

GUIDELINES AND PROCEDURES FOR PATENT APPLICATION*

*Aster I. Mercado**

INTRODUCTION

The Bureau of Patents acknowledges with appreciation the efforts exerted by the Department of Science and Technology (DOST) and the Philippine Institute for Development Studies (PIDS) directed at maximizing the possible benefits to be derived from the protection of the Intellectual Property Rights (IPR) of scientists and researchers. These efforts deserve commendation and at this juncture, allow me to congratulate the organizers of this seminar-discussion, particularly DOST Secretary Ceferino L. Folloso and PIDS President Ponciano S. Intal, Jr. for making this activity possible. I suppose that all participants also deserve to be congratulated for getting involved in this worthy undertaking.

INTELLECTUAL PROPERTY RIGHTS AWARENESS

It is unfortunate that in the Philippines, more than 90 percent of the population virtually know nothing or probably have not heard anything about intellectual property (particularly patent) rights. Our country, however, is not an isolated case. This lack of awareness of intellectual property rights is true worldwide, even in highly industrialized countries such as Japan, the United States and those in Europe.

Because of this reality, the promotion of awareness of IPR on a nationwide scale is indeed a gigantic task. For this reason, we in the Bureau of Patents are glad whenever occasions like this happen, especially those initiated not at our end. This only proves that in the Philippines, there is growing interest in IPR, and that the information dissemination campaign launched by the Bureau of Patents more than a year ago is slowly but surely gaining substantial ground.

MERITS OF THE PATENT SYSTEM

The merits of the patent system, if properly harnessed, may be very useful in catalyzing national economic growth. However, it is apparent

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*Senior Patent Examiner, Bureau of Patents, Trademarks and Technology Transfer, Department of Trade and Industry.

that the majority do not know or do not as yet appreciate the importance of the patent system and the meritorious contribution which the system offers. To benefit from this system, it is essential that we discuss thoroughly its merits.

In the patenting system being implemented in our country, inventive concepts are disclosed to the public as soon as they are patented. Without this system which we are fortunate to have, scientists, researchers and inventors would not have the proper inspiration and incentive to divulge to the public their contribution to the art in exchange for a patent grant. A timely disclosure to the public would save other scientific workers' and researchers' time, efforts and logistics devoted to working on concepts already covered by, or which rightfully belong to, earlier inventors.

Another merit of the patent system is that earlier inventions serve as a springboard towards greater progress and development. Earlier inventions apparently lead to more inventions. One specific example is the case of the microscope. This invention opened the gate to the microscopic world of Anton Van Leeuwenhoek, who, as we all know, was the first person to make glass lenses powerful enough to observe and describe bacteria. The work of Leeuwenhoek uncovered concepts which later on paved the way for multiple inventions relating to biotechnology in general. Advances in this field of technology continue up to this time and are likely to continue in the future. The impacts of these advances and inventions extend to other concerns, notably health, nutrition, energy and the environment. Directly or indirectly, we, the human race, benefit a lot from these technological advances.

The merits derived from the patent system are unquantifiable. Quite a number of inventions turn out to be commercially viable, and once market viability is established, employment is generated, and thereafter increased gainful productivity is realized. This is exactly what we hope to achieve with our present state of economy. Indeed, everybody clamors for economic progress, and in the light of these considerations, we welcome everybody in the earnest endeavor to achieve unprecedented economic progress partly through the merits of the patent system.

THE PHILIPPINE PATENT LAW (Republic Act No. 165)

What is a patent? It is a grant issued by the government, by virtue of Republic Act No. 165, giving an inventor, a designer or a maker the right to exclude others from making, using or selling his invention, design or utility model in the Philippines. Per the provision of R.A. 165, our patent system assures proper remuneration in the form of a patent protection.

This protection, which is issued in the form of patent grant, gives the inventor, designer or maker the sole right to exclude others from engaging in any activity related to the use, manufacture and sale of the patented invention, design or utility model. This particular provision of the patent law prohibits any person other than the patent owner from commercially exploiting a patented invention, design or utility model. In view of this, patent owners are assured that they will enjoy the fruits and benefits of their inventive labor during the term of the patent.

