

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 of the Office;
- (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 authorized to examine applications. The title or official designation of such officer or employee may change as the structure of the Office may be set;
- (e) "IP Code" means Republic Act No. 8293 otherwise known as the Intellectual Property Code of the Philippines;
- (f) "IPO 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; and
- (h) "Regulations" means 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.

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 Invention.* – An invention may be, or may relate to;

- a) a useful machine;
- b) a product;
- c) or process or an improvement of any of the foregoing;
- d) microorganism; and
- e) non-biological and microbiological processes. (Sec. 21, IP CODE)

Rule 202. *Non-Patentable Inventions.* – The following shall be excluded from patent protections:

- (a) Discoveries, scientific theories and mathematical method;
- (b) Schemes, rules and methods of performing mental acts, playing games or doing business, and programs for computers;
- (c) 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;
- (d) Plant varieties or animal breeds or essentially biological process for the production of plants or animals. This provision shall not apply to microorganisms and non-biological and microbiological processes;
- (e) Aesthetic creations; and
- (f) Anything which is contrary to public order or morality. (Sec. 22, IP CODE)

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 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. Prior use which is not present in the Philippines, even if widespread in a foreign country, cannot form part of the prior art if such prior use is not disclosed in printed documents or in any tangible form.

(b) The whole contents of an application for a patent, utility model, or industrial design registration, published under Sec. 44 of IP CODE, filed or effective in the Philippines, with a filing or priority date that is earlier than the filing or priority date of the application: Provided, That the application which has validly claimed the filing date of an earlier application under Section 31 of 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 identified in both applications are not one and the same, (Sec. 24, IP CODE):

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 Sec. 44, 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 filed application.

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;

(b) A foreign patent office, the Bureau or the Office, and the information was contained (a) in another application filed by the inventor and should not have been disclosed by the office, or (b) in 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.

For the purposes of subsection (a) "inventor" also means any person who, at the filing date of application, had the right to the patent. (Sec. 25, IP CODE)

Rule 206. *Inventive Step.* - (a) An invention involves an inventive step if, having regard to 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 Skilled in the Art.* - The person skilled in the art is presumed to be an ordinary practitioner aware of what was 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 which 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 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 representative 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 a 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 or more applications for the same invention made separately and independently of each other have the same filing date, or priority-date the patent will be issued jointly to the applicants of all such applications.

Rule 305. *Right of Priority.* – An application for 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 filing in the Philippines (Sec. 31, IP CODE).

This 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 306.1. *Multiple Priorities.* - An application can claim more than one priority even from different countries. If more than one patent priority is claimed, time limits computed from the priority date will be based upon the earliest priority date.

Rule 306.2. If one or more priorities are claimed, the right of priority shall cover only those elements of the application which are included in the application or applications whose priority is claimed.

Rule 306.3. If certain elements of the invention for which priority is claimed do not appear among the claims formulated in the previous application, priority may nonetheless be granted, provided that the previous application as a whole specifically disclose such elements.

Rule 306.4. Where an application could have claimed the priority of an earlier application, but when filed, did not contain such priority, the applicant shall be given two (2) months from the filing date to submit priority claim.

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

Rule 307. *Certified Copy of the Foreign Applications.* - The certified copy of foreign applications mentioned in Rule 302 shall be the copy of the priority application(s) as duly certified to be a true or faithful reproduction thereof by the Industrial Property 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 Filipino or English and shall be filed in writing either directly to the Bureau or by post and must be addressed to the Director. The application shall contain the following:

- (a) A request for the grant of a 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.

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

The application shall be deemed forfeited for non-payment of these fees.

Rule 402. *Marking of documents; acknowledgment.* The Bureau shall mark the documents making up the application with the date of the receipt. After receipt of the full payment of the required fees, the Bureau may issue an acknowledgment stating the application number, 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 which may be reproduced at will by applicants 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 skilled in the art.

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

Rule 407. *Content of the Description.* –

(1) 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) Briefly describe the figures in the drawings, if any;

(e) When there are drawings, there shall be a brief description of the several views of the drawings and the detailed description of the invention shall refer to its different parts, as shown in the views, by use of reference letters or numerals (preferably the latter);

(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 industry.

(2) The description shall be presented in the manner and order specified in paragraph 1, unless because of the nature of the invention, a different manner or a different order would afford a better understanding and a more economic presentation.

