

Rules and Regulations on Utility Models and Industrial Designs

(as amended by Order No. 61 series 2001 and Office Order No. 09 series of 2000)

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

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

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

PART 1

RULE 10. These regulations shall be known as the "Utility Model and Design Regulations". *[As amended by Office Order No. 09 (2000)]*

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

Utility Models

RULE 200. *Registrable Utility Models.* — Any technical solution of a problem in any field of human activity which is new and industrially applicable shall be registrable.

RULE 200.1 *Non-Registrable Utility Models*. — The following shall be excluded from protection as utility models:

- (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.

RULE 200.2 *Industrial Applicability*. — A utility model which can be produced and used in any industry shall be industrially applicable.

RULE 201. *Statutory Classes of Utility Models*. — A utility model may be, or may relate to

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

[As amended by Office Order No. 09 (2000)]

RULE 202. *First to File Rule*. — If two or more persons have made the same utility model separately and independently of each other, the right to the utility model registration shall belong to the person who filed an application for such utility model, or where two or more applications are filed for the same utility model to the applicant who has the earliest filing date or the earliest priority date.

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

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

Without need of any notice from the office, the filing fee shall be paid within one (1) month from the date of application was received by the office, otherwise, the application shall be deemed forfeited. [As amended by Office Order No. 09 (2000)]

RULE 204. *Right of Priority for Utility Model.* — An application for utility model filed by any person who has previously applied for the same utility model 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 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.

RULE 205. *Registration of Utility Model.* — A utility model application shall be registered without substantive examination provided all fees such as filing, excess claims and publication fees are paid on time and all formal requirements set forth in these Regulations are filed without prejudice to a determination as regards its novelty, industrial applicability and whether or not it is one of the non-registrable utility models. [As amended by Office Order No. 61 (2001)]

RULE 206. *Formality Examination of Utility Model Application.* — The utility model application shall be classified and examined as to the completeness of the formal requirements prescribed in these Regulations, and a report thereon shall be transmitted to the applicant. The formality examination shall take into account the parts of these Regulations on: (a) the right to a utility model registration, (b) who may apply for a utility model registration, (c) filing date requirements and (d) other formality requirements. [As amended by Office Order No. 09(2000)]

RULE 207. *Applicant's Action on the Formality Examination Report.* — Within two (2) months from the mailing date of the formality examination report, the applicant may: (1) voluntarily withdraw the application, (2) amend the application, (3) convert the application to an application for an invention patent, or (4) upon payment of the required fee, request for a registrability report. [As amended by Office Order No. 09 (2000)]

RULE 207.1. *Voluntary Withdrawal.* — The application shall be deemed withdrawn and all files expunged from the record of the Bureau upon receipt of the applicant's voluntary withdrawal.

RULE 207.2. *Amended Applications.* — The amended application shall be classified and subjected to formality examination. Report thereon shall be submitted to the applicant within two (2) months from receipt of the amended application. Within two (2) months from mailing date of the formality examination report on the amended application, the applicant may: (1) withdraw the application, (2) convert the same to an application for an invention patent, or (3) upon payment of the required fee, request for a registrability report. [As amended by Office Order No. 09 (2000)]

RULE 207.3. *Application Converted to an Application for Inventions Patent.* — The application or amended application which is converted into an application for an invention patent shall be processed as an invention patent application upon receipt of notice from the applicant.

RULE 207.4. *No Action on the Part of Applicant Where Formal Requirements are Complete.* — Where the application meets all the formal requirements for registrability and the Bureau fails to receive any action from the applicant, the utility model shall be published upon the expiration of two (2) months from the mailing date of the formality examination report, provided the issuance, publication and all required fees have been fully paid. [As amended by Office Order No. 16 (2001)]

RULE 207.5. *No Action on the Part of Applicant Where Formal Requirements are not Complete.* — Where the application fails to meet any of the formal requirements for registration and the Bureau fails to receive any action from the applicant, the application shall be deemed withdrawn and all files thereon shall be expunged from the records of the Bureau upon the expiration of two (2) months from the mailing date of the formality examination report. The Bureau may return to the applicant all the files expunged from its records.

RULE 207.6. *Registrability Report.* — The report shall contain citations of relevant prior art documents with appropriate indications as to their degree of relevance which will serve as an aid to the applicant or to third parties

including judicial and quasi-judicial bodies, in the determination of the validity of the utility model claim(s) in respect to newness. *[As amended by Office Order No. 16 (2001)]*

The registrability report shall be given within two (2) months from receipt of the request and upon payment of fees. If the applicant has requested for a registrability report prior to the publication of the utility model application, the registrability report shall be included in the publication of utility model application. *[As amended by Office Order No. 16 (2001)]*

RULE 207.7 *Non-Payment of Issuance and Publication Fees.* — Where the application meets all the formal requirements for registrability and the applicant fails to pay the issuance and publication fees within the prescribed period, the utility model application shall be deemed withdrawn. *[As amended by Office Order No. 09 (2000)]*

