

## **PART 4**

### Common Provisions

#### **CHAPTER 1**

##### Registrability

**RULE 400.** Novelty. — An industrial design or utility model shall not be considered new if it forms part of a prior art.

**RULE 401.** Prior Art. — Prior art shall consist of:

(a) Everything made available to the public anywhere in the world before the filing date or the priority date of the application provided that the disclosure is contained in printed documents or in any tangible form.

(b) The whole contents of an application for a patent for invention, utility model or industrial design published under Sec. 44 of the IP CODE, filed or effective in the Philippines, with a filing or priority date that is earlier than the filing or priority date of the industrial design or utility model application: Provided, That the application which has validly claimed priority shall be prior art with effect as of the said priority date, Provided Further, That the applicant identified in both applications are not one and the same.

Where two or more applications are independently filed with respect to the same industrial design or utility model, and the later applications are filed before the publication of the first application or earliest application, the whole contents of such first or earliest application shall be novel with respect to the later application or applications.

**RULE 402.** Non-Prejudicial Disclosure. — The disclosure of information contained in the industrial design application during the six (6) months preceding the filing date or the priority date of the application or during the twelve (12) months preceding the filing date or priority date in the case of utility model application shall not prejudice the applicant on the ground of lack of novelty if such disclosure was made by:

(a) The Maker/Designer;

(b) A patent office and the information was contained [i] in another application filed by the maker/designer and should have not been disclosed by the patent office, or [ii] in an application filed without the knowledge or consent of the designer by a third party which obtained the information directly or indirectly from the maker/designer; or

(c) A third party which obtained the information directly or indirectly from the maker/designer;

For the purposes of this Rule "designer" also means any person who, at the filing date of application, had the right to the industrial design. [As amended Office Order No. 09(2000)]

## CHAPTER 2

### Right to a Registration

**RULE 403.** Right to a Registration. — The right to a registration belongs to the maker or designer, his heirs, or assigns. When two (2) or more persons have jointly made a utility model or industrial design, the right shall belong to them jointly.

**RULE 404.** Who may be Named in an Application as an Applicant. — The application may be filed by the actual maker(s) or designer(s) or in the name of his heirs, legal representative or assigns.

**RULE 405.** Utility Models and Industrial Designs Created Pursuant to a Commission. — The person who commissions the work shall own the registration, unless otherwise provided in the contract.

In case the employee made the invention in the course of his employment contract, the registration shall belong to:

(a) The employee, if the activity is not a part of his regular duties even if the employee uses the time, facilities and materials of the employer.

(b) The employer, if the utility model or industrial design is the result of the performance of his regularly-assigned duties, unless there is an agreement, express or implied, to the contrary.

**RULE 406.** Multiple Priorities. — An application can claim more than one priority even from different countries. If more than one patent priority is claimed, time limits computed from the priority date will be based upon the earliest priority date.

**RULE 406.1.** If one or more priorities are claimed, the right of priority shall cover only those elements of the application which are included in the application or applications whose priority is claimed.

**RULE 406.2.** If certain elements of the utility model or industrial design for which priority is claimed do not appear among the claims formulated in the previous application, priority may nonetheless be granted, provided that the previous application as a whole specifically disclose such elements.

**RULE 406.3.** Where an application could have claimed the priority of an earlier application, but when filed, did not contain such priority, the applicant shall be given two (2) months from the filing date to submit the priority claim.

Submission of priority claim after the filing of the application shall be accompanied by a declaration of the applicant stating that the delay in submitting the priority claim was unintentional.

**RULE 407.** Certified Copy of the Foreign Applications. — The certified copy of foreign applications on which the priority claim is based shall be the copy of the application(s) as duly certified to be a true and faithful reproduction thereof by the Industrial Property Office which

received it or any other office which has official custody of the foreign application(s).