Rule 408. *Requirements of Applications Relating to Biological Materials and Microorganisms.* –

Where the application concerns a microbiological process or the product thereof and involves 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 skilled in the art, and such material is not available to the public, the invention shall only be regarded as being 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 request of the Examiner. Publication of the application under Section 44, IP CODE shall be held pending submission of said information; and
- (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 and involves 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 is submitted; 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 in regard to matters relating to the patent application as published.

Rule 410. *Title of the Invention.* – The title of the invention should be as short and specific as possible, and should appear as a heading on the first page of the specification. All fancy names are not permissible in the title.

Rule 411. *Abstract.* - The abstract written in a separate sheet with a heading “Abstract” 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. Each main technical feature mentioned in the abstract and illustrated by a drawing in the application shall be followed by a reference sign placed between parentheses.

Rule 412. *Prohibited Matter* – (a) The application shall not contain:

- (i) a statement or other matter contrary to “public order” or morality;
- (ii) statement disparaging the products or processes of any particular person or 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;
- (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. *(a) General Requisites for the Drawing.* – The drawing must be signed by the applicant or the name of the applicant may be signed on the drawing by his attorney or agent.

The drawing must show every feature of the invention covered by the claims, and the figures should be consecutively numbered.

(b) Drawing for an Improvement. - When the invention consists of an improvement of an old machine, the drawing must exhibit, in one or more views, the invention itself, isolated from the old structure, and also, in another view, so much only the old structure as will suffice to show the relation of the invention therewith.

Rule 414.1. *Uniform Standard of Excellence Suited to Photolithographic Process, Required of Drawings.* - The printing of the drawings in the IPO Gazette is done by the photolithographic process, and therefore the character of each original drawing must be brought as nearly as possible to a uniform standard of excellence suited to the requirements of the process, to give the best results, in the interests of the inventors, of the Office, and of the public. The following rules will therefore be strictly enforced, and any departure from them will be certain to cause delay in the examination of an application.

Rule 414.2. *Paper and Ink.* - Drawings must be made upon paper that is flexible, strong, white, smooth, non-shiny and durable. Two ply or three ply Bristol board is preferred. The surface of the paper should be calendered and of a quality which will permit erasure and correction with India ink. India ink, or its equivalent in quality, is preferred for pen drawings to secure perfectly black solid lines. The use of white pigments to cover lines is not permissible.

Rule 414.3. *Size of Drawing Sheet; Imaginary Line.* - The size of a sheet on which a drawing is made must be exactly 29.7 cm x 21 cm or the size of an A4 paper. The minimum imaginary margins shall be as follows: top 2.5 cm; left side 2.5 cm; right side 1.5 cm; bottom 1 cm. Within this imaginary margin all work and signatures must be included. One of the shorter sides of the sheet is regarded as its top, and, measuring downwardly from the imaginary line, a space of not less than 3 cm is to be left blank for the heading of title, name, number, and date.

Rule 414.4. *Character and Color Lines.* - All drawings must be made with the pen or by a photolithographic process which will give them satisfactory reproduction characteristics. Every line and letter (signatures included) must be absolutely black. This direction applies to all lines,

however fine, to shading and to lines representing cut surfaces in sectional views. All lines must be clean, sharp, and solid, and they must not be too fine or crowded. Surface shading, when used, should be open. Sectional shading should be made by oblique parallel lines, which may be about 0.3 cm apart. Solid black should not be used for sectional or surface shading. Freehand work should be avoided whenever possible.

Rule 414.5. *The Fewest Possible Number of Lines and Little or No Shading to be Used.* – Drawings should be made with the fewest lines possible consistent with clearness. By the observance of this rule the effectiveness of the work after reduction will be much increased. Shading (except on sectional views) should be used sparingly, and may even be dispensed with if the drawing be otherwise well executed. The plane upon which a sectional view is taken should be indicated on the general view by a broken or dotted line, which should be designated by numerals corresponding to the number of the sectional view. Heavy lines on the shade sides of objects should be used, except where they tend to thicken the work and obscure letter of reference. The light is always supposed to come from the upper left hand corner of an angle of 45 degrees.

