

THE REVISED IMPLEMENTING RULES AND REGULATIONS FOR PATENTS, UTILITY MODELS AND INDUSTRIAL DESIGNS

Whereas, the State recognizes that an effective industrial property system is vital to the development of domestic creativity, facilitates transfer of technology, attracts foreign investments, and ensures market access for our products;

Whereas, it is the policy of the State to streamline administrative procedures in granting patents and enhance the enforcement of intellectual property rights in the Philippines;

Now, therefore, pursuant to the provisions of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines, the following rules and regulations on inventions, utility models, and industrial designs are hereby promulgated.

GENERAL PROVISIONS **TITLE AND CONSTRUCTION**

Section 1. *Title of the Rules.* – These rules shall be known as the Revised Implementing Rules and Regulations for Patents, Utility Models, and Industrial Designs.

Section 2. *Applicability of the Rules.* – These rules shall apply to all cases involving the filing and examination of patent, utility model, and industrial design applications, including the grant and post-grant requirements and processes for letters patent as well as the registration and post-registration requirements and processes of utility models and industrial designs.

Section 3. *Construction of the Rules.* – These rules shall be liberally construed in order to achieve the objectives of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines.

PART 1 **DEFINITIONS**

Rule 100. *Definitions.* – Unless otherwise specified, the following terms shall have the meaning provided in this rule:

- (a) “Bureau” means the Bureau of Patents;
- (b) “Director” means the Director of the Bureau of Patents;
- (c) “Director General” means the Head of the Intellectual Property Office;
- (d) “Examiner” means any officer or employee of the Bureau of Patents authorize to examine applications;
- (e) “IP Code” means Republic Act No. 8293 otherwise known as the Intellectual Property Code of the Philippines;
- (f) “IPOPHE E-Gazette” means the Intellectual Property Office’s own publication where all matters required to be published under the IP Code shall be published;
- (g) “Office” means the Intellectual Property Office;
- (h) “PCT” means the Patent Cooperation Treaty;

- (i) “Regulations” mean this set of rules and regulations and such Rules of Practice as may be formulated by the Director of Patents and approved by the Director General;
- (j) “WIPO” means the World Intellectual Property Office.

PART 2 **PATENTABILITY**

Rule 200. Patentable Inventions. – Any technical solution of a problem in any field of human activity which is new, involves an inventive step and is industrially applicable shall be patentable (Sec. 21, IP Code).

Rule 201. Statutory Classes of Patentable Inventions. – A patentable invention may be or may relate to:

- (a) A product, such as a machine, a device, an article of manufacture, a composition of matter, a microorganism;
- (b) A process, such as a method of use, a method of manufacturing, a non-biological process, a microbiological process;
- (c) Computer-related inventions; and
- (d) An improvement of any of the foregoing.

Rule 202. Non-patentable Inventions. – The following shall be excluded from patent protection:

- (a) Discoveries, scientific theories, and mathematical methods, a law of nature, a scientific truth, or knowledge as such; *
- (b) Abstract ideas or theories, fundamental concepts apart from the means or processes for carrying the concept to produce a technical effect;
- (c) Schemes, rules, and methods of performing mental acts and playing games;
- (d) Method of doing business, such as a method or system for transacting business without the technical means for carrying out the method or system;
- (e) Programs for computers;
- (f) 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;
- (g) Plant varieties or animal breeds or essentially biological process for the production of plants and animals. This provision shall not apply to microorganisms and non-biological and microbiological processes;
- (h) Aesthetic creations; and
- (i) Anything which is contrary to public order, health, welfare, or morality, or process for cloning or modifying the germ line genetic identity of humans or animals or uses of the human embryo.

**In the case of drugs and medicines involving known substances, please refer to the Implementing Rules and Regulations of Republic Act 9502, otherwise known as the “Universally Accessible Cheaper and Quality Medicines Act of 2008”.*

Rule 203. Novelty. – An invention shall not be considered new if it forms part of a prior art (Sec. 23, IP Code).

Rule 204. Prior Art. – Prior art shall consist of:

- (a) Everything made available to the public anywhere in the world by means of a written or oral disclosure, by use, or in any other way, before the filing date or the priority date of the application claiming the invention. Information is deemed available to the public when it is not confidential or restricted to the use by a selective group. Prior use and oral disclosure, whether within or outside the Philippines, must be proven with substantial evidence.
- (b) The whole contents of an earlier application for a patent, utility model, or industrial design registration, published by the Intellectual Property Office of the Philippines, filed or effective in the Philippines, with a filing or priority date that is earlier than the filing or priority date of the application; Provided, that the application which has validly claimed the filing date of an earlier application under Section 31 of the IP Code, shall be prior art with effect as of the filing date of such earlier application; Provided further, that the applicant or the inventor of the invention identified in both applications are not one and the same (Sec. 24, IP Code).
- (c) The whole contents of corresponding foreign applications disclosing substantially the same invention, or a description thereof, published before the filing date of the application. Inventions are considered substantially the same if the composition of all important particulars, excluding mere formal, unimportant or obvious variations, define the invention.
- (d) Where two or more applications are independently filed with respect to the same invention, and the later applications are filed before the first application or earlier application is published, the whole contents of the first or earliest filed application published in accordance with Section 44 of the IP Code on or after the filing date or priority date of the later filed application shall be novelty destroying with respect to the later application filed.

Rule 204.1. Equivalentents. – A strict identity test is required to be applied in assessing novelty. A single prior art reference must disclose each and every element of a claimed invention in order to destroy novelty. Equivalentents are considered only in assessing inventive step.

Rule 205. Non-prejudicial Disclosure. – The disclosure of information contained in the application during the twelve (12) months preceding the filing date or the priority date of the application shall not prejudice the applicant on the ground of lack of novelty if such disclosure was made by:

- (a) The inventor or any person, who, at the filing date of the application, had the right to the patent.
- (b) A foreign patent office, the Bureau, or the Office, and such information was contained in:
 - (i) another application filed by the inventor and should not have been disclosed by the Office; or

- (ii) an application filed without the knowledge or consent of the inventor by a third party which obtained the information directly or indirectly from the inventor; or
- (c) A third party which obtained the information directly or indirectly from the inventor, provided further that all foreign patent offices that publish pending patent applications, as well as the WIPO which publishes patent applications filed through the PCT are excluded therefrom.

Rule 206. *Inventive Step.* –

- (a) An invention involves an inventive step if, having regard to the prior art, it is not obvious to a “person skilled in the art” at the time of the filing date or priority date of the application claiming the invention (Sec. 26, IP Code).
- (b) Only prior art made available to the public before the filing date or priority date shall be considered in assessing inventive step.

Rule 207. *Person Having Ordinary Skills in the Art.* – The person having ordinary skills in the art is presumed to be an ordinary practitioner aware of what is common general knowledge in the art at the relevant date. He is presumed to have knowledge of all references that are sufficiently related to one another and to the pertinent art and to have knowledge of all arts reasonably pertinent to the particular problems with which the inventor was involved. He is presumed also to have had at his disposal the normal means and capacity for routine work and experimentation.

Rule 208. *Industrial Applicability.* – An invention that can be produced and used in any industry shall be industrially applicable (Sec. 27, IP Code).

PART 3
RIGHT TO A PATENT

Rule 300. *Right to a Patent.* – The right to a patent belongs to the inventor, his heirs, or his assigns. When two (2) or more persons have jointly made an invention, the right to a patent shall belong to them jointly (Sec. 28, IP Code).

Rule 301. *Who may be named in an application as an applicant.* – The application may be filed by the actual inventor(s) or in the name of his heirs, legal representatives, or assigns.

Rule 302. *Inventions Created Pursuant to a Commission.* – The person who commissions the work shall own the patent, unless otherwise provided in the contract (Sec. 30.1, IP Code).

Rule 303. *Inventions made in the course of employment.* – In case the employee made the invention in the course of his employment contract, the patent shall belong to:

- (a) The employee, if the inventive activity is not the part of his regular duties even if the employee uses the time, facilities, and materials of the employer.
- (b) The employer, if the invention is the result of the performance of his regularly-assigned duties, unless there is an agreement, express or implied, to the contrary (Sec. 30.2, IP Code).

Rule 304. *First-to-File Rule.* – If two (2) or more persons have made the same invention separately and independently of each other, the right to the patent shall belong to the person who filed an application for such invention, or where two or more applications are filed for the same invention, to the applicant who has the earliest filing date or the earliest priority date (Sec. 29, IP Code).

Where two (2) or more applications for the same invention made separately and independently of each other have the same filing date or priority date, the time of the day the applications were filed will be considered in deciding who is entitled to the patent.

Rule 305. *Right of Priority.* – An application patent filed by any person who has previously applied for the same invention 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 of 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 the filing in the Philippines (Sec. 31, IP Code).

The six (6)-month period may be extended by the Director for a maximum of six (6) months upon showing of good cause or in compliance with treaties to which the Philippines is or may become a member.

Rule 306. *Multiple Priorities.* – An application can claim more than one priority even from different countries. If more than one (1) priority is claimed, time limits computed from the priority date will be based upon the earliest priority date; Provided, that the local application and the priority applications have common inventor(s) or applicant(s).

The corresponding multiple priority claim fee shall be paid upon filing of the claim for multiple priority.

Rule 306.1. If one or more priorities are claimed, the right of priority shall cover only those technical feature or features of the invention which are included in the application or applications whose priority is claimed.

Rule 306.2. If the technical feature or features of the invention for which priority is claimed does not appear among the claims formulated in the previous application, priority may nonetheless be granted; provided, that the previous application as a whole specifically discloses such technical feature or features.

Rule 306.3. Where an application could have claimed the priority of an earlier application, but when filed, did not contain such priority claim, the applicant shall be given two (2) months from the filing date to submit priority claim. Submission of priority claim after the filing of the application shall be accompanied by:

- (a) a declaration of the applicant stating that the delay in submitting the priority claim was unintentional; and
- (b) the full payment of the prescribed fee.

Failure to submit the priority claim within the prescribed period shall result in the application being treated as having no such claim for priority.

Rule 307. *Certified Copy of the Foreign Applications.* – The certified copy of foreign applications mentioned in Rule 305 shall be the copy of the priority application(s) as duly certified to be a true or faithful reproduction thereof by the patent office which received it or any other office which has official custody of the foreign application.

PART 4 **THE PATENT APPLICATION**

Rule 400. *The Patent Application.* – An application for a patent shall be in writing. It may be written in Filipino or English, and shall be filed by post or directly with the Bureau. Filing in electronic format or through the internet may also be done, if and when facilities therefor are made available by the Office. All applications shall be addressed to the Director.

The application shall contain the following:

- (a) A duly accomplished request for the grant of patent;
- (b) A description of the invention;
- (c) Drawing(s) necessary for the understanding of the invention;
- (d) One or more claims; and
- (e) An abstract.

Except for the request for grant, the documents making up the application filed in writing shall be in four (4) copies.

Rule 401. *Payment of Fees.* – An application shall be subject to the full payment of the filing fee, the search fee, and the publication fee (1st publication) within one (1) month after the filing date of the application.

Rule 401.1. *Effect of Non-payment of Fees.* – An application shall be deemed forfeited if the required fees are not fully paid within the period prescribed in Rule 401.

A forfeited application may be retrieved by the applicant by filing a formal written request therefor within four (4) months from the mailing date of the notice of forfeiture of the application. A forfeited application not retrieved within the prescribed period shall be expunged from the records and disposed of by the Bureau.

Rule 402. *Marking of Documents; Acknowledgement.* – The Bureau shall mark the documents making up the application with the date of the receipt. An acknowledgement shall be issued stating the application number, filing date, name of applicant, and title of the invention.

Rule 403. *Form of Request; Office Application Form.* – The request shall be made on a form drawn up by the Office. For the convenience of applicants, the Office shall draw up

and make available a standard application form (request for grant of a patent) which may be reproduced by the applicant and other persons at their own cost.

Rule 404. *The Request.* – The request shall contain the following:

- (a) Petition for the grant of a patent;
- (b) Applicant's name and address;
- (c) Title of the invention;
- (d) Inventor's name;
- (e) If with claim for convention priority, it shall contain the file number, country of origin, and the date of filing in the said country where the application was first filed;
- (f) Name and address of the resident agent/representative (if any); and
- (g) Signature of the applicant or resident agent/representative.

Rule 405. *Disclosure and Description of the Invention.* – The application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person having ordinary skills in the art.

Rule 406. *Test for Enabling Disclosure.* – The test for enabling disclosure is whether the person to whom it is addressed could, by following the directions therein, put the invention into practice.

Rule 406.1. *Enabling Disclosure.* – The enabling disclosure shall contain a clear and detailed description of at least one way of doing the invention using working examples. It shall contain a sufficient and clear disclosure of the technical features of the invention including the manner or process of making, performing, and using the same, leaving nothing to conjecture.

In case of chemical substance and pharmaceutical subject matter, the disclosure must include one or more representative embodiments or working examples, a description of the result of the pharmacological test in the case of pharmaceutical subject matter, and all compounds must include their claimed activity.