### CHAPTER 3

#### The Application

**RULE 408 (a).** All papers for an application for a utility model and industrial design registration which are to become part of the permanent records of the Office must be the original copy only, and legibly written, typewritten, or printed in permanent ink only on one side of the sheet. If necessary, only graphic symbols and characters and chemical or mathematical formulas may be written by hand or drawn. The typing shall be 1½ spaced. All text matter shall be in characters, the capital letters of which are not less than 0.21 cm. high, and shall be in dark, indelible color. [As amended Office Order No. 09(2000)]

(b) The documents making up the application shall be on a 29.7 cm x 21 cm paper or the size of an A4 paper which shall be pliable, strong, white, smooth, matt and durable.

(c) The specification and claim(s) of the application must be written with the lines numbered in sets of five and the number appearing on the left side margin.

(d) The description and the claims may contain chemical or mathematical formulas. The description may contain tables. The claims may contain tables only if their subject matter makes the use of tables desirable. Tables and chemical or mathematical formula may be placed sideways on the sheet if they cannot be presented satisfactorily in an upright position thereon; sheets on which tables or chemicals or mathematical formulas are presented sideways shall be so presented that the tops of the tables or formula are at the left side of the sheet.

(e) Physical values shall be expressed in the units recognized in international practice, wherever appropriate in terms of the metric system using system international (SI) units. Any data not meeting this requirement must also be expressed in the units recognized in international practice. For mathematical formula, the symbols in general use shall be employed. For chemical formula the symbols, atomic weights and molecular formula in general use shall be employed. In general, use should be made of the technical terms, signs and symbols generally accepted in the field in question.

(f) The terminology and the signs shall be consistent throughout the application.

(g) Each of the documents making up the application (request for registration, description, claims, drawings and abstract of the disclosure) shall commence on a separate sheet. The separate sheets shall be filed in such a way that they can easily be turned over, and joined together again. [As amended Office Order No. 09(2000)]

(h) Margins

The margins of the documents shall be within the following ranges:

Top 2 cm. 4 cm.

Leftside 2.5 cm. 4 cm.

Rightside 2. cm. 3 cm.  
Bottom 2 cm. 3 cm.

The margins of the documents making up the application must be completely blank.

All the sheets making up the documents shall have their pages numbered consecutively using Arabic numeral. The page numbers shall appear in the central portions of either the top or bottom margins.

(i) The documents making up the application except the request for grant shall be filed in four (4) copies.

**Rule 408 (j).** Paragraphs (d), (e) and (f) of this Rule shall only be applicable to utility model applications. [As amended Office Order No. 09(2000)]

**RULE 409.** Prohibited Matter. — (a) The application shall not contain:

- (i) a statement or other matter contrary to "public order" or morality;
  - (ii) statement disparaging the products or processes of any particular person other than the applicant, or the merits or validity of applications or patents of any such person. Mere comparison with the prior art shall not be considered disparaging per se; [As amended Office Order No. 09(2000)]
  - (iii) any statement or other matter obviously irrelevant or unnecessary under the circumstances.
- (b) If an application contains prohibited matter within the meaning of this Rule, the Bureau shall omit it when publishing the registration, indicating the place and number of words or drawing omitted.

**RULE 410.** Information Concerning Corresponding Foreign Application. — The applicant shall, at the request of the Director, furnish him with the date and number of any application filed by him abroad, hereafter referred to as the "foreign application", relating to the same or essentially the same utility model or industrial design as that claimed in the application filed with the Office and other documents relating to the foreign application.

**RULE 411.** Other Documents Relating to the Foreign Application may Consist of the Following:

- (a) A copy of the search reports in English on the corresponding or related foreign application prepared by the European, Japanese or United States Patent Offices, searching authorities under the Patent Cooperation Treaty or by the office where the first application was filed.
- (b) Photocopy of the relevant documents cited in the search report;
- (c) Copy of the patent granted to the corresponding or related application;
- (d) Copy of the examination report or decision on the corresponding or foreign related application; and
- (e) Other documents which could facilitate registration.

**RULE 412.** Non-Compliance. — The application is considered withdrawn if the applicant fails to comply with the requirement to furnish information concerning the corresponding foreign application within the specified period.