Rule 414.6. *Scale to which Drawing is Made to be Large Enough.* – The scale to which a drawing is made ought to be large enough to show the mechanism without crowding, and two or more sheets should be used if one does not give sufficient room to accomplish this end; but the number of sheets must never be more than what is absolutely necessary.

Rule 414.7. *Letters and Figures of Reference.* – The different views should be consecutively numbered. Letters and figures of reference must be carefully formed. They should, if possible, measure at least 32 millimeters in height, so that they may bear reduction to 10.6 millimeters; and they may be much larger when there is sufficient room. They must be so placed in the close and complex parts of drawings as not to interfere with a thorough comprehension of the same, and therefore should rarely cross or mingle with the lines. When necessarily grouped around a certain part, they should be placed at a little distance where there is available space, and connected by lines with the parts to which they refer. They should not be placed upon shaded surfaces, but when it is difficult to avoid this, blank space must be left in the shading where the letter occurs, so that it shall appear perfectly distinct and separate from the work. If

the same part of an 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 414.8. *Signature, Where to be Placed.* – The signature of the applicant should be placed at the lower right-hand corner within the imaginary margins of each sheet, but in no instance should they trespass upon the drawings.

Rule 414.9. *Title of the Drawing.* – The title should be written with pencil on the back of the sheet. The permanent name and title constituting the heading will be applied subsequently by the Bureau of Patents in uniform style.

Rule 414.10. *Position on Drawing Sheets of Large Views.* – All views on the same sheet must stand in the same direction and must, if possible, stand so that they can be read with the sheet held in an upright position. If views longer than the width of the sheet are necessary for the proper illustration of the invention, the sheet may be turned on its side. The space for heading must then be reserved at the right and the signatures placed at the left, occupying the same space and position as in the upright views and being horizontal when the sheet is held in an upright position. One figure must not be placed upon another or within the outline of another.

Rule 414.11. *Flow Sheets and Diagrams.* - Flow Sheets and diagrams are considered drawings.

Rule 414.12. *Requisites for the Figure of the IPO Gazette.* – As a rule, only one view of each invention can be shown in the IPO Gazette illustrations. The selection of that portion of a drawing best calculated to explain the nature of the invention or its specific improvement would be facilitated and the final result improved by judicious execution of a figure with express reference to the IPO Gazette, but which must at the same time serve as one of the figures referred to in the specification. For this purpose the figure may be a plan, elevation, section, or perspective view, according to the judgment of the draftsman. All its parts should be especially open and distinct, with very little or no shading, and it must illustrate only the invention claimed, to the exclusion of all other details. When well executed, it will be used without

curtailment or change, but any excessive fineness or crowding or unnecessary elaborateness of detail will necessitate its exclusion from the IPO Gazette.

Rule 414.13. *Reference Signs.* – Reference signs not mentioned in the description and claims shall not appear in the drawings and vice versa. The same features, when denoted by reference signs, shall throughout the application, be denoted by the same signs.

Rule 414.14. *Photographs.* – (a) Photographs are not normally considered to be proper drawings. Photographs are acceptable for obtaining a filing date and generally considered to be informal drawings. Photographs are only acceptable where they come within the special categories as set forth in the paragraph below. Photolithographs of photographs are never acceptable.

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

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

Rule 414.15. *Matters not Permitted to Appear on the Drawings.* – An agent's or attorney's stamp, or advertisement or written address shall not be permitted on the drawings.

Rule 414.16. *Drawings not Conforming to Foregoing Rules to be Accepted Only Conditionally.*
– A drawing not executed in conformity to the foregoing rules may be admitted for purposes of

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 competent draftsman to make their drawings.

Rule 415. *Claim.* – (a) The specification 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 and concise, and shall be supported by the description.

(c) One or more claims may be presented in dependent form, referring back and further limiting another claim or claims 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. For fee calculation purpose 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.

(d) The claim or claims must conform to the invention as set forth in the description made in the specification, 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 in the claims 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 references to the description or drawings. In particular, they shall not rely on such references as: "as described in part xxx of the description" or, "as illustrated in figure xxx of the drawings".

Rule 416. *Form and content of the claims.* – The claims shall define the matter for which protection is sought in terms of the 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 sub-paragraph (a), it is desired to protect; and

(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* – (a) Any application comprising more than five (5) claims, independent and/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 claim fees have not been paid in due time, they may still be validly 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 paid within the time limit and the grace period referred to in this Rule, the claim or claims concerned shall be deemed deleted.