RULE 207.8 *Final Action.* — Where the applicant fails to file a complete response to the formality examination report, any subsequent formality examination report submitted to the applicant shall be a final action which may be appealed to the Director of Patents in a manner provided for in these Regulations. *[As amended by Office Order No. 09 (2000)]*

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

The application shall contain the following:

- a) A duly accomplished request for registration as prescribed by the Bureau,
- b) Description containing the following:
 - 1. title
 - 2. technical field
 - 3. background of the Utility Model
 - 4. brief description of the several views of the drawings, if any
 - 5. detailed description
- c) Claim or claims
- d) Drawings, if any
- e) Abstract of the Disclosure

[As amended by Office Order No. 9, (2000),]

RULE 208.1. *Title.* — The title should be as short and specific as possible, and should appear as heading on the first page of the specification. Fancy names are not permissible in the title. *[As amended by Office Order No. 09 (2000).]*

RULE 208.2. *Technical Field.* — A statement of the technical field of the art to which the utility pertains. The statement should be directed to the subject matter of the claimed utility model.

RULE 208.3. *Background of the Utility Model.* — It is a description which indicates the so-called "background art" constituting the related prior art or state of the art or known technology for the utility model sought to be registered, including references to specific documents where appropriate. Where applicable, the problems involved in the information which may be solved by the applicant's utility model should be indicated.

RULE 208.4. *Brief Description of the Several Views of the Drawings, if there be any.* — Every view of the drawings should be briefly described, and indicated with corresponding figure numbers.

RULE 208.5. *Detailed Description.* — The detailed description must specifically include a complete description of the manner or making and using the utility model. It must set forth the precise or exact utility model for which registration is sought, in such manner as to distinguish the utility model from the prior art it pertains to and the technical problem solved by the utility model should be indicated.

RULE 208.6. *Claim or Claims.*

a) The claim(s) must define the subject matter of the utility model for which registration is sought. Such claim(s) should be clear and concise and fully supported by the description.

b) If the utility model application relates to an improvement, the claim(s) should specifically point out and distinctly claim the improvement in combination with a preamble statement indicating the prior art features which are necessary for the definition of the claimed subject matter.

RULE 209. *Unity of Utility Model.* — Only one independent genus or generic claim is permissible in a utility model application. However, specific variations of the utility model may be claimed in a reasonable number of dependent claims in a single application, provided such variations fall under a single statutory class provided in these Regulations and are embodied under a single general innovative concept. Such specific variations of the claimed utility model must fall within the scope of the generic claim.

RULE 209.1. *Claims Incurring Fee.* (a) Any utility model 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 210. *Requirement for Restriction; Division.* — A restriction or division of multiple embodiments in a utility model application may be deemed proper if such embodiments are independent and distinct, or can not be considered as specific variations specified in these Regulations. A divisional application covering the restricted embodiment(s), if filed during the pendency of the utility model application, shall be entitled to the benefit of the filing date of such parent application.

RULE 211. *Publication of the Utility Model Application.* An application which meets the formal requirements shall be published in the form of bibliographic data and representative drawing, if any, in the IPO Gazette. If an applicant has previously requested for a registrability report, the publication shall include the registrability report. [As amended by Office Order No. 61 (2001).]

RULE 211.1 *Adverse Information.* Effects. Within two (2) months from publication of the utility model application, any interested party may request the Director for a registrability report and/or furnish the Director information, evidence or data in writing and under oath, showing that the utility model is not new. The Director may require such third party to submit relevant and collateral facts or data to substantiate the information. [As amended by Office Order No. 61 (2001).]

Within two (2) months from receipt of the request and/or adverse information, the Director shall decide whether or not to register the utility model and shall issue the registrability report, if one has been requested. The Director may also issue a registrability report *motu proprio* within the same two (2)-month period. [As amended by Office Order No. 61 (2001),]

In case the Director refuses or denies the registration of the utility model, the applicant may appeal such decision to the Director General pursuant to Section 7.1 (b) of the IP Code and in accordance with Part 7 of these Regulations. [As amended by Office Order No. 61 (2001),]

In case the Director allows the registration of the utility model, any interested party may file a petition for cancellation with the Bureau of Legal Affairs in accordance with Section 109.4 of the IP Code and in accordance with the Regulations on, Inter Partes Proceedings. [As amended by Office Order No. 61 (2001),]

If the Director receives no adverse information within the 2-month period, he shall certify to that effect and direct the preparation and issuance of the certificate of registration with effect as of the date of publication of the utility model application. [As amended by Office Order No. 61 (2001),]

RULE 212. *Term of Registration of Utility Model.* — A utility model registration shall expire, without any possibility of renewal, at the end of seventh year after the date of the filing of the application.

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

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

[As amended by Office Order No. 09 (2000)]

RULE 213. *Cancellation of the Utility Model Registration.* — The utility Model registration shall be cancelled on the following grounds:

- (a) That the utility model does not qualify for registration as a utility model and does not meet the requirements of novelty and industrial applicability or it is among non-registrable utility models;
- (b) That the description and the claims do not comply with the prescribed requirements;
- (c) That any drawing which is necessary for the understanding of the utility model has not been furnished;
- (d) That the owner of the utility model registration is not the maker or his successor in title.