## CHAPTER 4

### Drawings

**RULE 413.** General Requisites for the Drawing. — The drawing must be signed by the applicant or the name of the applicant may be signed on the drawing by his attorney or agent. The drawing must show every feature of the utility model or industrial design covered by the claim(s), and the figures should be consecutively numbered.

**RULE 414.** Drawing for an Improvement. — When the utility model consists of an improvement of an old machine, the drawing must exhibit, in one or more views, the utility model itself, isolated from the old structure, and also, in another view, so much only the old structure as will suffice to show the relation of the utility model therewith.

**RULE 415.** Uniform Standard of Excellence Suited to Photolithographic Process, Required of Drawings. — Unless and until otherwise notified, the printing of the drawings in the IPO Gazette is done by the photolithographic process, and therefore the character of each original drawing must be brought as nearly as possible to a uniform standard of excellence suited to the requirements of the process, to give the best results, in the interests of the inventors, makers and designers, of the Office, and of the public. The following rules will therefore be strictly enforced, and any departure from them will be certain to cause delay in the registration of an application.

**RULE 416.** Paper and Ink. — Drawings must be made upon paper that is flexible, strong, white, smooth, non-shiny and durable. Two ply or three ply Bristol board is preferred. The surface of the paper should be calendered and of a quality which will permit erasure and correction with India ink. India ink, or its equivalent in quality, is preferred for pen drawings to secure perfectly black solid lines. The use of white pigments to cover lines is not permissible.

**RULE 417.** Size of Drawing Sheet; Imaginary Line. — The size of a sheet on which a drawing is made must be exactly 29.7 cm x 21 cm or the size of an A4 paper. The minimum imaginary margins shall be as follows: top 2.5 cm; left side 2.5 cm; right side 1.5 cm; bottom 1 cm. Within this imaginary margin all work and signatures must be included. One of the shorter sides of the sheet is regarded as its top, and, measuring downwardly from the imaginary line, a space of not less than 3 cm is to be left blank for the heading of title, name, number, and date.

**RULE 418.** Character and Color Lines. — All drawings must be made with the pen or by a photolithographic process which will give them satisfactory reproduction characteristics. Every line and letter (signatures included) must be absolutely black. This direction applies to all lines, however fine, to shading and to lines representing cut surfaces in sectional views. All lines must be clean, sharp, and solid, and they must not be too fine or crowded. Surface shading, when used, should be open. Sectional shading should be made by oblique parallel lines, which may be about 0.3 cm apart. Solid black should not be used for sectional or surface shading. Freehand work should be avoided whenever possible.

**RULE 419.** The Fewest Possible Number of Lines and Little or No Shading to be Used. — Drawings should be made with the fewest lines possible consistent with clearness. By the observance of this rule the effectiveness of the work after reduction will be much increased.

Shading (except on sectional views) should be used sparingly, and may even be dispensed with if the drawing be otherwise well executed. The plane upon which a sectional view is taken should be indicated on the general view by a broken or dotted line, which should be designated by numerals corresponding to the number of the sectional view. Heavy lines on the shade sides of objects should be used, except where they tend to thicken the work and obscure letter of reference. The light is always supposed to come from the upper left hand corner of an angle of 45 degrees.

**RULE 420.** Scale to which Drawing is Made to be Large Enough. — The scale to which a drawing is made ought to be large enough to show the mechanism without crowding, and two or more sheets should be used if one does not give sufficient room to accomplish this end; but the number of sheets must never be more than what is absolutely necessary.

**RULE 421.** Letters and Figures of Reference. — The different views should be consecutively numbered. Letters and figures of reference must be carefully formed. They should, if possible, measure at least 32 millimeters in height, so that they may bear reduction to 10.6 millimeters; and they may be much larger when there is sufficient room. They must be so placed in the close and complex parts of drawings as not to interfere with a thorough comprehension of the same, and therefore should rarely cross or mingle with the lines. When necessarily grouped around a certain part, they should be placed at a little distance where there is available space, and connected by lines with the parts to which they refer. They should not be placed upon shaded surfaces, but when it is difficult to avoid this, blank space must be left in the shading where the letter occurs, so that it shall appear perfectly distinct and separate from the work. If the same part of utility model or industrial design appears in more than one view of the drawing, it must always be represented by the same character, and the same character must never be used to designate different parts.

