2023 GLOBAL IP DIRECTORY

GLOBAL REACH, LOCAL KNOWLEDGE

CTC Legal Media *Publishers of*

The Patent Lawyer
www.patentlawyermagazine.com

The Trademark Lawyer
www.trademarklawyermagazine.com

The Life Sciences Lawyer
www.lslawmag.com

Mexico

Sponsored by

Santamarina + Steta


Perspective.
Innovation.
Growth.

Santamarina + Steta

Our experts provide high-quality services by making our clients' challenges their own.
We provide efficient and complex IP services with a business perspective to different industries.

We protect, defend and enforce your intangible assets, such as:

PATENTS • COPYRIGHTS • FRANCHISES • TRADEMARKS PLANT VARIETIES • INDUSTRIAL DESIGNS • TRADE SECRETS GEOGRAPHICAL INDICATIONS • DOMAIN NAMES

José Pablo Pérez Zea
jperez@s-s.mx

Daniel Legaspi J.
dlegaspi@s-s.mx

Efraín Olmedo
eolmedo@s-s.mx

santamarinasteta.mx

Mexico City +52 55 52795400
Monterrey +52 81 81336000
Querétaro +52 442 2900290

Patentability of mobile applications in Mexico

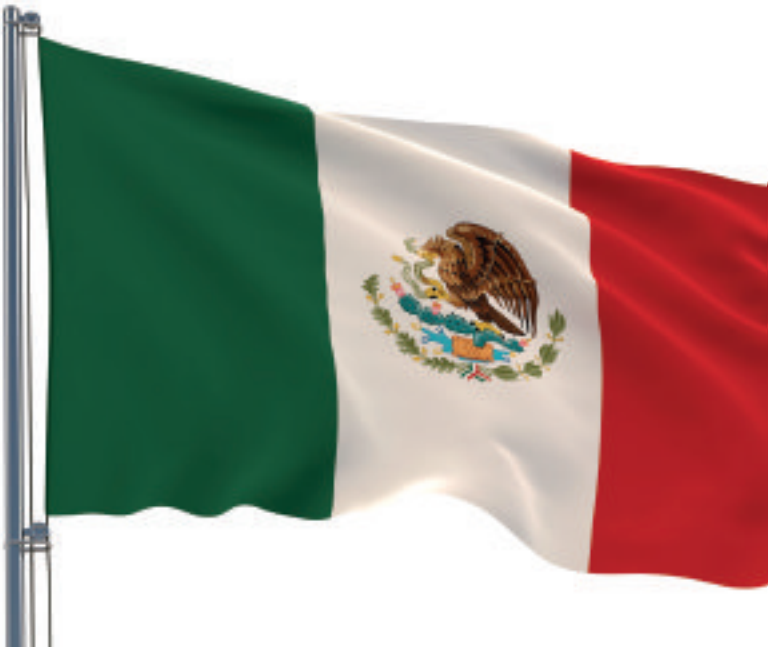
Santamarina + Steta experts explain the available methods for protecting software innovations in the mobile applications.

A patent is an exclusive right granted on an invention that has the following properties: (i) Novelty, which, according to Mexican legislation, anything that is not considered to be "prior art", i.e., that is information in the public domain; (ii) Industrial Application, which implies that the invention must have a practical utility that results in a benefit to society, being susceptible to its production and use in any branch of economic activity, for determined purposes; and (iii) Inventive Activity, which represents the technical development, consisting in the creative process whose results should not be deduced from the prior art in an obvious or evident way for a technician in the field.

This exclusive right empowers its owner to decide whether the invention may be used by third parties and, if so, in which manner, since patent protection means that an invention may not be produced, used, distributed for commercial purposes, or sold without the owner's consent.

Now, mobile applications have become an indispensable part of daily life in the digital world. Their economy has grown exponentially, driven by a vast community of software developers. In order to understand the figure for its protection, it is necessary to understand the difference between a computer program, software, and a mobile application.

First of all, a **computer program** is an original expression in any form, language, or code, of a set of instructions that, with a specific sequence,



structure, and organization, is intended for a computer or device to perform a specific task or function. On the other hand, the **software** is a set of computer programs, instructions and computer rules that allow the execution of different tasks, that is, a computer program is the foundation of software since several programs are needed to create it.

Now then, **mobile applications** are usually small software units with different functions that provide users with quality services and experiences, designed to run on a mobile device.

There is no doubt that mobile applications come from human invention and therefore should find protection in Intellectual Property; however, the mechanisms for their protection

> **It would be possible to patent a mobile application as long as it has a technical nature and meets the requirements of novelty, inventive activity, and industrial application.**

depend on the jurisdiction in which protection is sought.

The idea of patenting a mobile application under industrial property rights is common in other jurisdictions; however, the Federal Law for the Protection of Industrial Property applicable in Mexico, in its article 47 stipulates that computer programs cannot be considered inventions by themselves. In the same sense, the last paragraph of the aforementioned article establishes the possibility of patenting a computer program, as long as it is not only claimed as part of the invention but is composed of additional inventive elements.

