

PHILIPPINE RULES ON PCT APPLICATIONS

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;

Whereas, Senate Resolution No. 74 dated 05 February 2001 was passed whereby the Philippines ratified the Patent Cooperation Treaty (PCT);

Whereas, since 1978, the PCT system has offered investors and industry an advantageous route for obtaining patent protection internationally; aims to facilitate procedures for obtaining legal protection for inventions and disseminate technical information; seeks to simplify and to render more effective and more economical - in the interest of the applicants and the patent offices - previously established means of applying in several countries for patent protection for invention; would substantially benefit Philippine patent agents and industry from the filing in the Philippines of international applications under the PCT;

Whereas, in accordance with Article 63 of the PCT, the Treaty shall enter into force with respect to the Philippines, three (3) months after the date on which it has deposited its Instrument of Accession with the Director General of the World Intellectual Property Organization (WIPO);

Whereas, the Philippines deposited its Instrument of Accession with the Director General of the WIPO on 17 May 2001; and, therefore, the PCT entered into effect with respect to the Philippines on 17 August 2001;

Whereas, there is a need to guide applicants, patent attorneys/agents, and other interested parties in the Philippines on the PCT and its rules and regulations;

Now, therefore, pursuant to Senate Resolution No. 74 dated 05 February 2001, the provisions of the Patent Cooperation Treaty and the Regulations thereunder, Republic Act No. 8293 also known as the Intellectual Property Code of the Philippines, the following rules on PCT applications are hereby promulgated:

PART 1

GENERAL PROVISIONS

Rule 1. Title.- These rules shall be known as the Philippine Rules on PCT Applications or "PRo-PCT".

Rule 2. Definitions. - Unless otherwise specified, the following terms and acronyms shall be understood as follows:

(a) "Administrative Instructions" means that body of instructions for operating under the Patent Cooperation Treaty referred to in PCT Rule 89;

(b) "designated Office" means a national patent office or intergovernmental organization of or acting for the State designated by the applicant under Chapter I of the Treaty;

- (c) "designated State" refers to the State in which protection for the invention is desired on the basis of the international application and which is designated under Chapter I of the Treaty;
- (d) "Director General" means the Head of the Intellectual Property Office of the Philippines;
- (e) "elected Office" means a national patent office or intergovernmental organization of or acting for the State elected by the applicant under Chapter II of the Treaty;
- (f) "elected State" refers to the State in which protection for the invention is desired on the basis of the international application and which has been elected under Chapter II of the Treaty;
- (g) "IB" and "International Bureau" mean the International Bureau of the World Intellectual Property Organization as referred to in PCT Article 2(xix);
- (h) "International Application" and "PCT Application" mean an application filed under the Treaty;
- (i) "International Searching Authority" or "ISA" and "International Preliminary Examining Authority" or "IPEA" mean a national patent office or intergovernmental organization as appointed under the Treaty which processes international applications as prescribed by the Treaty and PCT Regulations;
- (j) "IP Code" means Republic Act No. 8293 otherwise known as the Intellectual Property Code of the Philippines;
- (k) "IPO" or "Office" means the Intellectual Property Office of the Philippines;
- (l) "IPO Fee Structure" means the rules and regulations establishing the fees and charges of the Intellectual Property Office of the Philippines;
- (m) "PCT" and "Treaty" mean the Patent Cooperation Treaty;
- (n) "PCT-EASY" means the software made available by the International Bureau for facilitating the preparation of the request part of an international application, and printing thereof, for filing together with a computer diskette prepared using that software, containing a copy in electronic form of the data contained in the request and of the abstract;
- (o) "PCT Regulations" means the set of rules, referred to in PCT Article 58 and annexed to the Treaty referred to as the Regulations Under the PCT;
- (p) "Priority Date" for the purposes of computing time limits under the PCT is defined in PCT Article 2(xi) as follows:
- (i) where the international application contains a priority claim under PCT Article 8, the filing date of the application whose priority is so claimed;
 - (ii) where the international application contains several priority claims under PCT Article 8, the filing date of the earliest application whose priority is so claimed;
 - (iii) where the international application does not contain any priority claim under PCT Article 8, the international filing date of such application;
- (q) "receiving Office" means a national patent office or intergovernmental organization with which the international application has been filed;

Other terms and expressions not defined in this rule are to be taken in the sense of the Treaty and PCT Regulations.

