The Patent Lawyer

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# *The Patent Lawyer* Editorial Board looks back at 2023 to summarize key cases and developments by jurisdiction.

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## Annual 2024

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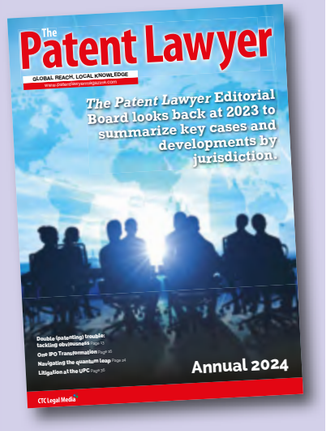


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# Editor's welcome

Welcome to *The Patent Lawyer Annual 2024.* This year has seen many key developments that will affect IP practice moving forward. To reflect, our 2023 Editorial Board have provided jurisdiction-specific reviews with their take on events. With comments from Canada, Germany, India, Japan, the UK, and the US, these reviews provide an overview of some of the important factors that will influence IP in 2024 and beyond.

In addition, this issue includes an exclusive interview with the UK IPO regarding the launch of their new digital services, designed to be more streamlined than ever before for a user-centric focus from both a patent professional and owner perspective.

> *We wish you a very happy and healthy 2024!*

From here, we take a look at the benefits and pitfalls of patent term adjustment and patent term extension in the US; introduce the new examination guidelines for utility patents in China; explore patenting the future of quantum software; assess how to best prepare for litigation at the UPC; review the abolishment of the 10-day rule in Europe; and much more!

Our *Women in IP Leadership* segment features Maria Boicova-Wynants, Partner at Starks, and Sandra Pohlman, Co-founder and Partner at df-mp, discussing challenges, achievements and ideas for continuing the empowerment of women in the industry.

Also find a special feature on prioritizing wellbeing in the IP profession – a vital subject that, in our opinion, requires much-needed attention.

Thank you to all our contributors and readers for another fantastic year, we wish you a very happy and healthy 2024!

Enjoy the issue.

**Faye Waterford, Editor**

## Mission statement

*The Patent Lawyer* educates and informs professionals working in the industry by disseminating and expanding knowledge globally. It features articles written by people at the top of their fields of expertise, which contain not just the facts but analysis and opinion. Important judgments are examined in case studies and topical issues are reviewed in longer feature articles. All of this and the top news stories are brought to your desk via the printed magazine or the website *www.patentlawyermagazine.com*

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November / December 2023

# Contents



# An unfortunate situation for divisional applications in Mexico

**Mauricio Samano, Associate at OLIVARES, provides a breakdown of the changes to divisional applications introduced in November 2020 with a review of the impact this has had on patent applications.**

Divisional applications are excellent for protecting additional embodiments of an invention. In many technology fields, and especially in the pharmaceutical industry, divisionals are a frequently used tool to create robust protection for a certain patent portfolio. Of course, Mexico is not an exception and for many years patent owners have filed many divisional applications either voluntarily or as a result of a lack of unity objection. This scenario has changed as a result of our new law that entered into force on November 5, 2020, which contains several limitations for filing divisional applications. Moreover, in the last few months, several erroneous interpretations from the Mexican Patent Office (IMPI) have further complicated the current scenario for filing divisionals in Mexico.

Mauricio Samano

## Divisionals before November 5, 2020

Before the Federal Law for the Protection of Industrial Property (FLPIP) entered into force on November 5, 2020, the applicable law was the former Intellectual Property Law (IPL) which had been in force since 1991. This previous law only specifically contemplated the scenario of filing a divisional application as a result of a lack of unity objection but, in practice, examiners also accepted voluntary divisionals as long as they were filed at any time during the prosecution of the parent case and before the payment of the grant fees. There was no limit to the number of voluntary divisionals that could be filed and no limitation for filing cascade divisional applications, it was frequent to see fourth and even sometimes fifth generation divisionals.

IMPI's practice for voluntary divisional applications was supported in Article 4G(2) of the Paris Convention which says that:

> "The applicant may also, on his own initiative, 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".

This practice went on for over three decades and was seen as positive by most patent owners.