Rule 407. *Contents of the Description.* – The description shall:

- (a) Specify the technical field to which the invention relates;
- (b) Indicate the background art which, as far as known to the applicant, can be regarded as useful for understanding the invention, for drawing up the search report and for the examination, and preferably, cite the documents reflecting such art;
- (c) Disclose the invention, as claimed, in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood, and state any advantageous effects of the invention with reference to the background art;
- (d) Where appropriate, refer to the different elements involved in the invention by the use of reference letters or numerals (preferably the latter). Such letters or numerals should be properly depicted in the drawings. In the case of an improvement, the detailed description shall particularly point out the improved

concept that may be regarded as novel and inventive and must be described in relation to the technical feature that belongs to the prior art for a clear and complete understanding of the improvement.

- (e) Briefly describe the figures in the drawings, if any;
- (f) Describe in detail at least one way of carrying out the invention claimed using examples where appropriate and referring to the drawings, if any; and
- (g) Indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is capable of exploitation in the industry.

Rule 408. *Requirements of Application relating to Biological Materials and Microorganisms.* – Where the application concerns a microbiological process, or the product thereof, involving the use of a microorganism which cannot be sufficiently disclosed in the application in such a way as to enable the invention to be carried out by a person having ordinary skills in the art and such material is not available to the public, the invention shall only be regarded as disclosed if:

- (a) A culture of the microorganism has been deposited in a depositary institution before filing the application;
- (b) The depositary institution and the file number of the culture deposit are stated in the application. If this information is not yet available at the time of filing the application, the said information shall be submitted within two (2) months from the request of the Examiner. Publication of the application under Section 44 of the IP Code shall be held pending until submission of the information;
- (c) The application as filed gives relevant information as is available to the applicant on the characteristics of the microorganism.

Rule 409. *Requirements of Application relating to Biological Materials and Microorganisms before Allowance.* – An application which concerns a microbiological process, or the product thereof, involving the use of any novel strain of microorganism shall be allowed only when the following conditions are met:

- (a) A deposit was made in a recognized international depositary authority;
- (b) Proof of such deposit together with the proper identification or deposit number assigned by the depositary; and
- (c) That the depositary should be under the contractual obligation to place the culture in permanent collection and to provide access to persons who shall have interest therein with regard to matters relating to the patent application as published.

Rule 410. *Title of the Invention.* – The title of the invention shall be as short and specific as possible. It shall appear as a heading on the first page of the description. The title shall be in technical terms particularly referring to the technical feature or features of the invention. All fancy names are not permissible in the title.

Rule 411. *Abstract of the Disclosure.* – The abstract shall be written in a separate sheet with the heading, “Abstract of the Disclosure.” It shall consist of a concise summary of the disclosure of the invention as contained in the description, claims, and drawings in preferably not more than one hundred fifty (150) words. It must be drafted in a way which allows the clear understanding of the technical problem, the gist of the

solution of that problem through the invention, and the principal use or uses of the invention. The abstract shall merely serve for technical information. Preferably, the scope of the invention should be disclosed such that it can serve as an efficient basis for search in the particular technical field.

Rule 412. Prohibited Matter. –

(a) The application shall not contain:

- (i) a statement or other matter contrary to “public order” or morality;
- (ii) a statement disparaging the products or processes of any particular person other than the applicant, or the merits or validity of application or patents of any such person. Mere comparison with the prior art shall not be considered disparaging per se; and
- (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 application indicating the place and number of words or drawing omitted.

Rule 413. General Requisites for the Drawings. –

- (a) The drawing must be signed by the applicant or his name may be on the drawing by his attorney or agent. The drawing must show every feature of the invention covered by the claims. The drawing(s) may consist of several views showing every feature of the invention to serve as aid in the complete understanding of the invention and each figure must be consecutively numbered and briefly described as to its matter of presentation.
- (b) When the invention relates to an improvement of the prior art, the drawing must exhibit, in one or more views, the novel or inventive improvement in relation with the old structure presented in dotted lines. Every element of the invention as shown in the drawing shall be designated with legible reference numeral or letter and, if appropriate, shall be accompanied by a pointing line directed to such particular element being referred to. The designated reference numeral or letter for a particular element shall be in conformity with what has been described or referred to in the detailed description.
- (c) Each element of each figure shall be in proper proportion to each of the other elements in the figure except where the use of a different proportion is indispensable for the clarity of the figure.
- (d) If the same part of the invention 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 414.1. Uniform Standard of Excellence required of Drawings. – The character of each original drawing must be brought as nearly as possible to a uniform standard of excellence suited for a good and clear visualization of the invention and it must conform to the standard requirements for the preparation of technical drawings, to give the best results in the interests of the inventors, the Office, and the public.

The following rules will therefore be strictly enforced and any departure from them will be certain to cause delay in the examination of an application.

Rule 414.2. Paper and Ink. – Drawings must be made upon a smooth non-glossy white paper with sufficient thickness and durability that will permit erasures and corrections with India ink. Only black India ink, or its equivalent, may be used for drawings to have solid lines. The use of white pigments to cover lines and other elements is not permissible.

Rule 414.3. Size of Paper and Margins. – Drawings shall be made on a paper that is exactly 29.7 cm x 21 cm or the size of an A4 paper. The minimum margins shall be as follows: Top 2.5 cm, left side 2.5 cm, right side 1.5 cm, and bottom 1 cm. All drawings, figure numbers, reference numerals and signatures, must be within the area bounded by the margins. 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 the title, name, number, and date.

Rule 414.4. Character and Color Lines. – All drawings must be made with the aid of drafting instruments which will give them satisfactory reproduction characteristics. Drawings shall be executed in durable, black, sufficiently dense and dark, uniformly thick and well-defined lines and strokes without colorings. Every line and letter (including signatures) must be absolutely black. The 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. They must not be too fine or crowded. Surface shading when used, should be open. Cross-sections shall be indicated by oblique hatching which should not impede the clear reading of the reference signs and leading lines. Solid black should not be used for sectional or surface shading. Freehand work should be avoided whenever possible.

Rule 414.5. The Fewest Possible Number of Lines and Little or No Shading to be Used. – Drawings should be made with the fewest possible lines consistent with clarity. 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 drawings 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. It should also be designated by numerals which correspond to the number of the sectional view. Heavy lines on the shaded sides of objects should be used except where they tend to thicken the work and obscure the letter of reference. In drafting the drawing, the location of the light is always assumed to come from the upper left hand corner of an angle of 45 degrees.

Rule 414.6. Scale to which the Drawing is made; Presentation of the Drawings. – The scale to which a drawing is made shall be large enough to show a clear and sufficient presentation of the different views of the invention without crowding. Two or more sheets may 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.

The same sheet of drawings may contain several figures. Where figures on two or more sheets form in effect a single complete figure, the figures on the several sheets shall be so arranged that the complete figure can be assembled without concealing any part of any of the figures appearing on the various sheets.

The scale of the drawings and the distinctness of their graphical execution shall be such that a photographic reproduction with a linear reduction in size to two-thirds would enable all details to be distinguished without difficulty.

When, in exceptional cases, the scale is given on a drawing, it shall be represented graphically.

Rule 414.7. *Letters and Figures of Reference.* – The different views shall be consecutively numbered. Letters and figures of reference must be carefully formed. They should, if possible, measure at least 32 mm. in height so that they may bear reduction to 10.6 mm; and they may be much larger when there is sufficient room. They must be placed in the close and complex parts of the drawings so as not to interfere with the thorough comprehension of the same and 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. If this cannot be avoided, a blank space must be left in the shading where the letter occurs, so that it shall appear perfectly distinct and separate from the work. All numbers, letters, and reference lines appearing on the drawings shall be simple and clear. Brackets, circles, or inverted commas shall not be used in association with numbers and letters.

Rule 414.8. *Signature, Where to be Placed.* – The name of the applicant and his signature, or the name and signature of his duly authorized representative, 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.

Rule 414.9. *Position on Drawing Sheets of Large Views.* – The different figures shall be arranged on a sheet or sheets without wasting space, preferably in an upright position, clearly separated from one another. Where the figures are not arranged in an upright position, for instance, if views longer than the width of the sheet are necessary for the proper illustration of the invention, they shall be presented sideways with the top of the figures at the left side of the sheet.

Rule 414.10. *Flow Sheets and Diagrams.* – Flow sheets and diagrams may be considered drawings provided they serve as an aid in the clear understanding of the invention.

Rule 414.11. *Requisites for the Figure in the IPOPHL E- Gazette.* – As a rule, only one view of each invention can be shown in the IPOPHL E-Gazette illustrations. The selection of the view of the drawing must show the nature of the invention or its specific improvement. For this purpose, the figure may be a perspective, plan, side or sectional view, according to the judgment of the Examiner.

Rule 414.12. *Reference Signs.* – Reference signs not mentioned in the description and claims shall not appear in the drawings and vice versa. The same feature, when denoted by reference signs, shall throughout the description and drawings be denoted by the same signs. If the drawings contain a large number of reference signs, it is strongly recommended to attach a separate sheet listing of all reference signs and the features denoted by them.

Rule 414.13. Photographs. –

- (a) Photographs are not normally considered to be proper drawings. Photographs are acceptable for purposes of obtaining a filing date and generally considered to be informal drawings. Photolithographs of photographs are never acceptable.
- (b) The Office accepts 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 inventions which are incapable of being accurately or adequately depicted by drawing drafting methods. The photographs or photomicrographs must show the invention more clearly than they can be done by 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 surface described as smooth, tint, white, or be photographs printed on a proper sized sensitized paper or in at least substance 20 bond paper.

Rule 414.14. Matters Not Permitted to Appear on the Drawings. – The stamp of an agent or attorney, advertisement, or written address shall not be permitted on the drawings.

Rule 414.15. 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 the purposes of examination if it sufficiently illustrates the invention, but in such case, the drawing must be corrected or a new one furnished before the application will be allowed.

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

Rule 415. Claims. –

- (a) The patent application must conclude with a claim, particularly pointing out and distinctly claiming the part, improvement, or combination which the applicant regards as his invention.
- (b) The application may contain one (1) or more independent claims in the same category (product, process, apparatus, or use), where it is not appropriate, having regard to the subject matter of the application, to cover this subject matter by a single claim which shall define the matter for which protection is sought. Each claim shall be clear, concise, and supported by the description.
- (c) One (1) or more claims may be presented in dependent form, referring back and further limiting another claim(s) in the same application. Any dependent claim which refers to more than one other claim (multiple dependent claim) shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim.
- (d) The claims must conform to the invention as set forth in the description and the terms and phrases used in the claims must find clear support or antecedent basis in the said description so that the meaning of the terms may be ascertainable by reference to the description. Claims shall not, except where absolutely necessary, rely in respect of the technical features of the invention, on reference to the

description or drawings. In particular, they shall not rely on references such as, “As described in part xxx of the description” or “As illustrated in figure xxx of the drawings.”

- (e) If the invention relates to an improvement, the claim or claims 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 416. *Form and Contents of the Claims.* – The claim shall define the matter for which protection is sought in terms of technical features of the invention. Wherever appropriate, the claims shall contain:

- (a) A statement indicating the designation of the subject matter of the invention and those technical features which are necessary for the definition of the claimed subject matter but which, in combination, are part of the prior art;
- (b) A characterizing portion preceded by the expression, “characterized in that” or “characterized by,” stating the technical features which, in combination with the features stated in subparagraph (a), it is desired to protect.
- (c) If the application contains drawings, the technical features mentioned in the claims shall preferably, if the intelligibility of the claim can thereby be increased, be followed by reference signs relating to these features and placed between parentheses. These reference signs shall not be construed as limiting the claim.

Rule 417. *Claims incurring Fee.* – Any application comprising of more than five (5) claims, independent 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 claims fee have not been fully paid in due time, they may still be 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 fully paid within the time limit and the grace period or the claims fee is not fully paid within the time limit prescribed during substantive examination of the application, the claim or claims concerned shall be deemed deleted.

For fee calculation purposes, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. Furthermore, any claim depending on a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claims. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have to pay the prescribed additional fees. Claims in dependent form shall be construed to include all the limitations of the claims incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.

Rule 418. *Presentation of the Application Documents.* –

- (a) All papers for an application for an invention patent which are to become part of the permanent records of the Office must be the original copy only. It must be legibly written, typewritten, or printed in permanent ink on one side of the sheet.

If necessary, only graphic symbols, characters, chemical or mathematical formulas not capable of being printed by a typewriter or through a word processor may be written by hand or drawn. The typing shall be 1 ½-spaced. All text matters shall be in characters, the capital letters of which are not less than 0.21 cm. high and shall be in dark, indelible color.