RULE 214. *Conversion of Invention Patent Application to an Application for Utility Model Registration.* — At any time before the grant or refusal of a patent for an invention, an applicant for a patent for an invention 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 application. An application may be converted only once.

RULE 215. *Conversion of an Application for Utility Model Registration to a Patent Application.* — 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 utility model application.

RULE 216. *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 for an invention whether simultaneously or consecutively.

PART 3

Industrial Designs

RULE 300. *Definition of Industrial Design.* — An industrial design is any composition of lines or colors or any three-dimensional form, whether or not associated with lines or colors: Provided that, such composition or form should give a special appearance to and can serve as pattern for an industrial product or handicraft that are new or original.

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

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

Industrial designs that are dictated essentially by technical or functional considerations to obtain a technical result or those that are contrary to public order, health or morals, are not registrable.” [As amended by Office Order No. 09 (2000)]

RULE 301.1. *Requisites for Registrability Explained.* — The object of the statute is to encourage the decorative arts and a design, which merely pleases the eye, is a proper subject matter for a design registration. That is to say, a registrable design must not only be new or original, but ornamental as well. Ornamentation implies beauty, the giving of a pleasing appearance to an object or article. Registrable design must therefore show a variance which enhances the aesthetic beauty and attractive appearance of the article and which significantly differs from known design features or combination of known design features.

RULE 302. *Degree of Novelty Required.* — The standard of novelty established by Sections 23 (Novelty) and 25 (Non-prejudicial disclosure) of the IP Code applies to industrial designs: provided that the period of twelve (12) months specified in Section 25 shall be six (6) months in the case of designs.

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

RULE 303. *Filing Date of Industrial Design Application.* — The Bureau shall accord as the filing date of an application for industrial design registration the date on which the Bureau received the following elements:

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

If these requirements are not received by the Bureau upon the filing of the application, it shall nevertheless accept the application and accord as the filing date the date on which all the formal requirements for registration are filed or the mistakes are corrected in accordance with these Regulations.

RULE 304. *First to File Rule.* — If two or more persons have made the same design separately and independently of each other, the right to the design registration shall belong to the person who filed an application for such design, or where two or more applications are filed for the same design to the applicant who has the earliest filing date or the earliest priority date.

RULE 305. *Right of Priority for Design.* — An application for design filed by any person who has previously applied for the same design 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 the foreign application: Provided, That: (a) the local application expressly claims priority; (b) it is filed within six [6] months from the earliest filing date of the corresponding foreign application; 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.

RULE 306. *Registration of Industrial Design.* If the application meets the requirements of the IP Code and these Regulations, including the requirement of novelty or originality, the Bureau shall effect the registration of the industrial design, Provided, that all fees are paid on time. [As amended by Office Order No. 61 (2001),]

RULE 307. *Formality Examination of Industrial Design Application.* — The industrial application shall be classified and examined as to the completeness of the formal requirements prescribed in these Regulations and a report thereon shall be transmitted to the applicant. The formality examination shall take into account the parts of these Regulations on: (a) the right to an industrial design registration, (b) who may apply for an design registration, (c) filing date requirements and (d) other formality requirements. [As amended Office Order No. 09 (2000)]

RULE 308. *Applicant's Action on the Formality Examination Report and the Search Report.* — Within two (2) months from the mailing date of the formality examination report, the applicant may: (1) voluntarily withdraw the application, (2) amend the application, or, (3) upon payment of the required fee, request for a registrability report. [As amended Office Order No. 09 (2000)]

RULE 308.1. *Voluntary Withdrawal.* — The application shall be deemed withdrawn and all files expunged from the records of the Bureau upon receipt of the applicant's voluntary withdrawal.

RULE 308.2. *Amended Applications.* — The amended application shall be classified and subjected to formality examination. Report thereon shall be submitted to the applicant within two (2) months from receipt of the amended application. Within two (2) months from mailing date of the formality examination report on the amended application, the applicant may: (1) withdraw the application, or, (2) upon payment of the required fee, request for a registrability report. [As amended Office Order No. 09 (2000)]

RULE 308.3. *No Action On The Part Of The Applicant Where Formal Requirements Are Complete.* Where the application meets all the formal requirements for registrability and the Bureau fails to receive any action from the applicant, the industrial design application shall be published upon the expiration of two (2) months from the mailing date of the formality report, provided the issuance, publication and all the required fees have been fully paid. [As amended Office Order No. 61 (2001)]

RULE 308.4. *No Action on the Part of Applicant where Formal Requirements are not Complete.* — Where the application fails to meet any of the formal requirements for registration and the Bureau fails to receive any action from the applicant, the application shall be deemed withdrawn and all files thereon shall be expunged from the records of the Bureau upon the expiration of two (2) months from the mailing date of the formality examination report. The Bureau may return to the applicant all the files expunged from its records.

