

May 12, 2000

June 1, 2000

OFFICE ORDER NO. 09

SUBJECT : *Amendments to the Rules and Regulations on Utility Models and Industrial Designs*

Pursuant to the authority granted by the provisions of Section 7.1 and Section 8.1 of R. A. 8293, the Rules and Regulations on Utility Models and Industrial Designs published on December 3, 1998 and took effect on December 18, 1998, are hereby amended as follows:

SECTION 1. A new rule is hereby added to provide a title for each reference as follows:

Rule 10. These Regulations shall be known as the "Utility Model and Design Regulations".

SECTION 2. Rule 201 is hereby amended to read as follows:

"Rule 201. *Statutory classes of Utility Models*. — A utility model may be, or may relate to:

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

SECTION 3. Rule 203 is hereby amended to read as follows:

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

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

Without need of any notice from the Office, the filing fee shall be paid within one (1) month from the date the application was received by the Office. Otherwise, the application shall be deemed forfeited.

SECTION 4. Rule 205 is hereby amended to read as follows:

"Rule 205. *Registration of Utility Model.* — A utility model application shall be registered without substantive examination provided all fees such as filing, excess claims and publication fees are paid on time, and all formal requirements set forth in these Regulations are filed."

SECTION 5. Rule 206 is hereby amended to read as follows:

"Rule 206. *Formality Examination of Utility Model Application.* — The utility model application shall be classified and examined as to the completeness of the formal requirements prescribed in these Regulations, and a report thereon shall be transmitted to the applicant." The formality examination shall take into account the parts of these Regulations on: (a) the right to a utility model registration, (b) who may apply for a utility model registration, (c) filing date requirements, and (d) other formality requirements."

SECTION 6. Rule 207 is hereby amended to read as follows:

"Rule 207. *Applicant's action on the Formality Examination Report.* — Within two (2) months from the mailing date of the formality examination report, the applicant may: (1) voluntarily withdraw the application, (2) amend the application, (3) convert the application to an application for an invention patent, or, (4) upon payment of the required fee, request for a registrability report.

SECTION 7. Rule 207.2 is hereby amended to read as follows:

"Rule 207.2. *Amended Applications.* — The amended application shall be classified and subjected to formality examination. Report thereon shall be submitted to the applicant within two (2) months from receipt of the amended application. Within two (2) months from the mailing date of the formality examination report on the amended application, the applicant may: (1) withdraw the application; (2) convert the same to an application for an invention patent; or (3) upon payment of the required fee, request for a registrability report.

SECTION 8. Rule 207.4 is hereby amended to read as follows:

"Rule 207.4 *No action on the part of applicant where formal requirements are complete.* — Where the application meets all the formal requirements for registrability and the Bureau fails to receive any action from the applicant, the utility model shall be deemed registered upon the expiration of two (2) months from the mailing date of the formality examination report, provided the issuance, publication and all required fees have been fully paid."

SECTION 9. Rule 207.6 is hereby amended to read as follows:

"Rule 207.6. *Registrability Report.* — The report shall contain citations of relevant prior art documents with appropriate indications as to their degree of relevance which will serve as an aid to the applicant in the determination of the validity of the utility model claim(s) in respect to newness. The registrability report shall be given to the applicant within two (2) months from receipt of the request from the applicant."

SECTION 10. A new Rule 207.7 is hereby added as follows:

"Rule 207.7. *Non-Payment of Issuance and Publication Fees.* — Where the application meets all the formal requirements for registrability and the applicant fails to pay the issuance and publication fees within the prescribed period, the utility model application shall be deemed withdrawn."

SECTION 11. A new Rule 207.8 is hereby added as follows:

"Rule 207.8 *Final Action.* — Where the applicant fails to file a complete response to the formality examination report, any subsequent formality examination report submitted to the applicant shall be a final action which may be appealed to the Director of Patents in a manner provided for in these Regulations."