PATENTABLE GRANTS

Sections 7, 55(a) and 55(b) of R.A. 165 provide for the issuance of patent grants to the following:

An Invention (Sec. 7 of R.A. 165)

An invention relates to any new and useful machine or device, manufactured product or substance, process or any improvement thereof that involves an inventive act of a degree more than that which expert artisans or mechanics could muster. Examples:

- (a) A new machine for harvesting palay
- (b) A new medicine used as a hair grower
- (c) Improved irrigation pumps
- (d) Paint compositions
- (e) A method for treating infections.

An Industrial Design (Sec. 55 [a] of R.A. 165)

An industrial design relates to any new, original and ornamental design for an article of manufacture. Examples:

- (a) A new design for furniture
- (b) A new design for shoes
- (c) A new design for toothbrush
- (d) A new design for containers
- (e) A new design for shoe soles.

A Utility Model (Sec. 55 [b] of R.A. 165)

A utility model relates to any new model of an implement or tools or of any industrial product or part of the same which does not possess the quality of invention but which is of practical utility by reason of its form, configuration, construction or composition. Examples:

- (a) Multipurpose scissors
- (b) An improved rice thresher
- (c) A charcoal stove
- (d) Shampoo compositions
- (e) Waterproof panel boards.

REQUIREMENTS OF PATENTABILITY

For an Invention

There are three statutory requisites of patentability for invention patents, namely:

- (a) Novelty,
- (b) Inventiveness, and
- (c) Usefulness/industrial applicability.

For a Utility Model

To merit patentability, the subject matter covered in a utility model application has to be both (a) novel and (b) useful or industrially applicable.

For a Design

A design application shall be patentable if it satisfies the following requirements:

- (a) Novelty, and
- (b) Ornamentality.

In all cases, novelty refers to the newness of the concept involved in an application, while inventiveness means that the concept covered in an applicant's claim is not within the reach of a person skilled in the art. To be useful or industrially applicable, the disclosure should warrant repeatability of the process involved and reproducibility on an industrial scale of the product claimed.

In the case of designs, ornamentality implies satisfying the aesthetic point of view or affording a beautiful and pleasing appearance.

WHAT CANNOT BE PATENTED

Nonpatentable inventions which are set forth in Sec. 8 of R.A. 165 are as follows:

- (a) A useless device or article;
- (b) A method of doing business;
- (c) Those which are contrary to public order or morals, or public health or welfare;

- (d) Ideas, a scientific principle or an abstract theorem not embodied in an invention; and
- (e) A process not directed to the making or improvement of a commercial product.

WHO MAY APPLY FOR A PATENT

The Philippine patent system follows the first-to-invent rule. In view of this, only real inventors may apply for a patent.

WHEN TO APPLY FOR A PATENT

For an Invention Patent

If the inventor describes his invention in a printed publication or uses the invention publicly or places it on sale, he must file a patent application *before one year has elapsed*; otherwise, the right to a patent is lost. This is embodied in Sec. 9 of R.A. 165 concomitant with Rule 33 of the Revised Rules of Practice in Patent Cases.

For a Design Patent

A design patent is subject to the same condition as for the invention patent but with a shorter *period of six months*. This is set forth in Sec. 56 of R.A. 165 and Rule 124 of the Revised Rules of Practice in Patent Cases.

For a Utility Model

In accordance with Sec. 55 of R.A. 165, the maker of a utility model must first file an application for a patent before describing his utility model in a printed publication circulated in the Philippines or disclosing and/or using the utility model publicly in this country.

PARTS OF A COMPLETE APPLICATION

A complete patent application consists of the following:

- (a) A petition or request for a patent;
- (b) A filing fee;
- (c) A combined Oath, Power of Attorney and Petition for Invention duly accomplished and notarized;
- (d) Specification and claims; and
- (e) Drawings when necessary.