Rule 3. Application of the PCT and PCT Regulations. - In all matters not specifically provided for under these Rules, the provisions of the Treaty, PCT Regulations and PCT Administrative Instructions shall apply in the processing of an international application during the international phase of the application. In the event of conflict between these Rules and those of the PCT, the provisions of the latter shall apply.

The international phase covers the period from the filing of the application in accordance with the PCT until the application enters the national phase.

Rule 4. Effect of an International Application. - 4.1. An international application designating the Philippines for the purposes of obtaining a national patent or a utility model, which has been accorded an international filing date in accordance with the Treaty and PCT regulations, shall have the effect of a national application for a patent or utility model, respectively, regularly filed with the Intellectual Property Office as of the international filing date, which date shall be considered to be the actual filing date in the Philippines. (PCT Article 11(3))

4.2. Subject to Review by the IPO under Rule 37, an international application designating the Philippines that is withdrawn or considered withdrawn under the Treaty and PCT Regulations, before the applicant has entered the national phase in the Philippines as provided in Part 3 of these Rules, that international application is likewise withdrawn or considered withdrawn in the Philippines. (PCT Article 24)

Rule 5. Seeking Two (2) Kinds of Protection; Prohibition Against Filing of Parallel Applications. - In respect of the Philippines as a designated or elected State, an applicant cannot seek two (2) kinds of protection for the same subject, one for utility model registration and the other for the grant of a patent whether simultaneously or consecutively. (PCT Article 43, IP Code Section 111)

Rule 6. Delivery Service. - Where the applicant sends a document or letter through mail and that document or letter is lost or reaches the IPO after the expiration of the applicable time limit under the Treaty and PCT Regulations and these Rules, PCT Rules 82.1(a) to (c) shall apply provided that the delivery service used is registered mail by a postal authority.

Rule 7. Appointment of Resident Agent or Representative. - (a) An applicant who is not a resident of the Philippines shall appoint and maintain an agent or representative residing in the Philippines upon whom notices or processes for judicial or administrative procedure may be served relating to the international application filed with the IPO as a receiving, designated or elected Office. An applicant who is a resident of the Philippines may likewise appoint and maintain an agent or representative residing in the Philippines for the same purpose. The list of registered resident agents or representatives is available in the IPO website.

(b) Where the international application is filed with the IPO as a receiving Office, the appointment of an agent must be effected in the Request form, signed by all applicants, or in a separate power of attorney submitted to the IPO where the Request form is signed by the appointed agent in accordance with PCT Rule 90.4. The separate power of attorney does not require legalization or notarization.

(c) For purposes of the procedure before the IPO as a designated or elected Office, the manner of appointing an agent or representative shall comply with the requirements prescribed in the implementing rules and regulations of the IP Code.

PART 2

INTERNATIONAL PHASE

Rule 8. The IPO as a Receiving Office. - 8.1. The IPO shall act as a Receiving Office only for applicants who are residents or nationals of the Philippines. (PCT Article 2 (xii) and (xv), PCT Article 10, PCT Rule 19)

8.2. The IPO, when acting as a Receiving Office, will be identified by the full title "Philippine Receiving Office" or by the abbreviation "RO/PH." (Section 107(b) of the PCT Administrative Instructions)

8.3. Without prejudice to the national security and interests of the Republic of the Philippines, the IPO shall perform all acts connected with the discharge of duties of a Receiving Office under the Treaty and PCT Regulations. The functions of the IPO as a Receiving Office include:

- (1) According of international filing dates to international applications fulfilling the requirements of PCT Article 11(1) and in particular, PCT Rule 20;
- (2) Checking that international applications meet the standards for format and content of PCT Article 14(1) and in particular, PCT Rules 9, 26, 29.1, 37, 38, 91, and portions of PCT Rules 3 through 11;
- (3) Assessing, collecting, and transmitting fees due for processing international applications (PCT Rules 14, 15, 16, 16bis);
- (4) Transmitting the record and search copies to the IB and ISA, respectively (PCT Rules 22 and 23); and
- (5) Transmitting the international application to the IB for processing, where the IPO is not the competent Receiving Office as defined under PCT Rule 19. (PCT Rule 19.4)

