

[IPO, December 29, 1998]

RULES AND REGULATIONS ON INVENTIONS

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 inventions are hereby promulgated:

Part 1 Definitions

RULE 100. Definitions. — Unless otherwise specified, the following terms shall have the meaning provided in this Rule:

- (a) "Bureau" means the Bureau of Patents of the Office;
- (b) "Director" means the Director of the Bureau of Patents;
- (c) "Director General" means the Head of the Intellectual Property Office;
- (d) "Examiner" means any officer or employee of the Bureau of Patents authorized to examine applications. The title or official designation of such officer or employee may change as the structure of the Office may be set;
- (e) "IP Code" means Republic Act No. 8293 otherwise known as the Intellectual Property Code of the Philippines;
- (f) "IPO Gazette" means the Intellectual Property Office's own publication where all matters required to be published under the IP Code shall be published;
- (g) "Office" means the Intellectual Property Office; and
- (h) "Regulations" means this set of rules and regulations and such Rules of Practice as may be formulated by the Director of Patents and approved by the Director General.

Part 2 Patentability

RULE 200. Patentable Inventions. — Any technical solution of a problem in any field of human activity which is new, involves an inventive step and is industrially applicable shall be patentable. (Sec. 21, IP CODE)

RULE 201. Statutory Classes of Invention. — An invention may be, or may relate to:

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

RULE 202. Non-Patentable Inventions. — The following shall be excluded from patent protections:

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

RULE 203. Novelty. — An invention shall not be considered new if it forms part of a prior art. (Sec. 23, IP CODE)

RULE 204. Prior Art. — Prior art shall consist of:

- (a) Everything made available to the public by means of a written or oral disclosure, by use, or in any other way, before the filing date or the priority date of the application claiming the invention. Prior use which is not present in the Philippines, even if widespread in a foreign country, cannot form part of the prior art if such prior use is not disclosed in printed documents or in any tangible form.
- (b) The whole contents of an application for a patent, utility model, or industrial design registration, published under Sec. 44 of IP CODE, filed or effective in the Philippines, with a filing or priority date that is earlier than the filing or priority date of the application: Provided, That the application which has validly claimed the filing date of an earlier application under Section 31 of IP CODE, shall be prior art with effect as of the filing date of such earlier application: Provided further, That the applicant or the inventor identified in both applications are not one and the same. (Sec. 24, IP CODE):

Where two or more applications are independently filed with respect to the same invention, and the later applications are filed before the first application or earlier application is published, the whole contents of the first or earliest filed application published in accordance with Sec. 44, IP CODE on or after the filing date or priority date of the later filed application shall be novelty destroying with respect to the later filed application.

RULE 205. Non-Prejudicial Disclosure. — The disclosure of information contained in the application during the twelve (12) months preceding the filing date or the priority date of the application shall not prejudice the applicant on the ground of lack of novelty if such disclosure was made by:

(a) The Inventor;

(b) A foreign patent office, the Bureau or the Office, and the information was contained (a) in another application filed by the inventor and should not have been disclosed by the office, or (b) in an application filed without the knowledge or consent of the inventor by a third party which obtained the information directly or indirectly from the inventor; or

(c) A third party which obtained the information directly or indirectly from the inventor.

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

RULE 206. Inventive Step. — (a) An invention involves an inventive step if, having regard to prior art, it is not obvious to a "person skilled in the art" at the time of the filing date or priority date of the application claiming the invention. (Sec. 26, IP CODE)

(b) Only prior art made available to the public before the filing date or priority date shall be considered in assessing inventive step.

RULE 207. Person Skilled in the Art. — The person skilled in the art is presumed to be an ordinary practitioner aware of what was common general knowledge in the art at the relevant date. He is presumed to have knowledge of all references that are sufficiently related to one another and to the pertinent art and to have knowledge of all arts reasonably pertinent to the particular problems with which the inventor was involved. He is presumed also to have had at his disposal the normal means and capacity for routine work and experimentation.

RULE 208. Industrial Applicability. — An invention which can be produced and used in any industry shall be industrially applicable. (Sec. 27, IP CODE):

Part 3 Right To A Patent

RULE 300. Right to a Patent. — The right to a patent belongs to the inventor, his heirs, or assigns. When two (2) or more persons have jointly made an invention, the right to a patent shall belong to them jointly (Sec. 28, IP CODE).

RULE 301. Who may be Named in an Application as an Applicant. — The application may be filed by the actual inventor(s) or in the name of his heirs, legal representative or assigns.

RULE 302. Inventions Created Pursuant to a Commission. — The person who commissions the work shall own the patent, unless otherwise provided in the contract. (Sec. 30.1, IP CODE)

RULE 303. Inventions made in the course of employment. — In case the employee made the invention in the course of his employment contract, the patent shall belong to:

(a) The employee, if the inventive activity is not a part of his regular duties even if the employee uses the time, facilities and materials of the employer

(b) The employer, if the invention is the result of the performance of his regularly-assigned duties, unless there is an agreement, express or implied, to the contrary. (Sec. 30.2, IP CODE)

RULE 304. First to File Rule. — If two (2) or more persons have made the same invention separately and independently of each other, the right to the patent shall belong to the person who filed an application for such invention, or where two or more applications are filed for the same invention, to the applicant who has the earliest filing date or, the earliest priority date (Sec. 29, IP CODE).

Where two or more applications for the same invention made separately and independently of each other have the same filing date or priority date, the patent will be issued jointly to the applicants of all such applications.

RULE 305. Right of Priority. — An application for patent filed by any person who has previously applied for the same invention in another country which by treaty, convention, or law affords similar privileges to Filipino citizens, shall be considered as filed as of the date of filing of the foreign application: Provided, That: (a) the local application expressly claims priority; (b) it is filed within twelve (12) months from the date the earliest foreign application was filed; and (c) a certified copy of the foreign application together with an English translation is filed within six (6) months from the date of filing in the Philippines (Sec. 31, IP CODE).

This six (6) month-period may be extended by the Director for a maximum of six (6) months upon showing of good cause or in compliance with treaties to which the Philippines is or may become a member.

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

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

RULE 306.3. If certain elements of the invention for which priority is claimed do not

appear among the claims formulated in the previous application, priority may nonetheless be granted, provided that the previous application as a whole specifically disclose such elements.

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

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

RULE 307. Certified Copy of the Foreign Applications. — The certified copy of foreign applications mentioned in Rule 302 shall be the copy of the priority application(s) as duly certified to be a true or faithful reproduction thereof by the Industrial Property Office which received it or any other office which has official custody of the foreign application.

Part 4 **The Patent Application**

RULE 400. The Patent Application. — An application for a patent shall be in Filipino or English and shall be filed in writing either directly to the Bureau or by post and must be addressed to the Director. The application shall contain the following:

- (a) A request for the grant of a patent;
- (b) A description of the invention;
- (c) Drawing(s) necessary for the understanding of the invention;
- (d) One or more claims; and
- (e) An abstract.

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

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

RULE 402. Marking of Documents; Acknowledgment. — The Bureau shall mark the documents making up the application with the date of the receipt. After receipt of the full payment of the required fees, the Bureau may issue an acknowledgment stating the application number, name of applicant and title of the invention.

RULE 403. Form of Request; Office Application Form. — The request shall be made on a form drawn up by the Office. For the convenience of applicants, the Office shall draw up and make available a standard application form which may be reproduced at will by applicants and other persons at their own cost.

RULE 404. The Request. — The request shall contain the following:

- (a) Petition for the grant of a patent;
- (b) Applicant's name and address;
- (c) Title of the invention;