RULE 308.5. *Registrability Report.* The report shall contain citations

of relevant prior art documents with appropriate indications as to their degree of relevance. It will serve as an aid to the applicant or to third parties including judicial and quasi-judicial bodies, in the determination of the validity of the industrial design claim(s) in respect to newness. *[As amended Office Order No. 61 (2001)]*

The registrability report shall be given within two (2) months from receipt of the request and upon payment of fees. If the applicant has requested for a registrability report prior to the publication of the industrial design application, the registrability report shall be included in the publication of the industrial design application. *[As amended Office Order No. 61 (2001)]*

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

RULE 308.7. *Final Action.* — Where the applicant fails to file a complete response to the formality examination report, any subsequent formality examination report submitted to the applicant shall be a final action which may be appealed to the Director in a manner provided for in these regulations. *[As amended Office Order No. 09(2000)]*

RULE 309. *The Application.* — An application for industrial design registration and other correspondences shall be in Filipino or English and must be addressed to the Director of the Bureau.

The application shall contain the following:

(a) A completely filled-out request for registration as prescribed by the Bureau containing the name and address of the applicant or where the applicant is not the designer, a statement indicating the origin of the right to the industrial design; and, an indication of the kind of article of manufacture to which the design shall be applied;

(b) Specification containing the following:

1. title;
2. brief description of the different views of the drawings.
3. characteristic-feature description of the design;
4. claim.

(c) Drawings of the different views of the design showing the complete appearance thereof including the signature of the applicant or representative. The Bureau may also accept photographs or other adequate graphic representation of the design provided the same comply with the requirements of these Regulations regarding drawings of industrial designs.

RULE 310. *Fees.* — An application for an industrial design registration shall be subject to the payment of the filing fee. The application shall be deemed forfeited if the filing fee is not paid within one (1) month from the date that the application was received by the Office. *[As amended Office Order No. 09(2000)]*

RULE 311. *Specimen.* — The Bureau of Patents may require that the application be accompanied by a "specimen" of the article embodying the industrial design which requirement shall be subject to the payment of the prescribed fee within one (1) month from submission of such specimen.

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

RULE 312. *Special Form of Specification for Application for Registration of Industrial Design.* — The application for registration of industrial design shall include a specification containing the following matters, arranged in the order hereunder shown:

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

RULE 312.1. *Title.* — The title of the design must technically designate the particular article embodying the design.

RULE 312.2. *Brief Description of the Several Views of the Drawings.* — Every view of the drawing should be briefly described, i.e. perspective, front, side, top, bottom and/or back, and indicated with corresponding figure numbers.

RULE 312.3. *Characteristic-Feature Description.* — A characteristic — feature statement describing the particular novel and ornamental features of the claimed design which are considered to be dominant.

RULE 312.4. *Claim.* — The claim shall be in formal terms to the ornamental design for the article (specifying name) substantially as shown and described. More than one claim is neither required nor permitted.

RULE 312.5. *Special Requirements for the Drawing of an Industrial Design.* — In addition to the drawings being made in conformity with the common rules laid down for drawings for utility models and industrial designs, the drawings for an industrial design must comprise sufficient number of views to constitute a complete disclosure of the appearance of the article. Appropriate surface shadings must be used to show the character or contour of the surfaces represented.

In case of a color claim, a cross-sectional view of the design may be required in lieu of surface shading, and the color coding based on the color chart as prescribed by the Bureau should be applied.

RULE 312.6. *Requirements for Graphic Representation of Industrial Designs.* — Graphic representation of industrial design such as computer aided drawing (CAD) in lieu of the India Ink Drawing could be accepted provided that such should be made in conformity with these Regulations particularly with request to the special requirements for drawing of an industrial design.

RULE 313. *Several Industrial Design in One Application.* — More than one embodiment of an industrial design in one application may be permissible in a proper case. A number of articles presented should not be patentably distinct from each other, and they should be of substantially similar dominant design features that are embodied in a single design concept. They must relate to the same subclass of the International Classification or to the same set or composition of articles. A "set of articles" which is customarily sold or used together as a set may be made a proper subject matter in one application for design registration provided that each article is of, or has, the same design or a substantially similar design.

RULE 313.1. *Restriction; Division.* — A restriction or division of multiple design embodiments may be deemed proper if two or more independent or distinct designs are presented in one design application for registration.