Rule 9. International Search and International Searching Authority. - 9.1. An international application shall be the subject of an international search, which shall be carried out by an ISA. The objective of the international search is to discover relevant prior art. (PCT Article 15 (1) and (2))

9.2. The Director General shall specify one or more competent ISAs for international applications filed with the IPO and, subject to any required acceptance or compliance with applicable requirements, the IPO shall publish in its website a list of those competent ISAs. (PCT Article 16(2), PCT Rules 35.1 and 35.2)

9.3. The applicant shall, in his Request Form, indicate his choice of the competent ISA. (PCT Rule 4.14bis)

Rule 10. International Preliminary Examination and International Preliminary Examining Authority. - 10.1. An international application may be the subject of an international preliminary examination which shall be carried out by an IPEA. (PCT Article 32(1))

10.2. The objective of the international preliminary examination is to formulate a preliminary and non-binding opinion on the questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious) and to be industrially applicable. (PCT Article 33(1))

10.3. The Director General shall specify one or more competent IPEAs for international applications filed with the IPO and, subject to any required acceptance or compliance with applicable requirements, the IPO shall publish in its website a list of those competent IPEAs. (PCT Rule 59.1(a))

10.4 Where there are two or more competent IPEAs for applications filed with the IPO, the applicant shall, in his Demand Form, indicate his choice of the competent IPEA.

Rule 11. Language Prescribed by the Receiving Office. - The language accepted by the Philippines receiving Office for the filing of international application is Filipino or English, provided that it is sufficient that the description and claims be in Filipino or English for the purposes of according an international filing date under PCT Article 11(1). (PCT Rules 12.1, 20.4(c) and 48.3(a))

Rule 12. Translation for the Purposes of International Search. - (a) Where the international application is filed in Filipino, the applicant shall, within one (1) month from the date of receipt of the international application by the IPO, furnish to the Office a translation of the international application into English in accordance with PCT Rule 12.3 (a) and (b).

(b) If the English translation is not furnished within the time limit under paragraph (a), the Office shall invite the applicant to furnish it within one (1) month from the date of invitation or two (2) months from the date of receipt of the international application by the IPO, whichever expires later. (PCT Rule 12.3(c))

(c) If the applicant does not furnish the English translation within the applicable time limit under paragraph (b), the international application shall be considered withdrawn and the IPO as a receiving Office shall so declare in accordance with PCT Rule 12.3(d).

(d) The IPO shall promptly furnish the IB and the ISA a copy of the English translation.

Rule 13. Documents and Correspondence. - (a) Any paper submitted by the applicant, other than the international application itself, must, if not itself in the form of a letter, be accompanied by a letter identifying the international application to which it relates and must be signed by the applicant. (PCT Rule 92.1(a))

(b) Correspondence intended for the applicant shall be sent to the agent appointed under Rule 7. (PCT Rules 90.1(a) and 90.3(a) and Section 108 of the PCT Administrative Instructions)

Rule 14. Keeping of Records and Files. - The IPO shall keep the records relating to the international application or purported international application for at least (ten) 10 years from the international filing date or, where no international filing date is accorded, from the date of receipt of the purported application. (PCT Rule 93.1)

Rule 15. The International Application. - An international application shall contain a request, a description, one or more claims, one or more drawings (where required), and an abstract. (PCT Article 3(2))

Rule 16. The Request. - The request shall be made in accordance with PCT Rules 3 and 4. Copies of the Request form are available at the IPO.

The Request Form may be made using PCT-EASY software made available by the IB, in which case, the applicant is required to submit the Request as a computer print-out together with a computer diskette containing a copy of the electronic form of the data contained in the

Request and of the abstract prepared using that software. (PCT Rule 89ter and Section 102bis of the PCT Administrative Instructions)

Rule 17. The Description. - The description shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art. (PCT Article 5, PCT Rule 5.1(a)(v))

The requirements as to the format and content of the description are set forth, in particular, in PCT Rules 5, 9, 10, and 11, and Section 204 of the PCT Administrative Instructions.