THE CONTENTS OF THE SPECIFICATION

The specification of a patent application must include the following:

(a) **The title of the invention.** This should appear as a heading on the first page of the specification and should be made very specific to the invention being sought for patenting.

(b) **Abstract.** The abstract of the invention is a brief technical description of the essential features of the inventive concept covered in the claims.

(c) **Field and background of the invention.** Applicants are required to provide in the specification a complete background of the invention including the concepts taught or described in the closest prior art.

(d) **Summary of the invention.** This part of the specification should define the object, advantages, purpose and nature and substance of the claims covered in the invention.

(e) **Brief description of the drawings of the invention.**

(f) **Detailed description of the invention.** The disclosure must specifically include the manner of making, compounding and using the precise invention. Applicants are required to provide an enabling disclosure so that any person skilled in the art may be able to make the invention.

(g) **Claim/s.** A claim is the definition or the measure of an invention. It defines the scope of patent protection. The claim should not include anything in the prior art. It should also not be so broad as to cover the work of others.

(h) **Signature of the inventor.**

LIFE OR TERM OF THE PATENT

Invention: 17 years

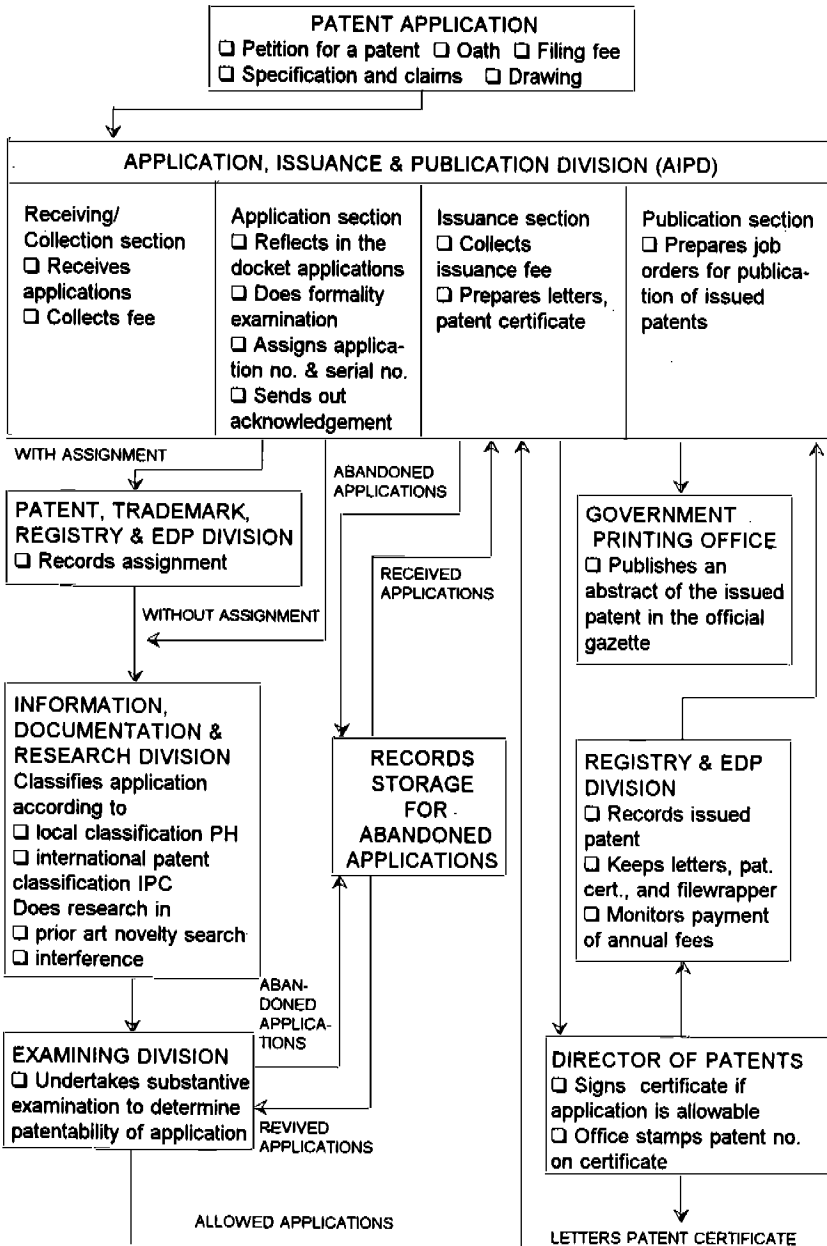
Design and utility model: 5 years with extension of two additional five-year terms.

