

Divisionals in Mexico under Federal Law for the Protection of Industrial Property (FLPIP)

Under Regulations of the Federal Law for the Protection of Industrial Property (FLPIP), divisional applications can be filed:

- **Voluntarily**, at any time during prosecution, but only when they result from the initial Mexican application, or;
- **As a requirement expressed by the IMPI (Mexican PTO) during examination**, due to an objection because of a **lack of unity of invention/design objection**.

The deadline to submit a voluntary divisional application is before the conclusion of the prosecution. That is, namely, before payment of the final fees or before the issuance of a statement of refusal or abandonment. **The deadline to submit a divisional application requested by the MXPTO through a unity of invention objection is the same as that for filing a response to the official action.**

If the examiner determines there is not unity of invention/design, examination will take place only for the main invention, which IMPI considers to be the invention comprised in claim 1.

The new regulations also establish that, for any invention/design not elected when dividing the original application, it will be assumed that there is no interest into the non-elected matter, and it will be considered as permanently abandoned. **Any invention/design not claimed in a divisional application and withdrawn from the original application cannot be claimed afterwards.**

In case subject matter not originally claimed, but supported by the specification, exists, the IMPI will accept its inclusion either in the original (if there is unity of invention) or in a divisional application.

The intention of the regulations is to avoid “cascade” divisionals. Thus, **divisionals resulting from other divisional application will only exist by specific requirement from the IMPI** when the unity of invention/design is broken as part of the amendments or limitations to the set of claims.

IMPI's practice for divisional applications is quite restrictive at this point. Therefore, we strongly suggest considering the following aspects related to subject matter of interest in Mexican applications:

- **IMPI presumption of main invention:** IMPI will presume that the invention described in claim 1 constitutes the main invention at the outset of substantive examination.
- **Retention of main invention in initial application:** the main invention must remain in the initial application, as divisional applications must relate to different subject matter. IMPI will not accept a divisional application that includes an invention previously examined as the main invention.
- **Reordering claims when claim 1 is not the applicant's focus:** if claim 1 does not reflect the applicant's principal interest, we strongly recommend submitting a voluntary amendment to reorder the claims prior to the start of substantive examination — ideally immediately following publication in the IP Gazette.
- **Filing divisional applications in response to unity of invention objections:** if a lack of unity of invention is raised in the initial application, all divisional applications proposed in response to the unity objection must be filed accordingly.
- **Acceptability of new claims in divisional applications:** voluntary divisional applications may include claims not originally filed in the initial application, provided that the subject matter is clearly supported by the specification.
- **Timing for filing divisional applications:** divisional applications from the initial application may only be filed before its prosecution is concluded. Prosecution is considered concluded upon payment of the grant fees, issuance of a refusal, or formal declaration of abandonment.

Should you require further clarification or assistance, please feel free to contact us. We remain committed to supporting you in formulating a **robust strategy** to ensure the effective protection of your intellectual property and scientific innovations.

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