Clarke, Modet & Cº
MÉXICO

Av. Insurgentes Sur 1647
Piso 15, Of. 1502
Col. San José Insurgentes
CP. 03900, Ciudad de México
México
Tel.: + 52 55 53402300
Fax: + 52 55 55236418

September 14, 2018

Dear Colleagues,

The Clarke Modet & Co. Team is committed to keep our valued clients informed about any developments related to IPRs in Mexico. In this sense, we would like to take a moment to inform you about the new criteria applied by Mexican Patent Office's (MPO) Examiners concerning plant-related inventions.

Recently, we have been served with recurrent office actions raising objections on the patentability of non-genetically modified plants, which led us to arrange several meetings with MPO's high-rank officers to inquire whether a change had occurred.

As a result of these meetings, MPO's officers have confirmed that there is indeed an internal policy for objecting patent applications related to products obtained from essentially biological processes, even though no patent examination guidelines have been issued. The new criteria arose in October 2017 and it is expected to be maintained indefinitely. These new criteria affect all pending applications and could be considered in nullity procedures related to granted patents, nevertheless, according to the MPO's officers, granted patents would not be invalidated *ex-officio*. Unfortunately, no official document has been issued and, up to date, there is no project for amending the Mexican Patent Law in this regard.

The change of criteria has no clear technical or legal basis. Apparently, the MPO is harmonizing their criteria with those of the European Patent Office (EPO). Accordingly, since the EPO's position to exclude plant-related inventions from patentability has been formalized, the MPO has consistently adopted the new criteria.

In short, according to the new criteria, products (plants) obtained by essentially biological processes will no longer be patentable nor all the essentially biological methods for obtaining plants, even if involving a technical step.

For your easy reference, please refer to the attached document for reviewing the most important remarks of the new criteria applying to plant-related inventions in Mexico.

In the hope the above information proves useful, we remain at your complete service should you have any doubts or wish to further discuss this matter.

Clarke, Modet & Cº
MÉXICO

Av. Insurgentes Sur 1647
Piso 15, Of. 1502
Col. San José Insurgentes
CP. 03900, Ciudad de México
México
Tel.: + 52 55 53402300
Fax: + 52 55 55236418

Important IP Update

Patentability of plant-related inventions in Mexico: New criteria.

i. Products obtained by essentially biological process are no longer patent-eligible, regardless of the claim language, format, or drafting used (even if material deposited under the Budapest Treaty is claimed).

ii. The MPO currently considers as examples of "essentially biological process for producing plants", a procedure involving the crossing of the whole genomes of two plants and selecting a plant having the desired traits.

iii. Adding a technical step to the process of crossing and selection, such as using molecular markers, does not modify the "essentially biological" nature of crossing and selection. Thus, MPO's officers confirmed that plants produced by marked-assisted breeding are now excluded from patentability.

iv. Asexual propagation and hybridization methods and products thereof are not patentable either. The patentability of methods using other plant breeding techniques would be assessed on a case-by-case basis.

v. As examples of non-essentially biological processes for producing plants, the MPO's officers mentioned man-induced mutagenesis, genetic engineering, and in vitro technologies even if they do not involve recombinant DNA technology.

vi. Likewise, methods for identifying and methods for selecting plants having desired traits are patentable subject-matter.

Therefore, since essentially biological processes for producing plants and the plants thereby produced are now excluded from patentability, the claims on plants obtained from essentially biological processes are being consistently rejected.

Finally, despite that granted patents covering products of biologically essential processes shall not be invalidated *ex officio,* if a third party with a legal interest filed a nullity action, the Patent Office could assess said patents with the new criteria.