FLOW CHART OF A PATENT APPLICATION (Figure 1)

An application is filed with the Patent Office and received at the Application, Issuance and Publication Division (AIPD). A filing fee is received by the cashier and a serial number is assigned if the contents thereof satisfy the requirements of a complete application (Rule 43, Sec. 13). The filing date of an application is the date on which the complete application is filed with the Patent Office or the date on which the last part of the application is completed.

The right to a patent application may be assigned, or letters of patent may be issued, to another in place of the applicant(s); however, any action of an assignee shall be recognized only when the assignment has

Fig. 1
FLOWCHART OF A PATENT APPLICATION



been recorded. From the AIPD, a complete application with an assignee is forwarded to the Patent Trademarks Registry and EDP Division for recording of the Assignment (Secs. 50, 51 and Rules 41, 179) (Rules 53, 179), before it is assigned for search at the Information, Documentation and Research Division (IDRD). An application which is unassigned goes directly to the IDRD.

At the IDRD, a thorough and rigid search on the pertinent art is conducted using the facilities and references in the office which include:

- (a) Local and foreign patents;
- (b) Chemical abstracts;
- (c) Printed publications which include scientific and technical periodicals dealing with law and science, law books relating to patent practice, encyclopedia on specialized technologies, textbooks which cover emerging new technologies such as, for example, biotechnology and genetic engineering.

To date, there are about 25,000 Philippine Patents, 7,200 Utility Model Patents, 4,900 Design Patents, and copyrights to more than 5,000 textbooks and less than 3,000 periodicals. There are also about 2,000,000 US Patents available either as printed copies or documented in micro-fiche in the science-law library of the office.

In view of the numerous references which steadily increase through the years, an application taken up for a search is classified according to subject matter using either:

- (a) Local classification, or
- (b) International patent classification.

Obviously, classification narrows down the scope of coverage of the references pertinent to a particular case. This system saves the researcher the useless and futile effort of going through endless files covering nonrelated art.

An interference search is also conducted using both pending and patented local cases.

PROCEDURE ON SUBSTANTIVE EXAMINATION

After the research phase, an application becomes ready for merit examination at the different Patent Examining Divisions, namely:

- (a) Chemical Examining Division;
- (b) Mechanical, Electrical, Design and Utility Model Examining Division.

The Examining Division is generally regarded as the core, nucleus or nerve center in the processing of a patent application. A lot takes place during this phase because it is during this time that the examiner, on the one hand tries to limit the scope of a claims coverage commensurate to the technology disclosed while the applicant, on the other hand, bargains and argues for the broadest possible coverage.

A. Cursory Check of the Documents and Parts of the Application

In accordance with Rule 47 of the Rules of Practice, only complete applications will be accepted and placed on file for examination. Generally, applications forwarded to the examining division are ready for merit examination. Nevertheless, the examiner always makes a cursory check of the component parts of the application (i.e., the Petition of Request for a Patent, the specifications and the claims including an abstract, an oath, drawings when necessary, and the prescribed filing fee). Any formal objections thereto are carefully noted and raised in the examiner's action.

B. Checking of Effective Filing Date

Applications Filed Under Sec. 9

Effective Filing Date

Original Application

Actual filing date

First of a series of applications of an invention disclosing a given invention

Divisional Application

Filing date of parent case

Derived from a pending parent application, disclosing and not claiming anything not disclosed in the parent case.

Should be filed within four months after the requirement to divide becomes final.

Should be filed not later than the date of patenting or abandonment of the parent case (Memorandum Circular TSE/65-8).

Continuation Application

Second application for the same invention claimed in a prior application and filed before the original is considered abandoned. No new matter included.

Usually resorted to after a final rejection in order to be entitled to further examination.

Filing date of parent case

Continuation-in-part Application (CIP)

File during the pendency of the original application.

Contains new matter.

Gets the benefit of the original filing date as to matters disclosed in the original application.

Substitute (Re-file)

A duplicate application should be filed after the abandonment of the original application.

Actual filing date

Re-issue

A re-issue patent is one issued for the unexpired term in lieu of a defective original patent.

An application filed in lieu of an original patent to correct an error in the latter that was committed without deceptive intent.

Effective filing date of the original application

Application Files Under Sec. 15 (Rule 56, Article IV, Convention of Paris)

The filing date of an earlier application filed in a foreign country

Application previously filed regularly in a foreign country which affords similar privileges to Filipino citizens, provided that local application is filed within 12 months after any such foreign application is filed.

The effective filing date of an application is very important in considering whether an application meritoriously satisfies the statutory requisites of relative novelty and inventiveness as set forth in Sec. 7 and Sec. 9 concomitant to Rules 33 and 34 of the Rules of Practice.

C. Examination Proper

C1. Nature of Proceedings in the Examination of a Patent Application

Applications are prosecuted *ex parte* by the applicant (Rules 78 and 79). An *ex parte* proceeding in the Patent Office may be likened to a lawsuit in which there is a plaintiff (which in this case is represented by the inventor) but no defendant, with the court itself (represented by the office) acting as the adverse party. In this lawsuit, the examiner represents the interest of the public. He tries to give the inventor the least possible monopoly in exchange for the technology disclosed, while the inventor or his duly assigned representative seeks as much monopoly as possible.

All business relating to such proceedings and any other patent concerns for that matter are transacted in writing. Verbal or oral allegations shall not be entertained (Rule 1).

C2. The Principal Examiner's Action

C2-1. Evaluation of the disclosure

The examiner evaluates the merits of an application taking into consideration the specification and the claims. The examiner sees to it that an application observes strict compliance not only with matters relating to the statutes and the rules but also with those relating to form. If the application and claims are prepared in a manner which is sufficient for the purpose of evaluating the inventive concepts embodied therein, then the examiner proceeds with the determination of whether there is a need to raise an issue on the unity of invention.

An application which has multiple inventions is subjected to a restriction requirement. The restriction requirement is raised to limit the application to a single invention only. If there is no question on the unity of invention or after the issue on the unity of invention has been settled, evaluation of the disclosure comes next.

The disclosure is evaluated taking into consideration the following:

- (a) Objects of the invention;
- (b) Detailed description of the invention; and
- (c) Drawings and brief description thereof when necessary.

In accordance with Rule 14d of the Rules of Practice, the technical description provided in the disclosure should be expressed in full, clear, concise and exact terms and addressed to a person skilled in the art.

If the disclosure is not complete and the examiner deems it impossible to carry out a complete examination due to the paucity of the disclosure, then merit examination is withheld pending the applicant's submission of a disclosure prepared in accordance with the rules (Rules 62 and 63).

C2-2. Claim (Rule 63); rejection thereof

A claim is the definition or the measure of an invention. It defines the *scope of patent protection*. To be allowable, a claim must not include anything in the prior art and should not be so broad as to cover the work of others.

REJECTIONS BASED ON STATUTORY GROUNDS

In the examination process, the alleged inventive concept embodied in a claim is compared *vis-à-vis* the state of the art. A rejection in view of the prior art is declared as either:

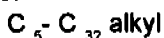
- (a) Unpatentability for want of novelty, or
- (b) Unpatentability for want of inventiveness.

The other statutory requisite of patentability is industrial applicability. To be industrially applicable, the disclosure should warrant repeatability of the process involved and reproducibility of the product claimed on an industrial scale. Should the claim fail to satisfy any of the three statutory requisites of patentability, i.e., novelty, inventiveness and industrial applicability, then it shall be held unpatentable. The statutory bases for this are Secs. 7 and 9 of R.A. 165 concomitantly with Rules 31, 33 and 34 of the Rules of Practice. Rejections of this type are what we call rejections based on statutory grounds.

REJECTION ON FORMAL MATTERS

Any of the following constitute a rejection on formal matters:

- (a) *Aggregation and old combination.* A combination of old elements each of which functions separately and substantially as it did before, completely uninfluenced by the action of the other parts.
- (b) *Indefiniteness.* The exact limitations of the invention should be specified in the claim. A claim is therefore deemed indefinite if the specified boundary between what is covered and what is not covered by the claim is not clear.
- (c) *Inadequate and insufficient disclosure.* A claim which is based on an insufficient disclosure is objected to for want of examples or illustrations supportive of the claimed inventive concept. The statutory basis for this is Sec. 14d of R.A. 165 which requires that the best mode contemplated by the inventor in carrying out the invention should be described using clear, concise and exact terms to enable someone with ordinary skill in the art to practice and use the invention without undue experimentation on his part.
- (d) *Breadth.* A claim is objected to based on undue breadth or broadness in view of the use of expansive definitions or limitations which could not be proved operable given the applicant's invention. Example:



If the illustration and examples given support only the lower limit of the alkyl group then a claim to the upper limit could be deemed unduly broad if an applicant fails to prove the operability of the defined inventive scheme using an alkyl with 32 carbon atoms.

- (e) *Functional expressions.* Process steps which describe the mere effect rather than the means employed to arrive at the desired effect.
- (f) *Incompleteness.* An objection on the ground of incompleteness is raised if the claim fails to include essential elements, process steps and critical parts of the invention such as for example, the weight contribution of essential elements of a composition, critical temperature and other critical operating conditions.

C3. Response by the applicant

The examiner's evaluation of a patent application is forwarded to the applicant in a formal correspondence termed as an examiner's action.

In order to be entitled to a re-examination, an applicant has to file a complete response to an examiner's action. A complete response is one which touches on all grounds of rejection raised in the examiner's action. This is in accordance with Rule 92 of the Rules of Practice which specifies that an applicant's response must appear throughout to be a bona fide attempt to advance the case to final action.

A response short of satisfying Rule 92 may be considered incomplete or nonresponsive as the case may be. An incomplete response is one which fails to include a traversal or amendments to certain rejections raised in the outstanding examiner's action whereas one which virtually ignores all rejections and objections raised in such action is deemed *nonresponsive*.

Statutory Period Set for Filing Applicants' Response

A response to the examiner's action is due within two months from the mailing date of the latter subject to two extensions equivalent to two months each. Therefore, the allowable time limit set to respond to the examiner's action is a maximum of six months.

C4. Applications abandoned for failure to prosecute and revival thereof

An application shall be declared abandoned in the event of the applicant's failure to prosecute within the statutory period set for this purpose (Rule 112).

Abandoned cases may be revived as pending applications within four months from the date of abandonment upon

- (a) good cause shown,
- (b) submission of an action responsive to the outstanding official action, and
- (c) payment of the required fee.

C5. Subsequent actions by examiner and responses of the applicant

In subsequent actions, the examiner acknowledges the response submitted by the applicant and notes therein the entry of additional claims and of allowable amendments requested for both the specification and the claims including a request for cancellation of any claim. In view of requested amendments, the claims under consideration are indicated

and the status thereof is carefully noted. If the claims are allowable, the examiner states so; if not, the reasons therefore are clearly and explicitly stated, and where possible, suggested amendments are included to accelerate the early allowance of the patentable subject matter covered in the claims.

Just like the response to the first official action, all responses to any other examiner's action become due within the period set forth under Rule 112. All such responses should be filled in completely so that rebuttals or amendments which could obviate or overcome all rejections could be included.

C6. Final Action

An applicant may persist in his claim for a patent with or without amendment after receiving the first examiner's action. Under Sec. 16 of R.A. 165, a re-examination of the application is in order. On re-examination (i.e., on the second or any subsequent examination) the rejection or other action may be made final. A final rejection includes a reiteration of all grounds for rejection applicable to the claims in the case, clearly specifying therein the rationale for the said rejection.

C6-1. Appealable to the Director (Rule 256)

Applicants may appeal to the Director for a final action within four months from the mailing date of the notice.

C6-2. Requirement for appeal (Rule 258)

An applicant's appeal must indicate the rejected claims for which the appeal is being filed. The appeal must also be accompanied by a request for reconsideration of the final rejection by presenting an argument/rebuttal which may be substantiated by the submission of affidavits or by entering amendments to the rejected claims, or both. Affidavits submitted after an appeal may be considered only upon proofs of good cause and sufficient reasons for admittance.

Within 60 days from the date of appeal, the appellant should file a brief of the arguments relied upon as a basis for the appeal; otherwise, the appeal shall be dismissed.

C6-3. Examiner's brief (Rule 259)

The appellant shall be served a written statement of the examiner's answer to his brief. If the examiner's brief in turn includes new points, a reply thereto may be filed within thirty days from the date of receipt thereof.

C6-4. Hearing

An oral hearing may be undertaken upon the appellant's request; otherwise, the appeal shall be assigned for consideration and decision.

C6-5. Director's decision (Rule 262); appeal to intermediate appellate court

After due consideration of the appealed case, the Director may either affirm or reverse the decision of the examiner.

As per R.A. 5434, any request for re-hearing or reconsideration of the case must be filed with the Intermediate Appellate Court within fifteen days from the date of notice.

C7. Interference Proceedings (Rules 190-194)

The question of priority of invention between two or more parties claiming substantially the same invention is determined by instituting interference proceedings.

C7-1. Preparation

Interference proceedings are instituted if there exists a plurality of application or if an application and a patent have a common patentable subject matter.

It is required that the claims covering the common invention be drafted in the same language in order that an interference could be declared.

An application which is up for interference shall be forwarded to the Director's office together with the notice of interference. The interfering subject matters and the claims corresponding thereto shall be defined in the notice.

C7-2. Declaration

The Director assigns numbers to the notices of interference which are then forwarded to all the parties involved. The Director assumes jurisdiction over the cases upon the institution and declaration of the interference.

C8. Recommendation for Allowance

The claims of an application shall be recommended for allowance if:

- (a) The examination report shows that the claim of an application is entitled to a patent under the law. A claim is deemed allowable if it satisfies all statutory requisites of patentability and if it

- meets all requirements based on nonstatutory grounds; and
- (b) No interference has been declared, or, if one has been declared, the case has been decided in favor of the applicant.

PATENT GRANT

A. Issuance of Letters Patent (Rule 144)

An allowed application is forwarded to the Director's office for final approval. Upon payment of the issuance fee, a letters patent is prepared at the AIPD. The letters patent certificate becomes a patent on the date the Director affixes his signature thereon.

B. Payment of Annual Fees (Rule 152)

The first annual fee on a patent for invention is due and payable on the expiration of the four years from the date of grant, while that for a utility model and a design patent is due on or before the start of the sixth year.

C. Effect of Nonpayment on Time (Rule 153)

A notice of nonpayment shall be published by the Patent Office in the Official Gazette. The patent lapses if the patentee fails to settle the annual fee and with the surcharge accruing thereto within a period of six months from the actual publication date in the Official Gazette. A notice relating to lapsed patents is also published in the Official Gazette.

D. Reinstatement of Lapsed Patent

A lapsed patent may be reinstated upon payment of the following:

- (a) annual fee;
- (b) surcharge for delayed payments;
- (c) surcharge for reinstatement; and
- (d) expenses for publication in the Official Gazette incurred for this purpose and upon showing satisfactory proof that nonpayment was not deliberately committed.