

PART 6

Other Proceedings Affecting the Application or the Registration

CHAPTER 1

Assignment

RULE 600. *Form of Assignment.* — To be acceptable for recording, the assignment:

- (a) must be in writing and if in a language other than English or Filipino, the document must be accompanied by an English translation;
- (b) must be acknowledged before a notary public or other officer authorized to administer oaths and perform other notarial acts, and be certified under the hand and official seal of the said notary or other officer;
- (c) must be accompanied by an appointment of a resident agent, if the assignee is not domiciled in the Philippines;
- (d) must identify the registration involved by number and date, giving the name of the registrant and the title of the utility model or industrial design as set forth in the certificate; in the case of an application for registration, the application number and filing date of the application should be stated, giving also the name of the applicant, and the title of the utility model or industrial design, set forth in the application, but if an assignment is executed concurrently with or subsequent to the execution of the application but before the application is filed, it should adequately identify the application, by its date of execution and name of the applicant, and the title of the utility model or industrial design; so that there can be no mistake as to the utility model or industrial design or application intended; and
- (e) must be accompanied by the required recording and publication fees.

RULE 601. *Form of Other Instrument Affecting the Title to a Registration or Application, Including Licenses.* — In order to be acceptable for recording, the form of such other instrument, including licenses, must conform with the requirements of the preceding rule.

RULE 602. *Assignment and Other Instruments to be Submitted in Duplicate.* — The original document of assignment, together with a signed duplicate thereof, shall be submitted; but if the original is not available, two certified copies thereof may be submitted instead. After recording, the Office shall retain the signed duplicate or one of the certified copies, as the case may be, and return the original or the other certified copy to the party filing the assignment, with a notation of the fact of recording.

RULE 603. *Date of Receipt of Assignment or Other Instrument or License Considered its Date of Recording.* — The date of recording of an assignment or other instruments is the date of its receipt at the Office in proper form and accompanied by the full recording fee.

Rule 604. *Certificates may be Issued to the Assignee in Place of the Applicant.* — In the case of the assignment of a pending application for registration, the certificate may be issued to the assignee of the applicant, provided the assignment has been recorded in the Office before the actual issue of the certificate.

RULE 605. *Action may be Taken by Assignee of Record in any Proceeding in the Office.* — Any

action in any proceeding in the Office which may or must be taken by a patentee or applicant may be taken by the assignee, provided the assignment has been recorded.

CHAPTER 2

Surrender, Correction and Amendment of Certificate

RULE 606. *Surrender of Certificate.* — (a) The owner of the registration, with the written and verified consent of all persons having grants or licenses or other right, title or interest in and to the registration and the utility model or industrial design covered thereby, which have been recorded in the Office, may surrender his registration, any claim or claims forming part thereof to the Office for cancellation. The petition for cancellation shall be in writing, duly verified by the petitioner and if executed abroad shall be authenticated.

(b) Any person may give notice to the Office of his opposition to the surrender of a registration, and if he does so, the Bureau shall notify the proprietor of the registration and determine the question.

(c) If the Office is satisfied that the registration may properly be surrendered, it may accept the offer and, as from the day when notice of his acceptance is published in the IPO Gazette, the registration shall cease to have effect, but no action for infringement shall lie and no right compensation shall accrue for any use of the registered utility model or industrial design before that day for the services of the government.

RULE 607. *Correction of Mistakes of the Office.* — Upon written petition, in duplicate, of the patentee or assignee of record, and upon tender to the Office of the copy of the registration issued to the patentee, the Director shall have the power to correct without fee any mistake in a registration incurred through the fault of the Office when clearly disclosed by the records thereof, to make the registration conform to the records.

RULE 608. *Correction of Mistake in the Application.* — On request of any interested person and payment of the prescribed fee, the Director is authorized to correct any mistake in the registration of a formal and clerical nature, not incurred through the fault of the Office.