> **Voluntary divisionals deriving from divisionals will no longer be allowed.**

## Divisionals from November 5, 2020, and onwards

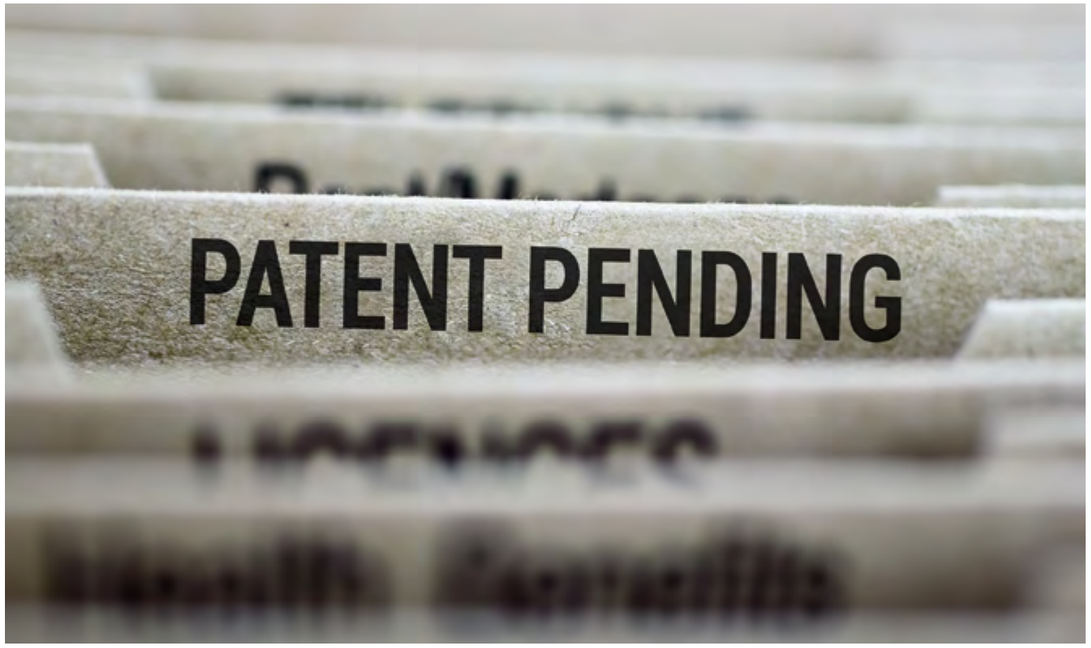
As previously mentioned, on November 5, 2020, our Federal Law for the Protection of Industrial Property (FLPIP) entered into force and this new law specifically contemplated the possibility of filing voluntary divisional applications. However, this new law also contemplated several limitations for filing divisionals which were absent in the former law which are mentioned below.

**a) Cascade divisionals**

As mentioned in Article 100 of our new IP Law, 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 is if the Mexican PTO requests further division through a lack of unity objection.

It is also possible to file multiple divisional applications all deriving from the same parent case.

A possible solution to this new situation is to file in the first divisional a set of claims that do not comply with unity of invention in order to ensure that the examiner issues a lack of unity objection, thus allowing the applicant to file further divisional applications in the future.




**b) Limitations on claimed subject matter in divisionals**

One major change in divisional practice is that now, 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. Therefore, when receiving a unity objection, the applicant needs to consider this when deciding the scope of protection that is of commercial interest to them. If this is not yet clear, it is important to not let go of any matter when dividing the application.

**c) Double patenting**

Double patenting has long been an issue in Mexico and, in practice, examiners tended to raise double patenting objections when there is scope overlap between the claims of a divisional and that 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.

Article 101 of our new law mentions that a patent will not be granted to a matter that is already protected in another patent or if the essential technical characteristics sought to be protected are a non-substantial variation of the matter protected in said other patent. This definitely poses a grey area on how double patenting will be assessed by the examiners and how they will interpret a "non-substantial variation". The assessment of the examiners will depend on the pertinent case law that will develop once these cases reach the Mexican courts.

> **IMPI started denying all voluntary cascade divisional applications regardless of whether the parent case was filed before or after November 5, 2020.**

## Résumé

**Mauricio Samano** works in the patent department at OLIVARES where his work 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 patent, utility model, 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.