Rule 18. The Claims. - The claim or claims shall define the matter for which protection is sought. Claims shall be clear and concise. They shall be fully supported by the description. (PCT Article 6, PCT Rule 6)

The requirements as to the format and content of claims are set forth, in particular, in PCT Rules 6, 9, 10, and 11.

Rule 19. The Drawings. - Drawings which are necessary for the understanding of the invention must be part of the international application as originally filed in order to maintain the international filing date during the national stage. If drawings are referred to in the international application but they are missing upon filing, the IPO shall give the applicant thirty (30) days from the date of receipt of the international application to submit the drawings. If the missing drawings are received within the thirty-day period, the international filing date shall be the date on which such drawings are received. If such drawings are not timely received, all references to drawings in the international application shall be considered non-existent. (PCT Article 7, 14(2), PCT Rule 26.2)

The physical requirements for drawings are set forth in PCT Rule 11.3.

Rule 20. The Abstract. - The abstract shall merely serve for technical information. Lack of an abstract upon filing of an international application will not affect the granting of a filing date. If the abstract is missing, the IPO shall invite the applicant to submit the same within one (1) month from the date of the invitation and the IPO shall notify the ISA accordingly. (PCT Article 3(3), 14(b), PCT Rule 26.1, 26.2, 38)

The requirements as to the format and content of the abstract are set forth in PCT Rule 8.

Rule 21. Priority Claim. - Any declaration referred to in Article 8(1) ("priority claim") shall be indicated in the Request Form as set forth in PCT Rule 4.10.

Any correction or addition on the priority claim shall be made in accordance with PCT Rule 26bis.

Rule 22. Physical Requirements. - 22.1. An international application and each of the documents that may be referred to in the checklist of the Request Form shall be filed in one (1) copy only. (PCT Rule 11.1)

22.2. All sheets of the international application must be on A4 size paper (29.7 cm x 21 cm) which shall be flexible, strong, white, smooth, non-shiny, and durable. (PCT Rules 11.3, 11.5)

22.3. In order to facilitate processing of the international applications, attention of applicants is directed to the other physical requirements for international application which are set forth in PCT Rule 11 and Section 207 of the PCT Administrative Instructions.

Rule 23. Who May File An International Application. - A resident or national of the Philippines may file an international application. If there are two or more applicants, the right to file an international application shall exist if at least one of them is a resident or national of the Philippines. (PCT Article 9(1), PCT Rule 19.2(i))

Rule 24. Where to File an International Application. - 24.1. A resident or national of the Philippines may file an international application with the IPO or the IB. (PCT Rule 19.1)

24.2. An international application may be filed directly with the IPO or through registered mail by postal authority.

Rule 25. According of International Filing Date and its Effect. - 25.1. The IPO, as the competent receiving Office, shall accord as the international filing date the date of receipt of the international application, provided that, at the time of receipt:

- (1) at least one applicant is a resident or national of the Philippines;
- (2) the international application is in the Filipino or English language; and
- (3) the international application contains at least the following elements:
 - (i) an indication that it is intended as an international application;
 - (ii) the designation of at least one Contracting State;
 - (iii) the name of the applicant;
 - (iv) a part which on the face of it appears to be a description; and
 - (v) a part which on the face of it appears to be a claim or claims. (PCT Article 11(1))

25.2. If the IPO finds that the applicant or not one of the applicants is a resident or national of the Philippines or that the language is neither Filipino nor English, the international application shall be treated and transmitted to the IB in accordance with PCT Rule 19.4, subject to payment of the transmittal fee under PCT Rule 14.

25.3. If the IPO finds that the international application did not, at the time of receipt, contain the elements listed in Rule 25.1 item (3), it shall invite the applicant to file the required correction within thirty (30) days from the date of the invitation. If the applicant complies with the invitation, the IPO shall accord as the international filing date the date of receipt of the required correction. If the applicant does not comply with the invitation, the IPO shall promptly in accordance with PCT Rule 20.7(i) notify the applicant that his application is not and will not be treated as an international application and shall indicate the reasons therefor. (PCT Article 11(2)(a) and (b))

Rule 26. Transmittal of the International Application. - 26.1. The IPO shall transmit the "record copy" of the international application to the IB in accordance with PCT Rule 22;