**RULE 422.** Signature, where to be Placed. — The signature of the applicant should be placed at the lower right-hand corner within the imaginary margins of each sheet, but in no instance should they trespass upon the drawings.

**RULES 423.** Title of the Drawing. — The title should be written with pencil on the back of the sheet. The permanent name and title constituting the heading will be applied subsequently by the Bureau of Patents in uniform style.

**RULE 424.** Position on Drawing Sheets of Large Views. — All views on the same sheet must stand in the same direction and must, if possible, stand so that they can be read with the sheet held in an upright position. If views longer than the width of the sheet are necessary for the proper illustration of the utility model or industrial design, the sheet may be turned on its side. The space for heading must then be reserved at the right and the signatures placed at the left, occupying the same space and position as in the upright views and being horizontal when the sheet is held in an upright position. One figure must not be placed upon another or within the outline of another.

**RULE 425.** Flow Sheets and Diagrams. — Flow Sheets and diagrams are considered drawings.

**RULE 426.** Requisites for the Figure of the IPO Gazette. — As a rule, only one view of each utility model or industrial design can be shown in the IPO Gazette illustrations. The selection of

that portion of a drawing best calculated to explain the nature of the utility model or industrial design or its specific improvement would be facilitated and the final result improved by judicious execution of a figure with express reference to the IPO Gazette, but which must at the same time serve as one of the figures referred to the specification. For this purpose the figure may be a plan, elevation, section, or perspective view, according to the judgment of the draftsman. All its parts should be especially open and distinct, with very little or no shading, and it must illustrate only the utility model or industrial design claimed, to the exclusion of all other details. When well executed, it will be used without curtailment or change, but any excessive fineness or crowding or unnecessary elaborateness of detail will necessitate its exclusion from the IPO Gazette.

**RULE 427.** Reference Signs. — Reference signs not mentioned in the description and claims shall not appear in the drawings and vice versa. The same features, when denoted by reference signs, shall throughout the application, be denoted by the same signs.

**RULE 428.** Photographs. — (a) Photographs are not normally considered to be proper drawings. Photographs are acceptable for obtaining a filing date and generally considered to be informal drawings. Photographs are only acceptable where they come within the special categories as set forth in the paragraph below. Photolithographs of photographs are never acceptable.

(b) The Office is willing to accept black and white photographs or photomicrographs (not photolithographs or other reproduction of photographs made by using screens) printed on sensitized paper in lieu of India ink drawings, to illustrate the inventions which are incapable of being accurately or adequately depicted by India ink drawings restricted to the following categories: crystalline structures, metallurgical microstructures, textile fabrics, grain structures and ornamental effects. The photographs or photomicrographs must show the utility model or industrial design more clearly than they can be done by the India ink drawings and otherwise comply with the rules concerning such drawings.

(c) Such photographs to be acceptable must be made on photographic paper having the following characteristics which are generally recognized in the photographic trade: paper with a surface described as smooth, tint, white, or be photographs mounted on a proper sized Bristol board.

**RULE 429.** Matters not Permitted to Appear on the Drawings. — An agent's or attorney's stamp, or advertisement or written address shall not be permitted on the drawings.

**RULE 430.** Drawings not Conforming to Foregoing Rules to be Accepted Only Conditionally. — A drawing not executed in conformity to the foregoing rules may be admitted for purposes of according a filing date only. In such cases, the drawing must be corrected or a new one furnished within two (2) months from mailing date of the formality report. Otherwise, the application shall be deemed withdrawn.

Applicants are advised to employ competent draftsman to make their drawings.

## CHAPTER 5

### Representation, Signatures

**RULE 431.** Employment of Attorney-at-Law or Agent Recommended. — An applicant or an assignee of the entire interest may prosecute his own case, but he is advised, unless familiar with such matters, to employ a competent attorney-at-law or agent, as the value of patents depends largely upon the skillful preparation of the specification and claims. The Office cannot aid in the selection of an attorney-at-law or agent.

