

**[ IPO OFFICE ORDER NO. 09, S. 2000, May 12, 2000 ]**

**AMENDMENTS TO THE RULES AND REGULATIONS ON UTILITY MODELS AND INDUSTRIAL DESIGNS**

Pursuant to the authority granted by the provisions of Section 7.1 and Section 8.1 of R. A. 8293, the Rules and Regulations on Utility Models and Industrial Designs published on December 3, 1998 and took effect on December 18, 1998, are hereby amended as follows:

**SECTION 1.**            **A new rule is hereby added to provide a title for each reference as follows:**

**"Rule 10.        These Regulations shall be known as the "Utility Model and Design Regulations ".**

**SECTION 2.**        Rule 201 is hereby amended to read as follows:

**"Rule 201 .    *Statutory classes of Utility Models.*** — A utility model may be, or may relate to:

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

**SECTION 3.**        Rule 203 is hereby amended to read as follows:

**"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 properly 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."

**SECTION 4 .**        Rule 205 is hereby amended to read as follows:

**"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."

SECTION 5 . Rule 206 is hereby amended to read as follows:

**"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."

SECTION 6. Rule 207 is hereby amended to read as follows:

**"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.

SECTION 7. Rule 207.2 is hereby amended to read as follows:

**"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 the 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.

SECTION 8. Rule 207.4 is hereby amended to read as follows:

**"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 deemed registered 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."

SECTION 9. Rule 207.6 is hereby amended to read as follows:

**"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 in the determination of the validity of the utility model claim(s) in respect to newness. The registrability report shall be given to the applicant within two (2) months from receipt of the request from the applicant."

SECTION 10. A new Rule 207.7 is hereby added as follows:

**"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."

**SECTION 11.** A new Rule 207.8 is hereby added as follows:

**"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."

**SECTION 12.** Rule 208 is hereby amended to read as follows:

**"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

**SECTION 13.** Rule 208.1 is hereby amended to read as follows:

**"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."

**SECTION 14.** Rule 212 is hereby amended to read as follows:

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

However, taking into account the first-to-file rule, the volume of the 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 the effectivity of these regulations shall expire, without possibility of renewal, at the end of seven (7) years from effectivity of these Regulations."

SECTION 15. Rule 301 is hereby amended to read as follows:

**"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, an article of manufacture, whether or not associated with lines, patterns or colors, which imparts an aesthetic and pleasing appearance of 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 technical result or those that are contrary to public order, health or morals, are not registrable."

SECTION 16. Rule 306 is hereby amended to read as follows:

**"Rule 306.** *Registration of Industrial Design.* — If the application meets the requirements of the IP Code and these regulations, the Bureau shall effect the registration of the industrial design: Provided that all the required fees are paid on time.

SECTION 17 . Rule 307 is hereby amended to read as follows:

**"Rule 307 .** *Formality Examination of Industrial Design Application.* — The industrial design 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 industrial design registration, (c) filing date requirements and (d) other formality requirements."

SECTION 18. Rule 308 is hereby amended to read as follows:

**"Rule 308.** *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, or, (3) upon payment of the required fee, request for a registrability report."

SECTION 19. Rule 308.2 is hereby amended to read as follows: