



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

SALIENT ASPECTS OF THE PATENT SYSTEM IN THE PHILIPPINES

Melanie Binauhan
Philippines

Outline

- PHILIPPINES: Brief introduction
- Organizational structure
- IPOPHL: Vision, Mission and Values
- Member of Global Community
- Bilateral Relation
- IPOPHL Services
- Philippines Patent Regime
- Different Types of IP Protection
- Procedure for Applications
- Application Flow Chart
- Statistics

Outline

- Utility Model and Industrial Designs
- Accelerated Examination
- Patent Quality Mechanisms
- ISA/IPEA
- Early Search Report/Written Opinion
- Competency-Based Trainings
- Challenges/Developments

Philippines/Pilipinas

THE PHILIPPINE ISLAND
in vector by Diwa Fernandez
<http://diwafernandez.com>

■ Luzon
■ Visayas
■ Mindanao

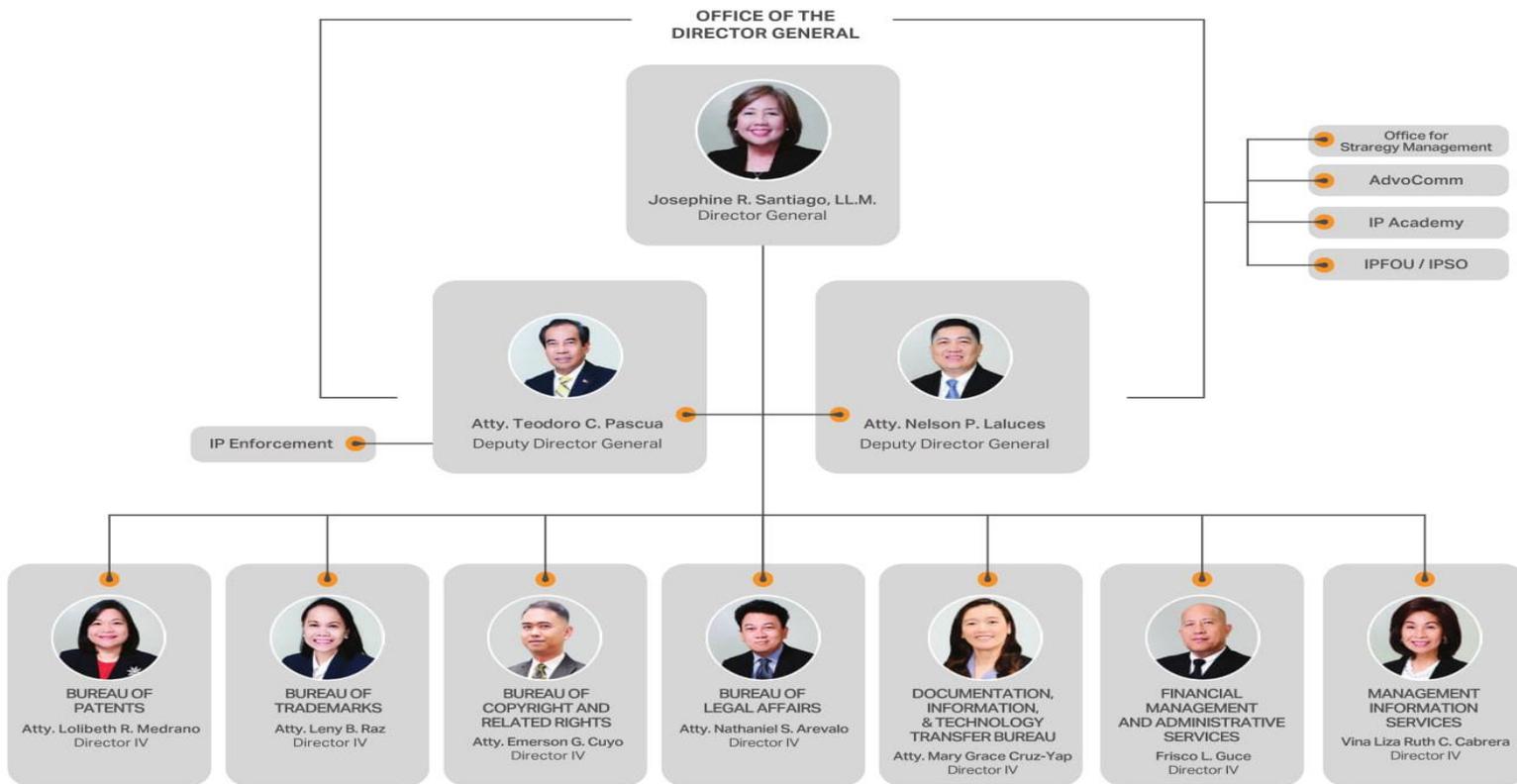


Official Name:	Republika ng Pilipinas
President:	Rodrigo R. Duterte (16 th)
Time:	UTC +8h
Capital City:	Manila
Largest City:	Quezon City
Land:	7,641 islands (2016) 300,000 km ² area
Climate:	Tropical and maritime 26.6°C mean annual temp (rainy and dry seasons)

Organizational Structure of the IPOPHL



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES



Intellectual Property Office of the Philippines(IPOPHL)



VISION:

An intellectual property conscious Philippines in a demystified, development-oriented, and democratized IP system by 2020.

