

Relevant Criterion Regarding Divisional Applications.

Article By:

Sergio L. Olivares

Daniel Sánchez

Alejandro Luna Fandiño

On July 15, 2022, the Mexican Circuit Court's en banc issued a decision regarding the correct time for submitting a petition for a divisional application for patents prosecuted under the rules of the former Industrial Property Law (abrogated in 2020). This decision was issued as consequence of two contradictory decisions issued by the two different Federal Circuit Courts.

The decision stated that divisional applications must be requested prior to the conclusion of the substantive examination, however, the decision was reluctant in pronouncing if the two months terms (that is four at the most) for the payment of fees after the Notice of Allowance is considered as part of this examination.

It is important to say that this criterion was issued because the former Industrial Property Law was ambiguous regarding divisional applications, including the timeframe for requesting them and several litigations were filed as consequence, however, the new Industrial Property Law (November 5, 2020) stated that the limitation for requesting a divisional application is prior the payment of fees of the patent, same that is required in the Notice of Allowance.

With respect to this new criterion, there are relevant points that must be considered:

- For patents prosecuted under the rules of the former Industrial Property Law.
- We do not oversee major risks for patents requested after November 5, 2020 under the rules of the new Industrial Property Law.
- Judicial decisions are not mandatory for the MPO but can be highly persuasive.
- The conflicts of applicability of law in time, in case of doubt Courts should also apply the most favorable law in benefit of citizens.

National Law Review, Volume XII, Number 234

Source URL: <https://natlawreview.com/article/relevant-criterion-regarding-divisional-applications>