RULE 609. *Changes in Registration.* — The owner of the registration shall have the right to request the Bureau to make changes in the Certificate in order to:

- (a) Limit the extent of the protection conferred by it;
- (b) Correct obvious mistakes or to correct clerical errors; and
- (c) Correct mistakes or errors, other than those referred to in letter (b), made in good faith; Provided, That were the change would result in broadening of the extent of the protection conferred by the registration, no request may be made after the expiration of two (2) years from the grant of a registration and the change shall not affect the rights of any third party which has relied on the registration, as published.

RULE 610. *Form and Publication of Amendment or Corrections.* — An amendment or correction of a registration shall be accomplished by a certificate of such amendment or correction, authenticated by the seal of the Office and signed by the Director, which certificate

shall be attached to the registration. Notice of such amendment or correction shall be published in the IPO Gazette and copies of the registration furnished by the Office shall include a copy of the certificate of the amendment or correction.

CHAPTER 3

Recordal; Transmission of Rights

RULE 611. *Transmission of Rights.* — Registration and applications for utility models and industrial designs shall be protected in the same way as the rights of other property under the Civil Code. Utility models and industrial designs and any right, title or interest in and to registration and utility models and industrial designs covered thereby may be assigned, or transmitted by inheritance or bequest or may be the subject of a license contract.

RULE 612. *Assignment.* — An assignment may be of the entire right, title or interest in and to the registration and application for utility models and industrial designs covered thereby, or of an undivided share of the entire registration and utility models and industrial designs in which event the parties become joint owners thereof. An assignment may be limited to a specified territory.

RULE 613. *Recording.* — The Office shall record assignments, licenses and other instruments relating to the transmission of any right, title or interest in and to certificates of registration or application for utility models and industrial designs, which are presented in due form to the Office for registration, in books and records kept for the purpose. The original document together with a signed duplicate thereof shall be filed and the contents thereof should be kept confidential. If the original is not available, certified copy thereof in duplicate may be filed. Upon recording, the Office shall retain the duplicate, and return the original or the certified copy to the party who filed the same and notice of the recording shall be published in the IPO Gazette.

Such instruments shall be void as against any subsequent purchaser or mortgagee for a valuable consideration and without notice unless it is recorded in the Office within three (3) months from the date thereof, or prior to the subsequent purchase or mortgage.

RULE 614. *Rights of Joint Owners.* — If two or more persons jointly own a registration and the utility model or industrial design covered thereby either by the issuance of the registration in their joint favor or by reason of the assignment of an undivided share in the registration and utility model or industrial design or by reason of the succession in title to such share, each joint owner shall be entitled to personally make, use, sell or import the utility model or industrial design for his own profit: Provided, however, That neither of the joint owners shall be entitled to grant licenses or to assign his right, title or interest or part thereof without the consent of the other owner or owners, or without proportionately dividing the proceeds with the other owner or owners.

CHAPTER 4

Request for Registrability Report

RULE 615. *Who May Request For Registrability Report.* The applicant or any interested party, including judicial and quasi-judicial agencies where a case is pending involving the utility model or industrial design concerned, may, upon payment of the required fee, request for registrability report concerning registered utility model or industrial design. Judicial and quasi-judicial agencies requesting registrability report, however, shall be exempt from the payment of fees. [As amended Office Order No. 61(2001)]

RULE 616. *Contents of Registrability Report.* — The registrability report concerning a registered utility model or industrial design shall contain citations of relevant prior art documents with appropriate indications as to their degree of relevance which may serve as an aid to the requesting party in the determination of the validity of the utility model claim(s) or the industrial design claim in respect to newness.

Where a registrability report has been issued prior to registration, and published after registration, of the utility model or industrial design in accordance with these Regulations, the registrability report issued hereunder shall be limited to the published registrability report; Provided, however, That the person requesting for the registrability report of the registered utility model or industrial design may expressly request that the registrability report include such other information or documents that may have arisen after the registration of the utility model or industrial design.

RULE 617. *Time within which to Issue Report.* — The registrability report shall be given to the party requesting within two (2) months from receipt of the request together with full payment of the required fee.