- (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 is pliable, strong, white, smooth, matte, and durable.
- (c) The description and claims of an invention patent must be written with the lines numbered in sets of five and the number must appear on the left side of the margin.
- (d) The description claims, and the abstract of the disclosure may contain chemical and mathematical formulas. The description and the abstract of the disclosure may contain tables. The claims may contain tables only if their subject matter makes the use of tables desirable. Tables and chemical or mathematical formulas may be presented 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 (SI units). Any data not meeting this requirement must also be expressed in the units recognized in international practice. For mathematical formulas, the symbols in general use shall be employed. For chemical formulas, 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 document making up the application (request for grant, 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.
- (h) The margins of the documents shall be within the following ranges: Top 2 cm. – 4 cm., left side 2.5 cm. – 4 cm., right side 2 cm. – 3 cm., and 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 numerals. 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 419. Working Models of the Invention, when Required. – A working model may be required for purposes of demonstration, to enable the Office to fully and readily understand the precise operation of the machine if the invention sought to be patented cannot be sufficiently described in the application. The Examiner shall notify the applicant of such requirement, which will constitute an official action in the case. When a working model has been presented in compliance with the official requirement, a report of workability assessment, the date of its presentation and demonstration, and

the date of filing thereof shall be entered in the file wrapper. Working models not required nor admitted will be returned to the applicant.

Rule 419.1. *Requisites for the Model.* – The working model, when required, must clearly exhibit every feature of the machine which forms the subject of the claim or claims of the invention. However, it should not include other matters than that covered by the actual invention or improvement unless it is necessary to the exhibition of the invention in a working model.

Rule 419.2. *Suspension of Action.* – When a working model is required, the applicant may file a request for suspension of action upon full payment of the prescribed fee. The period for suspension of action shall not exceed six (6) months from the date of filing such request. Failure to submit the working model within the prescribed period shall cause the application to be deemed withdrawn.

Rule 419.3. *Material required for the Model; Working Models.* –The model must be neatly and substantially made of durable material. However, when the material forms an essential feature of the invention, the model should be constructed of that material.

Rule 419.4. *Models Returned to the Applicant.* – In all applications which have been refused or withdrawn, the working model, unless, it is deemed necessary to be preserved in the Office, may be returned to the applicant upon demand and at his expense.

Rule 419.5. *Plant Visit and Inspection.* – In cases where the presentation of a working model is not possible due to the physical features of the invention (e.g. large machines, apparatuses, and systems), the applicant may file a request for a plant visit and inspection for a clear assessment of the workability of the invention. The Examiner handling the application shall be responsible for the visit and inspection and shall make a report regarding the workability of the invention. A copy of the report shall form part of the application file wrapper and another copy shall be submitted to the Director. The applicant shall shoulder expenses that may be incurred during the visit.

Rule 420. *Employment of Attorney-at-Law or Patent 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 patent agent, as the value of patents depends largely on the skillful preparation of the description and claims. The Office cannot aid in the selection of an attorney-at-law or patent agent.

Rule 421. *Appointment of Resident Agent and 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 for patent or the patent may be served.

Rule 421.1. *Agents or Representatives on Record.* – The application shall contain the name and contact details of the patent agent or representative. A representative or agent shall:

- (a) Be authorized to transact business regarding prosecution or maintenance of application/access to records; and
- (b) Address all communications, notices, and correspondence from the Office.

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

A power of attorney or authorization may be revoked at any stage in the proceedings upon proper notification to the Director. Upon revocation, the Office shall communicate directly with the applicant or with such other attorney or agent which the applicant may later appoint.

Rule 422. *(a) Decorum and Courtesy Required in the Conduct of Business.* – Applicants and their attorneys or agents are required to conduct 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 an attorney, and papers presented containing matters in violation of this rule will be submitted to the Director and returned to the sender, by his direct order.

(b) Complaints Against Examiners to be on Separate Paper. – Complaints against Examiners and other officers must be made in a communication separate from other papers and will be promptly investigate by or at the instance of the Director.

PART 5

WHO MAY APPLY FOR A PATENT

Rule 500. *Who may Apply for a Patent.* – Any person, natural or juridical, may apply for a patent. If the applicant is not the inventor, the Office shall require him to submit a proof of his authority to apply for the patent.

Rule 501. *When the Applicant Dies, becomes Insane or incapacitated.* – 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. He may also apply for and obtain the patent in the name of the applicant, his heirs, or assignee.

Rule 502. *Assigned Invention and Patents.* – In case the whole interest in the invention 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 shall sign the application.

Rule 503. *Definition of Juridical Person.* – A juridical person is a body of persons, a corporation, a partnership, or any legal entity that is recognized by law which grants a juridical personality separate and distinct from that of a shareholder, partner or member.

Rule 504. 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 Bureau shall require him to submit proof of authority to sign the application.

Rule 505. Forms of Signature. – 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, the use of a seal, or thumb marks instead of a hand-written signature; Provided, that where a seal or a thumb mark 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 letters patent.

PART 6 **FILING DATE AND FORMALITY EXAMINATION**

Rule 600. Filing Date Requirements. – The filing date of a patent application shall be the date on which the Office received the following elements in English or Filipino:

- (a) An express or implicit indication that a Philippine patent is sought;
- (b) Information identifying the applicant; and
- (c) Description of the invention and one (1) or more claims.

Rule 600.1. Incomplete Application. – Where the application refers to a drawing or drawings, it shall not be considered complete if the drawing or drawings are not included in the application.

Rule 600.2. For purposes of obtaining a filing date, the Bureau may accept a copy of the application received by the resident agent by telefax or e-mail; Provided, that the original copy is submitted within two (2) months from the filing date, otherwise, the filing date will be moved to the date when the original copy is received by the Office.

Rule 601. According a Filing Date. – The Office shall examine whether the patent application satisfies the requirements for the grant of filing date as provided in these Regulations. If a filing date cannot be accorded, the applicant shall be given an opportunity to correct the deficiencies. If the application does not contain all the elements indicated in these Regulations, the filing date will be the date when all the elements are received. If the deficiencies are not remedied within two (2) months from the date on which the application was initially presented to the Office, the application shall be considered withdrawn (Sec. 41, IP Code).

Rule 602. Late-filed or Missing Drawings. –

- (a) If the formality examination reveals that the drawings were filed after the filing date of the application, the Bureau shall send a notice to the applicant that the drawings and the references to the drawings in the application shall be deemed

deleted unless the applicant requests within two (2) months that the application be granted a new filing date which is the date on which the drawings were filed.

- (b) If the formality examination reveals that the drawings were not filed, the Bureau shall require the applicant to file the drawings within two (2) months. The Bureau shall also inform the applicant that the application will be given a new filing date which is the date on which the drawings are filed, or if they are not filed in due time, any reference to them in the application shall be deemed deleted. Any additional drawings beyond the original disclosure in the description filed after the filing date of the application shall be denied entry and the applicant shall be notified of such action.
- (c) Missing drawings and references to such drawings in the description filed after the filing date shall be deemed deleted unless the applicant requests within two (2) months from the date of submission that a new filing date, which is the date on which the drawing were filed, be issued to the application.
- (d) The new filing date shall be cited in all succeeding correspondences between the Bureau and the applicant.

Rule 603. *Formality Examination.* – If a patent application has been accorded a filing date and the required fee has been paid within one (1) month, the application shall be evaluated taking into consideration the formality requirements stated in these Regulations, such as:

- (a) Contents of the request for grant of a Philippine patent;
- (b) Priority documents, if with claim of convention priority (e.g. file number, date of filing, and country of the priority applications);
- (c) Proof of authority, if the applicant is not the inventor;
- (d) Deed of assignment;
- (e) Full payment of other fees (e.g. excess claims);
- (f) Signature of the applicant;
- (g) Identification of the inventor; and
- (h) Formal drawings.

Rule 604. *Unity of Invention.* –

- (a) The application shall relate to one invention only or to a group of inventions forming a single general inventive concept (Sec. 38.1, IP Code).
- (b) If several independent inventions which do not form a single general inventive concept are claimed in one application, the Director may require that the application be restricted to a single invention. A later application filed for an invention divided out shall be considered as having been filed on the same day as the first application; Provided, that the later application is filed within four (4) months after the requirement to divide becomes final or within such additional time not exceeding four (4) months as may be granted; Provided further, that each divisional application shall not go beyond the disclosure in the initial application. (Sec. 38.2, IP Code).

Rule 604.1. The fact that a patent has been granted on an application that did not comply with the requirement of unity of invention shall not be a ground to cancel the patent (Sec. 38.3, IP Code).

Rule 605. Requirements for Unity of Invention. –

- (a) The requirement of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.
- (b) The determination whether a group of inventions is linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternative within a single claim.
- (c) A plurality of independent claims in different categories may constitute a group of inventions linked to form a single general inventive concept. For instance, the link being that between a product and the process which produces it or between a process and an apparatus for carrying out the process.
- (d) Different specific combination of claims in different categories are permissible in any one application as shown in the following examples:
 - (1) In addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the product and an independent claim for a use of the product; or
 - (2) In addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the process; or
 - (3) In addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the product and an independent claim for apparatus or means specifically designed for carrying out the process.

Rule 606. Reconsideration for Requirement. –

- (a) If the applicant disagrees with the requirement of division, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefore. In requesting reconsideration, the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final.
- (b) The requirement for division will be reconsidered on such a request. If the requirement is repeated and made final, the Examiner will act on the claims of the invention elected.

Rule 607. Appeal from Requirement for Division. – After a final requirement for division, the applicant, in addition to making any response due on the remainder of the action, may appeal from the requirement together with the full payment of the prescribed fee. The prosecution on claims of the elected invention may be continued during such appeal. Final action or allowance of the claims of the invention elected shall be deferred until the appeal has been resolved. Appeal may not be allowed if reconsideration of the requirement was not requested.

Rule 608. Subsequent Presentation of Claims for Different Invention. – If, after an official action on an application, the applicant presents claim directed to an invention divisible from the invention previously claimed, such claims, if the amendment is entered, will be refused and the applicant will be required to limit the claims to the invention previously claimed.

Rule 609. Election of Species. – In the first action on an application containing a generic claim and claims restricted separately to each of more than one species embraced thereby, the Examiner, if of the opinion, after a complete search on the generic claim, that no generic claim presented is allowable, shall require the applicant in his response to that action to elect the species of his invention to which his claim shall be restricted, if no generic claim is finally held allowable.

Claims directed neither to the species nor to the genus of the disclosed invention may be allowed. Markush type claims, i.e. claims which enumerate in alternative manner, members or variations which are properly claimable as species claims may likewise be allowed, provided that the amount of the fees payable by the applicant or applicants shall be computed depending on the number of members or variations enumerated in the Markush type claims.

Rule 610. Separate Application for Invention not Elected. –The inventions which are not elected after a requirement for division may be the subject of separate applications which will be examined in the same manner as the original application (parent application) and shall have the benefit of any right of priority; Provided, that the application is filed within four (4) months from the date the requirement for division is made final. The said date shall be the date of election by the applicant or the mailing date of the subsequent office action stating that the restriction is made final. If with appeal, the four (4)-month period is reckoned from the mailing date of the notice of the decision to the appeal.

The non-elected invention may be filed together with an application form signed and executed by the applicant, an exact copy of the previously filed original document, proposed amended claims canceling the irrelevant claims or other matters, a copy of the drawings complying with rules relating to drawings, and the full payment of the corresponding filing fee.

However, if such an application is filed before the original application is patented or becomes withdrawn, and if it is identical with the original application as filed, the drawings being identical and the papers constituting an exact copy of the original papers which were signed and executed by the applicant, signing and execution of the application may be omitted; such application may consist of the filing fee, a copy of the drawings complying with rules relating to drawings and filed, together with a proposed amendment canceling the irrelevant claims or other matters.

Rule 611. Voluntary Divisional Application. – The applicant may file a voluntary divisional application on a pending application before the parent application is withdrawn or patented; Provided, that the subject matter shall not extend beyond the content of the parent application.

The voluntary divisional application shall be accorded the same filing date as the parent application and shall have the benefit of any right to priority. The application shall be filed wherein the requirements as to form of the application is in the same manner as stipulated in Rule 610.

Rule 611.1. *Term of a Divisional Application.* – The term of a divisional application shall be twenty (20) years from the filing date of the parent application.

Rule 612. *Information concerning Corresponding Foreign Application for Patents.* – The applicant shall, at the request of the Director, furnish him with the date and number of any application for a patent filed by him abroad, hereafter referred to as the “foreign application,” relating to the same or essentially the same invention as that claimed in the application filed with the Office and other documents relating to the foreign application (Sec. 39, IP Code).

Rule 612.1. 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 patent 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 adjudication of the application.

Rule 612.2. *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.

PART 7 **CLASSIFICATION AND SEARCH**

Rule 700. *Classification and Search.* – An application that has complied with the formal requirements shall be classified and a search shall be conducted to determine the prior art (Sec. 43, IP Code).

Rule 701. The Office shall use the International Patent Classification.

Rule 701.1. *Content of the Intellectual Property Search Report.* – The Intellectual Property 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 and inventive step of the invention;
- (b) The search report shall distinguish between cited documents published before the date of priority claimed, between such date of priority and the date of filing, and on or after the date of filing; and
- (c) The search report shall contain the classification of the subject matter of the application in accordance with the International Patent Classification.
- (d) The search report may also include documents cited in a search established in the corresponding foreign application.

