

**PART 2**  
*Utility Models*

**RULE 200.** *Registrable Utility Models.* — Any technical solution of a problem in any field of human activity which is new and industrially applicable shall be registrable.

**RULE 200.1** *Non-Registrable Utility Models.* — The following shall be excluded from protection as utility models:

- (a) Discoveries, scientific theories and mathematical method;
- (b) Schemes, rules and methods of performing mental acts, playing games or doing business, and programs for computers;
- (c) Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practiced on the human or animal body. This provision shall not apply to products and compositions for use in any of these methods;
- (d) Plant varieties or animal breeds or essentially biological process for the production of plants or animals. This provision shall not apply to microorganisms and non-biological and microbiological processes;
- (e) Aesthetic creations; and
- (f) Anything which is contrary to public order or morality.

**RULE 200.2** *Industrial Applicability.* — A utility model which can be produced and used in any industry shall be industrially applicable.

**RULE 201.** *Statutory Classes of Utility Models.* — A utility model may be, or may relate to

- (a) a useful machine;
- (b) an implement or tool;
- (c) a product or composition;
- (d) a method or process; or
- (e) an improvement of any of the foregoing.

[As amended by Office Order No. 09 (2000)]

**RULE 202.** *First to File Rule.* — If two or more persons have made the same utility model separately and independently of each other, the right to the utility model registration shall belong to the person who filed an application for such utility model, or where two or more applications are filed for the same utility model to the applicant who has the earliest filing date or the earliest priority date.

**RULE 203.** *Filing Date of Utility Model Application.* — The filing date of a utility model application shall be the date on which the Office received the following requirements:

- (a) A properly filled-out request form for registration as prescribed by the Bureau;
- (b) A description of the Utility Model;
- (c) Claim or claims; and
- (d) Drawings or a pictorial representation disclosing completely the utility model, if there is/are any.

Without need of any notice from the office, the filing fee shall be paid within one (1) month from the date of application was received by the office, otherwise, the application shall be deemed forfeited. [As amended by Office Order No. 09 (2000)]

**RULE 204.** *Right of Priority for Utility Model.* — An application for utility model filed by any person who has previously applied for the same utility model in another country which by treaty, convention, or law affords similar privileges to Filipino citizens, shall be considered as filed as of the date of filing the foreign application: Provided, That: (a) the local application expressly claims priority; (b) it is filed within twelve [12] months from the date the earliest foreign application was filed; and (c) a certified copy of the foreign application together with an English translation is filed within six [6] months from the date of filing in the Philippines.

**RULE 205.** *Registration of Utility Model.* — A utility model application shall be registered without substantive examination provided all fees such as filing, excess claims and publication fees are paid on time and all formal requirements set forth in these Regulations are filed without prejudice to a determination as regards its novelty, industrial applicability and whether or not it is one of the non-registrable utility models. [As amended by Office Order No. 61 (2001)]

**RULE 206.** *Formality Examination of Utility Model Application.* — The utility model application shall be classified and examined as to the completeness of the formal requirements prescribed in these Regulations, and a report thereon shall be transmitted to the applicant. The formality examination shall take into account the parts of these Regulations on: (a) the right to a utility model registration, (b) who may apply for a utility model registration, (c) filing date requirements and (d) other formality requirements. [As amended by Office Order No. 09(2000)]

**RULE 207.** *Applicant's Action on the Formality Examination Report.* — Within two (2) months from the mailing date of the formality examination report, the applicant may: (1) voluntarily withdraw the application, (2) amend the application, (3) convert the application to an application for an invention patent, or (4) upon payment of the required fee, request for a registrability report. [As amended by Office Order No. 09 (2000)]

**RULE 207.1.** *Voluntary Withdrawal.* — The application shall be deemed withdrawn and all files expunged from the record of the Bureau upon receipt of the applicant's voluntary withdrawal.

**RULE 207.2.** *Amended Applications.* — The amended application shall be classified and subjected to formality examination. Report thereon shall be submitted to the applicant within two (2) months from receipt of the amended application. Within two (2) months from mailing date of the formality examination report on the amended application, the applicant may: (1) withdraw the application, (2) convert the same to an application for an invention patent, or (3) upon payment of the required fee, request for a registrability report. [As amended by Office Order No. 09 (2000)]

**RULE 207.3.** *Application Converted to an Application for Inventions Patent.* — The application or amended application which is converted into an application for an invention patent shall be processed as an invention patent application upon receipt of notice from the applicant.