**RULE 432.** Appointment of Resident Agent or Representative. — An applicant who is not a resident of the Philippines must appoint and maintain a resident agent or representative in the Philippines upon whom notice or process for judicial or administrative procedure relating to the application or the registration may be served.

If there are two (2) or more agents appointed by the applicant, the Office shall forward all correspondence to the latest agent appointed. A substitute or associate attorney may be appointed by an attorney only upon the written authorization of his principal; but a third attorney appointed by the second will not be recognized.

**RULE 433.** Revocation of Power of Attorney. — A power of attorney or authorization may be revoked upon proper notification to the Director General, and, when revoked, the Office will notify the attorney or agent of such revocation and shall communicate with the latest attorney or agent appointed. [As amended Office Order No. 09(2000)]

**RULE 434.** Decorum and Courtesy Required in the Conduct of Business. — Applicants, their attorneys or agents are required to conduct their business with the Office with politeness, decorum, and courtesy. Applicants who act or persist in acting in violation of this rule, shall be required to be represented by attorney, and papers presented containing matter in violation of this Rule will be submitted to the Director General and returned to the sender, by his direct order.

## CHAPTER 6

### Who may Request for a Registration

**RULE 435.** Who may Request for a Registration. — Any person, natural or juridical, may request for a registration. If the applicant is not the maker/designer, the Office may require him to submit proof of his authority to apply for a registration.

**RULE 436.** When the Applicant Dies, Becomes Insane. — In case the applicant dies, becomes insane or incapacitated, the legally appointed administrator, executor, guardian, conservator, or representative of the applicant, may sign the application papers and other documents, and apply for and obtain the certification of registration in the name of the applicant, his heirs or assignee.

**RULE 437.** Assigned Applications. — In case the whole interest in the utility model or industrial

design is assigned, the application may be filed by or in the name of the assignee who may sign the application. In case the assignee is a juridical person, any officer thereof may sign the application in behalf of the said person. In case of an aliquot portion or undivided interest, any of the joint owners will sign the application.

**RULE 438.** Juridical Person — Definition. — A juridical person is a body of persons, a corporation, a partnership, or other legal entity that is recognized by law which grants a juridical personality separate and distinct from that of a share holder, partner or member.

**RULE 439.** Proof of Authority. — If the person who signs the application in behalf of a juridical person is an officer of the corporation, no proof of authority to file the said application will be required. However, if any other person signs for and in behalf of a juridical person, the Office shall require him to submit proof of authority to sign the application.

If the applicant appoints a representative to prosecute and sign the application, the Office shall require proof of such authority.

**RULE 440.** Forms of Signatures. — Where a signature is required, the Office may accept:

- (a) A hand-written signature; or
- (b) The use of other forms of signature, such as a printed or stamped signature, or the use of a seal, or thumb marks, instead of a hand-written signature. Provided, That where a seal or a thumbmark is used, it should be accompanied by an indication in letters of the name of the signatory.

No attestation, notarization, legalization or other certification of any signature or other means of self-identification referred to in the preceding paragraphs, will be required, except, where the signature concerns the surrender of a Certificate of Registration.

## **CHAPTER 7**

### Classification and Search

**RULE 441.** Classification and Search. — An application for utility model or an industrial design shall be classified and a search conducted to determine the prior art. [As amended Office Order No. 09(2000)]

**RULE 442.** Content of the Search Report. — The Search Report is drawn up on the basis of the claims, description, and the drawings if there is any:

- (a) The search report shall mention those documents, available at the Office at the time of drawing up the report, which may be taken into consideration in assessing novelty.
- (b) The search report shall contain the classification of the subject matter of the application in accordance with the International Classification.
- (c) The search report may include documents cited in a search established in the corresponding foreign application.

Upon payment of the required fees, the Office shall provide a copy of the Search Report with

respect to any published utility model and industrial design within a maximum period of two (2) months from receipt of the request. [As amended Office Order No. 09(2000)]

**RULE 443.** Confidentiality Before Publication. — A registration, which has not yet been published, and all related documents shall not be made available for inspection without the consent of the registrant.