PART 8
PUBLICATION AND REQUEST FOR EXAMINATION

Rule 800. *Publication of Application.* –

- (a) The application shall be published in the IPOPHL E-Gazette together with a search document established by or on behalf of the Office citing any relevant document or documents that reflect prior art, after the expiration of eighteen (18) months from the filing date or priority date.
- (b) The application will not be published if it has been finally refused, withdrawn, or deemed to be withdrawn before the technical preparation for publication.
- (c) The application to be published shall contain the bibliographic data, any drawing as filed and the abstract.
- (d) The Office shall communicate to the applicant the date and other information regarding the publication of the application and draw his attention to the period within which the request for substantive examination must be filed.
- (e) The Director General, subject to the approval of the Secretary of Trade and Industry, may prohibit or restrict the publication of an application, if in his opinion, to do so would be prejudicial to the national security and interests of the Republic of the Philippines (Sec. 44.3, IP Code).

Rule 800.1. *Early Publication of Patent Application.* – The application may be published before eighteen (18) months but not earlier than six (6) months from the filing date, provided that:

- (a) A written request for an early publication is filed before the Director;
- (b) The applicant attaches thereto a waiver on the confidentiality disclosures of the application, under oath;
- (c) The applicant agrees to have the application published without a search report; and
- (d) Full payment has been made of the early publication fees.

Rule 801. *Confidentiality before Publication.* – An application, including all related documents, which has not yet been published, shall not be made available for inspection without the consent of the applicant (Sec. 45, IP Code).

After publication, any interested party may inspect the complete description, claims, and drawings as filed with the Office.

Rule 802. *Community Review of Patent Applications.* – In the interest of transparency in granting patents and quality of patents granted, the concerned community shall be notified by the Office upon publication of the patent application.

Rule 803. *Observation by Third Parties.* – Within six (6) months from the date of publication of the application or the request for substantive examination filed by the applicant, whichever comes later, any person may present observations in writing concerning the patentability of the invention including matters pertaining to novelty, inventive step, and industrial applicability while citing relevant prior art. Additionally, a conference at the Office may be requested by the interested party to obtain a better understanding of the application, the patent prosecution process, and the patent system in general. The Office shall acknowledge the receipt of any observation or request for

conference and may request for additional information or clarifications. All observations shall be communicated to the applicant who may comment on them within thirty (30) days from the mailing date of the communication. Copies of any observation filed, comments thereto by the applicant, and minutes of conferences shall form part of the file wrapper in the subject application.

The observation and comments, as well as discussion in the conferences, shall be taken into consideration in examining the patent application. The Office shall notify the parties who have submitted observations or were present during the conferences of the decision of the Office involving the patent application, if and when it is granted registration, after issuance of the patent certificate.

Rule 804. *Request for Substantive Examination.* – A written request for substantive examination together with the full payment of the corresponding fee shall be filed within six (6) months from the date of publication of a patent application. The substantive examination is conducted to determine whether a patent application meets the requirement of patentability as provided by the IP Code. Failure of the applicant to file a request for substantive examination and pay the corresponding fees within the prescribed period shall result in the withdrawal of the application. The request for substantive examinations, once filed, shall be irrevocable. Fees paid therefor shall not be refunded.

Rule 805. *Rights conferred by an Application after Publication.* – The applicant shall have all the rights of a patentee under Section 76 of the IP Code against any person who, without his authorization, exercises any of the rights conferred under Section 71 of the IP Code in relation to the invention claimed in the published application, as if a patent has been granted for that invention; Provided, that the said person had:

- (a) Actual knowledge that the invention that he was using the subject matter of a published application; or
- (b) Received a written notice that the invention that he was using was the subject matter of a published application being identified in the said notice by its serial number; Provided, that the action may not be filed until after the grant of a patent on the published application and within four (4) years from the commission of the acts complained of (Sec. 46, IP Code).

Rule 806. *Citation of Prior Art References.* – Should domestic patents be cited, their numbers, dates, names of patentees, and classes of inventions shall be stated. Should foreign patents be cited, their nationality or country, numbers and dates, names of patentees must be stated, and such other data must be furnished as may be necessary to enable the applicant to identify the patents cited. In citing foreign patents, in case part of the patent be involved, the particular pages and sheets containing the parts relied upon must be identified. Should non-patent publications be cited, the author (if any), title, date, relevant pages or plates, and place of publication or place where a copy can be found shall be given.

Rule 806.1. *Citation of Prior Art References based on Personal Knowledge.* – If the citation of reference is based on facts within personal knowledge, the data shall be specific as possible and the reference must be supported, when called for by the applicant, by an affidavit of the person who has personal knowledge of such fact.

PART 9

PATENT EXAMINATION PROCESS AND PROCEEDINGS

Rule 900. *Applications Prosecuted Ex Parte.* – An application is prosecuted ex parte by the applicant. The role of the examiner is to ensure that only applications complying with the requirements of law for patentability are granted letters patent.

Rule 901. *Contest between the Examiner and the Applicant.* –The Examiner safeguards the public interests by allowing exclusivity based only on valid patent claims covered by the disclosure in the application. On the other hand, the applicant or his attorney may present arguments to obtain a broader protection and exclusivity for the invention.

Rule 902. *Official Actions of the Examiner.* – An Examiner's assessment of the patent application resulting in the issuance of Official Actions provides the applicant the opportunity to improve the application or clarify the patent claims through amendments and other means. Issues raised by the Examiner that are resolved in the examination process become an administrative ruling on the matter. This strengthens the legal presumption of the validity of the patent.

Rule 903. *Conference and Interviews with the Examiner.* – Conference or interview with the Examiner concerning an application which is the subject of an Official Action may be requested by the applicant or his attorney upon filing of a written request specifying the query and after payment of the required fees. However, the Examiner has the discretion to decline the interview or conference, and instead reply to the query immediately in writing. All conferences and interviews shall take place within the premises of the Bureau during regular office hours as specified by the Examiner, and minutes thereof shall form part of the File Wrapper.

Rule 904. *An Examiner's Refusal is not final.* – A refusal by the Examiner based on a prior art reference is merely preliminary. What is refused may involved only the claims and not necessarily the invention of the applicant, as the claims for an invention can be drafted in many ways in the light of existing prior art and other considerations. Further, an applicant may defend his application or introduce amendments through a written response. The Examiner, by seeking clarification and suggesting improvements and amendments in the light of prior art references, helps applicants strengthen the legal presumption of validity of the patent.

Rule 905. *Examiner's Decision Appealable to the Director.* – The decisions of Examiner in refusing applications are subject to appeal to the Director within four (4) months from the mailing date of the notice of the Final Refusal.

Rule 906. *Order of Examination.* – Applications filed in the Bureau and accepted as complete applications are assigned for examination to the respective Examiners handling the classes of invention to which the applications relate. Applications shall be taken up for examination by the Examiner in the order in which they have been filed. Applications, which have been acted upon by the Examiner, and which have been placed by the applicant in condition for further action by the said Examiner (amended

application) shall be taken up for such action in the order in which they have been placed in such condition (date of response).

Rule 907. *Nature of Examination; Examiner's Action.* –

- (a) On taking up an application for examination, the Examiner shall make a thorough study and investigation thereof of the available prior art relating to the subject matter of the invention sought to be patented. The examination shall be complete with respect both to compliance of the application with the statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.
- (b) The applicant will be notified of the Examiner's action. The reasons for any adverse action or any objection or requirement will be stated and such information or references will be given as it may be useful in aiding the applicant to judge the propriety of continuing the prosecution of his application.

Rule 908. *Completeness of the Examiner's Action.* – The Examiner's action shall, as much as practicable, be comprehensive and complete in raising all substantive matters. However, should there be issues relating to restriction requirement, fundamental defects in the application and the likes, the Examiner may limit his action to such matters before proceeding to the substantive aspects. Matters of form need not be raised by the Examiner until the claims are found allowable.

Rule 908.1. *Standard Action Form.* – A standard action form formulated to provide a complete action understandable by the applicant shall be used for the expeditious examination of the application. It shall contain matters pertaining to the merits of the application, the pertinent prior art references and other matters affecting the patentability of the application that must be complied with by the applicant.

Rule 909. *Refusal of Claims.* –

- (a) If the invention is not considered patentable in any manner, all the claims will be refused by the Examiner. If the invention is considered patentable as claimed in certain claims but unpatentable as claimed in other claims, the latter claims will be refused but will not result in the refusal to grant a patent provided it is limited only to claims that have not been refused.
- (b) In refusing claims for want of novelty or for want of inventive step, the Examiner must cite the references most relevant to the invention. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not obvious, must be clearly explained and each refused claim specified.
- (c) Claims may be refused for non-compliance with Sections 35.1 and 36.1 of the IP Code.

Rule 910. *Unpublished Applications Not Cited.* – Unpublished pending applications and unpublished withdrawn and forfeited applications as such shall not be cited as prior art references.

Rule 911. *Reply by the Applicant.* –

- (a) After the action of the Examiner, if the same be adverse in any respect, the applicant, if he persists in his application for a patent must reply thereto and may request re-examination and reconsideration with or without amendment.
- (b) In order to be entitled re-examination or reconsideration, the applicant must make a request therefore in writing; and he must also distinctly and specifically point out the supposed errors in the Examiner's action. The applicant must respond to every ground of objection and refusal in the prior Examiner's action (except that request may be made that objections or requirements as to form, not necessary to further consideration of the claims, be held in abeyance until claim is allowed) and the applicant's action must appear throughout to be a *bona fide* attempt to advance the case to final action. The mere allegation that the Examiner has erred will not be received as a proper reason for such re-examination or reconsideration.
- (c) In amending an application in response to a refusal regarding the patentability of a claim, the applicant must clearly point out the novel and inventive features which he thinks the claims present, in view of the relevant prior art disclosed by the references cited or the objections made. He must also show how the amendments avoid such references or objections.

Rule 912. *Re-examination and Reconsideration.* – After the response by the applicant, the application will be re-examined and reconsidered, and the applicant will be notified if claims are still refused or objections and requirements are made in the same manner as after the first examination. Applicant may respond to such Examiner's action in the same manner provided in these Regulations, with or without introducing amendments. Should amendments be introduced after the second Examiner's action, the same shall relate only to matters that are subject of the refusal. Thereafter, the application will again be considered in the light of the amendments.

Rule 913. *Final Refusal or Action.* –

- (a) On the second or any subsequent examination or consideration, the refusal or objection may be declared final by the Examiner. As such, the applicant's course of action is limited to filing an appeal or petition in accordance with the Regulations. A Petition may be filed with the Director in the case of an Examiners' Final Objections which do not involve a refusal of a claim while an Appeal is filed with the Director in the case of a final refusal involving the claims not allowed by the Examiner.
- (b) In making such final refusal, the Examiner shall reiterate all the grounds of refusal considered in refusing the claims. The Examiner may not cite additional grounds that have not been raised in the earlier communications to the applicant.

Rule 914. *Conversion of Patent Applications to Utility Model Applications.* – At any time before the grant or refusal of a patent, an applicant for a patent 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 initial application. An application may be converted only once (Sec. 110, IP Code).

Rule 915. 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, whether simultaneously or consecutively (Sec. 111, IP Code). In case an applicant files two (2) or more applications covering the same subject matter, only the application with the prior filing date or priority date shall be considered for examination while all other applications shall be deemed forfeited.

AMENDMENTS BY THE APPLICANT

Rule 916. Amendment by the Applicant. – An applicant may amend the patent application during examination; *Provided*, That such amendment shall not include new matter outside the scope of the disclosure contained in the application as filed (Sec. 49, IP Code).

Rule 917. Amendments after Final Action of the Examiner. –

- (a) During Appeal, amendments may be introduced by the applicant deleting claims or complying with any requirement of form as well as presenting refused claims in better form for consideration.
- (b) Should amendments be presented only after final refusal in any manner not in accordance with the Regulations, such amendments may still be admitted upon a showing of good cause and sufficient justification as to why the amendments are necessary and were not earlier presented.

Rule 918. Amendment and Revision Required. – The description, claims, and drawings must be amended and revised, when required, to correct inaccuracies of description and definition, or unnecessary prolixity, and to secure correspondence between the description, claims, and drawings.

Rule 919. Amendment of the Disclosure. – No deletion or addition shall broaden the disclosure of an application to include new matter after the filing date of the application. All amendments to the description, claims, or drawings and all addition thereto made after the filing date of the application must conform to at least one of them as it was as of the filing date. Matter not found in either, involving a departure from or an addition to the original disclosure cannot be added to the application even though supported by a supplemental oath and can be shown or claimed only in a separate application.

Rule 920. Amendment of Claims. – The claims may be amended by canceling particular claims, by presenting new claims, or by amending the language of particular new claims (such amended claims being in effect new claims). In presenting new or amended claims, the applicant must point out how they avoid any reference or ground of refusal of record which may be pertinent. Furthermore, in order to facilitate the processing of the examination of the application, the applicant shall indicate in his response which form part in the original disclosure constitutes the basis of the amendments.

Rule 921. 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 request for amendment directing or requesting that specified amendments be made together with a clean copy of the amended part of

the text where the amendment was made. The exact word(s) 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 922. *Entry and Consideration of Amendments.* –

- (a) Amendments are entered by the Bureau by making the proposed deletions by drawing a line in red ink through the word or words cancelled, and by making the proposed substitution or insertions in red ink, small insertions being written at the designated place and large insertions being indicated by reference.
- (b) Ordinarily all amendments presented in a paper filed while the application is open to amendments are entered and considered, subsequent cancellation or correction being required of improper amendments. Untimely amendatory papers may be refused entry or may be considered in whole or in part.

