

# The Patent Lawyer

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## Good for the gander: IPR estoppel

Haynes & Boone examine the lesser-known estoppel and what the rule prohibits.



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# Patent prosecution in Mexico in view of the new IP Law

**Mr. Sergio L. Olivares and Mr. Mauricio Samano of OLIVARES examine how IMPI will assess double patenting and second generation voluntary divisional applications.**

## Mexico's reality

Undoubtedly, these past few months have been challenging for most businesses around the world and law firms are no exception to this. The COVID-19 pandemic emergency has made social distancing a necessity and has led us to rethink the way we work and we are now avid users of electronic platforms and long hours at the office have now turned to long hours on home office.

In Mexico, due to the closure of the Mexican Institute of Industrial Property (hereinafter referred to as IMPI) from March 27 until July 12, the only venue for filing new patent applications was IMPI's online platform and even though terms did not run during the closure, online filing became an excellent solution to ascertain patent filings during this closure period and also avoided a massive physical filing once IMPI reopened. The current administration of IMPI has made it clear that their priority is to promote online filing over physical filing and recently, they have made possible the transformation of physical files to electronic ones which has become an attractive option to some applicants.

Now, in addition to the natural changes we have been living during this pandemic, we are also witnessing a new era for patent prosecution and enforcement in Mexico, since as of July 1st, 2020, a new Federal Law for the Protection of Intellectual Property was published in the *Official Federal* gazette and will enter in force 90 working days after its publication, namely on November 05, 2020. This completely new Mexican IP law, incorporates many practices currently held by IMPI and filled many grey areas that were present in the previous law.

As it relates to inventions, this new law



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incorporated some very positive changes which are in line with the requirements of the new USMCA Treaty, such as the possibility of applying for patent term extension in case of unreasonable delays (more than five years between the filing date in Mexico and the date of grant) directly attributable to IMPI during the prosecution of a patent application. This is made through the issuance of a complimentary certificate which cannot be longer than 5 years.

Further great news is that the life-term of Utility Models is now extended from 10 years to 15 years.

There is no doubt that this new IP law brings great benefits; however, there are two aspects of this new law that have raised many eyebrows (and not in a good way) among Mexican patent practitioners. We refer specifically to "double patenting" and "voluntary divisionals". Throughout this paper, we will ensure our best effort to explain these two subjects under the new IP Law and the grey areas that we feel need to be addressed.

## Double patenting

For the past several years, IMPI has issued double patenting objections without a specific provision in our law prohibiting double patenting. IMPI applied the criteria followed by most patent systems which is that two patents cannot be granted for the same invention. The basis for the criteria applied by IMPI is that an applicant has no legitimate interest in the proceedings that lead to the granting of a second patent for the same subject matter if he already possesses one granted patent for said matter.

However, our new IP Law contemplates a specific provision prohibiting double patenting

in its articles 50 and 101 stating that “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).

It is clear from the above articles that double patenting will not be allowed in Mexico; however, it is not clear how IMPI will assess double patenting.

Currently, a double patenting objection is issued both when the scope pursued in a second case (normally a divisional application) is identical to the scope already pursued in a first case and also when there is scope overlap between said second case and the first case. Specifically, Examiners analyze the scope of the matter granted in the first case, as well as the scope of the matter that the applicant is pursuing in the subsequent case, and verify whether there is an overlap in the scope of protection. In other words, if the parent case protects a series of chemical compounds and the subsequent case claims a series of chemical compounds wherein some of these compounds fall within the scope of the compounds claimed in the first case, the Examiner will issue a double patenting objection.

From our point of view, this practice is incorrect because the existence of scope overlap between a pending application and a granted patent in no way indicates that the same invention is trying to be protected twice and so far, we have been successful in overcoming double patenting objections due to scope overlap by presenting this argument.

By the same token, it is important to consider that a selection invention would be an exception to this criterion. Namely, if the applicant demonstrates that a specific chemical compound that is sought to be protected in a subsequent case and which falls within the scope of the chemical compounds granted in the first case, has a surprising and unexpected technical effect which could have not been deduced from any state of the art document, it is very likely that the Examiner will not issue a double patenting objection.

