

Current challenges in Mexican patent practice: divisional applications and double patenting

Sergio Olivares and Mauricio Samano of OLIVARES explore the evolving landscape of patent law in Mexico, with a focus on the complexities of divisional applications and the challenges faced by applicants navigating the new legal framework.

Since our current IP law (LFPPI) entered into force on November 5, 2020, we have seen several positive changes in Mexican patent practice. Our current IP law contemplates the patentability of medical uses and specifically contemplates the possibility of filing voluntary divisional applications. Another magnificent change in our IP law relates to grace periods. Article 52 of our new law still provides a 12-month grace period wherein public disclosures made by the applicant or their successor in title do not destroy novelty, provided that said disclosure was made within 12 months before the filing date or the priority date. Nevertheless, it broadens the activities that may qualify for getting the grace period, including now any disclosure made directly or indirectly by the inventor(s) or its assignees, as well as any disclosure made by any third party who obtained the information directly or indirectly from the inventor/s or its assignees. Last but not least, our current IP law contemplates for the first time the possibility of requesting patent term adjustment due to unreasonable delays that are directly attributable to the Mexican Institute of Industrial Property (hereinafter referred to as IMPI).

The benefits of our current IP law are clear; however, in practice, we are dealing with a series of erroneous interpretations of our IP law that are complicating the prosecution of patent applications in Mexico. Specifically, Examiners are misinterpreting the articles of our law pertaining to divisional applications and double patenting and raising



Sergio Olivares



Mauricio Samano

objections that lack any basis in our Law. This has been possible because, at this moment, the Regulations of our current IP law are still being drafted, and the applicable Regulations to our current law are those of our previous IP law which do not contemplate any provisions on how to regulate divisional applications and double patenting. In the next paragraphs, we will describe the current challenges we are facing in Mexico and hope to provide a clearer picture for applicants seeking to protect their inventions in Mexico.

Divisional applications

Article 100 of our current IP Law is the main article regulating the filing of divisional applications in Mexico. It contemplates the possibility of filing divisional applications either voluntarily or through a requirement issued by IMPI, such as a lack of unity objection. It also defines the timeframe for filing divisional applications and specifically states that a voluntary divisional application will only be possible if it derives from its parent case. In other words, voluntary divisionals deriving from divisionals will no longer be allowed. The only possible scenario for filing cascade divisionals (divisionals from divisionals) is if the Mexican PTO requests further division through a lack of unity objection. Article 100 of our IP law also mentions that when unity of invention is objected to, any invention or group of inventions that are not included in the initial application or in the application that originated the division cannot be included again in any of said applications.

On the other hand, article 113 of our IP law states that when an application lacks unity of invention, the Examiner will consider only the main invention that is mentioned first in the claims and will evaluate the compliance of the remaining patentability requirements (novelty, inventive step, etc.) only for this invention which is mentioned in first place in the set of claims. In this case, the Mexican PTO will require the applicant to limit the claims to the main invention and, if the case is, to file the corresponding divisional(s) applications.

Article 113 has caused several problems in Mexican patent practice because Examiners are raising a series of objections based on this article, which complicates the strategy for filing divisional applications.

There have been cases in which applicants receive a lack of unity objection in a first office action, and instead of limiting the claims of the parent case to those of the first invention identified by the Examiner, they decide to limit the claims of the parent case to one of the other inventions identified by the Examiner. However, in the second office action, the Examiner states that according to article 113 of our current IP law, the applicant is obligated to limit the claims of the parent case to those of the invention which is mentioned in first place in the set of claims and cannot claim any other invention in the parent case. In some cases, the Examiner has even gone to the extent of requesting the applicant to abandon the parent case and file a divisional application directed to the invention of interest in order to comply with Article 113 of our current IP law. From our point of view, this interpretation of Article 113 of our IP Law is erroneous and does not benefit the applicant. Article 113 only mentions that when unity of invention is objected to, the Mexican PTO will evaluate the invention that is mentioned at the beginning of the set of claims and that the applicant is required to limit the claims of the parent case to those of the "main invention." However, article 113 does not specifically say that the applicant is obligated to limit the scope of the parent case to the invention that is mentioned in the first place of the set of claims and that none of the other identified inventions can be claimed in the parent case. With this interpretation, the Mexican PTO is making an arbitrary decision and forcing the applicant to claim in the parent case an invention that, at that time, may no longer be of commercial interest to him.

Another erroneous interpretation we have observed regards the timing for filing divisional applications after receiving a lack of unity objection. We have seen cases in which, based on Article 113, Examiners request the applicant to file all the divisional applications of interest when replying to the office action that raised the lack of unity objection. In other words, if in the office



Résumés

Sergio Olivares joined OLIVARES in 1987 and has been practicing IP law for more than three decades. He has been a partner since 1994 and Chairman of the firm's Management Committee since 2009. He is proficient across all areas of IP law but works most closely with the firm's Patent Group. Sergio is highly recommended by leading industry publications and directories as a leader in IP. He has been integral to OLIVARES' expansion into new and innovative practice areas and has been at the helm of cases that are helping to shape the standard for evaluating inventive step and novelty for pharmaceutical patents.