RULE 314. *Publication of the Industrial Design Application.* An application which meets the formal requirements shall be published in the form of bibliographic data and representative drawing, if any, in the IPO Gazette. If an applicant has previously requested for a registrability report, the publication shall include the registrability report. [As amended Office Order No. 61(2001)]

RULE 314.1 *Adverse Information*. Effects. Within two (2) months from publication of the industrial design application, any interested party may request the Director for a registrability report and/or furnish the Director information, evidence or data in writing and under oath, showing that the industrial design is not new. The Director may require such third party to submit relevant and collateral facts or data to substantiate the furnished information. *[As amended Office Order No. 61(2001)]*

Within two (2) months from receipt of the request and/or adverse information, the Director shall decide whether or not to register the industrial design and shall issue the registrability report, if one has been requested. The Director may also issue a registrability report *motu proprio* within the same two (2)-month period. *[As amended Office Order No. 61(2001)]*

In case the Director refuses or denies the registration of the industrial design, the applicant may appeal such decision to the Director General pursuant to Section 7.1 (b) of the IP -Code and in accordance with Part 7 of these Regulations. *[As amended Office Order No. 61(2001)]*

In case the Director allows the registration, any interested party may file a petition for cancellation with the Bureau of Legal Affairs in accordance with Section 120 of the IP Code and in accordance with the Regulations on Inter Partes Proceedings. *[As amended Office Order No. 61(2001)]*

If the Director receives no adverse information within the 2-month period, he shall certify to that effect and direct the preparation and issuance of the certificate of registration with effect as of the date of publication of the industrial design application. *[As amended Office Order No. 61(2001)]*

RULE 315. *Term of Industrial Design Registration*. — The terms shall be five (5) years from the filing date of the application and may be renewed for not more than two (2) consecutive periods of five (5) years each, by paying the renewal fee (Secs. 118.1 and 118.2, R.A. 8293).

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

- (a) The first term of the industrial registrations filed prior to the effectivity of, and processed under, the IP Code shall end five (5) years from the effectivity of these Regulations.
- (b) The first term of the industrial registrations filed under the IP Code and pending upon the effectivity of these Regulations shall end five (5) years from the effectivity of these Regulations.

RULE 316. *The Renewal Fee*. — The renewal fee shall be paid within twelve (12) months preceding the expiration of the period of registration. A grace period of six (6) months shall be granted for payment of the fees after such expiration, upon payment of a surcharge.

RULE 317. *Cancellation of Design Registration*. — At any time during the term industrial design registration, any person upon payment of the required fee, may petition the Director of Legal Affairs of the Office to cancel the industrial design on any of the following grounds:

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

[As amended Office Order No. 09(2000)]

RULE 317.1. Where the grounds for cancellation relate to a part of the industrial design, cancellation may be effected to such extent only. The restriction may be effected in the form of an alteration of the effected features of the design.

PART 4

Common Provisions

CHAPTER 1

Registrability

RULE 400. *Novelty*. — An industrial design or utility model shall not be considered new if it forms part of a prior art.

RULE 401. *Prior Art*. — Prior art shall consist of:

- (a) Everything made available to the public anywhere in the world before the filing date or the priority date of the application provided that the disclosure is contained in printed documents or in any tangible form.
- (b) The whole contents of an application for a patent for invention, utility model or industrial design published under Sec. 44 of the 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 industrial design or utility model application: Provided, That the application which has validly claimed priority shall be prior art with effect as of the said priority date, Provided Further, That the applicant identified in both applications are not one and the same.

Where two or more applications are independently filed with respect to the same industrial design or utility model, and the later applications are filed before the publication of the first application or earliest application, the whole contents of such first or earliest application shall be novel with respect to the later application or applications.

RULE 402. *Non-Prejudicial Disclosure*. — The disclosure of information contained in the industrial design application during the six (6) months preceding the filing date or the priority date of the application or during the twelve (12) months preceding the filing date or priority date in the case of utility model application shall not prejudice the applicant on the ground of lack of novelty if such disclosure was made by:

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

For the purposes of this Rule "designer" also means any person who, at the filing date of application, had the right to the industrial design. *[As amended Office Order No. 09(2000)]*

CHAPTER 2

Right to a Registration

RULE 403. *Right to a Registration.* — The right to a registration belongs to the maker or designer, his heirs, or assigns. When two (2) or more persons have jointly made a utility model or industrial design, the right shall belong to them jointly.

RULE 404. *Who may be Named in an Application as an Applicant.* — The application may be filed by the actual maker(s) or designer(s) or in the name of his heirs, legal representative or assigns.

RULE 405. *Utility Models and Industrial Designs Created Pursuant to a Commission.* — The person who commissions the work shall own the registration, unless otherwise provided in the contract.

In case the employee made the invention in the course of his employment contract, the registration shall belong to:

(a) The employee, if the 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 utility model or industrial design is the result of the performance of his regularly-assigned duties, unless there is an agreement, express or implied, to the contrary.

RULE 406. *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 406.1. 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 406.2. If certain elements of the utility model or industrial design 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 406.3. 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 the 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 407. *Certified Copy of the Foreign Applications.* — The certified copy of foreign applications on which the priority claim is based shall be the copy of the application(s) as duly certified to be a true and faithful reproduction thereof by the Industrial Property Office which received it or any other office which has official custody of the foreign application(s).