26.2. The IPO shall transmit the "search copy" of the international application to the competent ISA after payment of the search fee by the applicant in accordance with PCT Rule 23. (PCT Article 12(1))

26.3. The Director General may prohibit or restrict the transmittal 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. The Director General may apply other measures, as provided under PCT

Article 27(8), that will not prevent the transmittal of the record copy and search copy but will restrict the contents of the transmittals. (PCT Rule 22.1, PCT Article 27(8))

Rule 27. The International Publication and its Effect. - 27.1. In accordance with PCT Article 21 and PCT Rule 48, the IB shall publish the international application promptly after the expiration of eighteen (18) months from the priority date of the application. However, the applicant may ask the IB to publish his international application any time before the expiration of eighteen (18) months from the priority date in accordance with PCT Rule 48.4.

27.2. In accordance with PCT Article 29(1), as far as the protection of any rights of the applicant under Section 46 of the IP Code in the Philippines is concerned, the international publication in English of an international application shall have the same effect as a publication in the IPO Gazette under Section 44 of the IP Code and its implementing rules and regulations provided that notice of the international publication and copy of the international application has been transmitted by the applicant to the actual unauthorized user of the invention claimed in the international application pursuant to Sec. 46.2 of the IP Code. (PCT Article 29(1))

27.3. If the language in which the international publication has been effected is a language other than English, the protection of any right of the applicant under Section 46 of the IP Code in the Philippines shall be applicable only from such time as a translation into English has been published in the IPO Gazette under Section 44 of the IP Code and its implementing rules and regulations, and, such translation into English has been transmitted by the applicant to the actual unauthorized user of the invention claimed in the international application pursuant to Section 46.2 of the IP Code. (PCT Article 29(2))

27.4. Where the international publication has been effected, on the request of the applicant, before the expiration of eighteen (18) months from the priority date, the rights provided for under Sec. 46 of the IP Code shall be applicable only from the expiration of eighteen (18) months from the priority date subject to the conditions mentioned in the preceding paragraphs. (PCT Article 29(3))

Rule 28. Demand for International Preliminary Examination. - 28.1. On filing of a demand under PCT Article 31, the international application shall be the subject of an international preliminary examination.

28.2. The demand for international preliminary examination shall be filed directly by the applicant with the competent IPEA prior to the expiration of the nineteenth (19th) month from the priority date.

28.3. The demand shall indicate the States in which the applicant intends to use the results of the international preliminary examination.

28.4. In accordance with PCT Article 31 and PCT Rules 57 and 58, the demand shall be subject to the payment by the applicant of the prescribed fees directly to the IPEA within one (1) month from the date on which the demand was submitted. (PCT Rules 57, 58, and 58bis)

Copies of the Demand Form are available at the IPO.

Rule 29. Manner of Making Corrections. - Any correction offered to the IPO as a receiving Office may be stated in a letter addressed to the IPO if the correction is of such a nature that it can be transferred from the letter to the record copy without adversely affecting the clarity and the direct reproducibility of the sheet on to which the correction is to be transferred; otherwise,

the applicant shall be required to submit the missing requirement or a replacement sheet containing the correction accompanied by a letter indicating the differences between the replaced sheet and the replacement sheet. (PCT Rule 26.4)

Rule 30. Delays in Meeting Time Limits. Delays in meeting time limits during international processing of international applications may only be excused as provided in PCT Rule 82.

Rule 31. Recording of Changes. - Before the expiration of the time limit referred to in PCT Articles 22(1) and 39(1)(a), the IPO may receive from the applicant a request for the recording of a change in the person, name, residence, nationality or address of the applicant or a change in the person, name or address of the inventor, the agent or the common representative. The IPO shall notify the IB of the request for recording a change. (PCT Rule 92bis.1(a))

Rule 32. Withdrawals. - The IPO may receive from the applicant notice of withdrawal of the international application, any designation, or priority claims in accordance with PCT Rule 90bis(1), 90bis(2), 90bis(3).

Withdrawal of a demand or any election shall be made directly to the IB in accordance with PCT Rule 90bis.4.