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, 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 1 ½ 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.

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

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

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

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

(g) Each of the documents making up the application (request for grant, specification, claims, drawings and abstract) 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) Margins

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

Top : 2 cm. - 4 cm.

Leftside : 2.5 cm. - 4 cm.

Rightside : 2 cm. - 3 cm.

Bottom : 2 cm. - 3 cm.

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

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

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

Rule 419. *Models, when Required.* - A model may be required when 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 model has been received in compliance with the official requirement, the date of its filing shall be entered on the file wrapper. Models not required nor admitted will be returned to the applicants. When a model is required, the examination may be suspended until it shall have been filed.

Rule 419.1. *Requisites for the Model.* - The model, when required, must clearly exhibit every feature of the machine which form the subject of a claim of invention, but should not include other matter than that covered by the actual invention or improvement, unless it be necessary to the exhibition of the invention in a working model.

Rule 419.2. *Material Required for the Model; Working Models.* - The model must be neatly and substantially made of durable material, but when the material forms an essential feature of

the invention, the model should be constructed of that material.

A working model may be required if necessary to enable the office to fully and readily understand the precise operation of the machine.

Rule 419.3. *Models, when Returned to Applicant.* – In all applications which have been rejected or become abandoned, the model, unless it be deemed necessary that it be preserved in the Office, may be returned to the applicant upon demand and at his expense; and the model in any pending case may be returned to the applicant upon the filing of a formal abandonment of the application signed by the applicant in person and any assignee.

Models belonging to patented cases shall not be taken from the Office without the authorization by the Director.

Rule 419.4. *Models filed as exhibits in contested cases.* – Models filed as exhibits in contested cases may be returned to the parties at their expense. If not claimed within a reasonable time, they may be disposed of at the discretion of the Director.

Rule 420. *Employment of Attorney-at-Law or Agent Recommended.* – An applicant or an assignee of the entire interest may prosecute his own case, but he is advised, unless familiar with such matters, to employ a competent attorney-at-law or agent, as the value of patents depends largely upon the skillful preparation of the specification and claims. The Office cannot aid in the selection of an attorney-at-law or agent.

Rule 421. *Appointment of Resident Agent or Representative.* - An applicant who is not a resident of the Philippines must appoint and maintain a resident agent or representative in the Philippines upon whom notice or process for judicial or administrative procedure relating to the application for patent or the patent may be served.

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

(b) Revocation of Power of Attorney. - A power of attorney or authorization may be revoked at any stage in the proceedings of a case upon proper notification to the Director General, and, when revoked, the Office will notify the attorney or agent of such revocation and shall communicate directly with the applicant or with such other attorney or agent as he may later appoint.

Rule 422. *(a) Decorum and Courtesy Required in the Conduct of Business.* - Applicants, their attorneys or agents are required to conduct their business with the Office with politeness, decorum, and courtesy. Applicants who act or persist in acting in violation of this rule, shall be required to be represented by attorney, and papers presented containing matter in violation of this rule will be submitted to the Director 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 investigated 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 may require him to submit proof of his authority to apply for a patent.

Rule 501. - *When the applicant dies, becomes insane.* - In case the applicant dies, becomes insane or incapacitated, the legally appointed administrator, executor, guardian, conservator, or representative of the applicant, may sign the application papers and other documents, and apply for and obtain the 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 will sign the application.

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

Rule 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.

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

Rule 505. *Forms of signatures.* - Where a signature is required, the Office may accept:

(a) A hand-written signature; or

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

No attestation, notarization, legalization or other certification of any signature or other means of self-identification referred to in the preceding paragraphs, will be required, except, where the signature concerns the surrender of a 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, subject to submission of the original copy within two (2) months from the filing date.

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 the 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 should be that 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.

(2) If the formality examination reveals that the drawings were not filed, the Bureau shall

require applicant to file them within two (2) months and 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.

(3) 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, compliance with other requirements will be checked. Such other requirements may relate to the following:

- (a) contents of the request for grant of a Philippine patent;
- (b) Priority documents if with claim of convention priority (i.e., 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) Payment of all fees, (e.g. excess claims)
- (f) Signatures of the applicants;
- (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 unity 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 so 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, the link being e.g. that between a product and the process which produces it; or between a process and an apparatus for carrying out the process.