Consequently, although the existing computer programs and software on the market cannot be protected by the patent figure, it would be possible to patent a mobile application as long as it has a technical nature and meets the requirements of novelty, inventive activity, and industrial application. In order to achieve this, the mobile application should satisfy different requirements such as interacting autonomously with its environment, gathering information, and returning results based on data collection, or being part of a medical device, for example.

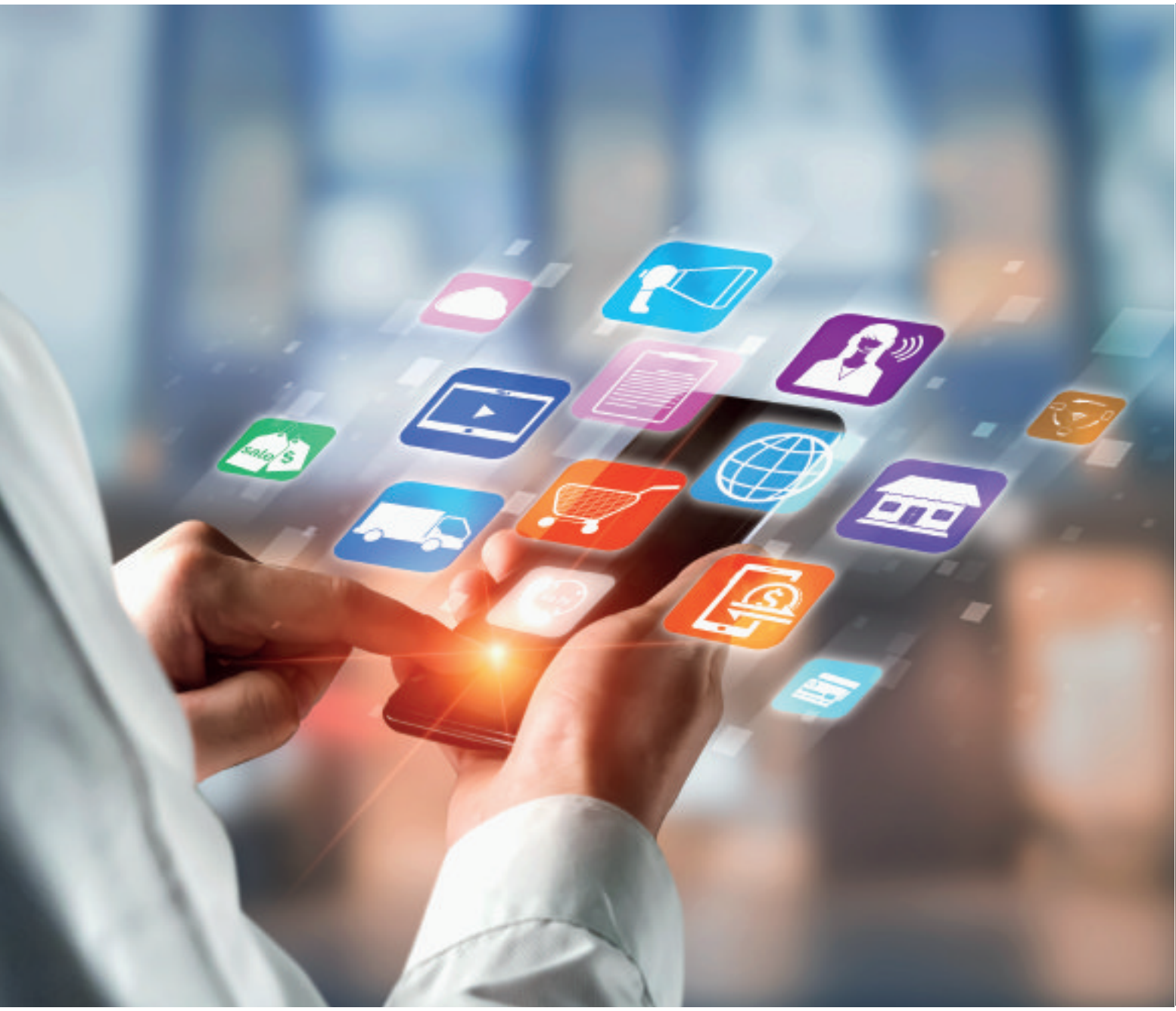
It should not be forgotten that a patent is granted for a unique invention that is developed to provide a technical solution to a certain problem and the solution to this problem cannot replace other existing technical or physical solutions.

On the other hand, it is important to point out that computer programs (source code or object) are protected by copyright in Mexico, thus, according to our legislation, the protection of works is granted from the moment they have been fixed in a material medium, regardless of their merit, destination or mode of expression.

In this regard, it is important to note that the moral rights of the work will always belong to its author. On the other side, the patrimonial rights of the work will be in force during the life of the author, plus one hundred additional years counted from his death or one hundred years after having been disclosed.

Likewise, according to our legislation, it is possible to assign the patrimonial rights of a work, but unlike trademark rights, this assignment is not indefinite or perpetual, since after a certain term the patrimonial rights must return to their original owner. Our Law stipulates that, in the event that the parties do not expressly establish an agreement, this term will be five years and that the term may only be longer than 15 years when the investment or the magnitude of the project demands.