We will have to wait and see how IMPI will assess double patenting objections once the new IP law enters in force and hope that specific guidelines on how to evaluate double patenting



## Résumés

### **Sergio L. Olivares, Jr., Partner**

Sergio Olivares, Jr. joined OLIVARES in 1987 and today leads the firm with strength and a commitment to transparency, client satisfaction, and personal service. He has been a partner since 1994 and Chairman of the Management Committee since 2009. Mr. Olivares' breadth of experience is extensive; he is skilled in the prosecution and litigation of intellectual property rights, including trademarks, copyrights, patents, and unfair competition. He is proficient across all areas of intellectual property law but works most closely with the firm's Patent Group. Mr. Olivares is highly recommended by leading industry publications and directories as a leader in IP. He has been influential in ensuring that OLIVARES remains highly innovative, helping to support the firm's effort to add new practice areas and industry groups that will enable the firm to offer its clients a more comprehensive approach.

### **Mauricio Samano, Engineer.**

Mauricio Samano works in the patent department of our firm. His work at OLIVARES mainly focuses in prosecuting Chemical, Biotechnological and Pharmaceutical patent applications, as well as in providing technical opinions regarding patent infringement. He has experience in conducting state of the art searches and drafting patent, utility model and industrial design applications. Additionally, he has participated in interviews with examiners of the Mexican Institute of Industrial Property (IMPI) and the United States Patent and Trademark Office.



will be included in the upcoming Regulations of our new IP law.

### **Voluntary divisionals:**

The filing of voluntary divisionals has been a common practice in Mexico throughout several years in spite of the fact that there was no specific provision in our domestic law recognizing the possibility of filing voluntary divisional applications.

The legal support for this practice lay in article 4-G(2) of the Paris Convention, which mentions the following:

(2) "The applicant may also, on his own initiative (e), divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized (f)."

Currently, in the practice, voluntary divisionals are widely accepted by IMPI at any moment during the prosecution of a patent application and before the payment of the grant fees of the patent application.

Also, at this point in time there is no limit in the amount of voluntary divisionals that can be filed and it was possible to file second generation voluntary divisionals (divisionals from divisionals), third generation divisionals, and so on without any restriction.

Currently, we are glad that the new Mexican IP Law specifically recognizes the possibility of filing voluntary divisional applications. Article 100 of our new IP law specifically recognizes the possibility of filing voluntary divisional applications and article 102 mentions that the time limit for filing a voluntary divisional is before the payment of the grant fees. However, article 100 contains a paragraph that mentions



## **A new era for patent prosecution and enforcement in Mexico.**



the following:

"The divisional application cannot consist in the division of other divisional applications, unless IMPI esteems that said further division proceeds, or in case IMPI requests said further division"

The above paragraph clearly leaves a big question mark on the acceptance of second generation voluntary divisional applications (cascade divisionals) and so far, we are unsure how IMPI will determine if a second generation voluntary divisional application will be accepted. This will of course not be the case for second generation divisionals that are generated as a result of a lack of unity objection raised by IMPI in relation to a particular divisional application.

Another paragraph that we found worrying is the following paragraph of article 100:

"When due to the division, an invention or group of inventions has been excluded, these cannot be claimed again in the initial application or in the application that originated the division, as the case applies"

In view of the above, it is clear that the practice for filing divisional applications has changed and that from now on it will be important to tailor an adequate strategy for filing divisional applications beforehand.

### **Conclusions:**

As of today, many questions are left unanswered and we still have many doubts on how IMPI will assess double patenting and second generation voluntary divisional applications. For this reason, we are attentive to see how the Regulations of the new Federal Law for the Protection of Intellectual Property will be drafted and if they will provide an adequate guidance for Examiners on how to address these and other grey areas in our domestic law.

An adequate reflection for these times we are living is that in view of our new Law, we recommend to not hurry key decisions such as the filing of divisional applications and consult with your Mexican partner an upfront strategy in order to assure that you obtain a solid protection for the whole scope of commercial interest.

## **Contact**

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