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Q244

Inventorship of multinational inventions

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I. Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

Inventorship is defined in the Mexican Industrial Property Law (IPL) as follows:

Article 9 provides that the natural person that makes an invention, utility model or industrial design has the exclusive right to use such invention, utility model or industrial design.

Article 10bis. The right to obtain a patent or a registration shall belong to the inventor or designer, as the case may be, without prejudice to the provisions of Article 14 of this Law. If two or more persons have made the invention, utility model or industrial design jointly, the right to obtain the patent or registration shall belong to them jointly.

Article 13 provides that the natural person(s) appearing in the application as inventor(s), is/are presumed to be the inventor(s) of the patent or registration.

a. If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

Mexican law is silent regarding express means for determining inventorship.

However, as mentioned before, the person(s) appearing as the inventor(s) in the application is/are presumed to be the inventor(s). In this regard, if both A and B are both named in the application, they both would be deemed as inventors.

Now then, if there is not agreement regarding inventorship, the following must be considered. According to Article 10 BIS of the IPL, if the invention, utility model or industrial design was made by two or more persons jointly, the right to obtain a patent or registration belongs to them all in conjunction.

The natural person (inventor) that MAKES an invention (a human creation) shall have the rights for using it pursuant to Art. 9, of the IPL. This means that both, person A and B could be considered inventors for the purposes of the patent under Mexican law because both were instrumental in reducing the invention to practice. The invention could not have been made without the knowledge and ideas of person A but it would also have been impossible to make without the skills of person B. These facts lead to the inevitable conclusion that the invention was the result of the joint effort of both persons, that is, the invention was made jointly. Accordingly, there is no doubt that Article 10 Bis of the IPL is applicable and the right to obtain a patent (reserved to inventors under Art. 9), belongs to both A and B in conjunction.

b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

Please comment:

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

Please comment:

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

Please comment:

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

If yes, what are the requirements and time limits for such correction?:

There is no time limit provided by the IPL, thus it is understood that this can be done during the validity of the patent.

As to the requirements, the change must be proved with documents showing why the inventorship changes are required.

In other words, in case an inventor has to be incorporated to the application, documents such as affidavits with the consent of the inventor(s) must be filed before the Patents Office, in order for this to proceed.

Likewise, for removing an inventor, documents with the consent of all the inventors should be filed. This may be achieved through a civil action before a Federal Civil Court; in any case the inventors must prove why the person that will be removed does not have the right to be mentioned as inventor.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

Since the inventorship may be corrected at any time, at first glance we would say that this does not lead to invalidation or no enforceability. In this case, the intentionality is not relevant since as mentioned before, inventorship is correctable.

However, we must consider that in case a conflict between the inventors is raised, the inventor claiming that he was not included in the application could file an invalidity action pursuant to section IV of Article 78 of the IPL, on the basis that the patent was granted to a person that was not entitled to it. In this case the intentionality will matter

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

If no please comment:

The IPL does not require that a patent application claiming an invention made in Mexico has to be filed first in our country.

a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

7)	Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?
	no If no please comment: The IPL does not require that a patent application claiming an invention made, at least in part in Mexico has to undergo a secrecy review or any other similar process, before it can be filed in another country

II. Policy considerations and proposals for improvements of the current law

8)	If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?
	As mentioned before the IPL provides an inventorship presumption, however, the law provides that inventor is the natural person that makes an invention. Likewise, the IPL defines invention, thus, we consider that it is understood that inventor is the natural person making a human creation to transform energy or matter to benefit and satisfy human needs. Such invention is defined by the corresponding claims, thus the participation of the inventors, in the making of the invention, must be included in such claims.

9)	If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?
	Since the IPL does not require first filing requirement for patent applications of inventions made in Mexico, this question cannot be responded.

10)	If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?
	Since the IPL does not require a secrecy review of patent applications of inventions made in Mexico, this question cannot be responded.

11)	Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.
	As mentioned before, the IPL does not provide special provisions regarding multinational inventorship, thus all the inventors are treated the same.

III. Proposals for harmonisation

12)	Is harmonisation in this area desirable?
	yes Please comment.:

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13)	Please provide a definition of inventorship that you believe would be an appropriate international standard.
	The following definition is proposed: Inventor is the natural person(s) that makes an invention as claimed in a patent application, as defined in the law, which contributed directly and effectively to its creation process

14)	Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).
	<p>First of all, correction of inventorship should be allowed at any time, i.e. during the pendency of the application and after it has been granted.</p> <p>Name corrections and other errors similar in nature should be corrected with a simple petition filed by the applicant or patent owner.</p> <p>Now, in case there is no conflict regarding the inclusion or removal of one or several inventors, the correction should be accepted by filing a written consent of all the inventors in case of addition of one or more inventors. In case of removal of inventors with their mere written consent should be sufficient. In cases where consent of inventors to be removed cannot be obtained, with the written consent of all remaining inventors.</p> <p>In case a conflict in this regard is faced, this is, if one of the inventors is not included or does not want to be removed, a petition filed by the interested party should be received by the Patent Office.</p> <p>In this petition the interested party should file all the evidence to prove: that he participated in the creation of the invention thus having the right to be included or to remain as inventor; and, the other inventors should have the right to file evidence proving that the petitioner does not contributed to the creation process does not having the right to be included or remain as inventor.</p>

15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

First filing requirements should not be considered appropriate regarding multinational inventions.

16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

Secrecy reviews requirements should not be considered appropriate regarding multinational inventions

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

This requirement is not appropriate.

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

This requirement is not appropriate.

19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

Multinational inventions should not be treated differently nor have special standards for inventors based on their nationality.

Summary

The Mexican Industrial Property Law (MIPL) defines inventorship in articles 9, 10bis and 13, providing that a natural person making an invention, utility model or industrial design has the exclusive right to use such invention, utility model or industrial design.

The right to obtain a patent or a registration belongs to the inventor or designer. If two or more persons have made the invention, utility model or industrial design jointly, the right to obtain the patent or registration shall belong to them jointly.

Likewise, the natural person(s) appearing in the application as inventor(s), is/are presumed to be the inventor(s) of the patent or registration.

On the other hand, the MIPL does not rely on or look to a particular part of the

patent application nor provide special provisions regarding the citizenship of the inventor(s) or the place where the invention was made.

However, the inventorship of a patent application can be corrected after the filing date in Mexico, without having time limits but the validity of the patent.

As to the requirements for these corrections, the solicitor has to prove, with documents, why the inventorship changes are required.

In case a conflict between the inventors is raised, the inventor claiming that he was not included in the application could file an invalidity action pursuant to section IV of Article 78 of the MIPL, on the basis that the patent was granted to a person that was not entitled to it.

Finally, the MIPL does not provide special rules regarding first filing requirements, secrecy review or multinational inventorship for patent applications of inventions made in Mexico.

In light of the foregoing the conclusion is that harmonization in this area is desirable.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.