(d) Three different specific combinations of claims in different categories which are permissible in any one application are the following:

(1) in addition to an independent claim for a given product, an independent claim for a process specially adopted 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 therefor. 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 principal Examiner will, at the same time, 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. The prosecution on claims of the elected invention may be continued during such appeal. Appeal may be deferred until after final action on or allowance of the claims of the invention elected. 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 rejected 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 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 maybe

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/s 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 original applications. However, if such an application is filed before the original application is patented or withdrawn, and if it is 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 applicant 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. *Divisional Application* – (a) The applicant may file a divisional application on a pending application before the parent application is withdrawn, abandoned or patented, provided that the subject matter shall not extend beyond the content of the parent application. The divisional application shall be accorded the same filing date as the parent application, and shall have the benefit of any right to priority.

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.
- (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 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 IPO Gazette together with a search document established by or on behalf of the Office citing any 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 or withdrawn or deemed to be withdrawn before the termination of 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) After publication of a patent application, any interested party may inspect the application documents filed with the Office.

(f) 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, IP CODE)

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

Rule 802. *Observation of Third Parties.* - Following the publication of the application, any person may present observations in writing concerning the patentability of the invention. Such observations shall be communicated to the applicant who may comment on them. The Office shall acknowledge and put such observations and comment in the file of the application to which it relates. (Sec. 47, IP CODE)

Rule 803. *Request for Substantive Examination.* - The application shall be deemed withdrawn unless within six (6) months from the date of publication under these rules, a written request to determine whether a patent application meets the requirements of Patentability as provided for by the IP CODE, and the fees have been paid on time.

Rule 803.1. Withdrawal of the request for examination shall be irrevocable and shall not authorize the refund of any fee. (Sec. 48, IP CODE)

Rule 804. *Rights Conferred by an Application After Publication.* - The applicant shall have all the rights of a patentee under Sec. 76, of the IP CODE against any person who, without his authorization, exercised any of the rights conferred under Section 71 of said law 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 was the subject matter of a published application; or

(b) Received 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 805. *Citation and references.* - Should domestic patents be cited, their numbers and dates, the names of the patentees, and the classes of inventions must be stated. Should foreign patents be cited, their nationality or country, numbers and dates and the names of the 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.

PART 9

THE EXAMINATION OF THE APPLICATION;

NATURE OF PROCEEDINGS IN THE EXAMINATION OF AN APPLICATION FOR A PATENT;

GENERAL CONSIDERATIONS

Rule 900. *Applications prosecuted ex parte.* – An application is prosecuted ex parte by the applicant; that is, the proceedings are like a lawsuit in which there is a plaintiff, but no defendant, the court itself acting as the adverse party.

Rule 901. *Proceedings a contest between the Examiner and the applicant.* - An ex parte proceeding in the Bureau is a law contest between the Examiner, representing the public and trying to give the inventor the least possible monopoly in return for his disclosure, and the applicant or his attorney trying to get as much monopoly as possible.

Rule 902. *Applicant supposed to look after his interest.* - The Bureau, represented by the Examiner, is not supposed to look after the interests of an applicant. The Examiners are charged with the protection of the interest of the public, and hence must be vigilant to see that no patent issues for subject matter which is not patentable, and is already disclosed in prior inventions and accessible to the public at large.

Rule 903. *Preliminary adverse actions of the Examiner valuable to applicant.* - The positive value of preliminary adverse actions of the Examiner should be fully appreciated by the applicant and his attorney. A hard-fought application will produce a patent much more likely to stand in court than a patent which has slid through the Bureau easily. This is so for two reasons: first, the rejections have given the applicant or his attorney suggestions of strengthening amendments so that his claims have been made infinitely less vulnerable than would be otherwise possible; secondly, every point raised by the Examiner and finally decided by the Bureau in favor of the applicant will give him a prima facie standing on that point in court. The Office is empowered by law to pass upon applications for patents and, because of the authority vested in it, its decisions with respect to the granting of an application or on any point connected with it will be presumed to be correct by the courts.