Rule 923. *Amendments to the Drawing.* – No change in the drawing may be made except by permission of the Bureau. Request for changes in the manner of presentation shown in any drawing may be made only upon payment of the required fee. A sketch in permanent ink showing the proposed changes to become part of the record must be filed together with the request for amendment. The paper requesting amendments to the drawing should be separate from other papers. The drawing may not be pulled out from the Bureau except for signature. Substitute drawings will not ordinarily be admitted in any case unless required by the Bureau.

Rule 924. *Amendment of Amendments.* – When an amendatory clause is to be amended, it should be wholly rewritten and the original insertion cancelled so that no interlineations or deletions shall appear in the clause as finally presented. Matters cancelled by amendment can be reinstated only by a subsequent amendment presenting the cancelled matter as a new insertion.

Rule 925. *Substitute Description.* – If the number or nature of the amendments shall render it difficult to consider the case or to arrange the papers for printing or copying, the Examiner may require the entire description, claims, or any part thereof to be rewritten. A substitute description will ordinarily not be accepted unless required by the Examiner. A substitute description may be required within two (2) months from grant of the patent prior to publication of the patent in the IPOPHL E-Gazette.

Rule 926. *Numbering of Claims.* – Numbering of Claims is mandatory, and the numbers appearing at the time the application was filed must be preserved throughout the prosecution process. When claims are deleted, the remaining claims must not be renumbered. When claims are added or replaced, they must be numbered consecutively beginning with the number following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the Examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

Rule 927. *Petition from Refusal to Admit Amendment.* – From the refusal of the Examiner to admit an amendment, in whole or in part, a petition for admittance of such amendment may be filed before the Director under the Regulations.

TIME FOR RESPONSE BY THE APPLICANT;
WITHDRAWAL OF APPLICATION

Rule 928. *Withdrawal of Application for Failure to Respond within 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 a reasonable time specified. Any request for such extension must be filed not later than the day on which the response of 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 the mailing date of the official action requiring such response.
- (c) Prosecution of an application to save it from withdrawal shall include such complete and proper action as the condition of the case may require. Any amendment or applicant's response not responsive to the last official action shall not operate to save the application from being deemed withdrawn.
- (d) When an action by the applicant is a *bona fide* attempt to advance the case to final action and is a substantially 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 929. *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 shall be accompanied by:

- (a) A showing of a justifiable reason for the failure to prosecute;
- (b) A complete proposed response; and
- (c) Full payment of the required fee.

No revival shall be granted to an application that has been previously revived with cost.

An application not revived in accordance with this Rule shall be deemed forfeited.

Rule 929.1. *Revival of Application Without Cost.* – An application deemed withdrawn due to loss of applicant's response or Examiner's action that was not received as evidenced by the post office return card, and other unforeseen circumstances which may be considered as fault of the Office shall be revived without cost; Provided, a petition to revive without cost is filed within four (4) months from the date of

withdrawal of the application. In case of loss of applicant's response, the petition must be accompanied by the copy bearing the original stamp of the Office.

Rule 930. *Voluntary Withdrawal of Application.* – An application may be voluntarily withdrawn by filing a written declaration of withdrawal to the Bureau. The application must be identified and the declaration must be signed by the applicant or assignee of record, if any. Voluntarily withdrawn application shall not be revived and will be deemed forfeited.

Rule 931. *Reconstitution of Application File Wrappers.* – An application file wrapper or any document therein declared lost may be reconstituted; Provided, that the application remains active, not withdrawn, or forfeited. For this purpose, a petition must be filed by the applicant requesting for the reconstitution of the application file wrapper or lost document stating therein the pertinent facts and circumstances including the prosecution history and various communications between the applicant and the Office involving the application. Further, a carbon original or a duplicate copy containing the acknowledgement receipt by the Office of the subject documents sought to be reconstituted are attached to the petition. Mere photocopies shall not be acceptable.

PART 10 **GRANT OF PATENT**

Rule 1000. *Grant of Patent.* – If the application meets the requirements of the IP Code and these Regulations, the Office shall grant the patent; Provided, that all the fees are paid on time. If the required fees for grant and printing are not paid in due time, the application shall be deemed withdrawn (Sec. 50, IP Code).

Rule 1001. *Contents of Patent.* – The patent shall be issued in the name of the Republic of the Philippines under the seal of the Office and shall be signed by the Director of Patents, and registered together with the description, claims, and drawings, if any, in books and records of the Office (Sec. 53, IP Code).

Rule 1002. *Publication upon Grant of Patent.* – The grant of the patent, together with other information, shall be published in the IPOPHL E- Gazette within six (6) months

Rule 1003. Any interested party may inspect the complete description, claims, and drawings of the patent on file with the Office (Sec. 52.2, IP Code).

Rule 1004. *Term of Patent.* – The term shall be twenty (20) years from the filing date of the application. However, a patent shall cease to be in force and effect if any prescribed annual fees there for is not paid within the prescribed time or if the patent is cancelled in accordance with the provisions of the IP Code and these Regulations.

PART 11 **ANNUAL FEES**

Rule 1100. *Annual Fees.* – The first annual fee on patent shall be due and payable on the expiration of four (4) years from the date the application is published, and on each

subsequent anniversary of such date. Payment may be made within three (3) months before the due date. The obligation to pay the annual fees shall terminate should the application be withdrawn, refused, or cancelled.

For the PCT national phase entry applications, the first annual fee shall be due and payable on the expiration of four (4) years from the international publication date, regardless of the language of the publication.

Rule 1101. *Date Application is published.* – The application is published on the date that the IPOPHL E-Gazette containing the application is released from circulation. For example, if the IPOPHL E-gazette containing the application is released for circulation on January 15, 1999, then the first annual fee shall be due and payable on January 15, 2003.

Rule 1102. *Non-payment of Annual Fees; Grace Period.* - If an annual fee is not paid within the prescribed time, a notice of non-payment shall be published in the IPOPHL E-gazette. After the publication, the notice shall also be immediately mailed to the patent owner, applicant, or the resident agent.

Within a grace period of six (6) months from the publication of the notice of non-payment in the IPOPHL E-gazette, the annual fee plus the prescribed surcharge for delayed payment and the publication fee must be paid in full. Upon failure to pay the annual fees, surcharges, and the publication fee within the grace period, a notice that the application is deemed withdrawn or that the patent considered lapsed as of the date following the expiration of the original period within which the annual fee was due, shall be issued and published in the IPOPHL E-gazette and recorded in the appropriate register of the Office.

PART 12

OTHER PROCEEDINGS AFFECTING THE APPLICATION FOR PATENT

Chapter 1. *Recording of Assignment of Letters Patent and Other Instruments affecting Title to Patents, Including Licenses*

Rule 1200. *Form of assignment of a patent or of an application for a patent.* – 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) so that there can be no mistake as to the patent or application intended, must identify the letters patent involved by number, and date, name of the patentee, and title of the invention as set forth in the patent; in the case of an application for patent, the application number and the filing date of the application should be stated, giving also the name of the

applicant, and title of the invention, 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, or before its application number is ascertained, it should adequately identify the application by date of execution, name of the applicant, and title of the invention; and

(e) must be accompanied by the required recordal and publication fees.

Rule 1201. *Form of other instruments affecting the title to a patent or application including licenses.* – In order to be acceptable for recording, the form of such instrument, including licenses, must conform with the requirements of the preceding Rule.

Rule 1202. *Assignment and other instruments to be submitted in duplicate.* – The original document together with a signed duplicate thereof shall be submitted. If the original is not available, an authenticated copy thereof in duplicate may be submitted instead. After recording, the Office shall retain the signed duplicate or one of the authenticated copies, as the case may be, and return the original or the other authenticated copy to the party who filed the same, with notation of the fact of recording.

Rule 1203. *Date of recording of assignment or other instruments or license considered its date of filing.* – The date of recording of an assignment or other instrument is the date of its receipt by the Office in proper form and accompanied by full payment of the required recording and publication fees.

Such instruments shall be void against any subsequent purchaser or mortgager for a valuable consideration and without notice, unless it is recorded in the Office within three months from the date thereof, or prior to the subsequent purchase or mortgage (Sec. 106, IP Code). Notice of the recording shall be published in the IPOPHL E-Gazette.

Rule 1204. *Letters Patent may be issued to the assignee in place of the applicant.* – In the case of the assignment of a pending application for patent, the letters patent may be issued to the assignee of the applicant, provided the assignment has been recorded in the Office before the actual issue of the patent.

Rule 1205. *Action may be taken by the 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 Patent.*

Rule 1206. *Surrender of Patent.* –

(a) The owner of the patent, with written and verified consent of all persons having grants or licenses or other right, title or interest in and to the patent and the invention covered thereby, which have been recorded in the Office, may surrender his patent, 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 (Sec. 56, IP Code).

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

- (c) If the Office is satisfied that the patent may properly be surrendered, he may accept the offer and, as from the day when notice of his acceptance is published in the IPOPHL E Gazette, the patent shall cease to have effect, but no action for infringement shall lie and no right compensation shall accrue for any use of the patented invention before that day for the services of the government (Sec. 56, IP Code).

Rule 1207. *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 patent issued to the patentee, the Director shall have the power to correct without fee any mistake in a patent incurred through the fault of the Office when clearly disclosed by the records thereof, to make the patent conform to the records (Sec. 57, IP Code).

Rule 1208. *Correction of mistakes 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 patent of a formal and clerical nature, not incurred through the fault of the Office (Sec. 58, IP Code).

Rule 1209. *Changes in Patent.* – The owner of the patent shall have the right to request the Bureau to make changes in the patent 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 section (b), made in good faith; Provided, that where the change would result in broadening of the extent of the protection conferred by the patent, no request may be made after the expiration of two (2) years from the grant of a patent and the change shall not affect the rights of any third party which has relied on the patent, as published.

Rule 1210. *Form and publication of amendments or corrections.* – An amendment or correction of a patent 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 patent. Notice of such amendment or correction shall be published in the IPOPHL E- Gazette and copies of the patent furnished by the Office shall include a copy of the certificate of the amendment or correction (Sec. 60, IP Code).

Chapter 3. *Assignment and Transmission of Rights.*

Rule 1211. *Assignment and Transmission of Rights.* – Patents or applications for patents and inventions to which they relate, shall be protected in the same way as the rights of other property under the Civil Code. Inventions and any right, title, or interest in and to patents and inventions covered thereby, may be assigned or transmitted by inheritance or bequest or may be the subject of a license contract (Sec. 103, IP Code).

Rule 1212. *Assignment of inventions.* – An assignment may be of the entire right, title, or interest in and to the patent and the invention covered thereby, or of an undivided share of the entire patent and invention, in which event the parties become joint owners thereof. An assignment may be limited to a specified territory (Sec. 104, IP Code).

Rule 1213. *Rights of joint owners.* – If two (2) or more persons jointly own a patent and the invention covered thereby, either by the issuance of the patent in their joint favor or by reason of the assignment of an undivided share in the patent and invention or by reason of the succession

in title to such share, each of the joint owners shall be entitled to personally make, use, sell, or import the invention for his own profit; *Provided however*, That neither of the joint owners shall be entitled to grant licenses or to assign his right, title, interest, or part thereof without the consent of the other owner or owners, or without proportionally dividing the proceeds with such other owner or owners. (Sec. 107, IP Code).

PART 13 **PETITIONS AND APPEAL**

Rule 1300. *Nature of the function of Examiners.* – The function of determining whether or not an application for grant of patent should be allowed or refused under the facts disclosed in the application, references consulted by the Examiner, and under the applicable law (statutory and decisional), is a quasi-judicial function and involves the exercise of judicial discretion.

Thus, with respect to such function, the Director cannot lawfully exercise direct control, direction, and supervision over the Examiners but only general supervision, exercised through a review of the recommendation they may make for the grant of patent and of other actions, and through a review of their adverse decisions by petition or appeal.

Rule 1301. *Petition to the Director to question the correctness of the action of an Examiner on a matter not subject to appeal.* – Petition may be filed with the Director from any repeated action or requirement of the Examiner which is not subject to appeal and in other appropriate circumstances. Such petition, and any other petitions which may be filed, must contain a statement of the facts involved and the point or points to be reviewed. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition. The Examiner, as the case may be, may be directed by the Director to furnish a written statement setting forth the reasons for his decision upon the matter averred in the petition, supplying a copy thereof to the petitioner. The mere filing of a petition will not stay the maximum period of six (6) months counted from the mailing date of the Examiner's action subject of the appeal for replying to an Examiner's action nor act as a stay of other proceedings.

Rule 1302. *Appeals to the Director.* – Every applicant for the grant of a patent may, upon the final refusal of the Examiner to grant the patent, appeal the matter to the Director. Appeal may also be taken to the Director from any adverse action of the Examiner in any matter over which these Regulations give original jurisdiction to the Examiner. A second adverse decision by the Examiner on the same grounds may be considered as final by the applicant, petitioner, or patentee for purposes of appeal.

