



Divisional patent applications and claim amendments in Brazil and other major Latin American jurisdictions.

Main differences when comparing to EPO practice.



Agenda:



- I. Short introduction to the firm
- II. Divisional patent applications and claim amendments
 - 1.) Brazil
 - 2.) Mexico
 - 3.) Argentina
 - 4.) Main differences compared to EPO practice





Office Locations:

Brazil, Mexico, Argentina, Colombia

Spain, Portugal



Speaker:

Manuel Tiedemann, LL.M.

H&A Spain, Partner

European and German Attorney



Office Locations:

Brazil, Mexico, Argentina, Colombia
Spain, Portugal

IP Firm:

Professional partnership,
founded in 1980

Staff:

More than 170 IP specialists

- Speak numerous languages including Japanese
- Country Desks (e.g. US, Asia, Germany)

Geographical Scope

H&A is a leading IP firm in the **European market** and **Latin American market** and represents its clients primarily at:

- European Patent Office (EPO; Munich) and European TM and Design Office (EUIPO, Alicante)
- Spanish (OEPM) and Portuguese (INPI) Patent and Trademark Office
- All Latin American Patent and Trademark Offices
 - Middle and South America
 - The Caribbean Islands

Focus on Latin America

H&A files every year around **2.000 Latin American patent, design and trademark applications** based on 2 working models:

Direct Office Contact:

Using our local Offices in Brazil, Mexico, Argentina and Colombia and its local IP teams straight forward.

Latin American Desk:

Using centralizing Latin American Desk in Spain to streamline patent, design and trademark families in various countries simultaneously.

- Single point of contact
- Overlapping timezone
- Sometimes EPO criteria in Latam

Agenda:

- I. Short introduction to the firm
- II. Divisional patent applications and claim amendments
 - 1.) Brazil
 - 2.) Mexico
 - 3.) Argentina
 - 4.) Main differences compared to EPO practice





Office Locations:

Brazil, Mexico, Argentina, Colombia

Spain, Portugal



Speaker:

Rafaela Mattos

H&A Brazil

Brazilian Patent Attorney

Divisional applications



How: Divisionals may be filed at the applicant's own will or at the request of the BRPTO for a lack of unity.

Purpose: I) claims contain a group of inventions that comprise more than one inventive concept (namely, the claims lack unity of invention); or II) the application presents group of inventions interrelated by the same inventive concept as an alternative implementation of the invention.

Divisional applications



Subject-matter and Scope: Divisional cannot exceed the subject-matter disclosed in the parent application, which framework is determined with the request for examination of the parent application. Claims may not overlap or broaden the claims of the parent application

May lead to double patenting, which is not permitted in Brazil, as the divisional application should not be encompassed by the claimed matter of the parent application if granted.

Divisional applications



Timing: limitation imposed by article 32 of the Brazilian IP Law, which regulates the possibility of voluntary amendments: amendments may be filed up to the time that the request for examination is submitted, provided they are designed to better clarify or define the application and are limited to the matter initially disclosed in the application.

AFTER THE REQUEST OF EXAMINATION IS SUBMITTED, VOLUNTARY AMENDMENTS ARE ONLY ACCEPTED TO EITHER CORRECT A MATERIAL TYPING MISTAKE OR EITHER TO RESTRICT THE PROTECTION INITIALLY CLAIMED.

Divisional applications



Before the request of examination of the parent application: Applicant in a better position to draft the divisional set of claims, which may encompass any subject matter that was originally disclosed in the specification;

After the examination request of the parent application: divisional set of claims must be restricted to subject matter claimed in the claim set of its parent application;

Divisional applications



Origin: Parent application (as many as wished). However, no divisional from a previous divisional may be filed.

Procedural situation: Divisional are considered to be in the same procedural phase of the parent application, subjected to the payment of the same fees and have to be simultaneously decided.

When: Deadline for filing divisionals is the issuance of the notice of allowance, notice of rejection or notice definitely abandoning the parent application.

II. 1

Brazil

Divisional applications



Thank you for your attention!



The following two slides are a “take away” summary

Relevance of claims when requesting examination – voluntary amendments



Up to examination request (36 months from the filing date) claims can be amended voluntarily (Art 32 IP law).

Request for examination determines the framework for examination of the application and of any subsequent divisional application.

Subject-matter not included in the claims by the time of requesting examination **will no longer be able to be prosecuted neither in the application nor in any divisional application.**

Particularities of Brazilian practice



Relevant implications:

- Amendments that extend the claimed scope will not be accepted.
- Changes in claim categories will not be accepted except for very limited cases.

Claims must be in two part form (Preamble characterized by invention)

Medical uses must be claimed in Swiss-type format and included in the claims before the request for examination if not present.

IMPORTANT ADVICE: Make sure that you include claims to any object/category included in the application as filed that you might foresee of interest for protection, in order to avoid objection due to Article 32 of the IP Law.

Agenda:

- I. Short introduction to the firm
- II. Divisional patent applications and claim amendments
 - 1.) Brazil
 - 2.) Mexico
 - 3.) Argentina
 - 4.) Main differences compared to EPO practice





Office Locations:

Brazil, **Mexico**, Argentina, Colombia

Spain, Portugal



Speaker:

Karla Islas

Head of H&A Mexico

Mexican Patent Attorney



DIVISIONAL APPLICATIONS

In Mexico, divisional application criteria over the time has been flexible, however according to the New Mexican Law (LFPPPI); which entered into force last November 5, 2020, some practical updates should be considered when filing divisional applications.



- ★ How to file divisional applications?
- ★ When to file divisional applications?



How to file a divisional application?

→ A) On a voluntarily way.

B) By request of Mexican Office due to lack of unity of invention.



FIRST OPTION:

HOW and when to file a divisional application?

A) On voluntarily way:



Divisional application (s) can be filed as long as the initial or parent application is ongoing, or before or at the same time of the issuance of the decision of granting, rejecting, abandoning or withdrawing the parent application.

In case of granting, it should be filed no later than at the time of the title issuance payment and the first annuities.

II. 2 Mexico

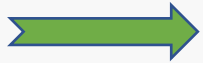


The applicant may voluntarily divide an initial application that is still pending, keeping as the filing date of each divisional application, the same date of said initial application and, if applicable, the priority date.



SECOND OPTION:

B) By request of the Mexican Patent Office.



The second way of filing a divisional application(s) is by request of the Mexican Patent Office due to lack of unity of invention and this is requested by means of a technical office action.

Mexican Patent Office shall consider as main invention only the one which is mentioned firstly in the claims and this invention should be included as the set of claims alongside the response to the office action.



Things to consider when filing a divisional application:

- ★ Divisional application must claim an invention different from the one claimed in the parent one:

No additional subject matter or subject matter that has a broader scope than the one initially filed is allowed.

- ★ Claims that do not have lack of unity and are not filed in a divisional, can still be filed "voluntarily" as long as the parent application is still pending, or the issuance of title and annuities payment have not been submitted.



Restrictions:

- Limitation to cascade of divisionals: no divisionals from divisionals unless the Mexican Patent Office considers it's appropriate or specifically requires it.
- Reincorporation of non-elected subject-matter when responding to a unity objection is not allowed. Divisionals must be filed at the same time.



Restrictions:

- Claimed subject-matter must be different from the matter claimed in the initial application or in other divisional. By contrary, the above may rise to double patenting rejections.



Claim amendments:

Claims must be in two part form: Preamble and characterizing portion .

Applicant entitled to amend the set of claims anytime during prosecution, (but preferably before the substantive examination takes place).

- Spontaneously by the applicant (voluntarily) or
- As a response to an office action.



Claim amendments:

Once the patent is granted, it is no longer possible to amend the set of claims

Amendments that extend the claimed scope will not be accepted.

When filing a new set of claims, all claims must be sustained by the description, then adding or extending the scope of the subject matter disclosed in the description as it was filed, is not allowed.

Agenda:

- I. Short introduction to the firm
- II. Divisional patent applications and claim amendments
 - 1.) Brazil
 - 2.) Mexico
 - 3.) Argentina
 - 4.) Main differences compared to EPO practice





Office Locations:

Brazil, Mexico, **Argentina**, Colombia

Spain, Portugal



Speaker:

Rocio Natalia Gendra

H&A Argentina

Argentinean Patent and Trademark Attorney

Divisional patent applications and claim amendments

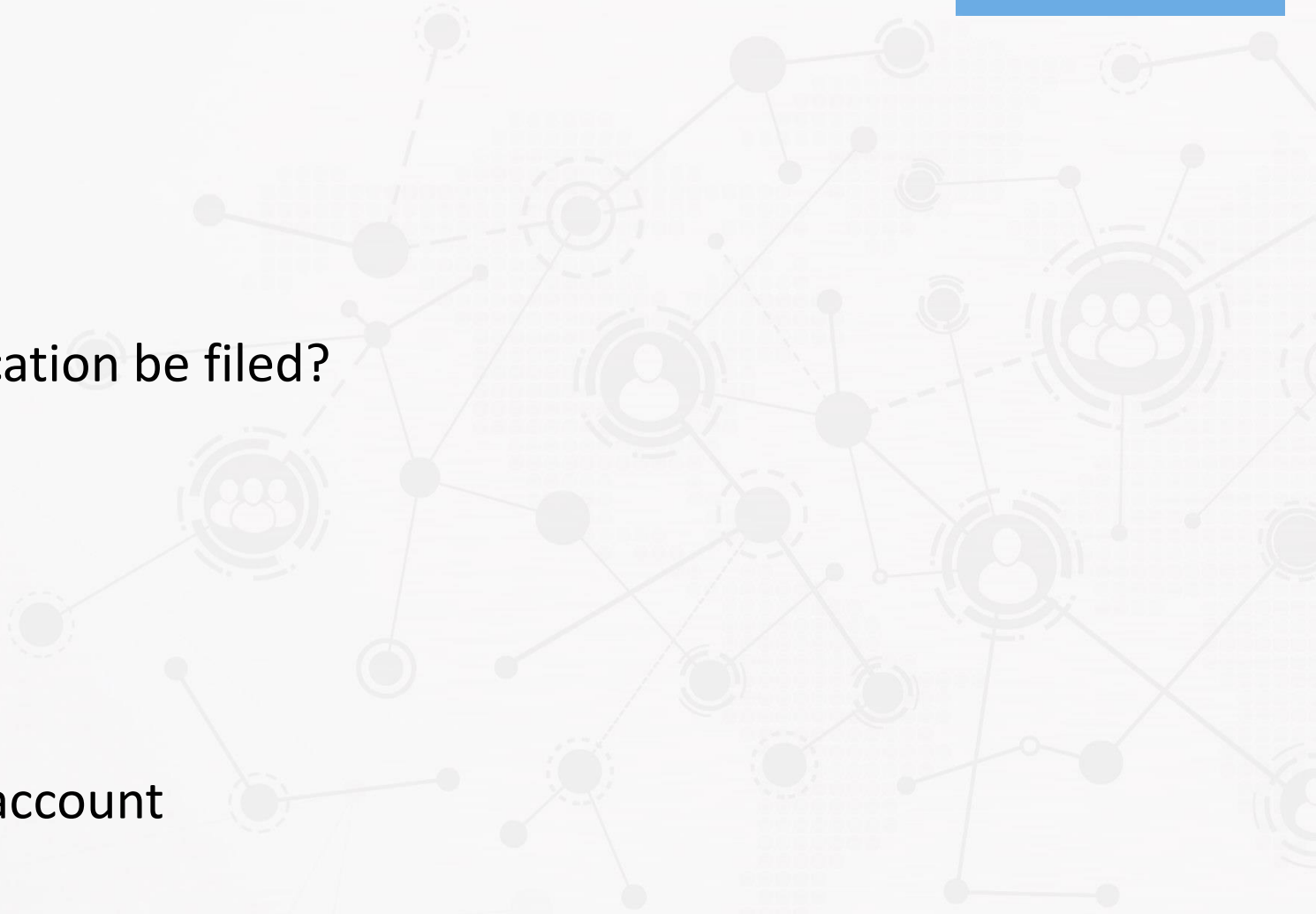


Divisional Applications

- Provisional protection
- Pharma applications
- When can a divisional application be filed?
- How?
- Effective Date?
- Term of Protection

Claim amendments

- Particulars to be taken into account
- Time limit





Provisional Protection

- Argentinean rules do not allow provisional protection for pending patent applications.

Pharma Applications

- Argentinean PTO has a restrictive approach: In principle, only new molecular entities could be patented
- Alternative to rejections: Usually file a divisional patent application to keep the invention alive, looking for and waiting for a change of the PTO policies

Divisional Applications



When?

- Voluntarily or upon examiner's request
- BE CAREFUL! When requested by the examiner, if no divisional is filed, the application is declared abandoned

Special Remarks:

- Parent case must still be under prosecution
- Cascade divisionals are allowed BUT, both the older as well as last parent must be still under prosecution when the youngest is filed.



How?

- Indicate the type of application
- Parent case reference must be stated
- Applicant's particulars must be detailed
- Description, including drawings and sequence list if any
- Set of claims
- Abstract
- Substantive examination request at the filing? It will depend if it is filed on or after eighteen months since parent filing date.



Effective Filing Date

- Filing date of the parent, or the priority filing date, if any.