**RULE 444.** Unpublished, Withdrawn and Forfeited Applications not Cited. — Unpublished, withdrawn and forfeited applications as such will not be cited as references.

## CHAPTER 8

### Amendments; Withdrawal by the Applicant

**RULE 445.** Amendment by the Applicant. — An applicant may amend the application prior to registration: Provided, That such amendment shall not include new matter outside the scope of the disclosure contained in the application as filed.

**RULE 446.** Amendment and Revision Required. — The description, claim(s) and drawing(s) must be amended and revised when required, to correct inaccuracies of disclosure and definition or unnecessary prolixity, and to secure correspondence between the claim(s), the description and the drawing(s).

**RULE 447.** Manner of Making Amendments. — Erasures, additions, insertions, or alterations of the papers and records must not be made by the applicant. Amendments by the applicant are made by filing a paper in accordance with these Regulations, directing or requesting that specified amendments be made. The exact word or words to be stricken out or inserted in the application must be specified and the precise point indicated where the deletion or insertion is to be made. The basis of the proposed amendments in the original application as filed shall be indicated.

**RULE 448.** Entry and Consideration of Amendments. — (a) Amendments are entered by the Office by making the proposed deletions by drawing a line in red ink through the word or words cancelled, and by making the proposed substitutions or insertions in red ink, small insertions being written in at the designated place and larger insertions being indicated by reference.

**RULE 449.** Amendments to the Drawing. — The paper requesting amendments to the drawing should be separate from other papers. The drawing may not be withdrawn from the Office except for signature. Substitute drawings will not ordinarily be admitted in any case unless required by the Office.

**RULE 450.** Substitute Specification. — If the number or nature of the amendments shall render it difficult to arrange the papers for printing or copying, the Examiner may require the entire description or claim(s), or any part thereof, to be rewritten. A substitute specifications will ordinarily not be accepted unless it has been required by the Examiner. A substitute specifications may be required within two (2) months from registration prior to publication of the registration in the IPO Gazette.

**RULE 451.** Express Withdrawal of Application. — An application may be expressly withdrawn by filing in the Office a written declaration of withdrawal, signed by the applicant himself and the assignee of record, if any, and identifying the application.

## CHAPTER 9

### Time for Response by Applicant; Withdrawal of Application for Failure to Respond Within Time Limit

**RULE 452.** Withdrawal of Application for Failure to Respond to the Formality Examination Report and the Notice of Issuance and Publication Fees Within the Prescribed Time Limit. —

(a) If an applicant fails to prosecute his application within the required time as provided in these Regulations, the application shall be deemed withdrawn.

(b) The time for reply may be extended only for good and sufficient cause, and for reasonable time specified. Any request for such extension must be filed on or before the day on which action by the applicant is due. The Examiner may grant a maximum of two (2) extensions, provided that the aggregate period granted inclusive of the initial period allowed to file the response, shall not exceed six (6) months from mailing date of the official action requiring such response.

(c) Prosecution of an application to save it from being deemed withdrawn must include such complete and proper action as the condition of the case may require. Any amendment not responsive to the last official action shall not operate to save the application from being deemed withdrawn.

(d) When the action by the applicant is a bona fide attempt to advance the case to final action, and is substantially a complete response to the Examiner's action, but consideration of some matter or compliance with some requirements has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of withdrawal is considered.

(e) Prompt ratification or filing of a correctly signed copy may be accepted in case of an unsigned or improperly signed paper.

**RULE 453.** Revival of Application. — An application deemed withdrawn for failure to prosecute may be revived as a pending application within a period of four (4) months from the mailing date of the notice of withdrawal if it is shown to the satisfaction of the Director that the failure was due to fraud, accident, mistake or excusable negligence.

A petition to revive an application deemed withdrawn must be accompanied by (1) a showing of the cause of the failure to prosecute, (2) a complete proposed response, and (3) the required fee.

An application not revived in accordance with this rule shall be deemed forfeited. [As amended Office Order No. 09(2000)]