SECTION 12. Rule 208 is hereby amended to read as follows:

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

The application shall contain the following:

- (a) A duly accomplished request for registration as prescribed by the Bureau,

- (b) Description containing the following:
 - 1. title
 - 2. technical field
 - 3. background of the Utility Model
 - 4. brief description of the several views of the drawings, if any
 - 5. detailed description
- (c) Claim or claims
- (d) Drawings, if any
- (e) Abstract of the Disclosure

SECTION 13. Rule 208.1 is hereby amended to read as follows:

"Rule 208.1. *Title*. — The title should be as short and specific as possible, and should appear as heading on the first page of the specification. Fancy names are not permissible in the title."

SECTION 14. Rule 212 is hereby amended to read as follows:

"Rule 212. *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.

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

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

SECTION 15. Rule 301 is hereby amended to read as follows:

"Rule 301. *Requisites for Registrability of Industrial Design.* — In order to be registrable, an industrial design must be any new or original creation relating to the ornamental features of shape, configuration, form, or combination thereof, an article of manufacture, whether or not associated with lines, patterns or colors, which imparts an aesthetic and pleasing appearance of the article. The design which is embodied in any composition of lines, patterns or colors must be inseparable from the article and cannot exist alone merely as a scheme of surface ornamentation.

An article of manufacture is defined as anything which belongs to the useful or practical art, or any part thereof, which can be made and sold separately.

Industrial designs that are dictated essentially by technical or functional considerations to obtain technical result or those that are contrary to public order, health or morals, are not registrable."

SECTION 16. Rule 306 is hereby amended to read as follows:

"Rule 306. *Registration of Industrial Design.* — If the application meets the requirements of the IP Code and these regulations, the Bureau shall effect the registration of the industrial design: Provided that all the required fees are paid on time."

SECTION 17. Rule 307 is hereby amended to read as follows:

"Rule 307. *Formality Examination of Industrial Design Application.* — The industrial design application shall be classified and examined as to the completeness of the formal requirements prescribed in these Regulations and a report thereon shall be transmitted to the applicant. The formality examination shall take into account the parts of these Regulations on: (a) the right to an industrial design registration, (b) who may apply for an industrial design registration, (c) filing date requirements and (d) other formality requirements."

SECTION 18. Rule 308 is hereby amended to read as follows:

"Rule 308. *Applicant's action on the Formality Examination Report.* — Within two (2) months from the mailing date of the formality examination report, the applicant may: (1) voluntarily withdraw the application, (2) amend the application, or, (3) upon payment of the required fee, request for a registrability report."

SECTION 19. Rule 308.2 is hereby amended to read as follows:

"Rule 308.2. *Amended Applications.* — The amended application shall be classified and subjected to formality examination. Report thereon shall be submitted to the applicant within two (2) months from receipt of

the amended application. Within two (2) months from the mailing date of the formality examination report on the amended application, the applicant may: (1) withdraw the application, or, (2) upon payment of the required fee, request for a registrability report."

SECTION 20. Rule 308.3 is hereby amended to read as follows:

"Rule 308.3. *No action on the part of the applicant where the formal requirements are complete.* — Where the application meets all the formal requirements for registrability and the Bureau fails to receive any action from the applicant, the industrial design shall be deemed registered upon the expiration of two months from the mailing date of the formality examination report provided the issuance, publication and all the required fees have been fully paid.

SECTION 21. In Rule 308.5 is hereby amended to read as follows:

"Rule 308.5. *Registrability Report.* — This report shall contain citations of relevant prior art documents with appropriate indications as to their degree of relevance which will serve as an aid to the parties concerned in the determination of the validity of the industrial design claim in respect to newness. The registrability report shall be given to the applicant within two (2) months from receipt of the request from the applicant."

SECTION 22. A new Rule 308.6 is hereby added as follows:

"Rule 308.6. *Non-Payment of Issuance and Publication Fees.* — Where the application meets all the formal requirements for registrability and the applicant fails to pay the issuance and publication fees within the prescribed period, the industrial design application shall be deemed withdrawn."

SECTION 23. A new Rule 308.7 is hereby added as follows:

"Rule 308.7 *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."

SECTION 24. Rule 310 is hereby amended to read as follows:

"Rule 310. *Fees.* — An application for an industrial design shall be subject to the payment of the filing fee. The application shall be deemed forfeited if the filing fee is not paid within one (1) month from the date the application was received by the Office."

SECTION 25. Rule 317 is hereby amended to read as follows:

"Rule 317. *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 Legal Affairs of the Office 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 contents of the application as originally filed."