Rule 904. *A preliminary rejection should not be taken literally; Examiner is only trying to be helpful.* - A rejection by the Examiner is never to be taken literally. An applicant should remember that the Examiner may not be actually rejecting his invention. The Examiner may in fact be quite prepared to admit the invention over the references to the prior art. He may be **merely rejecting the applicant's claims, that is, the way in which the applicant has expressed his invention.**

An Examiner will frequently make a blanket rejection on some reference to the prior art just to be helpful to the applicant - just to give the applicant a chance to explain away some reference and make a change in his claims to avoid it, rather than to wait until the patent is granted and is involved in a litigation, when it may be too late to make the explanation.

Rule 905. *The Examiners shall have original jurisdiction over all applications; appeal to the Director.* - The examination of all applications for the grant of invention patents shall be under the original jurisdiction of the several Examiners; their decisions, when final, shall be subject to petition, or appeal to the Director within four (4) months from the mailing date of the notice of the decision. As regards information on any specific technical or scientific matter pending final action by the Bureau, the applicant may, upon payment of a fee, request in writing for a conference with the Examiner specifying the query he would want to propound to the Examiner but in respect of which the Examiner has the discretion to grant the request or choose to reply to the query in writing.

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 amendment).

Rule 907. *Nature of examination, Examiner's action.* - (a) On taking up an application for examination, the Examiner shall make a thorough study thereof and shall make a thorough investigation 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 may be useful in aiding the applicant to judge the propriety of continuing the prosecution of his application.

Rule 908. *Completeness of Examiner's action.* - **The Examiner's action will be complete as to** all matters, except that in appropriate circumstances, such as restriction requirement, fundamental defects in the application, and the like, the action of the Examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the Examiner until a claim is found allowable.

Rule 909. *Rejection of claims.* – (a) If the invention is not considered patentable, in any manner, all the claims will be rejected by the Examiner. If the invention is considered patentable as claimed in certain of the claims, but unpatentable as claimed in other claims, the latter claims will be rejected but will not result in the refusal to grant a patent provided it is limited only to claims that have not been rejected.

(b) In rejecting 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 rejected claim specified.

(c) Claims may be rejected for non-compliance with Sec. 35.1 and Sec. 36.1, IP CODE.

Rule 910. Unpublished, withdrawn and forfeited applications not cited. – Unpublished, withdrawn and forfeited applications as such will not be cited as references.

Rule 911. *Reply by 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 or reconsideration, with or without amendment.

(b) In order to be entitled to re-examination or reconsideration, the applicant must make a request therefor in writing, and he must distinctly and specifically point out the supposed errors **in the Examiner's action; the applicant must respond to every ground of objection and rejection 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 a 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 reexamination or reconsideration.

(c) In amending an application in response to a rejection, the applicant must clearly point out the patentable inventiveness and novelty which he thinks the claims present, in view of the state of the 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 response by applicant, the application will be re-examined and reconsidered, and the applicant will be notified if claims are rejected, or objections or requirements 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 amendment, but any amendments after the second Examiner's action must ordinarily be restricted to the rejection or to the objections or requirements made,** and the application will be again considered.

Rule 913. *Final rejection or action.* – (a) On the second or any subsequent examination or consideration, **the rejection or other action may be made final, where upon applicant's response**

is limited to appeal, in the case of rejection of any claim or to amendment as specified in these Regulations. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim as provided in these Regulations. Response to a final rejection or action must include cancellation of, or appeal from the rejection of, each claim so rejected; and, if any claim stands allowable, compliance with any requirement or objection as to form.

(b) In making such final rejection, the Examiner shall repeat all grounds of rejection then considered applicable to the claims in the case, clearly stating the reasons therefor. The Examiner may not cite grounds that have not been raised in the earlier communications to the applicant.

Rule 914. *Conversion of Patent Applications or Applications for Utility Model.* - (a) 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)

(b) At any time before the grant or refusal of a utility model registration, an applicant for a utility model registration may, upon payment of the prescribed fee, convert his application into a patent application, which shall be accorded the filing date of the initial application. (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)

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) After final rejection or action, amendments may be made canceling claims or complying with any requirement of form which has been made, and amendments presenting rejected claims in better form for consideration on appeal may be admitted; but any proceedings relative thereto, shall not operate to relieve the application from its condition as subject to appeal or to save it from being considered withdrawn.

(b) Should amendments touching the merits of the application be presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.

