patent is granted, anyone can inform the IMPI of causes of invalidity. The authority may consider such information discretionally to initiate an *ex officio* cancellation proceeding.

5.4 Is there a right of appeal from a decision of the Patent Office, and if so, to whom?

This opposition is more like a third-party prior art submission. The person filing it is not considered as part of the patent prosecution proceeding and therefore does not have legal standing to appeal. Furthermore, the IMPI does not issue a formal resolution to the opposition itself.

5.5 How are disputes over entitlement to priority and ownership of the invention resolved?

Disputes over entitlement to priority and ownership of the invention are resolved by Civil Courts. There is concurrent jurisdiction for both Federal and Local Civil Courts and its resolution as to ownership has to be complied with by the IMPI.

However, a cause of invalidity is provided both in the MIPL and the IPPL when a patent was granted to a person/entity that was not entitled to apply for it.

5.6 Is there a "grace period" in your jurisdiction, and if so, how long is it?

The Industrial Property Law contemplates a one-year grace period. This one-year grace period is limited in the MIPL to public disclosures made by applicants or inventors. However, in the IPPL, the grace period applies more broadly to any direct or indirect public disclosures made by the inventor(s) or applicant(s), or by third parties that obtained the information from them.

When the corresponding application is filed, the evidentiary documents shall be included in the manner laid down in

the Regulations under this Law. The publication of an invention contained in a patent application or in a patent granted by a foreign office shall not be subject to the grace period.

5.7 What is the term of a patent?

The term of a patent is 20 years from the filing date. Term extensions are available in Mexico; please see question 4.1 above.

5.8 Is double patenting allowed?

Double patenting is not allowed in Mexico.

6 Border Control Measures

6.1 Is there any mechanism for seizing or preventing the importation of infringing products, and if so, how quickly are such measures resolved?

The Industrial Property Law establishes that there are available injunctions for infringement of patent rights on a provisional and permanent basis in Mexico. The Customs Law establishes the rules for implementing the same with Mexican Customs.

Generally speaking, in order to grant a preliminary injunction, it is necessary to comply with certain requisites, such as that the holder of the industrial property right has applied to the products, packaging or wrapping of the products protected by the patent, the marking indications, or, by some other means, have made it public knowledge that there is a protected industrial property right.

Other pertinent requisites can be found in Article 199*bis* 1, which requires that the requesting party complies with the following as well:

- (1) Prove that they hold a patent right and any of the following in addition:
 - (a) The existence of an infringement to his right.
 - (b) That the infringement to his right will be imminent.
 - (c) The existence of the likelihood of irreparable damages suffered.
 - (d) The existence of justified fear that the evidence will be destroyed, concealed or altered.
- (2) Grant sufficient bond in order to warrant the damages which would be caused to the person against whom the measures are demanded.
- (3) Provide the IMPI with the information necessary for the identification of the goods or establishments in which or where the infringement to industrial property rights is occurring.

In regard to the scope of the injunctions, the IMPI may order the alleged infringer or third parties to suspend or discontinue the acts constituting a violation of the provisions of law and the seizure of goods such as:

- (1) Objects manufactured or used illegally.
- (2) Objects, wrappers, containers, packaging, paperwork, advertising material and similar articles that infringe any industrial property right protected by the Industrial Property Law.
- (3) Signs, labels, tags, paperwork and similar articles that infringe any of the rights protected by the Industrial Property Law.
- (4) Implements or instruments intended or used for the manufacture, preparation or production of any alleged-to-infringe relevant industrial property rights. It is important to mention that the alleged infringer is entitled to file a counter-bond to obtain the lifting of the preliminary injunctions.

In regard to the time frame, once the legal requisites are fulfilled, normally preliminary injunctions are adopted and put into practice in a rather fast fashion that may range from two to seven days, depending on the need to implement the same; i.e. seizures at customs, due to the nature of the importation process and the need for a rather quick implementation, may take 48 hours.

Permanent injunctions are declared once the administrative infringement proceeding is finally decided.

7 Antitrust Law and Inequitable Conduct

7.1 Can antitrust law be deployed to prevent relief for patent infringement being granted?

There is no precedent in Mexico of antitrust, unfair competition or business-related tort actions brought against patentees for the use of a patent. Courts generally consider that the use of a state-given right cannot constitute a violation in these areas.