**RULE 207.4.** *No Action on the Part of Applicant Where Formal Requirements are Complete.* — Where the application meets all the formal requirements for registrability and the Bureau fails to receive any action from the applicant, the utility model shall be published upon the expiration of two (2) months from the mailing date of the formality examination report, provided the issuance, publication and all required fees have been fully paid. [As amended by Office Order No. 16 (2001)]

**RULE 207.5.** *No Action on the Part of Applicant Where Formal Requirements are not Complete.* — Where the application fails to meet any of the formal requirements for registration and the Bureau fails to receive any action from the applicant, the application shall be deemed withdrawn and all files thereon shall be expunged from the records of the Bureau upon the expiration of two (2) months from the mailing date of the formality examination report. The Bureau may return to the applicant all the files expunged from its records.

**RULE 207.6.** *Registrability Report.* — The report shall contain citations of relevant prior art documents with appropriate indications as to their degree of relevance which will serve as an aid to the applicant or to third parties including judicial and quasi-judicial bodies, in the determination of the validity of the utility model claim(s) in respect to newness. [As amended by Office Order No. 16 (2001)]

The registrability report shall be given within two (2) months from receipt of the request and upon payment of fees. If the applicant has requested for a registrability report prior to the publication of the utility model application, the registrability report shall be included in the publication of utility model application. [As amended by Office Order No. 16 (2001)]

**RULE 207.7** *Non-Payment of Issuance and Publication Fees.* — Where the application meets all the formal requirements for registrability and the applicant fails to pay the issuance and publication fees within the prescribed period, the utility model application shall be deemed withdrawn. [As amended by Office Order No. 09 (2000)]

**RULE 207.8** *Final Action.* — Where the applicant fails to file a complete response to the formality examination report, any subsequent formality examination report submitted to the applicant shall be a final action which may be appealed to the Director of Patents in a manner provided for in these Regulations. [As amended by Office Order No. 09 (2000)]

**RULE 208.** *Requirements for Applications for Utility Model.* — An application for Utility Model Registration and other correspondences shall be in Filipino or English and must be addressed to the Director of the Bureau of Patents.

The application shall contain the following:

- a) A duly accomplished request for registration as prescribed by the Bureau,
- b) Description containing the following:
  1. title
  2. technical field
  3. background of the Utility Model

4. brief description of the several views of the drawings, if any
5. detailed description

- c) Claim or claims
- d) Drawings, if any
- e) Abstract of the Disclosure

[As amended by Office Order No. 9, (2000),]

**RULE 208.1. *Title.*** — The title should be as short and specific as possible, and should appear as heading on the first page of the specification. Fancy names are not permissible in the title. [As amended by Office Order No.09 (2000).]

**RULE 208.2. *Technical Field.*** — A statement of the technical field of the art to which the utility pertains. The statement should be directed to the subject matter of the claimed utility model.

**RULE 208.3. *Background of the Utility Model.*** — It is a description which indicates the so-called "background art" constituting the related prior art or state of the art or known technology for the utility model sought to be registered, including references to specific documents where appropriate. Where applicable, the problems involved in the information which may be solved by the applicant's utility model should be indicated.

**RULE 208.4. *Brief Description of the Several Views of the Drawings, if there be any.*** — Every view of the drawings should be briefly described, and indicated with corresponding figure numbers.

**RULE 208.5. *Detailed Description.*** — The detailed description must specifically include a complete description of the manner or making and using the utility model. It must set forth the precise or exact utility model for which registration is sought, in such manner as to distinguish the utility model from the prior art it pertains to and the technical problem solved by the utility model should be indicated.

**RULE 208.6. *Claim or Claims.***

- a) The claim(s) must define the subject matter of the utility model for which registration is sought. Such claim(s) should be clear and concise and fully supported by the description.
- b) If the utility model application relates to an improvement, the claim(s) should specifically point out and distinctly claim the improvement in combination with a preamble statement indicating the prior art features which are necessary for the definition of the claimed subject matter.

**RULE 209. *Unity of Utility Model.*** — Only one independent genus or generic claim is permissible in a utility model application. However, specific variations of the utility model may be claimed in a reasonable number of dependent claims in a single application, provided such variations fall under a single statutory class provided in these Regulations and are embodied under a single general innovative concept. Such specific variations of the claimed utility model must fall within the scope of the generic claim.