Rule 918. *Amendment and revision required.* - The specification, claims and drawing must be amended and revised when required, to correct inaccuracies of description and definition or unnecessary prolixity, and to secure correspondence between the claims, the specification and the drawing.

Rule 919. *Amendment of 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 specification, claims or drawing, and all additions 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 rejection 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 paper in accordance with these Regulations, directing or requesting that specified amendments be made. The exact word or words to be stricken out or inserted in the application must be specified and the precise point indicated where the deletion or insertion is to be made. The basis of the proposed amendments in the original application as filed shall be indicated.

Rule 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 substitutions or insertions in red ink, small insertions being written in at the designated place and larger insertions being indicated by reference.

(b) Ordinarily all amendments presented in a paper filed while the application is open to amendment are entered and considered provided that amendments that do not comply with this rule may not be accepted. Untimely amendatory papers may be refused entry and consideration in whole or in part.

Rule 923. *Amendments to the drawing.* - (a) No change in the drawing may be made except by permission of the Bureau. Request for changes in the construction shown in any drawing may be made only upon payment of the required fee. A sketch in permanent ink showing proposed changes to become part of the record must be filed together with the search request. The paper requesting amendments to the drawing should be separate from other papers. The drawing may not be withdrawn 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. Matter cancelled by amendment can be reinstated only by a subsequent amendment presenting the cancelled matter as a new insertion.

Rule 925. *Substitute specification.* - 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 specification or claims, or any part thereof, to be rewritten. A substitute specification will ordinarily not be accepted unless it has been required by the Examiner. A substitute specification may be required within two (2) months from grant of the patent prior to publication of the patent in the IPO Gazette.

Rule 926. *Numbering of claims.* - The original numbering of the claims must be preserved through the prosecution. When claims are cancelled, the remaining claims must not be renumbered. When claims are added by amendment or substituted for cancelled claims, they must be numbered by the applicant consecutively beginning with the number next 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 will lie to the Director under these Regulations.

Rule 928. *Interviews with the Examiners: when no interview is permitted* - Interviews with the Examiner concerning an application pending before the Bureau can be held only upon written request specifying the query the applicant would want to propound and after payment of the required fee, but in respect of which the Examiner has the jurisdiction to grant interview or instead reply to the query in writing. The interview shall take place within the premises of the Bureau and during regular office hours as specified by the Examiner. All interviews or conferences with Examiners shall be reduced to writing and signed by the Examiner and the applicant immediately after the conference. Such writing shall form part of the records of the

Bureau. Interviews for the discussion of pending applications shall not be held prior to the first official action thereon.

TIME FOR RESPONSE BY APPLICANT;

WITHDRAWAL OF APPLICATION

Rule 929. *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 on or before the day on which action by the applicant is due. The Examiner may grant a maximum of two (2) extensions, provided that the aggregate period granted inclusive of the initial period allowed to file the response, shall not exceed six (6) months from mailing date of the official action requiring such response.

(c) Prosecution of an application to save it from withdrawal 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 930. *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.

Rule 931. *Express withdrawal of application.* – An application may be expressly withdrawn by filing in the Bureau a written declaration of withdrawal, signed by the applicant himself and the assignee of record, if any, and identifying the application.

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. 63, IP CODE)

Rule 1002. *Publication upon Grant of Patent.* – The grant of the patent together with other information shall be published in the IPO Gazette within six (6) months. (Sec. 52.1, IP CODE)

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)

PART 11

TERM OF PATENT

Rule 1100. *Term of patent.* – The term shall be twenty (20) years from the filing date of the application (Sec. 54, IP CODE). However, a patent shall cease to be in force and effect if any prescribed annual fees therefor 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.

Rule 1101. *Annual Fees.* – The first annual fee on a 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. (Sec. 55, IP CODE)

Rule 1102. *Date application is published.* The application is published on the date that the IPO Gazette containing the applications is released for circulation. For example, if the IPO 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 1103. *Non-payment of annual fees.* If any annual fee is not paid within the prescribed time, the application shall be deemed withdrawn or the patent considered as lapsed from the day following the expiration of the period within which the annual fees were due. A notice that the application is deemed withdrawn or the lapse of a patent for non-payment of any annual fee shall be published in the IPO Gazette and the lapse shall be recorded in the appropriate register of the Office. (Sec. 55.2, IP CODE).