Mauricio Samano works in the patent department of our firm. His work in OLIVARES mainly focuses on prosecuting Chemical, Biotechnological, and Pharmaceutical patent applications, as well as providing technical opinions regarding patent infringement. He has experience in conducting state-of-the-art searches and drafting patents, utility models, and industrial design applications. Additionally, he is a member of the International Patent Law and Trade Committee, as well as of the Latin American Practice Committee of Intellectual Property Owners (IPO) organization.



action, the Examiner raises a lack of unity objection and identifies three inventions, the applicant is required to keep the first invention in the parent case and, at that moment, file a divisional application directed to the second invention and another divisional directed to the third invention. This interpretation is completely erroneous since neither Article 100 nor Article 113 contemplate that limitation. As drafted, our current law can perfectly contemplate the possibility of limiting the scope of the parent case to one of the inventions identified by the Examiner and filing a single divisional application containing the remaining inventions that were eliminated from the parent case as a result of the lack of unity objection. Also, this interpretation is contradictory to the paragraph of Article 100, which mentions that it is possible to file a divisional that derives from another divisional in case the Mexican PTO requests the division through a lack of unity objection. It is clear that our IP law contemplates the possibility of filing a single divisional application that contains multiple inventions, and the criteria followed by some Examiners of the Mexican PTO lacks any legal basis in our IP law.

Double patenting

It is worth mentioning that double patenting has long been an issue in Mexico and, in practice, before our current IP law entered into force, Examiners tended to raise double patenting objections when there was scope overlap between the claims of a divisional and those of its parent case. However, double patenting was not defined in our previous law, so it was feasible to argue that the only scenario in which double patenting existed was if the scope of the claims of the divisional was identical to the scope of the claims of the parent case from which said divisional derived from. This argument proved successful with IMPI.

Our current IP law does contemplate specific provisions regarding double patenting. However, these provisions are very vague, leaving a considerable grey area for interpretation. The specific articles that regulate double patenting in our current IP law are Articles 50 and 101, which mention the following: "During substantive examination and in the granting of rights, IMPI shall look out for the public domain and prevent double patenting of the same invention," (Article 50) and "No patent will be granted to matter that is already protected by another patent, or which essential technical characteristics are a non-substantial variation of the matter protected by another patent, even when the applicant is the same in both," (Article 101).

Since our current IP law does not define what should be considered as a "substantial variation,"

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Examiners are issuing double patenting objections in many divisional applications that only have a minor scope overlap with the claims that were granted in the parent case that originated said divisional and which are clearly directed to different subject matter. There is an urgent need to define what is considered as a "substantial variation" so that, when performing the substantive examination, Examiners can focus on the relevant patentability issues of a divisional application (novelty, inventive step, enablement, sufficiency, etc.) from the beginning instead of putting time and effort into searching any kind of scope overlap to justify raising a double patenting objection.

Conclusions

In closing, our new IP Law offers several benefits for patent owners, and we can say that the balance is mostly positive. However, as we have mentioned in the previous paragraphs, our IP law still has many grey areas, particularly regarding divisional applications and double patenting. It is of utmost importance that the Regulations of our current IP Law are published as soon as possible so as to provide a clear path for applicants that seek to protect their inventions in Mexico since at this moment four years have passed since our current IP law entered into force and we are still using the Regulations of our previous law to interpret our current law.

In Mexico, we have a new president who started her one-term of six years on October 1, 2024, and she recently appointed a new head of the Mexican Institute of Industrial Property, a lawyer with extensive experience in several areas of public service. Our new head of the Mexican Institute of Industrial Property has expressed an interest in working closely with the Mexican IP associations. Thus, the current scenario in Mexico is positive and we are hopeful that the publication of the Regulations of our current IP Law will now be a priority.

Contact

OLIVARES

Pedro Luis Ogazón 17, Col. San Ángel, 01000, Ciudad de México
Tel: +52 55 5322 3000
 olivaresnews@olivares.mx
 www.olivares.mx

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RONNY AMIRSEHI, LL.M-IP
Managing Partner
Medtech/Life Sciences

Ronny is admitted before the USPTO, EPO, and UPC. He concentrates his practice on U.S. and European patent prosecution, UPC invalidity proceedings, and EPO opposition and appeal proceedings. He has around 20 years of experience prosecuting US and European patent applications.

Ronny started his patent law career in New York at Kenyon & Kenyon in 2004. He further developed his knowledge and expertise at various international law firms in Europe.

Ronny received his diploma in Patent Litigation in Europe from CEIPI and his Master of Laws degree in Intellectual Property Law from Munich Intellectual Property Law Center partnering with the Max Planck Institute and the George Washington University Law School. He studied biomedical engineering at University of California-San Diego.

Sample Representative Matters:

- A medical device company: image guided surgical robots.
- A medical device company: minimally invasive solutions for the aesthetic markets.
- A medical device company: intraocular lens solutions for cataract surgery.
- medical device company: anti-aging technologies.
- A medical laser and energy-based devices manufacturer.
- A global leader in providing investigative analytics software.
- A biotechnology company developing Bio-artificial Pancreas, intended to cure Type 1 diabetes.

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World Trade Center, Schiphol Boulevard 127, 1118 BG Schiphol, The Netherlands

www.leoandus.com info@leoandus.com