Rule 1303. *Effect of a final decision of an Examiner which is not appealed.* – A final decision of an Examiner which is not appealed to the Director within the time permitted, or if appealed, the appeal is not prosecuted, shall be considered as final to all intents and purposes, and shall have the effect of *res judicata* in respect of any subsequent action on the same subject matter.

If an application is considered withdrawn for failure of the applicant to respond to an action of the Examiner on the merits, the order declaring the application as forfeited for failure to file a petition for revival within the prescribed period shall likewise have the effect of *res judicata*.

Rule 1304. *Time and manner of appeal.* – Any petition or appeal must be taken by filing the petition in duplicate or notice of appeal, as the case may be, and full payment of the required fee

within two (2) months from the mailing date of the action subject of the petition or appeal, must specify the various grounds upon which the petition or appeal is taken, and must be signed by the petitioner or appellant, or by his attorney of record. The period herein provided shall, in no case, exceed the maximum period of six (6) months from the mailing date of the action subject of the petition or appeal.

Rule 1305. *Appellant's brief required.* – In case of an appeal, the appellant shall file a brief within two (2) months from the date of filing of the notice of appeal. The brief shall contain the authorities and arguments on which he relies to maintain his appeal. Failure to file the brief within the time allowed shall make the appeal stand dismissed. No extension of time is allowed in filing the brief.

Rule 1306. *The Examiner's answer.* – The Examiner shall submit to the Director an Examiner's brief containing a written statement in answer to the petition or appellant's brief, as the case may be, within two (2) months from the date of issuance of an order from the Director directing him to submit such statement. Copy of such statement shall be served on the petitioner or appellant by the Examiner.

Rule 1307. *Appellant's Reply.* – In case of an appeal, the appellant may file a reply brief directed only to such new points as may be raised in the Examiner's answer, within one (1) month from the date of receipt of such Examiner's answer.

Rule 1308. *Decision of the Director and Appeal to the Director General.* – The decision or order of the Director reversing the refusal of the Examiner shall be immediately final and executory. However, if the decision of the Director affirms the refusal of the Examiner, the applicant may file a notice of appeal to the Director General within thirty (30) days from receipt of the Director's decision, otherwise the refusal of the application shall become final and executory. No motion for reconsideration of the decision or order of the Director General shall be allowed. When the Director's decision becomes final and executory, in any of the two instances, the application shall be remanded to the Examiner.

Rule 1309. *Appellant's Brief Required.* – The appellant shall, within thirty (30) days from the date of filing of the notice of appeal, file a brief of the authorities and arguments on which he relies to maintain his appeal. On failure to file the brief within the time allowed, the appeal shall stand dismissed.

Rule 1310. *Director's Comment.* The Director shall submit within thirty (30) days his comments on the appellant's brief if so required by the Director General.

Rule 1311. *Appeal to the Court of Appeals.* – The decision of the Director General reversing the decision of the Director and allowing the application shall be immediately final and executory. On the other hand, the decision of the Director General affirms the decision of the Director, which refuses the application, shall be final and executory if an appeal to the Court of Appeals is not perfected in accordance with the Rules of Court applicable to appeals from decisions of the Regional Trial Courts. No motion for reconsideration of the decision or order of the Director General shall be allowed. When the Director's decision becomes final and executory, in any of the two instances, the application shall be remanded to the Examiner.

PART 14
UTILITY MODELS

Rule 1400. *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 1401. *Non-registrable Utility Models.* – The provisions regarding “Non-Patentable Inventions” as provided for in Part 2, Rule 202 of the Regulations for Patents shall apply, *mutatis mutandis*, to non-registrable utility models.

Rule 1402. *Industrial Applicability.* – A utility model which can be produced and used in any industry shall be industrially applicable.

Rule 1403. *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 elements in English or Filipino:

- (a) An express or implicit indication that a utility model registration is sought;
- (b) Information identifying the applicant; and
- (c) Description of the utility model and one (1) or more claims.

Rule 1403.1. *Incomplete Application.* – The provisions regarding “Incomplete Applications” as provided for in Part 6, Rules 600.1 and 600.2 of the Regulations for Patents shall apply, *mutatis mutandis*, to an incomplete utility model application.

Rule 1403.2. *According a Filing Date.* – The provision on “According a Filing Date to Applications” as provided for in Part 6, Rule 601 of the Regulations for Patents shall apply, *mutatis mutandis*, to utility model applications.

Rule 1403.3 *Late-filed or missing drawings.* – The provision on “Late-filed or Missing Drawings” as provided for in Part 6, Rules 602 of the Regulations for Patents shall apply, *mutatis mutandis*, to utility model application.

Rule 1404. *Payment of Fees.* – An application for a utility model registration shall be subject to the full payment of the filing fee and publication fees within one (1) month after the filing date of the application.

Rule 1404.1. *Effect of Non-payment of Fees.* – – An application shall be deemed forfeited if the required fees are not fully paid within the period prescribed in Rule 1404.

A forfeited application may be retrieved by the applicant by filing a formal written request therefor within four (4) months from the mailing date of the notice of forfeiture of the application. A forfeited application not retrieved within the prescribed period shall be expunged from the records and disposed of by the Bureau.

Rule 1405. *Registration of Utility Model.* – The Office shall adopt an expeditious registration process for a utility model. All applications for utility model shall be registered without substantive examination provided all required fees, including fees for excess claims and publication are paid and all formal requirements set forth in these Regulations are complied with.

However, applicants may wish to request for a registrability report in accordance with Rules 1901-1903 before enforcing their rights to benefit from the determination of novelty and industrial applicability by the Office.

Rule 1406. *Formality Examination of Utility Model Application.* —The Office shall conduct a formality examination of the application and a report thereon shall be transmitted to the applicant.

The application shall be evaluated taking into consideration the formality requirements stated in these Regulations, such as:

- (a) It is one of those falling under the non-registrable utility models;
- (b) Contents of the request for the registration of a utility model;
- (c) Priority documents, if with claim for convention priority (i.e., file number, date of filing, and country of the priority applications);
- (d) Proof of authority, if the applicant is not the maker;
- (e) Deed of assignment;
- (f) Payment of all fees (e.g. excess claims)
- (g) Signatures of the applicant/s;
- (h) Identification of the maker/s
- (i) Contents of the description, claims, and abstract; and
- (j) Formal drawings, if any.

Rule 1407. *Applicant's Action on the Formality Examination Report.* – Within two (2) months from the mailing date of the formality examination report, the applicant may:

- (a) Amend the application;
- (b) Voluntarily withdraw the application; or
- (c) Convert the application to an application for an invention patent.

In case the applicant decides to amend the application, the provisions on “Reply by the Applicant” as provided for in Part 9, Rule 911 and “Re-examination and Reconsideration and Final Refusal” as provided for in Part 9, Rules 912 and 913 of the Regulations for Patents shall apply, *mutatis mutandis*, to utility model applications.

Failure to respond to the examination report within two (2) months from the mailing date thereof shall cause the withdrawal of the application.

Rule 1407.1. *Working Models of the Utility Model, when Required.* – The provisions regarding working models as provided for in Part 4, Rules 419, 419.1, 419.2, 419.3, 419.4, and 419.5 of the Regulations for Patents shall apply, *mutatis mutandis*, to utility model applications.

Rule 1408. *Voluntary Withdrawal.* – A utility model application may be voluntarily 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. The application shall be deemed withdrawn and all files expunged from the records of the Bureau upon receipt of the applicant's voluntary withdrawal. Voluntarily withdrawn application shall not be revived and will be deemed forfeited.

Rule 1409. 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 in a manner provided for in these Regulations.

Rule 1410. The Utility Model Application. – An application for a utility model shall be in writing. It may be written in Filipino or English, and shall be filed by post or directly with the Bureau. Filing in electronic format or through the internet may also be done, if and when facilities therefor are made available by the Office. All applications shall be addressed to the Director.

The application shall contain the following:

- (a) A duly accomplished request for the registration of a utility model;
- (b) A description containing the following:
 - (1) Title
 - (2) Technical field
 - (3) Background of the utility model
 - (4) Summary of the utility model
 - (5) Brief description of the several views of the drawings, if any
 - (6) Detailed description
- (c) Claim(s);
- (d) Drawing(s) necessary for understanding the utility model, if any; and
- (e) An abstract of the disclosure

Except for the request for registration, the documents making up the application filed in writing by post or directly to the Bureau shall be in four (4) copies.

Rule 1410.1. Title. – The title of the utility model should be as short and specific as possible. It should appear as a heading on the first page of the description. The title shall be in technical terms particularly referring to the technical feature or features of the utility model. All fancy names are not permissible in the title.

Rule 1410.2. 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 1410.3. Background of the Utility Model. – The applicant shall provide a description of the background art which shall include the state of the art, all related arts and known technology relevant to the utility model sought to be registered. As much as possible, references to specific documents and source of the information provided should be included. More importantly, the technical problem which the applicant's utility model intends to solve should be explained thoroughly.

Rule 1410.4. Summary of the Utility Model. – The summary must disclose the utility model, as claimed, in such terms that the technical problem and its technical solution are adequately explained. The difference between the utility model and the background art, in terms of its advantages and benefits, must also be stated.

Rule 1410.5. Brief Description of the Drawings. – Every view of the drawings should be briefly described and given figure numbers.

Rule 1410.6. Detailed Description. – The detailed description must completely specify the manner of making and using of the utility model to enable the person having ordinary skills in the art to understand and practice the same; setting forth the precise and exact utility model as claimed; distinguishing the utility model from the relevant prior art it pertains to; and indicating the technical problem solved by the utility model.

The provisions regarding the requirements for the detailed description as provided for in Part 4, Rules 405, 406, 406.1, 407, 408, and 409 of the Regulations for Patents shall apply, *mutatis mutandis*, to the detailed description for utility models.

Rule 1410.7. Claim. – 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.

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.

The claim requirements as provided for in Part 4, Rules 415 (a), (c), (d), and 416 of the Regulations for Patents shall apply, *mutatis mutandis*, to claims for utility models.

Rule 1410.8. Abstract of the Disclosure. – The abstract must be written in a separate sheet with the heading, “Abstract of the Disclosure.” It shall consist of a concise summary of the disclosure of the utility model as contained in the description, claims, and drawings in preferably not more than one hundred fifty (150) words. It must be drafted in a way which allows the clear understanding of the technical problem, the gist of the solution of that problem through the utility model, and the principal use or uses of the utility model. The abstract shall merely serve for technical information.

Preferably, the scope of the utility model should be disclosed such that, it can serve as an efficient basis for search in the particular technical field.

Rule 1411. Claims incurring Fee. – The “Claims incurring Fee” provision as provided for in Part 4, Rule 417 of the Regulations for Patents shall apply, *mutatis mutandis*, to claims incurring fee for utility models.

Rule 1412. 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 stated 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 1413. 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 cannot be considered as specific variations specified in these Regulations. A divisional application covering the restricted embodiment(s), if filed during pendency of the utility model application, shall be entitled to the benefit of the filing date of such parent application.

The provisions regarding requirements and procedures for restriction as provided for in Part 6, Rules 604, 606, 607, 608, 610, and 611 of the Regulations for Patents shall apply, *mutatis mutandis*, to utility model applications.

Rule 1413.1 *Term of a Divisional Application.* – The term of a divisional application shall be seven (7) years from the date of filing of the parent application without any possibility of renewal.

Rule 1414. *Publication of the Utility Model Application.* – A utility model application shall be published in the IPOPHL E-Gazette after formality examination prior to registration. However, the application may be published immediately after filing provided the following formal requirements are complied with upon filing of the application:

- (a) The description and claims and drawings (if any) are made in accordance with these Regulations;
- (b) The filing fee and other required fees have been fully paid;
- (c) If priority is claimed, the prior documents are submitted; and
- (d) other additional formal requirements required by the Office have been complied with.

Rule 1415. *Term of Registration of Utility Model.* – A utility model registration shall expire, without any possibility of renewal, at the end of the seventh year after the date of filing of the application.

Rule 1416. *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 the 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; and
- (d) That the owner of the utility model registration is not the maker or his successor in title.

Rule 1417. *Conversion of Invention Patent Application to a Utility Model Application.* – At any time before the grant or refusal of a patent for an invention, an applicant for an invention patent may, upon full payment of the prescribed fee, convert his application into an application for a utility model registration and shall be accorded the filing date of the patent application. An application may be converted only once.

The application or amended application which is converted into an application for a utility model registration shall be processed as a utility model application upon receipt of notice from the applicant.

Rule 1418. *Conversion of an Application for Utility Model Registration to an Invention Patent Application.* – At any time before the grant or refusal of a utility model registration, an applicant for a utility model registration may, upon full payment of the prescribed fee, convert his application into a patent application and shall be accorded the filing date of the utility model application. An application may be converted only once.

The application or amended application which is converted into an application for an invention patent registration shall be processed as an invention patent application upon receipt of notice from the applicant.

Rule 1419. *Published Patent Application converted to an Application for Utility Model Registration.* – Following the conversion of a published patent application to a utility model application, any person may present written adverse information concerning the registrability of the utility model within one (1) month from the date the concerned community was notified of the conversion. The converted application shall be subject to adverse information proceedings in accordance with these Regulations.