CHAPTER 3

The Application

RULE 408 (a). All papers for an application for a utility model and industrial design registration which are to become part of the permanent records of the Office must be the original copy only, and legibly written, typewritten, or printed in permanent ink only on one side of the sheet. If necessary, only graphic symbols and characters and chemical or

mathematical formulas may be written by hand or drawn. The typing shall be 1½ spaced. All text matter shall be in characters, the capital letters of which are not less than 0.21 cm. high, and shall be in dark, indelible color. [As amended Office Order No. 09(2000)]

(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 claim(s) of the application must be written with the lines numbered in sets of five and the number appearing on the left side margin.

(d) The description and the claims may contain chemical or mathematical formulas. The description 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 registration, description, claims, drawings and abstract of the disclosure) shall commence on a separate sheet. The separate sheets shall be filed in such a way that they can easily be turned over, and joined together again. [As amended Office Order No. 09(2000)]

(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 408 (j). Paragraphs (d), (e) and (f) of this Rule shall only be applicable to utility model applications. [As amended Office Order No. 09(2000)]

RULE 409. *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 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; [As amended Office Order No. 09(2000)]
- (iii) any statement or other matter obviously irrelevant or unnecessary under the circumstances.

(b) If an application contains prohibited matter within the meaning of this Rule, the Bureau shall omit it when publishing the registration, indicating the place and number of words or drawing omitted.

RULE 410. *Information Concerning Corresponding Foreign Application*. — The applicant shall, at the request of the Director, furnish him with the date and number of any application filed by him abroad, hereafter referred to as the "foreign application", relating to the same or essentially the same utility model or industrial design as that claimed in the application filed with the Office and other documents relating to the foreign application.

RULE 411. 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 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 registration.

RULE 412. *Non-Compliance*. — The application is considered withdrawn if the applicant fails to comply with the requirement to furnish information concerning the corresponding foreign application within the specified period.

CHAPTER 4

Drawings

RULE 413. *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 utility model or industrial design covered by the claim(s), and the figures should be consecutively numbered.

RULE 414. *Drawing for an Improvement*. — When the utility model consists of an improvement of an old machine, the drawing must exhibit, in one or more views, the utility model 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 utility model therewith.

RULE 415. *Uniform Standard of Excellence Suited to Photolithographic Process, Required of Drawings.* — Unless and until otherwise notified, 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, makers and designers, 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 registration of an application.

RULE 416. *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 417. *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 418. *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 419. *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 420. *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 421. *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 utility model or industrial design 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 422. *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 423. *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 424. *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 utility model or industrial design, 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 425. *Flow Sheets and Diagrams.* — Flow Sheets and diagrams are considered drawings.

RULE 426. *Requisites for the Figure of the IPO Gazette.* — As a rule, only one view of each utility model or industrial design can be shown in the IPO Gazette illustrations. The selection of that portion of a drawing best calculated to explain the nature of the utility model or industrial design 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 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 utility model or industrial design 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 427. *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 428. *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 utility model or industrial design 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 429. *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 430. *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 according a filing date only. In such cases, the drawing must be corrected or a new one furnished within two (2) months from mailing date of the formality report. Otherwise, the application shall be deemed withdrawn.

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

CHAPTER 5

Representation, Signatures

RULE 431. *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 432. *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 or the registration may be served.

If there are two (2) or more agents appointed by the applicant, the Office shall forward all correspondence to the latest 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.

RULE 433. *Revocation of Power of Attorney.* — A power of attorney or authorization may be revoked upon proper notification to the Director General, and, when revoked, the Office will notify the attorney or agent of such revocation and shall communicate with the latest attorney or agent appointed. [As amended Office Order No. 09(2000)]

RULE 434. *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 General and returned to the sender, by his direct order.

CHAPTER 6

Who may Request for a Registration

RULE 435. *Who may Request for a Registration.* — Any person, natural or juridical, may request for a registration. If the applicant is not the maker/designer, the Office may require him to submit proof of his authority to apply for a registration.

RULE 436. *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 certification of registration in the name of the applicant, his heirs or assignee.

RULE 437. *Assigned Applications.* — In case the whole interest in the utility model or industrial design 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 438. *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 439. *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 Office 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 Office shall require proof of such authority.

RULE 440. *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 Certificate of Registration.

CHAPTER 7

Classification and Search

RULE 441. *Classification and Search*. — An application for utility model or an industrial design shall be classified and a search conducted to determine the prior art. *[As amended Office Order No. 09(2000)]*

RULE 442. *Content of the Search Report*. — The 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.
- (b) The search report shall contain the classification of the subject matter of the application in accordance with the International Classification.
- (c) The search report may include documents cited in a search established in the corresponding foreign application.

Upon payment of the required fees, the Office shall provide a copy of the Search Report with respect to any published utility model and industrial design within a maximum period of two (2) months from receipt of the request. *[As amended Office Order No. 09(2000)]*

RULE 443. *Confidentiality Before Publication*. — A registration, which has not yet been published, and all related documents shall not be made available for inspection without the consent of the registrant.

RULE 444. *Unpublished, Withdrawn and Forfeited Applications not Cited*. — Unpublished, withdrawn and forfeited applications as such will not be cited as references.

