

[IPO ORDER NO. 79, S. OF 2005, August 15, 2005]

AMENDMENTS TO THE REGULATIONS ON INTER PARTES PROCEEDINGS (AS AMENDED BY OFFICE ORDER NO. 18, S. 1998 AND AS MODIFIED BY OFFICE ORDER NO. 12, S. 2002)

Whereas, it is the policy of the Intellectual Property Office to continuously review and streamline its operations, systems, processes, including administrative procedures in resolving disputes and controversies involving intellectual property rights;

Whereas, under Section 10.3 of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines, the Director General may by Regulations establish the procedure to govern Inter Partes proceedings;

Whereas, the Regulations on Inter Partes Proceedings, which took effect on 20 October 1998 was amended per Office Order No. 18, s. 1998 dated 31 December 1998 and subsequently modified per Office Order No. 12, s. 2002 re: IPO Uniform Rules on Appeal;

Whereas, there is a need to further amend the Regulations on Inter Partes Proceedings in order to achieve a more efficient and expeditious resolution of Inter Partes cases in the Bureau of Legal Affairs;

Now, wherefore, the Regulations on Inter Partes Proceedings, as amended and modified, are hereby further amended, as follows:

SECTION 1. Rule 1, Section 1(f) is hereby amended, to read as follows:

(f) "Hearing Officer" means the Officer authorized to exercise the functions of "Hearing Officer" in these Regulations;

Section 2. Rule 2, Sections 1 to 3 are hereby amended, to read, as follows:

Section 1. The contested or Inter Partes proceedings are:

1.1 Patent Cases

(a) Petition to cancel an invention patent, utility model registration, industrial design registration, or any claim or parts of a claim, and registration of topography or layout design of integrated circuits

based on Rule 402, paragraphs (a) and (b) of the Layout Design (Topography) of Integrated Circuits Regulations (Office Order No. 19, s. 2002);

(b) Petition for Compulsory Licensing or a license to exploit a patented invention.

1.2. Trademark Cases

(a) Opposition against the registration of a mark published for opposition; and

(b) Petition to cancel the registration of a mark.

Section 2. Parties in Inter Partes proceedings – The petitioner in a cancellation proceeding and in a compulsory licensing proceeding or the opposer in an opposition proceeding shall be deemed to be in the position of plaintiff while the patentee, registrant or applicant shall be the respondent in a cancellation, compulsory licensing or opposition proceeding who shall be in the position of defendant, with respect thereto.

Section 3. Original jurisdiction over Inter Partes proceedings – The Bureau shall have original jurisdiction over Inter Partes proceedings. The proceedings shall be heard before the Director, Assistant Director or the duly designated Hearing Officer. The Director, however, shall render, issue and sign all decisions and final orders.

Section 3. Rule 2, Section 5 is deleted.

Section 4. Rule 2, Section 6 and 7 are hereby amended and converted into Sections 5 and 6, to read as follows:

Section 5. Rules of Procedure to be followed in the conduct of hearing of Inter Partes cases. – The rules of procedure herein contained primarily apply in the conduct of hearing of *Inter Partes* cases. The Rules of Court may be applied suppletorily. The Bureau shall not be bound by strict technical rules of procedure and evidence but may adopt, in the absence of any applicable rule herein, such mode of proceedings which is consistent with the requirements of fair play and conducive to the just, speedy and inexpensive disposition of cases, and which will give the Bureau the greatest possibility to focus on the contentious issues before it.

Section 6. Powers of Hearing Officer – Hearing Officers are authorized to administer oaths and affirmations, issue summons to compel attendance of parties and witnesses as well as subpoena duces tecum for the production of any book,

papers, correspondence and other records which are material to the case. Hearing Officers may also make preliminary rulings on questions raised during the proceedings provided that the Director shall render the ultimate decisions or issue final orders.

SECTION 5. Rule 2, Sections 8 to Section 23 are hereby deleted and in place thereof, are the following new Sections:

Section 7. Filing of Petition or Opposition –

7.1. The petition or opposition, together with the affidavits of witnesses and originals of the documents and other requirements, shall be filed with the Bureau, provided, that in case of public documents, certified copies shall be allowed in lieu of the originals. The Bureau shall check if the petition or opposition is in due form as provided in the Regulations particularly Rule 3, Section 3; Rule 4, Section 2; Rule 5, Section 3; Rule 6, Section 9; Rule 7, Sections 3 and 5; Rule 8, Sections 3 and 4.

For petition for cancellation of layout design (topography) of integrated circuits, Rule 3, Section 3 applies as to the form and requirements. The affidavits, documents and other evidence shall be marked consecutively as "Exhibits" beginning with the letter "A".

7.2. The prescribed fees under the IPO Fee Structure shall be paid upon the filing of the petition or opposition otherwise, the petition or opposition shall be considered as not filed.

7.3. If the petition or opposition is in the required form and complies with the requirements including the certification of non-forum shopping, the Bureau shall docket the same by assigning the Inter Partes Case Number. Otherwise, the case shall be dismissed outright without prejudice. A second dismissal of this nature shall be with prejudice.

7.4. The Bureau shall *motu proprio* dismiss the case outright due to lack of jurisdiction, improper venue, and failure to state a cause of action.

Section 8. Answer –

8.1. Within three (3) working days from receipt of the petition or opposition, the Bureau shall issue an order for the respondent to file an answer together with the affidavits of witnesses and originals of documents, and at the same time shall notify all parties required to be notified in the IP Code and these Regulations, provided, that in case of public

documents, certified true copies may be submitted in lieu of the originals. The affidavits and documents shall be marked consecutively as "Exhibits" beginning with the number "1".

8.2. The respondent shall file the answer within thirty (30) days from receipt of the Notice to Answer together with the duly marked affidavits of witnesses and other documents serving copies thereof upon the petitioner or opposer. Upon proper motion and payment of the applicable fee, the Bureau may grant an additional period of thirty (30) days within which to file the answer. No further extension shall be granted except for the most compelling reason and in no case shall the period exceed 120 days from receipt of the Notice to Answer.

8.3. The petitioner or opposer may file a reply within a non-extendible period of ten (10) days from receipt of a copy of the answer. On the other hand, the respondent may file a rejoinder also within ten (10) days from receipt of a copy of the reply. In filing the reply or rejoinder, additional documents may be submitted, which shall be duly marked in accordance with the preceding sections.

Section 9. Petition or Opposition and Answer must be verified – Subject to Rules 7 and 8 of these regulations, the petition or opposition and the answer must be verified. Otherwise, the same shall not be considered as having been filed.

Section 10. Prohibited pleadings – No motion to dismiss shall be entertained. Instead, all grounds for dismissal shall be pleaded as affirmative defenses, the resolution of which shall be made in the decision on the merits. Neither shall a motion for bill of particulars, motion for reconsideration of interlocutory orders, and all other pleadings subsequent to the filing of a rejoinder, shall be allowed.

Section 11. Effect of failure to file Answer – In case the respondent fails to file an answer, or if the answer is filed out of time, the case shall be decided on the basis of the petition or opposition, the affidavits of the witnesses and the documentary evidence submitted by the petitioner or opposer.

Section 12. Evidence for the Parties –

12.1. The verified petition or opposition, reply if any, duly marked affidavits of the witnesses, and the documents submitted, shall constitute the entire evidence for the petitioner or opposer. The verified answer, rejoinder if any, and the duly marked affidavits and documents submitted shall constitute the evidence for the respondent. Affidavits, documents and other evidence not submitted and duly marked in accordance with the preceding sections shall not be admitted as evidence.