Term of Protection

- 20 years since filing date of the parent patent application, or oldest parent patent application in case of cascade divisional

Claim Amendments



Can be carried out spontaneously by the applicant or as a response to an office action

All claims must be sustained by the description

Greater number of claims than the prior set=extra fee must be paid

It can be done at any time during prosecution, but CAREFUL! Once the patent is granted, it is not longer possible to amend the set of claims

Agenda:

- I. Short introduction to the firm
- II. Divisional patent applications and claim amendments
 - 1.) Brazil
 - 2.) Mexico
 - 3.) Argentina
 - 4.) Main differences compared to EPO practice





Office Locations:

Brazil, Mexico, Argentina, Colombia

Spain, Portugal



Speaker:


Gustavo Gonzalez

Head of H&A Electro-/Mechanics Division, Partner
European and Spanish Patent Attorney

II. 4

Comparative chart

Comparison

Topic	 EPO	 BRAZIL	 MEXICO	 ARGENTINA
How?	At the applicant's own volition or in response to an objection of lack of unity raised by the PTO.	At the applicant's own volition or in response to an objection of lack of unity raised by the PTO.	At the applicant's own volition or in response to an objection of lack of unity raised by the PTO.	At the applicant's own volition or in response to an objection of lack of unity raised by the PTO.
Sequences of divisionals	Allowed	Not allowed	Not allowed unless the PTO requires it	Allowed
Double patenting	Not allowed	Not allowed	Not allowed	Not allowed
Scope	Limited by the parent application as filed	Limited by the parent application as filed <u>before request of examination</u> Limited by the subject matter claimed in the claims <u>after request of examination</u>	Limited by the parent application as filed	Limited by the parent application as filed
Until when?	While the parent is pending <u>If granted:</u> The EPO notifies the date of the grant in advance <u>If refused:</u> The EPO does not notify the date of the refusal But Div. can be filed until the end of the appeal period (2 m)	While the parent is pending <u>If granted:</u> The PTO does not notify the date of the grant. <u>If refused:</u> The PTO does not notify the date of the refusal	While the parent is pending <u>If granted:</u> The PTO does not notify the date of the grant But Div. can be filed before payment of the granting fees <u>If refused:</u> The PTO does not notify the date of the refusal But the decision can be appeal and Div. can be filed	While the parent is pending <u>If granted:</u> The PTO does not notify the date of the grant <u>If refused:</u> The PTO does not notify the date of the refusal But the decision can be appeal and Div. can be filed

II. 4

Comparative chart

Comparison



Topic	EPO	BRAZIL
How?	At the applicant's own volition or in response to an objection of lack of unity raised by the PTO.	At the applicant's own volition or in response to an objection of lack of unity raised by the PTO.
Sequences of divisionals	Allowed	Not allowed
Double patenting	Not allowed	Not allowed
Scope	Limited by the parent application as filed	Limited by the parent application as filed <u>before request of examination</u> Limited by the subject matter claimed in the claims <u>after request of examination</u>
Until when?	While the parent is pending <u>If granted</u> : The EPO notifies the date of the grant in advance <u>If refused</u> : The EPO does not notify the date of the refusal But Div. can be filed until the end of the appeal period (2 m)	While the parent is pending <u>If granted</u> : The PTO does not notify the date of the grant. <u>If refused</u> : The PTO does not notify the date of the refusal

II. 4



Comparative
chart

Comparison



Topic	EPO	MEXICO
How?	At the applicant's own volition or in response to an objection of lack of unity raised by the PTO.	At the applicant's own volition or in response to an objection of lack of unity raised by the PTO.
Sequences of divisionals	Allowed	Not allowed unless the PTO requires it
Double patenting	Not allowed	Not allowed
Scope	Limited by the parent application as filed	Limited by the parent application as filed
Until when?	<p>While the parent is pending</p> <p><u>If granted</u>: The EPO notifies the date of the grant in advance</p> <p><u>If refused</u>: The EPO does not notify the date of the refusal</p> <p>But Div. can be filed until the end of the appeal period (2 m)</p>	<p>While the parent is pending</p> <p><u>If granted</u>: The PTO does not notify the date of the grant</p> <p>But Div. can be filed before payment of the granting fees</p> <p><u>If refused</u>: The PTO does not notify the date of the refusal</p> <p>But the decision can be appeal and Div. can be filed</p>

Comparison

Topic	 EPO	 ARGENTINA
How?	At the applicant's own volition or in response to an objection of lack of unity raised by the PTO.	At the applicant's own volition or in response to an objection of lack of unity raised by the PTO.
Sequences of divisionals	Allowed	Allowed
Double patenting	Not allowed	Not allowed
Scope	Limited by the parent application as filed	Limited by the parent application as filed
Until when?	While the parent is pending <u>If granted:</u> The EPO notifies the date of the grant in advance <u>If refused:</u> The EPO does not notify the date of the refusal But Div. can be filed until the end of the appeal period (2 m)	While the parent is pending <u>If granted:</u> The PTO does not notify the date of the grant <u>If refused:</u> The PTO does not notify the date of the refusal But the decision can be appeal and Div. can be filed



Thank you !



www.hyaip.com

info@herrero.es

**H
&
A**

Argentina (Buenos Aires)

Brasil (Río de Janeiro)

Colombia (Bogotá)

México (Ciudad de México)

Portugal (Lisboa)

Spain (Madrid)