CHAPTER 8

Amendments; Withdrawal by the Applicant

RULE 445. *Amendment by the Applicant.* — An applicant may amend the application prior to registration: Provided, That such amendment shall not include new matter outside the scope of the disclosure contained in the application as filed.

RULE 446. *Amendment and Revision Required.* — The description, claim(s) and drawing(s) must be amended and revised when required, to correct inaccuracies of disclosure and definition or unnecessary prolixity, and to secure correspondence between the claim(s), the description and the drawing(s).

RULE 447. *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 448. *Entry and Consideration of Amendments.* — (a) Amendments are entered by the Office 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.

RULE 449. *Amendments to the Drawing.* — The paper requesting amendments to the drawing should be separate from other papers. The drawing may not be withdrawn from the Office except for signature. Substitute drawings will not ordinarily be admitted in any case unless required by the Office.

RULE 450. *Substitute Specification.* — If the number or nature of the amendments shall render it difficult to arrange the papers for printing or copying, the Examiner may require the entire description or claim(s), or any part thereof, to be rewritten. A substitute specifications will ordinarily not be accepted unless it has been required by the Examiner. A substitute specifications may be required within two (2) months from registration prior to publication of the registration in the IPO Gazette.

RULE 451. *Express Withdrawal of Application.* — An application may be expressly withdrawn by filing in the Office a written declaration of withdrawal, signed by the applicant himself and the assignee of record, if any, and identifying the application.

CHAPTER 9

Time for Response by Applicant; Withdrawal of Application

for Failure to Respond Within Time Limit

RULE 452. *Withdrawal of Application for Failure to Respond to the Formality Examination Report and the Notice of Issuance and Publication Fees Within the Prescribed Time Limit.* —

(a) If an applicant fails to prosecute his application within the required time as provided in these Regulations, the application shall be deemed withdrawn.

(b) The time for reply may be extended only for good and sufficient cause, and for 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 being deemed withdrawn must include such complete and proper action as the condition of the case may require. Any amendment not responsive to the last official action shall not operate to save the application from being deemed withdrawn.

(d) When the action by the applicant is a bona fide attempt to advance the case to final action, and is substantially a complete response to the Examiner's action, but consideration of some matter or compliance with some requirements has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of withdrawal is considered.

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

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

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

An application not revived in accordance with this rule shall be deemed forfeited. [*As amended Office Order No. 09(2000)*]

PART 5

The Certificate of Registration

RULE 500. *Contents of Certificate of Registration.* — The Certificate of Registration shall be issued in the name of the Republic of the Philippines under the seal of the Office and shall be signed by the Director, and registered together with the description, claims, and drawings, if any, in books and records of the Office.

RULE 501. Any interested party may inspect the complete description, claims and drawings on file with the Office.

PART 6

Other Proceedings Affecting the Application or the Registration

CHAPTER 1

Assignment

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

(a) must be in writing and if in a language other than English or Filipino, the document must be accompanied by an English translation;

(b) must be acknowledged before a notary public or other officer authorized to administer oaths and perform other notarial acts, and be certified under the hand and official seal of the said notary or other officer;

(c) must be accompanied by an appointment of a resident agent, if the assignee is not domiciled in the Philippines;

(d) must identify the registration involved by number and date, giving the name of the registrant and the title of the utility model or industrial design as set forth in the certificate; in the case of an application for registration, the application number and filing date of the application should be stated, giving also the name of the applicant, and the title of the utility model or industrial design, set forth in the application, but if an assignment is executed concurrently with or subsequent to the execution of the application but before the application is filed, it should adequately identify the application, by its date of execution and name of the applicant, and the title of the utility model or industrial design; so that there can be no mistake as to the utility model or industrial design or application intended; and

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

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

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

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

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

RULE 605. *Action may be Taken by Assignee of Record in any Proceeding in the Office.* — Any action in any proceeding in the Office which may or must be taken by a patentee or applicant may be taken by the assignee, provided the assignment has been recorded.

CHAPTER 2

Surrender, Correction and Amendment of Certificate

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

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

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

RULE 607. *Correction of Mistakes of the Office.* — Upon written petition, in duplicate, of the patentee or assignee of record, and upon tender to the Office of the copy of the registration issued to the patentee, the Director shall have the

power to correct without fee any mistake in a registration incurred through the fault of the Office when clearly disclosed by the records thereof, to make the registration conform to the records.

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

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

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

RULE 610. *Form and Publication of Amendment or Corrections.* — An amendment or correction of a registration shall be accomplished by a certificate of such amendment or correction, authenticated by the seal of the Office and signed by the Director, which certificate shall be attached to the registration. Notice of such amendment or correction shall be published in the IPO Gazette and copies of the registration furnished by the Office shall include a copy of the certificate of the amendment or correction.

CHAPTER 3

Recordal; Transmission of Rights

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

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

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

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

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

CHAPTER 4

Request for Registrability Report

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

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

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

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

PART 7

Petitions and Appeals

RULE 700. *Petition to the Director to Question the Correctness of the Action of an Examiner on Matters of Form.* — Petition may be filed with the Director from any repeated action or requirement of the Examiner on matters of form 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.