**RULE 209.1. *Claims Incurring Fee.*** (a) Any utility model application comprising more than five (5) claims, independent and/or multiple/alternative dependent claims at the time of filing, or added claims after the filing date in respect of each claim over and above five (5) incurs payment of a claims fee. The claims fee shall be payable within one (1) month after the filing of the application. If the claim fees have not been paid in due time, they may still be validly paid within a grace period of one (1) month from notice pointing out the failure to observe the time limit. If the claims fee is not paid within the time limit and the grace period referred to in this Rule, the claim or claims concerned shall be deemed deleted.

**RULE 210. *Requirement for Restriction; Division.*** — A restriction or division of multiple embodiments in a utility model application may be deemed proper if such embodiments are independent and distinct, or can not be considered as specific variations specified in these Regulations. A divisional application covering the restricted embodiment(s), if filed during the pendency of the utility model application, shall be entitled to the benefit of the filing date of such parent application.

**RULE 211. *Publication of the Utility Model Application.*** An application which meets the formal requirements shall be published in the form of bibliographic data and representative drawing, if any, in the IPO Gazette. If an applicant has previously requested for a registrability report, the publication shall include the registrability report. [As amended by Office Order No. 61 (2001),]

**RULE 211.1 *Adverse Information. Effects.*** Within two (2) months from publication of the utility model application, any interested party may request the Director for a registrability report and/or furnish the Director information, evidence or data in writing and under oath, showing that the utility model is not new. The Director may require such third party to submit relevant and collateral facts or data to substantiate the information. [As amended by Office Order No. 61 (2001),]

Within two (2) months from receipt of the request and/or adverse information, the Director shall decide whether or not to register the utility model and shall issue the registrability report, if one has been requested. The Director may also issue a registrability report *motu proprio* within the same two (2)-month period. [As amended by Office Order No. 61 (2001),]

In case the Director refuses or denies the registration of the utility model, the applicant may appeal such decision to the Director General pursuant to Section 7.1 (b) of the IP Code and in accordance with Part 7 of these Regulations. [As amended by Office Order No. 61 (2001),]

In case the Director allows the registration of the utility model, any interested party may file a petition for cancellation with the Bureau of Legal Affairs in accordance with Section 109.4 of the IP Code and in accordance with the Regulations on, *Inter Partes Proceedings*. [As amended by Office Order No. 61 (2001),]

If the Director receives no adverse information within the 2-month period, he shall certify to that effect and direct the preparation and issuance of the certificate of registration with effect as of the date of publication of the utility model application. [As amended by Office Order No. 61 (2001),]

**RULE 212. *Term of Registration of Utility Model.*** — A utility model registration shall expire,

without any possibility of renewal, at the end of seventh year after the date of the filing of the application.

However, taking into account the first-to-file rule, the volume of pending applications as of the effectivity of the IP Code and the time that has elapsed between the effectivity of the IP Code and the effectivity of these Regulations:

- (a) The registration of Utility Model applications pending at the effective date of, and proceeded with in accordance with, the IP Code shall expire, without possibility of renewal, at the end of seven (7) years from effectivity of these Regulations;
- (b) The registration of utility model applications filed after the effectivity of the IP Code and pending upon effectivity of these Regulations shall expire, without possibility of renewal, at the end of seven (7) years from effectivity of these Regulations.

[As amended by Office Order No. 09 (2000)]

**RULE 213.** *Cancellation of the Utility Model Registration.* — The utility Model registration shall be cancelled on the following grounds:

- (a) That the utility model does not qualify for registration as a utility model and does not meet the requirements of novelty and industrial applicability or it is among non-registrable utility models;
- (b) That the description and the claims do not comply with the prescribed requirements;
- (c) That any drawing which is necessary for the understanding of the utility model has not been furnished;
- (d) That the owner of the utility model registration is not the maker or his successor in title.

**RULE 214.** *Conversion of Invention Patent Application to an Application for Utility Model Registration.* — At any time before the grant or refusal of a patent for an invention, an applicant for a patent for an invention may, upon payment of the prescribed fee, convert his application into an application for registration of a utility model, which shall be accorded the filing date of the application. An application may be converted only once.

**RULE 215.** *Conversion of an Application for Utility Model Registration to a Patent Application.* — At any time before the grant or refusal of a utility model registration, an applicant for a utility model registration may, upon payment of the prescribed fee, convert his application into a patent application, which shall be accorded the filing date of the utility model application.

**RULE 216.** *Prohibition Against Filing of Parallel Applications.* — An applicant may not file two (2) applications for the same subject, one for utility model registration and the other for the grant of a patent for an invention whether simultaneously or consecutively.