MISSION:

We commit to deliver high quality and efficient services to promote innovation and encourage the creation, utilization, protection of and respect for intellectual property.

VALUES:

JUSTNESS

INTEGRITY

EXCELLENCE

HARMONY AND TEAMWORK

ACCOUNTABILITY

IPOPHL MEMBER OF GLOBAL IP COMMUNITY

- Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (2012)
- WIPO Copyright Treaty (2002)
- WIPO Performances and Phonograms Treaty (2002)
- Patent Cooperation Treaty (2001)
- Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations (1984)
- Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure (Entered 1981)
- Convention Establishing the World Intellectual Property Organization (1980)
- Paris Convention for the Protection of Industrial Property Rights (1965)
- Berne Convention for the Protection of Literary and Artistic Works (1951)
- Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) (1994)

- ASEAN Working Group on IP Cooperation (AWGIPC)
Philippines is the *Country Champion* in 12 initiatives under the 2016-2025 Action Plan



Bilateral Relations

IPOPHL Services



IPOPHL Headquarters in Fort Bonifacio,
Taguig City

12 IP satellite offices

- **Registration Services:**
 - Patent Cooperation Treaty
 - Madrid System
 - ISA/IPEA
 - Invention
 - Industrial Design
 - Utility Model
 - Copyright
- **Developmental:**
 - Innovation & Technology Support Office (ITSO), Technology Transfer

- **Adjudication:**
 - Adjudication of administrative cases (IP mediation, inter partes)
 - Alternative Dispute Resolution
- **Enforcement of IPR**



IP Satellite Offices

Established in selected areas in the country to provide a base for launching public awareness campaigns in key areas and make technical and advisory services readily available to enable IP stakeholders in the regions ensure the effective use of the IP system for protection and commercialization of their IP assets

VISAYAS

Iloilo
Cebu
Tacloban
Dumaguete

MINDANAO

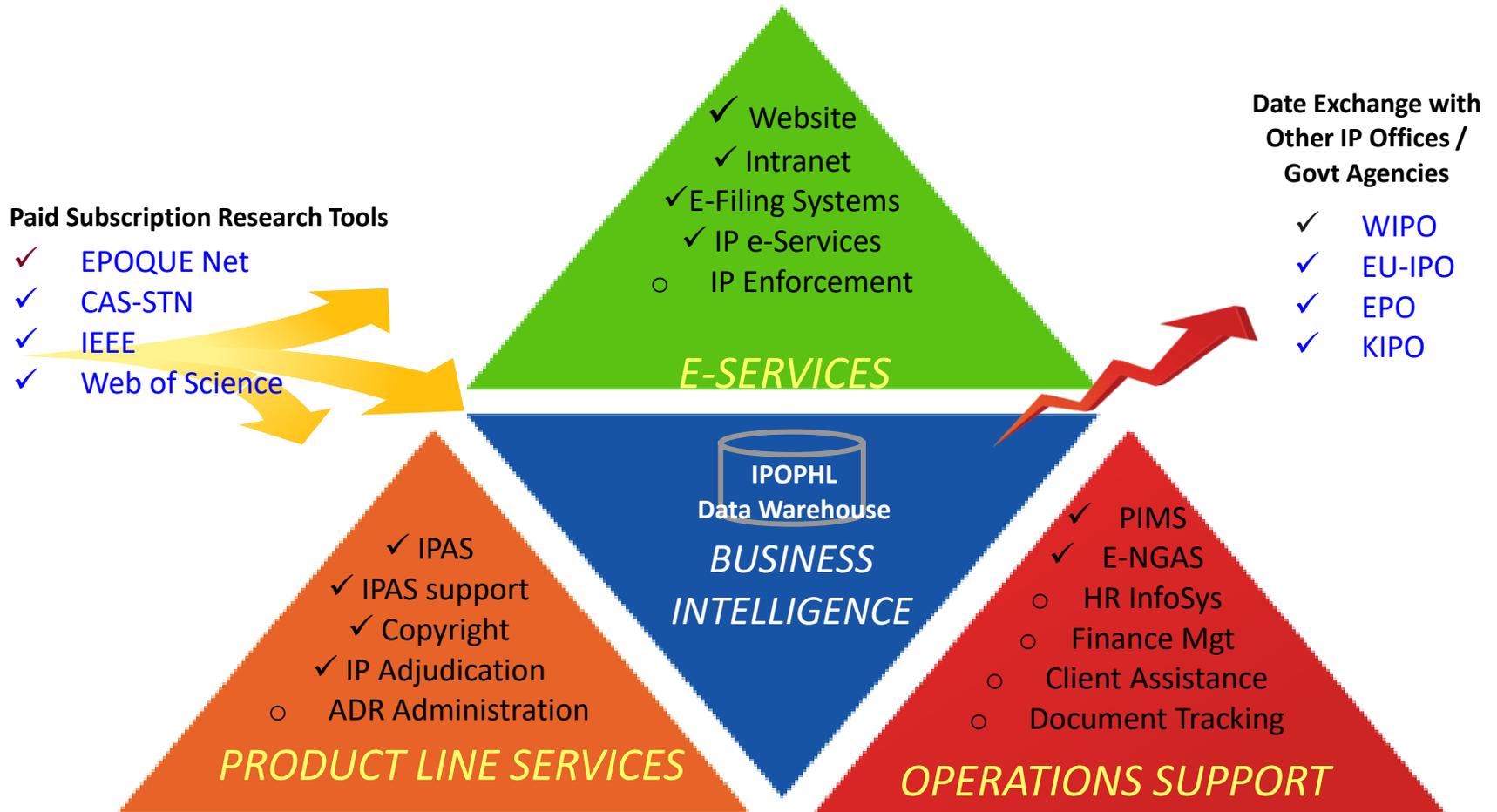
Cagayan de Oro
Davao
General Santos
Zamboanga