7.2 What limitations are put on patent licensing due to antitrust law?

An action could theoretically be brought for activities falling outside the scope of a patent, such as non-competition agreements for products that are not covered by the claims, product-tying within that scope, or unfair competition activities such as advertising that a product is better than an alternative for the sole reason of it having a patent. Actions could also be brought before the Antitrust Commission for other forms of abuse of patent rights, such as clearly unfounded attempts to enforce a patent.

On July 20, 2016, the Mexican Antitrust Commission (known by its Spanish acronym, COFECE) announced that it will conduct a study regarding competition concerns over pharmaceutical products with lapsed patents. This is the first time such a study has been undertaken in Mexico.

The Commission will first analyse the rationale behind the fact that there are approximately 350 products listed in the National Formulary with sole suppliers, although around 63% of these products have lapsed patents. COFECE emphasised that this analysis should not be considered in any way as a prejudgment of potential misconducts. It pointed out that this assessment aims to provide Mexican Regulatory Agencies with recommendations on how to encourage competition and correct inefficiencies.

We consider that the COFECE official communication in this regard contains several flaws and confuses concepts in order to justify the study. For example, the Commission provides data concerning out-of-pocket expenses of the private sector to explain its reasoning for reviewing public acquisitions of medical products; however, these are separate realms governed by various factors and rules and are not necessarily related.

7.3 In cases involving standard essential patents, are technical trials on patent validity and infringement heard separately from proceedings relating to the assessment of fair reasonable and non-discriminatory (FRAND) licences? Do courts grant FRAND injunctions, i.e. final injunctions against patent infringement unless and until defendants enter into a FRAND licence?

Yes. The technical trials on patent validity and infringement are heard by the IMPI, whereas proceedings relating to the assessment of FRAND licences are heard by the COFECE.

There is no precedent in which FRAND injunctions were granted against patent infringement. However, the COFECE has broad faculties to impose injunctions, thus it may be argued that such authority could order the stay of a patent infringement case until a proceeding concerning a FRAND licence is decided or even a final injunction against patent infringement.

8 Current Developments

8.1 What have been the significant developments in relation to patents in the last year?

The main developments that were expected in the last year, that are now a reality, include the introduction of NAFTA 2.0, which in Mexico will be named T-MEX, and a whole new IP law, which will enter into force in November 5, 2020, named the Industrial Property Protection Law (IPPL).

Intellectual property provisions from the T-MEX, TLCUEM and TPP11 are included in the IPPL, as are the provisions of the Hague Treaty regarding Industrial Designs, since this latter treaty was due to enter into force in Mexico in July 2020.

In regard to patent prosecution and patent litigation, the IPPL has significant developments which are mentioned above and which can be summarised as follows:

- Double patenting prohibition. While this is the current practice, the new practice will introduce an explicit prohibition.
- A grace period for prior disclosures made by third parties in violation or breach of confidential agreements.
- A new legal system for divisional patents that will narrow the possibilities for patent owners to divide their parent application multiple times.
- A new “Bolar” clause for biotechnological and chemical inventions.

- Supplementary Patent Certificates (SPCs) to compensate for the delay in granting the approvals of marketing authorisations.
- Prohibition for narrowing the scope of the allowed claims when an invalidity action has started.
- Authority to allow monetary damages after infringement ruling are granted to the IMPI. In such case, the IMPI will open an incidental proceeding to rule on this matter.
- Direct jurisdiction to Civil Courts, both Federal and Local, to rule on damages.
- The 40% rule as described above remains in place.
- A new conciliation proceeding before the IMPI has been introduced.

8.2 Are there any significant developments expected in the next year?

New regulations for the IPPL are expected later in 2020 or during the first semester of 2021. Regulations cannot exceed the general legal framework provided by law, and therefore no substantial changes are expected but rather specific provisions on to how to apply the law.

8.3 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

In past years it has been a trend to file *ex parte* post-grant amendments to patents when invalidity actions were filed against them; however, this possibility is forbidden in the new IPPL.

On the other hand, use of the new civil venue for collecting damages for IP violations, including patent violations, will certainly be a trend in the coming years.



