



**MEMORANDUM OF UNDERSTANDING ON
TECHNICAL AND STRATEGIC COLLABORATION
BETWEEN
THE MEXICAN INSTITUTE OF INDUSTRIAL PROPERTY
OF THE UNITED MEXICAN STATES
AND
THE UNITED STATES PATENT AND TRADEMARK OFFICE**

The Mexican Institute of Industrial Property of the United Mexican States (IMPI) and the United States Patent and Trademark Office (USPTO), hereinafter jointly referred to as "the Offices";

SEEKING to strengthen their mutually beneficial cooperation in technical and strategic areas of common interest, established by the Memorandum of Understanding on Bilateral Cooperation on Industrial Property Cooperation between the Mexican Institute of Industrial Property of the United Mexican States and the United States Patent and Trademark Office, signed by the heads of the Offices on April 22, 2013, in Alexandria, Virginia, United States of America and the Patent Prosecution Highway (PPH) Program effective between the Offices since March 1, 2011;

RECOGNIZING that a strong patent system is essential for stimulating innovation, entrepreneurship, economic development and mutually beneficial technology transfer;

ACKNOWLEDGING the importance of ensuring high-quality patent processes and legal certainty in the proper functioning of the patent system in view of common challenges brought about by globalization, digitalization and emerging technologies;

CONSIDERING the impact of intellectual property (IP) on socio-economic development and the importance of raising IP awareness and facilitating capacity building;

SEEKING a response to the growing number of patent applications filed in multiple jurisdictions, reflecting an increasing demand for patent protection;

NOTING the common objective of providing efficient, user-friendly and predictable patent systems for the benefit of domestic and foreign applicants alike;

CONSIDERING the advantages to patent offices by avoiding duplicative work through work sharing and increasing efficiency and quality in the patent examination process;

SEEKING to strengthen search and examination capacities and skills to ensure a high quality, timely and efficient examination;



AIMING to ensure the high-quality, timely and efficient processing of patent application filings at IMPI through systematic and efficient reutilization of USPTO search and examination results, and for USPTO to provide the technical support required to achieve this;

CONSIDERING that cooperation instruments between the IMPI and the USPTO benefit applicants through high-quality, expeditious, and inexpensive examination, and benefit the Offices by avoiding duplicate work and reducing patent workload;

RECOGNIZING that the effectiveness of technical cooperation between the Offices may depend on the extent to which the respective substantive patent laws and patent examination practices are aligned or similar;

HAVE REACHED THE FOLLOWING UNDERSTANDING:

1. Purpose

The purpose of this Memorandum of Understanding (MoU) is to set up flexible framework to facilitate development of a mutually beneficial long-term collaboration between the Offices in strategic and technical areas of common interest in the field of patents, in accordance with the Offices respective responsibilities in this area.

2. Common cooperation objectives

Within the scope of this MoU, the Offices intend to:

- a. Ensure efficient patent examination and high patent quality in order to foster innovation and economic development, support bilateral trade and investment between the United Mexican States and the United States of America;
- b. Increase the quality, efficiency and timeliness of the processing of patent application filings at the IMPI by efficiently reutilizing USPTO prior art searches and examination results on counterpart patent applications at IMPI;
- c. Increase the quality, efficiency and timeliness of the processing of patent applications at the IMPI through the exchange of information and good practices with the USPTO, including training and other technical support pursuant to the terms of this MoU;
- d. Ensure long-term sustainability of bilateral cooperative activities by exchanging best practices in areas relevant to this MoU;
- e. Establish regular exchanges of patent information, to enhance patent examination quality and legal certainty, and



- f. Promote patent information and related tools as beneficial instruments for stimulating innovation, commercialization and mutually beneficial technology transfer.

3. Efficient reutilization of USPTO search and examination results by IMPI in the examination of counterpart patent applications

3.1. Efficient reutilization USPTO searches and examination results

The Offices intend to implement a framework for the efficient reutilization of USPTO search and examination results to allow the IMPI to enhance and expedite the processing of counterpart patent applications with the same earliest date of priority. The IMPI intends to perform substantive examination of patent applications consistent with Mexican law and regulations.

For purposes of this MoU, “efficient reutilization” refers to relying on USPTO prior art search and examination results in the review of a counterpart patent application by the IMPI. The IMPI may consult USPTO to define aspects related to timeliness and reliance on USPTO search and examination results.

The USPTO intends to assist the IMPI in preparing and revising patent examination guidelines setting out, *inter alia*, technical and procedural details concerning IMPI’s efficient reutilization of USPTO search and examination results.

The Offices do not intend for this MoU to affect validity determinations in Mexico after grant of a patent by the IMPI. The Offices intend for Mexican laws and regulations to govern such determinations.