Rule 1420. *Prohibition Against Filing of Parallel Applications.* – The “Prohibition against Filing of Parallel Applications” as provided for in Part 9, Rule 915 of the Regulations for Patents shall apply, *mutatis mutandis*, to utility models.

PART 15 **INDUSTRIAL DESIGNS**

Rule 1500. *Industrial Design.* – An industrial design is any composition of shape, lines, colors, or a combination thereof, or any three-dimensional form, whether or not associated with shape, lines, or colors, which produce an aesthetic and ornamental effect in their *tout ensemble* or when taken as a whole; Provided, that such composition or form gives a special appearance to and can serve as pattern for an industrial product or handicraft.

Industrial products include articles of manufacture that belong to the useful or practical art, or any part including thereof, which can be made and sold separately.

Rule 1501. *Non-registrable Industrial Design.* – The following industrial designs shall not be registrable:

- (a) Industrial designs that are dictated essentially by technical or functional considerations to obtain a technical result;
- (b) Industrial designs which are mere schemes of surface ornamentations existing separately from the industrial product or handicraft; and
- (c) Industrial designs which are contrary to public order, health, or morals.

Rule 1502. *Requisites for Registrability of Industrial Design.* – In order to be registrable, an industrial design must be a new or original creation.

Rule 1503. *Degree of Novelty Required.* – The standard of novelty established by Section 23 (Novelty) and Section 25 (Non-prejudicial Disclosure) of the IP Code applies to industrial designs; Provided, that the period of twelve (12) months specified in Section 25 regarding non-prejudicial disclosure shall be six (6) months in the case of designs.

An industrial design shall not be considered new if it differs from prior designs only in minor respects that can be mistaken as such prior designs by an ordinary observer.

Rule 1504. *Filing Date of Industrial Design Application.* – The Bureau shall accord as the filing date of an application for industrial design registration the date on which the Bureau received the following elements:

- (a) Indications allowing the identity of the applicant to be established; and
- (b) A representation of the article embodying the industrial design or a pictorial representation thereof.

If these requirements are not complied with upon the filing of the application, the Bureau shall nevertheless accept the application and require applicant to comply with the requirements in order for the application to be accorded a filing date in accordance with these Regulations.

Rule 1505. *Registration of Industrial Design.* – The Office shall adopt an expeditious registration process for industrial design. All applications for industrial design shall be registered without substantive examination provided all required fees, including fees for publication are paid and all formal requirements set forth in these Regulations are complied with. However, applicants may wish to request for a registrability report in accordance with Rules 1901-1903 before enforcing their rights to benefit from the determination on the novelty or originality of the design by the Office.

Rule 1506. *Formality Examination of Industrial Design Application.* –The Office shall conduct a formality examination of the application and a report thereon shall be transmitted to the applicant.

The application shall be evaluated taking into consideration the formality requirements stated in these Regulations, such as:

- (a) It is one of those falling under the non-registrable industrial designs;
- (b) Contents of the request for the registration of an industrial design;
- (c) Priority documents, if with claim of convention priority (i.e. file number, date of filing, and country of the priority applications);
- (d) Proof of authority, if the applicant is not the designer;
- (e) Deed of assignment, if applicable;
- (f) Payment of all fees;
- (g) Signatures of the applicants;
- (h) Identification of the designer;
- (i) Contents of the description (characteristic feature); and
- (j) Formal drawings.

Rule 1507. *Applicant's Action on the Formality Examination Report.* – Within two (2) months from the mailing date of the formality examination report, the applicant may:

- (a) Amend the application; or
- (b) Voluntarily withdraw the application.

In case the applicant decides to amend the application, the provisions on “Reply by the Applicant” as provided for in Part 9, Rule 911 and “Re-examination and Reconsideration and Final Refusal” as provided for in Part 9, Rules 912 and 913 of the Regulations for Patents shall apply, *mutatis mutandis*, to industrial design applications.

Failure to respond to the examination report within two (2) months from the mailing date thereof shall cause the withdrawal of the application.

Rule 1508. *Voluntary Withdrawal.* – An industrial design application may be voluntarily 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. The application shall be deemed withdrawn and all files expunged from the records of the Bureau upon receipt of the applicant's voluntary withdrawal. Voluntarily withdrawn application shall not be revived and will be deemed forfeited.

Rule 1509. *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 in a manner provided for in these Regulations.

Rule 1510. *The Industrial Design Application.* – An application for an industrial design shall be in writing. It may be written in Filipino or English, and shall be filed by post or directly with the Bureau. Filing in electronic format or through the internet may also be done, if and when facilities therefor are made available by the Office. All applications shall be addressed to the Director.

The application shall contain the following:

- (a) A completely filled-out request for registration as prescribed by the Bureau containing the name and address of the applicant or where the applicant is not the designer, a statement indicating the origin of the right to the industrial design, and an indication of the kind of article of manufacture to which the design shall be applied;
- (b) A description containing the following:
 - (1) Title;
 - (2) Brief description of the different views of the drawings;
 - (3) Characteristic-feature description of the design; and
 - (4) Claim.
- (c) Drawings of the different views of the design showing the complete appearance thereof including the signature of the applicant or representative. The Bureau may also accept photographs or other adequate graphic representation of the design provided the same comply with the requirements of these Regulations regarding drawings of industrial designs.

Except for the request for registration, the documents making up the application filed in writing by post or directly to the Bureau shall be in four (4) copies.

Rule 1511. *Payment of Fees.* – An application for an industrial design registration shall be subject to the full payment of the filing fee including the publication fee within one (1) month after the filing date of the application.

Rule 1511.1. *Effect of Non-payment of Fees.* – – An application shall be deemed forfeited if the required fees are not fully paid within the period prescribed in Rule 1512.

A forfeited application may be retrieved by the applicant by filing a formal written request therefor within four (4) months from the mailing date of the notice of forfeiture of the application. A forfeited application not retrieved within the prescribed period shall be expunged from the records and disposed of by the Bureau.

Rule 1512. Specimen. – The Bureau may require that the application be accompanied by a specimen of the article embodying the industrial design with which requirement shall be subject to the full payment of the prescribed fee within one (1) month from submission of such specimen.

The specimen is defined as a sample or unit of the industrial product that is deliberately selected for examination, display or study and chosen as typical of its kind.

Rule 1513. Special Form of Description for Application for Registration of Industrial Design. – The application for registration of an industrial design shall include a description containing the following matters, arranged in the order hereunder shown:

- (a) Title of the design;
- (b) Detailed description of the several views or figures of the formal drawings;
- (c) Statement of the characteristic features of the design, if required; and
- (d) Claim.

Rule 1513.1. Title. – The title of the design must technically designate the particular article embodying the design.

Rule 1513.2. Brief Description of the Several Views of the Drawings. – Every view of the drawing should be briefly described, i.e. perspective, front, side, top, bottom, or back, and given corresponding figure numbers.

Rule 1513.3. Characteristic Feature. – A characteristic feature statement describing the particular novel and ornamental features of the claimed design which are considered to be dominant, if required.

Rule 1513.4. Claim. – The claim shall be in formal terms of the ornamental design for the article (specifying name) substantially as shown and described. More than one claim is neither required nor permitted.

Rule 1514. Special Requirements for the Drawing of an Industrial Design. – In addition to the drawings being made in conformity with the common rules stipulated in these Regulations for drawings of utility models and industrial designs, the drawings for an industrial design must comprise a sufficient number of views to constitute a complete disclosure of the appearance of the article. Appropriate surface shadings must be used to show character or contour of the surfaces represented.

The applicant may submit photographs of the design in lieu of the required format of the drawings as specified by these Regulations; Provided, that the photographs are printed on the paper prescribed by these Regulations, with figure numbers shown in black ink on the paper proximate the corresponding photograph.

Where color is a material feature of the industrial design as used or intended to be used, the color or colors employed may be actually reproduced in the drawings. Otherwise, a statement

must be made giving the name or names of the color or colors claimed indicating the principal part or parts of the article which is in such color or colors.

Rule 1514.1. *Requirements for Graphic Representation of Industrial Designs.* – Graphic representation of industrial designs such as computer-aided drawings (CAD) in lieu of the India ink drawings may be accepted; Provided, that such should be made in conformity with these Regulations particularly with respect to the special requirements for drawing of an industrial design.

Rule 1514.2. *Use of Broken Lines in the Design Drawings.* – Unclaimed environmental structure in the drawing disclosure may be shown only in broken lines, where necessary, as where the nature and intended application of the claimed design cannot be indicated adequately by a reasonable concise title or statement in the description. Such showing by broken lines should not be executed in a manner as to obscure or confuse the appearance of the claimed design. In general, when such broken lines are used, they should not intrude upon or cross the showing of the claimed design and should not be of heavier weight than the lines used in depicting the claimed design. Where a broken line showing the environmental structure must necessarily cross or intrude upon the representation of the claimed design, such an illustration should be included as a separate figure in addition to the other figures which disclose fully the subject matter for which the design protection is sought.

Rule 1515. *Several Industrial Designs in One Application.* – More than one embodiment of an industrial design in one application may be permissible in a proper case. A number of articles presented should not be patentably distinct from each other, and they should be of substantially similar dominant design features that are embodied in a single design concept. They must relate to the same subclass of the International Classification or to the same set or composition of articles. A “set of articles” which is customarily sold or used together as a set may be made a proper subject matter in one application for design registration, provided that each article is of, or has, the same design or a substantially similar design.

Where two or more articles are used together as a set of articles, the design of the set of articles may acquire design registration, provided that the set of articles constitutes a coordinated whole.

Rule 1516. *Restriction; Division.* – A restriction or division of multiple design embodiments may be deemed proper if two or more independent or distinct designs are presented in one design application for registration.

The provisions regarding requirements for restriction as provided for in Part 6, Rules 604, 606, 607, 608, 610, and 611 of the Regulations for Patents shall apply, *mutatis mutandis*, to industrial design applications.

Rule 1516.1. *Term of a Divisional Application.* – The term of the divisional application shall be five (5) years from the filing date of the parent application and may be renewed for not more than two (2) consecutive periods of five (5) years each, by paying the renewal fee.

Rule 1517. *Publication of the Industrial Design Application.* – An industrial design application shall be published in the IPOPHL E-Gazette after formality examination prior to registration. However, the application may be published immediately after filing provided the following formal requirements are complied with upon filing of the application:

- (a) The description and claim and drawings are made in accordance with these Regulations;
- (b) The filing fee and other required fees have been fully paid;
- (c) If priority is claimed, the prior documents are submitted; and
- (d) Other additional formal requirements required by the Office have been complied with.

Rule 1518. *Term of Industrial Design Registration.* – The terms shall be five (5) years from the filing date of the application and may be renewed for not more than two (2) consecutive periods of five (5) years each, by paying the renewal fee (Sections 118.1. and 118.2, IP Code).

Rule 1519. *The Renewal Fee.* – The renewal fee shall be paid within twelve (12) months preceding the expiration of the period of registration. A grace period of six (6) months shall be granted for payment of the fees after such expiration, upon payment of a surcharge.

Rule 1520. *Cancellation of Design Registration.* – At any time during the term of the industrial design registration, any person upon payment of the required fee, may petition the Director of the Bureau of Legal Affairs to cancel the industrial design on any of the following grounds:

- (a) If the subject matter of the industrial design is not registrable within the terms of Sections 112 and 113 of the IP Code;
- (b) If the subject matter is not new; or
- (c) If the subject matter of the industrial design extends beyond the content of the application as originally filed.

Rule 1520.1. Where the grounds for cancellation relate to a part of the industrial design, cancellation may be effected to such extent only. The restriction may be effected in the form of an alteration of the effected features of the design.

PART 16

COMMON PROVISIONS FOR UTILITY MODELS AND INDUSTRIAL DESIGNS

Chapter 1. *Registrability.*

Rule 1600. *Novelty; Prior Art.* – The provisions on “Novelty” and “Prior Art” as provided for in Part 2, Rules 203, 204 and 204.1 of the Regulations for Patents shall apply, *mutatis mutandis*, to utility models or industrial designs.

Rule 1601. *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 applications shall not prejudice the applicant on the ground of lack of novelty if such disclosure was made by:

- (a) The maker, designer or any person who, at the time of the date of filing, has the right to the registration;
- (b) A foreign patent office, the Bureau, or the Office, and such information was contained in:
 - (i) another application filed by the maker or designer and should have not been disclosed by the Office; or

- (ii) an application filed without the knowledge or consent of the maker or the designer by a third party which obtained the information directly or indirectly from the maker or designer; or
- (c) A third party which obtained the information directly or indirectly from the maker or designer, provided further that all foreign patent offices that publish pending patent applications, as well as the WIPO which publishes patent applications filed through the PCT are excluded therefrom.

Chapter 2. Right to a Registration.

Rule 1602. Right to a Registration. – The provision on the “Right to a Patent” as provided for in Part 3 of the Regulations for Patents shall apply, *mutatis mutandis*, to utility models or industrial designs.

In the case of industrial designs, to claim for right of priority under Rule 305 of these Regulations, the local application must be filed within six (6) months from the earliest filing date of the corresponding foreign application.