Rule 1104. *Grace period.* A grace period of six (6) months from the due date shall be granted for the payment of the annual fee, upon payment of the prescribed surcharge for delayed payment. (Sec. 55.3, IP CODE)

PART 12

OTHER PROCEEDINGS AFFECTING THE APPLICATION OR THE PATENT

Chapter 1. *Recording of Assignment of Letters Patent, and of 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, giving the name of the patentee and the title of the invention as set forth in the patent; in the case of an application for patent, the application number and filing date of the application should be stated, giving also the name of the applicant, and the 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 its date of execution and name of the applicant, and the 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 other 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 a notation of the fact of recording.

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

Such instruments shall be void as against any subsequent purchaser or mortgagee for a valuable consideration and without notice unless it is recorded in the Office within three 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 IPO 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 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 the 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, it may accept the offer and, as from the day when notice of his acceptance is published in the IPO 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 mistake in the application.* – On request of any interested person and payment of the prescribed fee, the Director is authorized to correct any mistake in the patent of a formal and clerical nature, not incurred through the fault of the Office. (Sec 58, IP CODE)

Rule 1209. *Changes in patent.* – (a) 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 letter (b), made in good faith; Provided, That were 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 amendment 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 IPO 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)

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 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 joint owner 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 or interest or part thereof without the consent of the other owner or owners, or without proportionately dividing the proceeds with the other owner or owners. (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 denied under the facts disclosed in the application and in the 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 petition 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 abandoned for failure of the applicant to respond to an action of the Examiner on the merits, the order declaring the application as withdrawn which has become final 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 a notice of appeal, as the case may be, and 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, within two (2) months, without extension, 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 1306. *The Examiner's answer.* – The Examiner shall furnish a written statement in answer to the petition or appellant's brief, as the case may be, within two (2) months from the order of 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 copy of such answer is received by him.

Rule 1308. *Appeal to the Director General.* The decision or order of the Director shall become final and executory fifteen (15) days after receipt of a copy thereof by the appellant unless within the said period, a motion for reconsideration is filed with the Director or an appeal to the Director General has been perfected by filing a notice of appeal and payment of the required fee.

Only one motion for reconsideration of the decision or order of the Director shall be allowed.

Rule 1310. *Director's comment.* The Director shall submit within one (1) month 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 shall be final and executory unless an appeal to the Court of Appeals is perfected in accordance with the Rules of Court applicable to appeals from decisions of Regional Trial Courts. No motion for reconsideration of the decision or order of the Director General shall be allowed.

FINAL PROVISIONS

Section 1. *Correspondence.* The following regulations shall apply to correspondence between patentee/applicants and the Office or the Bureau:

(a) Business to be transacted in writing. All business 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.

(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, the title of the invention, the application number and the filing date of the application.

(f) Letters relating to granted patents. When the letter concerns a granted patent, it shall state the name of the patentee, the title of the invention, the patent number and date of issuance.

(g) Subjects on which information cannot be given. The Office cannot respond to inquiries as to the newness or inventive step of an alleged invention desired to be patented in advance of the filing of an application for a patent.

On the propriety of making an application for the grant of patent, 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, until the organization of the Bureau is completed, the functions necessary to implement these Regulations shall be performed by the personnel of the former Bureau of Patents, Trademarks and Technology Transfer as may be designated by the Director General upon the recommendation of the Chiefs of the Chemical Examining Division and the Mechanical and Electrical Examining Division of the Bureau of Patents, Trademarks and Technology Transfer, or the Director of Patents if one has been appointed and qualified or the Caretaker or the Officer-in-Charge as the Director General may designate.

Section 4. *Repeals.* All rules and regulations, memoranda, circulars, and memorandum circulars and parts thereof inconsistent with these Regulations particularly the Rules of Practice in Patent Cases, as amended, are hereby repealed; Provided that all applications for patents pending in the Bureau of Patents, Trademarks and Technology Transfer shall be proceeded with and patents thereon granted in accordance with the Acts under which said applications were filed, and said Acts are hereby continued to be enforced, to this extent and for this purpose only.

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. *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 7. *Effectivity.* These rules and regulations shall take effect fifteen (15) days after publication in a newspaper of general circulation.

Done this 29th day of December 1998.

APPROVED:

EMMA C. FRANCISCO
Director General