3.2. Technical cooperation measures to support the efficient reutilization of USPTO search and examination results.

To facilitate the implementation of section 4 of this MoU, the USPTO may provide the IMPI with the following:

- a. Exchange of information and cooperation activities such as seminars, workshops, conferences, among other actions, that may be useful to better access, interpret and effectively use USPTO search and examination results;
- b. Technical assistance for the effective implementation of this MoU.
- c. Other cooperation mechanisms, as decided by the Offices.



4. Technical and strategic cooperation

4.1. Technical cooperation for effectively processing patent applications

The USPTO and the IMPI may decide to conduct training and other cooperation activities such as seminars, workshops, conferences, among other actions to facilitate implementation of this MoU.

These may include exchange of best practices between patent examiners and training.

4.2. Supporting infrastructure

The Offices intend to independently upgrade and enhance their respective information technology systems. The Offices may exchange information in this regard, where appropriate.

4.3. Exchange of patent information

The Offices intend to exchange patent information concerning quality, timeliness, and procedural aspects impacted by this MoU.

4.4. Patent support, promotion and raising awareness activities

The Offices may cooperate in raising awareness campaigns, promotion activities and other initiatives to support use of the patent system by relevant stakeholders, which may include small and medium-sized enterprises, chambers of commerce, and universities.

The Offices may conduct studies and reports, as well as develop support materials in the fields covered by this MoU.

The Offices may, where appropriate, inform and consult the public on their bilateral cooperation activities.

Each Office may invite the other to provide instructors and speakers for seminars and training courses that it has organized, subject to available resources.

4.5. Exchange of best practices in patent examination and administration

The Offices may, where feasible, exchange information on their respective patent grant procedures, classification systems, quality assurance and examination practices, as well as in connection with their respective implementation of the Patent Cooperation Treaty, done at Washington on June 19, 1970 (PCT), with a view to improving the functioning of their respective patent systems.



5. Cooperation work plans

The Offices intend to cooperate in the draft of periodic work plans that set out anticipated activities under this MoU.

The work plans may detail implementation and functioning of the IMPI's efficient reutilization of USPTO search and examination results. The Offices may periodically evaluate and exchange information resulting from the work plans.

A work plan may not to be construed as amending this MoU. In case of any conflict between a work plan and the provisions of this MoU, the Offices intend for this MoU to prevail.

6. Program coordination

Each Office may appoint a coordinator who may be in charge of implementing, monitoring and evaluating the cooperation activities arising from this MoU.

The coordinator may also act as the main contact point for all communications between the Offices and coordinate bilateral exchanges and activities resulting from this MoU.

The Offices may hold regular consultations and meetings, both at a working and management level, to monitor and review the implementation or interpretation of this MoU.

7. Funding of the cooperation

The Offices intend that the implementation of any activity under this MoU is subject to the availability of funds required to finance it, as well as the availability of other necessary means and resources. Activities may also be subject to procurement processes and travel-related policies at each Office. The Offices intend to finance its own activities.

8. Status of assigned staff

The Offices intend for any staff assigned to coordinate cooperation activities of this MoU to remain under the direction and authority of their respective Office. The Offices do not intend for any employment relationship to exist between staff of one Office and the other Office.

9. Modifications

This MoU may be modified by mutual consent of the Offices either in a modifying MoU or by exchange of letters, specifying the starting date of the modifications and signed by the authorized signatory or signatories of each Office.

10. Consultations

The Offices may hold consultations at any time, in order to address any issue regarding the interpretation or implementation of this MoU.

11. Duration

The Offices intend for this MoU to take effect the day of its signature and to continue in effect for a period of five (5) years. This MoU may be extended for up to five (5) years by mutual consent of the Offices.

Either Office may terminate this MoU at any time but should give at least ninety (90) calendar days' written notice to the other Office, except as otherwise provided in this MoU.

In the case of early termination of this MoU, the efficient reutilization of USPTO search and examination results by the IMPI as per section 3 of this MoU may continue during the notice period and the Offices may mutually consent to continue any cooperation activities already initiated. To this end, the Offices intend to consent in writing to any details regarding continuation of activities.


12. Miscellaneous

This MoU does not create any rights or obligations under international or domestic law. The Offices implement this MoU within the framework of their respective laws and regulations.

This MoU is in two original copies, in the Spanish and English languages, both texts being equally valid.

**FOR THE MEXICAN INSTITUTE OF
INDUSTRIAL PROPERTY OF THE
UNITED MEXICAN STATES**

**FOR THE UNITED STATES PATENT
AND TRADEMARK OFFICE**



Juan Lozano Tovar
Director-General



Andrei Iancu
Under Secretary of Commerce for
Intellectual Property and Director

Signed at Mexico City, Mexico on January 28, 2020.