Chapter 3. The Application.

Rule 1603. Presentation of the Application Documents. –

- (a) All documents relating to an application for a utility model or industrial design which are to become part of the permanent records of the Office must be the original copy only. It must be legibly written, typewritten, or printed in permanent ink only on one side of the sheet. If necessary, only graphic symbols, characters, and chemical or mathematical formulas not capable of being printed by a typewriter or through a word processor may be written by hand or drawn. The typing shall be 1 ½-spaced. All text matters shall be in characters, the capital letters of which are not less than 0.21 cm. high and shall be in dark, indelible color.
- (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, matte, and durable.
- (c) The description and claims 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, the claims, and the abstract of the disclosure may contain chemical or mathematical formulas. The description and the abstract of the disclosure 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 the system international (SI units). Any data not meeting this requirement must also be expressed in the units recognized in international practice. For mathematical formulas, the symbols in general use shall be employed. For chemical formulas, 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 document making up the application (request for grant, 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.
- (h) The margins of the documents shall be within the following ranges: Top 2 cm. – 4 cm., left side 2.5 cm. – 4 cm., right side 2 cm. – 3 cm., and 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 numerals. 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 registration, shall be filed in four (4) copies.
- (j) Sections (d), (e), and (f) of this Rules shall be applicable only to utility model applications.

Rule 1604. Prohibited Matter. –

- (a) The application shall not contain:
 - (i) Any statement or other matter contrary to public order or morality;
 - (ii) Any 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; or
 - (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 1605. 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 1606. 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 patent 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 adjudication of the application.

Rule 1607. 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 1608. Drawings. – The provisions for the presentation of the formal drawings as provided for in Part 4, Rules 413 and 414.1 to 414.15 of the Regulations for Patents shall apply, *mutatis mutandis*, to utility models or industrial designs.

Chapter 5. Representation; Signatures.

Rule 1609. Employment of Attorney-at-Law or Agent Recommended. – The provisions on the “Employment of Attorney-at-Law or Agent Recommended” as provided for in Part 4, Rule 420 of the Regulations for Patents shall apply, *mutatis mutandis*, to utility models or industrial designs.

Rule 1610. Appointment of Resident Agent or Representative. – The provisions on “Appointment of Resident Agent or Representative” as provided for in Part 4, Rules 421 and 421.1 of the Regulations for Patents shall apply, *mutatis mutandis*, to utility models or industrial designs.

Rule 1611. Decorum and Courtesy Required in the Conduct of Business. – The provisions on “Decorum and Courtesy required in the Conduct of Business” as provided for in Part 4, Rule 422 of the Regulations for Patents shall apply, *mutatis mutandis*, to utility models or industrial designs.

Chapter 6. Who may Request for a Registration.

Rule 1612. Who may Request for a Registration. – The provisions on “Who may Apply for a Patent” as provided for in Part 5 of the Regulations for Patents shall apply, *mutatis mutandis*, to utility models or industrial designs.

Chapter 7. Classification and Search.

Rule 1613. Classification and Search. – The provisions on “Classification and Search” as provided for in Part 7 of the Regulations for Patents shall apply, *mutatis mutandis*, to utility model or industrial design.

Rule 1614. Unpublished, Withdrawn, and Forfeited Applications not cited. – Unpublished, withdrawn, and forfeited applications as such will not be cited as references.

Chapter 8. Amendments by the Applicant.

Rule 1615. Amendments by the Applicant. – The provisions on the “Amendments by the Applicant” as provided for in Part 9, Rules 916 to 928 of the Regulations for Patents shall apply, *mutatis mutandis*, to utility models or industrial designs.

Chapter 9. Time for Response by Applicant; Withdrawal of Application for Failure to Respond within Time Limit.

Rule 1616. Time for Response by Applicant; Withdrawal of Application for Failure to Respond within Time Limit. – The provisions on the “Time for Response by Applicant” and “Withdrawal of

Application” as provided for in Part 9, Rules 928, 929, 929.1, and 930 of the Regulations for Patents shall apply, *mutatis mutandis*, to utility models or industrial designs.

Rule 1617. *Reconstitution of Application File Wrappers.* – The provisions on the “Reconstitution of Application File Wrappers” as provided for in Part 9, Rule 931 of the Regulations for Patents shall apply, *mutatis mutandis*, to utility models or industrial designs.

PART 17 **ADVERSE INFORMATION**

Rule 1700. *Community Review of the Utility Model and Industrial Design Applications.* – In the interest of transparency in registering utility models or industrial designs and quality of utility models or industrial designs registered, the concerned community shall be notified by the Office upon publication of the utility model or industrial design applications .

Rule 1701. *Adverse Information.* – Within thirty (30) days from the date of publication of the utility model or industrial design application, any person may present written adverse information concerning the registrability of the utility model or industrial design including matters pertaining to novelty and industrial applicability while citing relevant prior art. The adverse information shall be in the form of a sworn statement stating the personal information and circumstance of the affiant and the grounds for objecting to the registration. The sworn statement shall be substantiated by evidence or proof and a registrability report of the application may be attached thereto. The Office shall not consider any submission that fails to comply with the foregoing requirements. Additionally, a conference at the Office may be requested by the interested party to obtain a better understanding of the application, the registration process, and the registration system in general. For this purpose, the party shall indicate three possible dates within thirty (30) days from request when the party is available for the conference. The Office shall acknowledge the receipt of the request for the conference and may request for additional information or clarifications on the adverse information filed. Within ten (10) days after the conference, parties may file a supplemental Adverse Information, in the form of a sworn statement, to include new information. All adverse information shall be communicated to the applicant who may comment on them within thirty (30) days from the mailing date of the communication. Copies of any adverse information filed and comments thereto by the applicant shall form part of the file wrapper in the subject application.

Only the adverse information as filed in accordance with these Regulations shall be taken into consideration in deciding the registrability of the utility model and industrial applications. The Office shall notify the parties who have submitted adverse information of the decision of the Office involving the utility model and industrial design applications.

Rule 1702. *Decision of the Director.* – The Director shall decide whether or not to register the utility model or industrial design. The Director may also direct the applicant to amend the application to conform with the requirements of registrability. For this purpose, the Director may issue a registrability report *motu proprio*. Amended applications shall be re-published prior to registration in accordance with these Regulations.

In case the Director refuses or denies the registration of the utility model or industrial design, 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 13 of these Regulations. No motion for reconsideration of the decision or order of the Director shall be allowed.

In case the Director allows the registration of the utility model or industrial design, any interested party may file a petition for cancellation with the Bureau of Legal Affairs in accordance with Section 109.4 for utility model and Section 120 for industrial design of the IP Code, and in accordance with the Regulations for Inter Partes Proceedings. Appeal to the Director General of the decision of the Director granting the utility model or industrial design is not allowed.

Rule 1703. *Registration of Utility Model and Industrial Design without Adverse Information.* – Where the application meets all the formal requirements for registrability as set forth in these Regulations and the Office does not receive any adverse information from the concerned community after the expiration of the thirty (30)-day publication period, the Office shall grant the registration of the utility model or industrial design and inform the applicant as well as the community of the same.

PART 18 **THE CERTIFICATE OF REGISTRATION**

Rule 1800. *Contents of Certificate of Registration.* – The Certificate of Registration shall be issued in the name of the Republic of the Philippines under the seal of the Office and shall be signed by the Director, and registered together with the description, claims, and drawings, if any, in books and records of the Office.

Rule 1801. *Inspection of Documents.* – Any interested party may inspect the complete description, claims, and drawings on file with the Office.

PART 19 **OTHER PROCEEDINGS AFFECTING THE APPLICATION OR THE REGISTRATION FOR** **UTILITY MODEL AND INDUSTRIAL DESIGN**

Chapter 1. *Assignment, Surrender, Correction, and Amendments of Certificate; Recordal and Transmission of Rights.*

Rule 1900. *Assignment, Surrender, Correction, and Amendments of Certificate; Recordal and Transmission of Rights.* – The provisions on the “Recording of Assignment of Letters Patent and other Instruments affecting Title to Patents, Including Licenses; Surrender, Correction, and Amendments of Patent; Recordal and Assignment and Transmission of Rights” as provided for in Part 12 of the Regulations for Patents shall apply, *mutatis mutandis*, to utility models and industrial designs.

Chapter 2. *Request for Registrability Report.*

Rule 1901. *Who may Request for a 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 full payment of the required fee, request for a registrability report concerning the registered utility model or industrial design.

However, judicial and quasi-judicial agencies requesting for a registrability report, however, shall be exempt from the payment of fees.

Rule 1902. 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 or claims or the industrial design claim in respect to newness.

The report shall indicate the range of the search which shall include relevant prior art publicly known or used by others in the Philippines or those described in printed publications circulated anywhere in the world or made available to the public through electronic telecommunication lines anywhere in the world prior to the filing date or priority date of the utility model or industrial design application . In the case of prior art publicly known or used, the same shall be supported by an affidavit.

When a registrability report is issued prior to the publication of the application for a utility model or industrial design registration, the registrability report shall be published together with the application.

Notwithstanding the issuance of a prior registrability report, whether published or not in accordance with the preceding paragraph, the applicant or any interested party may request for a subsequent registrability report to include such other information or documents that may have arisen or discovered after the issuance of the prior report.

Rule 1903. Time within which to issue Report. – The registrability report shall be given to the requesting party within two (2) months from receipt of the request together with full payment of the required fee.

PART 20 **PETITIONS AND APPEALS**

Rule 2000. Petitions and Appeals. – The provision on “Petitions and Appeals” as provided for in Part 13, Rules 1300 to 1311 of the Regulations for Patents shall apply, *mutatis mutandis*, to utility models or industrial designs.

FINAL PROVISIONS

Section 1. Correspondence. – The following provisions shall apply to correspondence between the inventor/applicant, maker/applicant, or designer/applicant and the Office of the Bureau:

- (a) *Business to be transacted in writing.* – All businesses with the Office or Bureau shall be transacted in writing. Actions will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is a disagreement or doubt.
- (b) *Personal attendance of applicants and other persons unnecessary.* – Unless otherwise provided, the personal attendance of applicants and other persons at the Office is unnecessary. Their business can be transacted by correspondence.

- (c) *Correspondence to be in the name of the Director of Patents.* – All Office letters with respect to matters within the jurisdiction of the Bureau must be sent in the name of the Director of Patents. All letters and other communications intended with respect to such matters must be addressed to him, and if addressed to any other officer, they will ordinarily be returned.
- (d) *Separate letter for each case.* – In every case, a separate letter shall be written in relation to each distinct subject of inquiry.
- (e) *Letter relating to applications.* – When a letter concerns an application, it shall state the name of the applicant, title of the invention/utility model/industrial design, the application number and the filing date of the application.
- (f) *Letters relating to letters patent, registered utility model or industrial design.* – When the letter concerns a letters patent, registered utility model or industrial design, the name of the patentee/maker/designer, title of the patent/utility model/industrial design, patent number/registration number, and date of issuance must be stated.
- (g) *Subjects on which information cannot be given.* – The Office cannot respond to inquiries as to the inventiveness or novelty of an alleged invention desired to be patented or the novelty of a utility model or industrial design desired to be registered in advance of the filing of an application for a patent, utility model, or industrial design.

On the propriety of making an application for the patent, registration of utility model or industrial design, the applicant must judge for himself or consult an attorney-at-law or patent agent. The Office is open to him, and its records pertaining to all patents granted may be inspected either by himself or by any attorney or agent he may call to his aid. Further than this, the Office can render him no assistance until his application comes regularly before it in the manner prescribed by law and by these Regulations. A copy of the law, rules, or circular of information, with a section marked, set to the individual making an inquiry of the character referred to, is intended as a respectful answer by the Office. Examiners' digests are not open to public inspection.

The foregoing shall not, in any way, be interpreted to prohibit the Office from undertaking an information dissemination activity in whatever format, to increase awareness on the patent law.

Section 2. Fees and Charges to be Prepaid; Fees and Charges Payable in Advance. – Express charges, freight, postage, telephone, telefacsimile, including cost of paper and other related expenses, and all other charges on any matter sent to the Office must be prepaid in full. Otherwise, the Office shall not receive nor perform any action on such matters. The filing fees and all other fees and charges payable to the Office shall be collected by the Office in advance of any service to be rendered.

Section 3. Implementation. – In the interest of the service, the function necessary to implement these Regulations shall be performed by the personnel of the concerned examining divisions and the administrative division of the Bureau.

Section 4. Repeals. – All rules and regulations, memoranda, circulars, and parts thereof inconsistent with these Regulations, particularly the Rules and Regulations on Inventions which took effect on January 15, 1999 and the Rules and Regulations on Utility Models and Industrial Designs which took effect on December 17, 1998 are hereby repealed.

Section 5. *Separability.* – If any provision in these Regulations or application of such provision to any circumstance is held invalid, the remainder of these Regulations shall not be affected thereby.

Section 6. *Effectivity.* – These rules and regulations shall take effect fifteen (15) days after the publication in a newspaper of general circulation. Done this 20th day of April 2011.

ATTY. RICARDO R. BLANCAFLOR
Director General