



National Group: MEXICO

Title: Questionnaire Apotex Inc. v Sanofi-Aventis
Proposed AIPPI intervention – Supreme Court of Canada appeal

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Questions

A. Utility or industrial applicability requirement

1. Does your national law have a utility or industrial applicability requirement for patentability?

Yes.

2. Please briefly describe the utility or industrial applicability requirement, including whether it is based on:
 - (a) statute;
 - (b) jurisprudence; or
 - (c) both.

Statute. Articles 12 section IV and 16 of the Industrial Property Law (IPL), provide that any invention needs to meet novelty, inventive step and subject to industrial applicability. The latter is defined as: “the possibility that an invention has practical utility or can be made or used in any branch of economic activity, for the purposes stated in the application.” Finally, articles 47 and 55 of LPI provide other requirements for showing the industrial applicability in the specification and for submitting further information during prosecution of the patent application.

3. What must be disclosed in the patent specification to satisfy the utility or industrial applicability requirement? In particular, must the patent specification disclose:
 - (a) the utility or industrial applicability;
 - (b) a basis (eg test data) to prove or demonstrate that the utility or industrial applicability is achieved; and/or
 - (c) a basis (eg test data) and/or a line of reasoning from which the utility or industrial applicability may be predicted?

Upon its legal definition the Industrial applicability concept is set as the possibility of an invention for having a practical utility or can be made or used in any branch of economic activity. In that sense, industrial applicability needs to be understood as “possible utility” rather than “actual utility”. After LPI’s amendments made by the Mexican Congress in 2010, it could be understood that the purposes for what the invention is addressed (that possible utility) needs to be disclosed in the specification.

Article 47, section I of LPI also provides the need of disclosing information that exemplifies the industrial applicability “possible utility” in the specification. In the practice, test data is requested by Mexican Examiners in the pharmaceutical field, to show that “possible utility”, whereas in the mechanic and electrical fields are commonly understood from the specification.

4. Is the basis for any disclosure required in the patent specification:

- (a) statute;
- (b) jurisprudence; or
- (c) both?

Statute.

B. Prosecution

5. Is it necessary to demonstrate utility or industrial applicability during prosecution?

Yes.

6. Is the requirement to demonstrate utility or industrial application during prosecution based on:

- (a) statute
- (b) jurisprudence; or
- (c) both?

Statute.

7. Is there a material date by which the utility or industrial applicability be demonstrated?

There is no clear answer for this question in the LPI. Article 12, section IV of LPI, provides the need of disclosing the industrial applicability in the specification. Article 47, section I provides the need of disclosing information that exemplify the industrial applicability in the specification, however, article 55 of LPI also provides the opportunity for applicant to submit further information during the prosecution of the patent application.

8. What evidence is required to demonstrate utility or industrial applicability? For example:

- (a) can post filing evidence be used; and/or
- (b) can the applicant rely upon the utility or industrial applicability being soundly predicted as opposed to demonstrated?

What it is required is to state in the specification the industrial applicability and include in case of being necessary information that exemplifies it, having the opportunity to submit further information for this purposes later on. However, in accordance with the definition of

industrial applicability it could be enough to rely upon the industrial applicability stated in the specification.

C. Litigation

9. Is lack of utility or industrial applicability a basis for a validity attack in litigation?

Yes.

10. Is such attack permitted by reason of:

- (a) statute;
- (b) jurisprudence; or
- (c) both?

Statute.

11. Is there a material date by which the utility or industrial applicability must be demonstrated?

There is no clear answer for this question in the LPI. Article 12, section IV of LPI, provides the need of disclosing the industrial applicability in the specification. Article 47, section I provides the need of disclosing information that exemplify the industrial applicability in the specification, however, article 55 of LPI also provides the opportunity for applicant to submit further information during the prosecution of the patent application.

12. What evidence may the patentee adduce in response? For example:

- (a) can post filing evidence be used; and/or
- (b) can the patentee rely upon the utility or industrial applicability being soundly predicted as opposed to demonstrated?

What is required is to state in the specification the industrial applicability and include in case of being necessary information that exemplifies it, having the opportunity to submit further information for this purposes later on. However, in accordance with the definition of industrial applicability it could be enough to rely upon the industrial applicability stated in the specification.