RULE 701. *Appeals to the Director.* — Every applicant may, upon the final refusal of the Examiner to register, appeal the matter to the Director.

RULE 702. *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.

RULE 703. *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.

RULE 704. *Time and Manner of Appeal.* — Any petition or appeal must be taken by filing the petition in duplicate and payment of the required fee within two (2) months from the mailing date of the action appealed from, must specify the various grounds upon which the appeal is taken, and must be signed by the petitioner or appellant or by his attorney of record. The petition shall include a brief of the authorities and arguments on which he relies to maintain his appeal. A third copy of the petition shall be furnished the Examiner. On failure to file the brief within the time allowed, the appeal shall stand dismissed.

RULE 705. *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 706. *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 707. *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 a 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 708. *Appellant's Brief Required.* — The appellant shall, within one (1) month 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 709. *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 710. *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 registrant/applicant 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 utility model or industrial design, the application number and the filing date of the application.

(f) Letters relating to registered utility model or industrial design. When the letter concerns a registered utility model or industrial design, it shall state the name of the patentee, the title of the utility model or industrial design, the registration number and date of issuance.

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

On the propriety of making an application for the registration of utility model or industrial design, the applicant must judge for himself or consult an attorney-at-law or patent agent. The Office is open to him, and its records pertaining to all patents granted may be inspected either by himself or by any attorney or agent he may call to his aid. Further than this the Office can render him no assistance until his Application comes regularly before it in the manner prescribed by law and by these Regulations. A copy of the law, rules, or circular of information, with a section marked, set to the individual making an inquiry of the character referred to, is intended as a respectful answer by the Office.

Examiners' digests are not open to public inspection.

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

SECTION 2. *Fees and Charges to be Prepaid; Fees and Charges Payable in Advance.* — Express charges, freight, postage, telephone, telefacsimile including cost of paper and other related expenses, and all other charges on any matter sent to the Office must be prepaid in full. Otherwise, the Office shall not receive nor perform any action on such matters.

The filing fees and all other fees and charges payable to the Office shall be collected by the Office in advance of any service to be rendered.

SECTION 3. *Formality and Search Report Covering Pending Applications.* — (a) With respect to applications for utility model or industrial design registrations which were filed on or before December 31, 1998 and being proceeded with under the IP Code on January 1, 1998, the Formality Report and the Search Report shall be issued by the Chiefs of the Mechanical and Electrical Examining and the Chemical Examining Divisions of the former Bureau of Patents, Trademarks and Technology Transfer on or before January 31, 1999.

(b) With respect to applications for utility model or industrial design registrations which were filed on or before December 31, 1998 and being proceeded with in accordance with the Acts under which they were filed as elected by the applicants pursuant to Memorandum Order No. 1040 issued on December 16, 1997 by the Secretary of Trade and Industry, the results of the formality examination as well as the search thereon will be communicated to the applicant in accordance with the Rules of Practice in Patent Cases, as amended. However, in order to avoid any potential conflict between such applications and those filed under the IP Code, the Chiefs of the Mechanical and Electrical and the Chemical Examining Divisions shall issue the office actions covering the results of the formality and the search thereon on or before January 31, 1999. Furthermore, said applications may still be proceeded with in accordance with these

Regulations by filing a written notice to the Office together with an express statement of the applicant's action in accordance with Rule 207 or Rule 308 of these Regulations, as the case may be.

SECTION 4. *Duration of Utility Model and Industrial Design Registration of Pending Applications.* — Considering the time that has lapsed since the filing of the applications under the former Acts but are proceeded with in accordance with these Regulations as well as the time that has lapsed since the effectivity of the IP Code, the following rules shall govern the determination of duration of pending applications:

(a) The registration of utility model applications that were filed under the IP Code prior to the effectivity of these Regulations and applications that were filed under the former Acts but proceeded with in accordance with these Regulations shall expire, without possibility of renewal, at the end of the seventh year from the effectivity of these Regulations.

(b) The registration of industrial design applications that were filed under the IP Code prior to the effectivity of these Regulations and applications that were filed under the former Acts but proceeded with in accordance with these Regulations shall for a period of five (5) years from the effectivity of these Regulations, subject to renewal as provided in the IP Code and these Regulations.

SECTION 5. *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 6. *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 and all applications for utility models or industrial design pending at the effective date of the IP Code on January 1, 1998 shall be proceeded with in accordance with the IP Code and these Regulations unless pursuant to Memorandum Order No. 1040 dated December 16, 1997 issued by the Secretary of Trade and Industry, the applicants elected, on or before June 30, 1998, to prosecute said applications in accordance with the Acts under which they were filed.

SECTION 7. *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 effected thereby.

SECTION 8. *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 9. *Effectivity.* — These rules and regulations shall take effect fifteen (15) days after publication in a newspaper of general circulation.

Done this 2nd day of December 1998.

(Sgd.) EMMA C. FRANCISCO, Director General

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