Daniel Sanchez y Bejar joined OLIVARES in 2000 and became a partner in 2011. He is one of the leading intellectual property (IP) and administrative litigators in Mexico and is recognised by industry rankings and publications.

Mr. Sanchez's work is extensive, with experience in prosecution and litigation across all areas of IP, including trademarks, copyrights, patents and unfair competition. His broad background allows him to tailor enforcement strategies to a range of needs. His practice is focused in litigation and regulatory matters, with a specialisation in life sciences and technology. Mr. Sanchez co-chairs OLIVARES' Litigation Team, the Patent Team and the IT industry group. His team is focused on litigation before the Mexican Institute of Industrial Property (IMPI) and the Federal Courts and in patent prosecution before IMPI. As one of the few regulatory and administrative litigation experts in Mexico, Mr. Sanchez guided the development and implementation of a revolutionary and proprietary software system that replicates the drug naming and labelling approval process within COFEPRIS, Mexico's health ministry.

OLIVARES

Pedro Luis Ogazón 17
Col. San Ángel
C.P 01000 Mexico City
Mexico

Tel: +55 5322 3000
Email: daniel.sanchez@olivares.mx
URL: www.olivares.mx



Sergio L. Olivares, Jr. joined OLIVARES in 1987 and has been practising intellectual property (IP) law for more than three decades. He has been a partner since 1994 and Chairman of the firm's Management Committee since 2009. He is proficient across all areas of IP law, but works most closely with the firm's Patent Group. Mr. Olivares is highly recommended by leading industry publications and directories as a leader in IP. He has been integral to Olivares' expansion into new and innovative practice areas; has been at the helm of cases that are helping to shape the standard for evaluating inventive step and novelty for pharmaceutical patents; and was involved in a landmark Supreme Court case that changed the landscape for unfair competition enforcement in Mexico. Mr. Olivares received his J.D. from the Universidad Intercontinental in 1991 and graduated from the Franklin Pierce Center for Intellectual Property in 1993.

OLIVARES

Pedro Luis Ogazón 17
Col. San Ángel
C.P 01000 Mexico City
Mexico

Tel: +55 5322 3000
Email: sergio.olivares@olivares.mx
URL: www.olivares.mx

OLIVARES began in 1969 as an intellectual property boutique. Today, the IP Practice serves many different industries, receives numerous awards for excellence in legal service, and leads the charge in protecting clients' valuable IP assets. Whether navigating complex pharmaceutical patent regulations, developing trademark protection strategies, or litigating copyright disputes, OLIVARES gets results.

The award-winning patent attorneys and engineers specialise in the fields of chemistry, biotechnology, pharmacology, mechanics, electronics, computer programs (software), bioinformatics and nanotechnology, among others, and work with some of the world's largest companies to help secure patent rights in Mexico and across Latin America.

Now, with more than 50 years in business, OLIVARES continues its legacy of excellence in client service and attracts clients from all areas of Mexico in addition to clients from foreign countries needing counsel regarding Mexican laws, regulations and cases.

www.olivares.mx



ICLG.com

Current titles in the ICLG series

Alternative Investment Funds
Anti-Money Laundering
Aviation Finance & Leasing
Aviation Law
Business Crime
Cartels & Leniency
Class & Group Actions
Competition Litigation
Construction & Engineering Law
Consumer Protection
Copyright
Corporate Governance
Corporate Immigration
Corporate Investigations
Corporate Tax
Cybersecurity
Data Protection
Derivatives
Designs
Digital Business

Digital Health
Drug & Medical Device Litigation
Employment & Labour Law
Enforcement of Foreign Judgments
Environment & Climate Change Law
Environmental, Social & Governance Law
Family Law
Fintech
Foreign Direct Investment Regimes
Franchise
Gambling
Insurance & Reinsurance
International Arbitration
Investor-State Arbitration
Lending & Secured Finance
Litigation & Dispute Resolution
Merger Control
Mergers & Acquisitions
Mining Law
Oil & Gas Regulation

Outsourcing
Patents
Pharmaceutical Advertising
Private Client
Private Equity
Product Liability
Project Finance
Public Investment Funds
Public Procurement
Real Estate
Renewable Energy
Restructuring & Insolvency
Sanctions
Securitisation
Shipping Law
Telecoms, Media & Internet
Trade Marks
Vertical Agreements and Dominant Firms