SECTION 26. Rule 402 is hereby amended to read as follows:

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

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

For the purposes of this Rule "designer" also means any person who, at the filing date of application, had the right to the industrial design."

SECTION 27. Rule 408(a) is hereby amended to read as follows:

"Rule 408(a). All papers for an application for a utility model and industrial design registration which are to become part of the permanent records of the Office must be the original copy only, and legibly written, typewritten, or printed in permanent ink only on one side of the sheet. If necessary, only graphic symbols and characters and chemical or mathematical formulas may be written by hand or drawn. The typing shall be 1½ spaced. All text matter shall be in characters, the capital

letters of which are not less than 0.21 cm. high, and shall be in dark, indelible color."

SECTION 28. Rule 408(g) is hereby amended to read as follows:

"Rule 408(g). Each of the documents making up the application (request for registration, description, claims, drawings and abstract of the disclosure) shall commence on a separate sheet. The separate sheets shall be filed in such a way that they can easily be turned over, and joined together again."

SECTION 29. A new Rule 408(j) is hereby added as follows:

"Rule 408(j). Paragraphs (d), (e) and (f) of this Rule shall only be applicable to utility model applications."

SECTION 30. Rule 409(a)(ii) is hereby amended to read as follows:

"Rule 409(a)(ii) statement disparaging the products or processes of any particular person other than the applicant, or the merits or validity of applications or patents of any such person. Mere comparison with the prior art shall not be considered disparaging per se;"

SECTION 31. Rule 433 is hereby amended to read as follows:

"Rule 433. *Revocation of Power of Attorney*. — A power of attorney or authorization may be revoked upon proper notification to the Director General, and, when revoked, the Office will notify the attorney or agent of such revocation and shall communicate with the latest attorney or agent appointed."

SECTION 32. Rule 441 is hereby amended to read as follows:

"Rule 441. *Classification and Search*. — An application for utility model or an industrial design shall be classified and a search conducted to determine the prior art."

SECTION 33. Rule 442 is hereby amended to read as follows:

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

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

- (c) The search report may include documents cited in a search established in the corresponding foreign application.

Upon payment of the required fees, the Office shall provide a copy of the Search Report with respect to any published utility model and industrial design within a maximum period of two (2) months from receipt of the request."

SECTION 34. A new Chapter 9 in Part 4 is hereby added as follows:

CHAPTER 9

TIME FOR RESPONSE BY APPLICANT; WITHDRAWAL OF APPLICATION FOR FAILURE TO RESPOND WITHIN TIME LIMIT

Rule 452. *Withdrawal of application for failure to respond to the formality examination report and the notice of issuance and publication fees within the prescribed time limit.*

- (a) If an applicant fails to prosecute his application within the required time as provided in these Regulations, the application shall be deemed withdrawn.
- (b) The time for reply may be extended only for good and sufficient cause, and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the applicant is due. The Examiner may grant a maximum of two extensions, provided that the aggregate period granted inclusive of the initial period allowed to file the response, shall not exceed six (6) months from mailing date of the official action requiring such response.
- (c) Prosecution of an application to save it from being deemed withdrawn must include such complete and proper action as the condition of the case may require. Any amendment not responsive to the last official action shall not operate to save the application from being deemed withdrawn.
- (d) When action by the applicant is a bona fide attempt to advance the case to final action, and is substantially a complete response to the Examiner's action, but consideration of some matter or compliance with some requirements has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of withdrawal is considered.

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

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

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

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

SECTION 35. *Furnishing of Certified Copies.* — Mr. Eduardo Joson, Records Officer II, is hereby directed to immediately file three (3) certified copies of these Regulations with the University of the Philippines Law Center, and, one (1) certified copy each to the Office of the President, the Senate of the Philippines, the House of Representatives, the Supreme Court of the Philippines, and the National Library.

SECTION 36. This Office Order shall take effect on 01 June 2000.

DONE this 12th day of May 2000 at Makati City, Philippines.

Recommending Approval:
EPIFANIO M. EVASCO
Director
Bureau of Patents

Approved:
(Sgd.) EMMA C. FRANCISCO
Director General

By:
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