Fortunately, with respect to computer programs, Article 103 of the Federal Copyright Law establishes an exception, which allows the assignment of rights of these works to be not limited to a defined term. On the other hand, it is also important to note that the Law provides that the ownership of computer works that have been entrusted by employers to their employees, as a function of their work, will belong to the employer.



Notwithstanding the foregoing, it is always advisable that in those cases where the creation of the computer program is entrusted to third parties, without any employment relationship between the parties involved, a "work for hire" contract is executed, which will allow that from the moment of the creation of the computer program, the ownership of the economic rights is recognized to the person who entrusted the creation of the work.

In this sense, the economic rights of a computer work entitle its owner to authorize or prohibit: i) the permanent or provisional reproduction of the program, ii) the translation, adaptation, arrangement or any modification to the program, as well as the reproduction of the resulting program, iii) any form of distribution of the program or any copy thereof, iv) the decompilation, reverse engineering, and disassembly and, v) the public communication of the program.

Consequently, seeking the protection of mobile applications, in addition to allowing their owners to take the previously mentioned actions with respect to the work, also allows an adequate defense of the same against third parties who make unauthorized use or reproduction of the same. This allows that at a commercial level exists legal actions against those competitors who reproduce the work or

use it, either to market it under another name or to manage their business.

An important element to take into consideration is that, although computer programs are protected by the Federal Copyright Law *per se*, the fact is that the knowledge of infringement proceedings in the field of commerce is taken before the Mexican Institute of Industrial Property, which at the request of the owner may initiate actions consisting in the seizure of merchandise, prohibition of commercialization, closing of the establishment, among other precautionary measures.

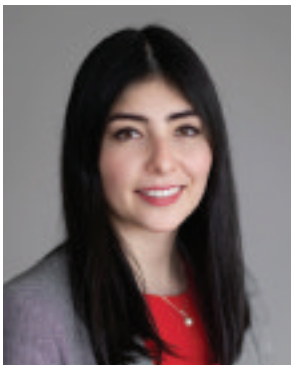
In this regard, it should be noted that contrary to the protection provided by the patent, copyright protection has an extraterritorial scope and is recognized in several jurisdictions as a result of the signing of international treaties on the subject. However, those programs that manage to obtain patent protection will only enjoy an exclusive right in the jurisdiction that grants the registration.

This should be taken into consideration when seeking protection for mobile applications, specifically in Mexico.

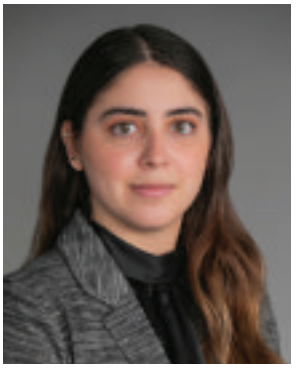
Contact

Santamarina + Steta
Campos Eliseos, 345 floors 2 and 3
Polanco Chapultepec, Miguel Hidalgo
11560, Mexico City, Mexico.
Tel: +52 55 52795400
Web: santamarinasteta.mx

Authors:



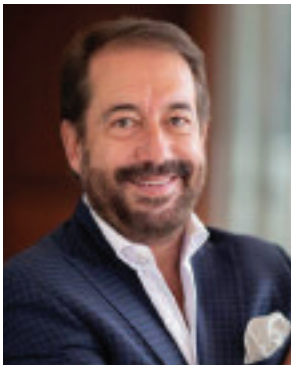
Ivanna Craviotto
icraviotto@s-s.mx



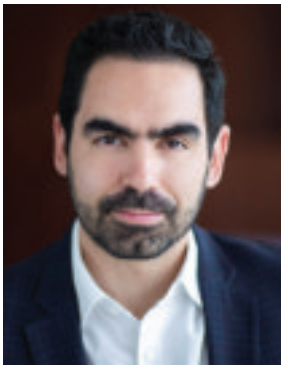
Faride Hage
fhage@s-s.mx

Samantha Maldonado
smaldonado@s-s.mx

Co-authors:



José Pablo Pérez Zea
jperez@s-s.mx



Daniel Legaspi
legaspi@s-s.mx

References:

Patentes. OMPI Organización Mundial de la Propiedad Intelectual. Recuperado de: https://www.wipo.int/patents/es/
La innovación y la propiedad intelectual. OMPI Organización Mundial de la Propiedad Intelectual. Recuperado de: https://www.wipo.int/ip-outreach/es/ipday/2017/innovation_and_intellectual_property.html
Derechos de Autor. OMPI Organización Mundial de la Propiedad Intelectual. Recuperado de: https://www.wipo.int/copyright/es/
https://anincubator.com/que-es-una-aplicacion-movil/
https://definicion.de/software/
https://stileex.xyz/es/diferencia-programa-ordenador-software/#:~:text=Un%20programa%20es%20una%20secuencia,software%2C%20puede%20haber%20varios%20programas.
https://www.bitlaw.com/software-patent/index.html#:~:text=In%20order%20for%20software%20to,is%20eligible%20for%20patent%20protection.
https://www.upcounsel.com/software-patent