Rule 33. Certified Copies of the International Application and Priority Document. - (a) The applicant may request the IPO to prepare a certified copy of the international application as filed and of any corrections thereto upon payment of the appropriate fee. (PCT Rule 20.9)

(b) Where the priority document is issued by the IPO, the applicant may, pursuant to PCT Rule 17.1(b), request the IPO to prepare and transmit the priority document to the IB. Such request shall be made not later than sixteen (16) months after the priority date and shall be subject to payment of a fee.

PART 3

NATIONAL PHASE

Rule 34. The IPO as a Designated or Elected Office. - 34.1. The IPO will act as the Designated or Elected Office for international applications in which the Philippines has been designated or elected. (PCT Articles 2(xii), 2(xiii), 2(xiv), and IP Code Sections 5(a), 7(b), 8.1)

34.2. The IPO, when acting as a Designated or Elected Office during international processing will be identified by the full title "Philippine Designated Office" or by abbreviation "DO/PH" and "Philippine Elected Office" or by abbreviation "EO/PH." (Section 107(b) of the PCT Administrative Instructions)

34.3. The major functions of the IPO in respect to international applications in which the Philippines has been designated or elected, shall include:

- (1) Receiving various notifications throughout the international phase; and
- (2) Accepting for national phase examination international applications which comply with Part 3 of these Rules.

Rule 35. Entry Into National Phase. - (a) An international application enters the national phase when the applicant furnishes IPO a copy of the international application in English (unless

already transmitted by the IB), or, if the application was filed in another language, its English translation not later than thirty (30) months from the priority date based on PCT Article 22 (1) and PCT Article 39 (1) (a).

Subject to the payment of an extension fee for late entry equal to fifty percent (50%) of the filing fee prescribed in the IPO Fee Structure, the entry into the national phase may be extended by one (1) month.

(b) The filing fee prescribed in the IPO fee structure shall be paid within one (1) month from the date of entry into the national phase; provided that an international application which claims the priority of an earlier Philippine national application shall be exempt from payment of the filing fee. If the applicant fails to pay the filing fee as herein provided, the application shall be deemed withdrawn in the Philippines.

(c) The translation of the international application, as filed, referred to in paragraph (a) shall include a translation into English of:

(1) the description;

(2) the claims as filed and, where applicable, as amended under PCT Article 19;

(3) any text matter of the drawings;

(4) the abstract; and

(5) where applicable, amendments to the description, claims or drawings under PCT Article 34, as contained in the annexes to the international preliminary examination report.

If the translation of the amendments under PCT Article 19 or PCT Article 34, as the case may be, is not included, those amendments will be considered cancelled.

(d) During the national phase, and at anytime before a patent is granted or refused on the international application, the applicant may present amendments to the specification, claims and drawings in accordance with the IP Code and its implementing rules and regulations.

Rule 36. Entry Into the National Phase of an International Application Claiming The Priority of an Earlier Philippine National Application. Within one (1) month from the date of entry into the national phase of an international application claiming the priority of an earlier Philippine national application, the IPO shall invite the applicant to elect only one (1) application for further prosecution within two (2) months from the date of the invitation, or within a longer period which the IPO may allow but not to exceed six (6) months from the date of entry into the national phase.

Rule 37. Review by IPO as a Designated Office. - (a) Where the receiving Office other than the IPO has refused to accord an international filing date to an international application designating the Philippines or has declared that the international application is considered withdrawn either generally or as to the Philippines, or where the IB has made a finding under PCT Article 12(3) that the international application is considered withdrawn because it has not received the record copy within the prescribed time limit, the applicant may request review of the matter by the IPO provided the requirements of and the time limit specified by the Treaty and PCT regulations as well as the requirements for entry into national phase in these Rules are complied with.

(b) Where the refusal, declaration or finding mentioned in paragraph (a) was the result of an error or omission on the part of the receiving Office or that the finding was the result of an error or omission on the part of the IB, the IPO as a designated Office may treat the international application as if such error or omission has not occurred. (PCT Article 25)

Rule 38. Time Limit to Submit the Priority Document. - 38.1. The priority claim of an international application designating or electing the Philippines shall not be disregarded by IPO, where the priority document is received by the IB not later than sixteen (16) months after the priority date in accordance with PCT Rule 17.1 (a) and (b).

38.2. If the priority document is not submitted to the IB within sixteen (16) months after the priority date in accordance with PCT Rule 17.1 (a) and (b), the applicant may submit to the IPO a certification from the national Office concerned stating the following data regarding the application the priority of which is claimed: name of the applicant, filing date, application number and title of the application. The certification, and its English translation if not in English, together with payment of the fee for extension of time to submit priority document and the surcharge for late payment provided for in the IPO Fee Structure, shall be submitted within six (6) months from the date of entry of the international application into the national phase without need of notice. The certification and its English translation if not in English do not require legalization. Failure of the applicant to comply with this rule shall be ground to disregard the priority claim.

38.3 Where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable, the applicant shall be required to submit the English translation of the priority document. (PCT Rule 17.1a, 17.1b, 51bis.1(e))

Rule 39. Procedure for Grant of Patent. - An international application that has entered the national phase shall be governed by the applicable provisions under Republic Act No. 8293 and its implementing rules and regulations and the applicable provisions of the Treaty, PCT Regulations, and PCT Administrative Instructions.

Rule 40. Application of the IPO Fee Structure. - The IPO Fee Structure shall apply after entry into the national phase of the international application provided that:

(a) an international application which validly claims the priority of an earlier Philippine national application shall be exempt from payment of fees that were already paid in connection with that earlier Philippine national application;

(b) the due date for payment of the first annual fee shall be computed from the date of the international publication regardless of the language of publication; and

(c) the international application shall be deemed withdrawn if the substantive examination fee is not paid within six (6) months from the date of entry into the national phase. The applicant may use a form for payment prescribed by IPO for this purpose.

PART 4

FEES DURING INTERNATIONAL PHASE

Rule 41. Fees to be Collected by the IPO. - The following fees shall be collected by the IPO:

41.1. Fees for the benefit of the IPO. The type and amount of fees for the benefit of the IPO are:

Ref. Code

Type of Fee

Amount

(Philippine Peso)

901

Transmittal Fee PCT Rule 14

3,500.00

902

Priority Document Fee PCT Rule 17.1(b)

500.00

903

Fee for Transmitting Priority Document PCT Rule 17.1(b)

1,750.00

904

Confirmation Fee

PCT Rules 4.9(c) and 15.5(a)

Fifty (50%) of the sum of designation fees under PCT Rule 15.5 in Philippine currency at the prevailing rate of exchange at the time the payment is due

905

Late Payment Fee PCT Rule 16bis.2(a)(ii)

3,500.00

906

Certified Copy of the International Application Fee PCT Rule 20.9

500.00

907

Transmittal Fee PCT Rule 19.4

3,500.00

41.2. Fees for the benefit of the IB (International Fee)

The amount of the basic fee referred to in PCT Rule 15.1(i), the designation fee referred to in PCT Rule 15.1(ii) for any designation made under PCT Rule 4.9(a), and the designation fee

referred to in PCT Rule 15.5 for any designation made under PCT Rule 4.9(b) and confirmed under PCT Rule 4.9(c), are published in the PCT Gazette and are available at the IPO.

41.3. Fee for the benefit of the ISA (Search Fee)

The amount of the search fee referred to in PCT Rule 16.1 of the competent ISA or ISAs for the Philippines is published in the PCT Gazette.

Rule 42. Due Dates and Extension of Time Limits for Payment of Fees Collected by IPO. - All fees must be paid on or before the due date prescribed in the PCT Regulations and these Rules.

42.1. The transmittal fee, basic fee and search fee shall be paid by the applicant within one (1) month from the date of receipt by the IPO of the international application; (PCT Rule 14.1(c), 15.4(a), 16.1(f))

42.2. The designation fee for any designation made under PCT Rule 4.9(a) shall be paid within a time limit of:

(a) one (1) year from the priority date, or

(b) one (1) month from the date of receipt of the international application if that one-month period expires later than one (1) year from the priority date; (PCT Rule 15.4(b))

42.3. Where the fees due under this rule have not been paid, or that the amount paid is insufficient to cover the total amount due, the IPO shall invite the applicant to pay the required fees together with the late payment fee within one (1) month without extension of time from the date of invitation; (PCT Rule 16bis.1(a))

42.4. The designation fee under PCT Rule 15.5 for any designation made under PCT Rule 4.9(b) and confirmed under PCT Rule 4.9(c), together with the confirmation fee under PCT Rule 15.5, shall be paid within fifteen (15) months from the priority date.

Rule 43. Fees for the Benefit of IPO; Form, Manner and Currency of Payment. - (a) All fees for the benefit of the IPO shall be paid in cash, money order, bank drafts and/or checks in Philippine currency. In case of cash payment, the date of receipt is the date on which the full amount due was paid in cash. In case of money order, check or bank draft payment, the date of receipt of the money order, check or bank draft will be the date of presentment provided that the same is honored upon first presentment and provided that the payment covers the full amount due.

(b) Payment shall be made to the IPO Cashier during regular working days and business hours from Monday to Friday, 8:00 a.m. to 12:00 noon and from 1:00 p.m. to 5:00 p.m.

Rule 44. Fees for the Benefit of IB and ISA; Form, Manner and Currency of Payment. - 44.1 All fees for the benefit of the IB and the ISA collected by IPO as receiving Office shall be paid to IPO in the currency or any of the currencies, if more than one, specified by the IB or the ISA as the case may be, in the form of cash or bank draft. In case of cash payment, the date of receipt is the date on which the full amount due was paid in cash. In case of bank draft payment, the date of receipt of the bank draft will be the date of presentment provided that the same is honored upon first presentment and provided further that the payment covers the full amount due. Payment shall be made to the IPO Cashier during regular working days and business hours from Monday to Friday, 8:00 a.m. to 12:00 noon and from 1:00 p.m. to 5:00 p.m.

44.2. Where the international application incurs an additional fee other than the search fee under PCT Rule 16, the applicant shall pay directly to the ISA such other fees required by the ISA in the currency, form and manner prescribed by it.

44.3. The Schedules of Fees of the IB and ISAs are published in the PCT Gazette and are available at the IPO.

Rule 45. Fees Payable to the IPEA. - The international preliminary examination fee and the handling fee under PCT Rule 58 shall be paid directly to the IPEA in the currency, form and manner prescribed by it.

Other fees due to the IPEA in accordance with the Treaty and PCT Regulations shall be paid directly to the IPEA in the currency, form and manner prescribed by it.

The Schedules of Fees of the IPEAs are published in the PCT Gazette and are available at the IPO.

Rule 46. Refunds. - 46.1 The IPO shall refund the international fee to the applicant in accordance with PCT Rule 15.6:

(a) if the IPO has found that the international filing date cannot be accorded in accordance with PCT Article 11(1);

(b) if, before the transmittal of the record copy to the IB, the international application is withdrawn or considered withdrawn; or

(c) if, due to prescriptions concerning the national security, the international application is not treated as such.

46.2. The IPO shall refund the search fee to the applicant in accordance with PCT Rule 16.2:

(a) if the IPO has found that the international filing date cannot be accorded in accordance with PCT Article 11(1);

(b) if, before the transmittal of the search copy to the ISA, the international application is withdrawn or considered withdrawn; or

(c) if, due to prescriptions concerning the national security, the international application is not treated as such.

Rule 47. Reduction in Fees. - An applicant may be entitled to a reduction in fees provided that the requirements, as specified by the IB and Authorities under the Treaty granting such reduction in fees, are fully satisfied and/or duly complied with.

PART 5

FINAL PROVISIONS

Rule 48. Separability Clause. - If any provision in these Rules or application of such provision to any circumstance is held invalid, the remainder of these Rules shall not be affected.

Rule 49. Filing of Certified Copies. - Mr. Eduardo Josen, Records Officer II, is hereby directed to immediately file three (3) certified copies of these Rules with the University of the Philippines Law Center, and, one (1) certified copy each with the Office of the President, the

Senate of the Philippines, the House of Representatives, the Supreme Court of the Philippines, and the National Library.

Rule 50. Effectivity. - Without prejudice to the performance by the IPO of its functions as a receiving Office, designated Office or elected Office under the Treaty, from and as of the entering into effect of the Treaty with respect to the Philippines on 17 August 2001, these Rules shall take effect on October 22, 2001 after publication in a newspaper of general circulation in the Philippines on October 4, 2001.

EMMA C. FRANCISCO

Director General