LUZON

Baguio
Tuguegarao
Legazpi
Pampanga
Naga
National Capital Region



IPOPHL INFO SYSTEMS CONTEXT DIAGRAM



PHILIPPINES Patent Regime

CURRENT REGIME

First to File(RA 8293)

- **First-to-File System**
- **Period of Grant of Invention, UM and ID:**
 - **Invention – 20 years from filing date or effective filing date**
 - **Utility Model – 7 years without extension**
 - **Industrial Design – 5 years and may be renewed for not more than two (2) consecutive periods of five (5) years each, by paying the renewal fee**
- **Publication:**
 - 1st Pub: 18 months after filing date**
 - 2nd Pub: After grant**

OLD REGIME

First to Invent (RA 165)

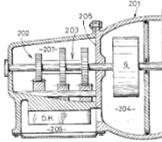
- **First-to-Invent System**
- **Period of Grant of Invention, UM and ID:**
 - **Invention – 17 years from grant**
 - **Utility Model – 5 years and may be renewed for not more than two (2) consecutive periods of five (5) years each**
 - **Industrial Design – 5 years and may be renewed for not more than two (2) consecutive periods of five (5) years each**
- **Publication: after grant**

Different Types of Intellectual Property in the Philippines

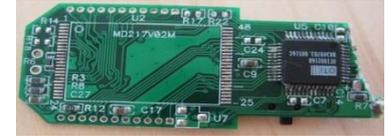


INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

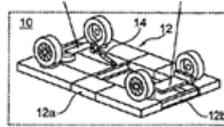
Patents



Integrated Circuit



Utility Models



Trademarks



Industrial Design



Copyright



Geographical Indication



Undisclosed
information



Cebu's Lucky Fried Mangoes photo taken in:

https://ready2biznez01.weebly.com/uploads/4/4/9/6/44964583/s184936795618356398_p3_i1_w480.jpeg

INTEGRATED CIRCUIT:

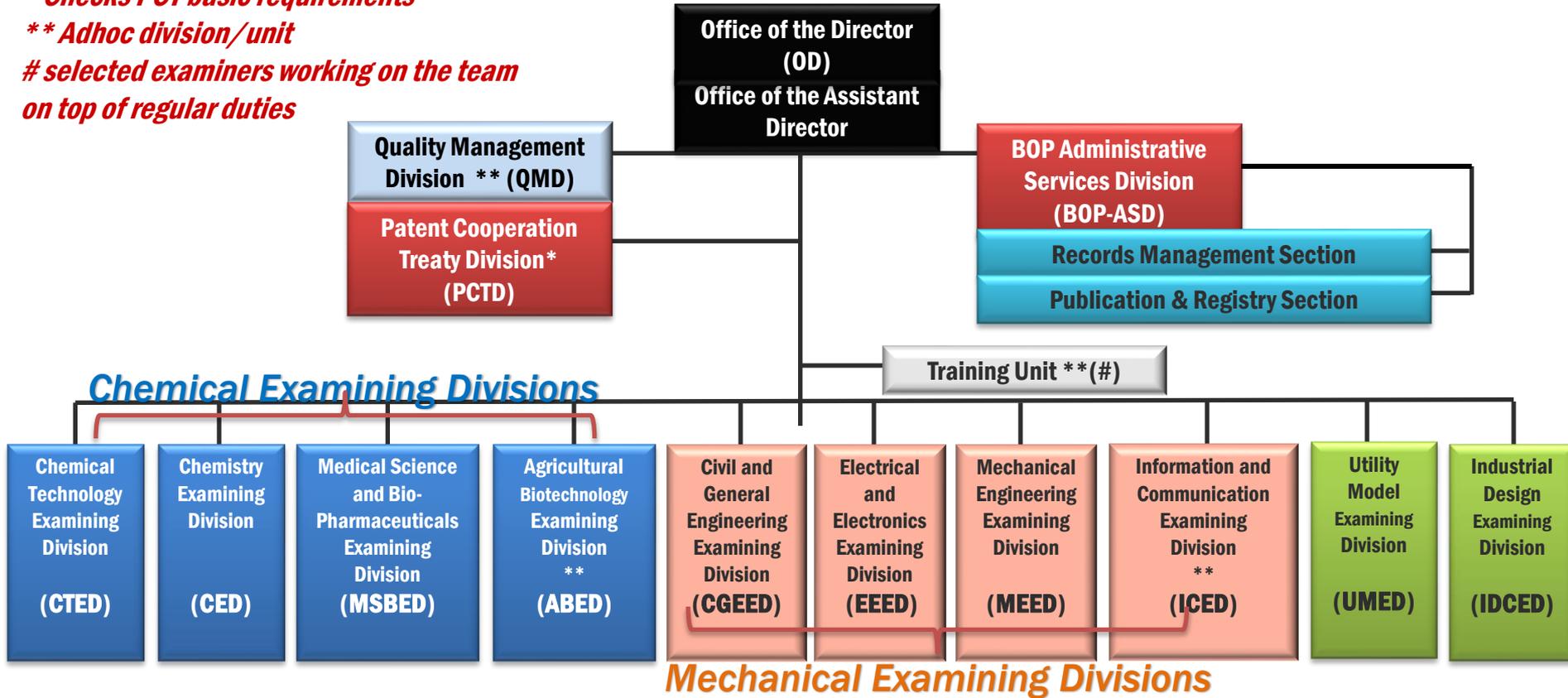
<https://www.elprocus.com/wp-content/uploads/2016/07/Integrated-circuit-design.jpg>

Organizational Structure of the Bureau of Patents

** Checks PCT basic requirements*

*** Adhoc division/unit*

*# selected examiners working on the team
on top of regular duties*



Bureau of Patents: What We do...

- Search, examination, and grant of patent applications
- Registration of utility models, industrial designs, and integrated circuits
- Conduct studies and researches in the field of patents for policy making

WHO MAY APPLY FOR PATENT?

- Natural Person
- Juridical Person
 - ❑ a body of persons, a corporation, a partnership, or other legal entity recognized by law.

Appointment of Resident Agent and Representative

- **Rule 421.** 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 for patent or the patent may be served.
- **Rule 421.1.** The application shall contain the name and contact details of the patent agent or representative. A representative or agent shall:
 - (a) Be authorized to transact business regarding prosecution or maintenance of application/access to records; and
 - (b) Address all communications, notices, and correspondence from the Office.

Appointment of Resident Agent and Representative

- If there are two (2) or more agents appointed by the applicant, the Office shall forward all actions to the last agent appointed on record. A substitute or associate attorney may be appointed by an attorney only upon the written authorization of his principal. However, a third attorney appointed by the second will not be recognized.
- A power of attorney or authorization may be revoked at any stage in the proceedings upon proper notification to the Director. Upon revocation, the Office shall communicate directly with the applicant or with such other attorney or agent which the applicant may later appoint.

PATENTABLE INVENTIONS (Rule 201, IRR)

- **A product**, such as a machine, a device, an article of manufacture, a composition of matter, a microorganism
- **A process**, such as a method of use, a method of manufacturing, a non-biological process, a microbiological process
- **Computer-Related inventions**, invention involves a computer, computer network or other programmable apparatus, with features realized wholly or partly by means of a **computer program**; and
- **An improvement of any of the foregoing**

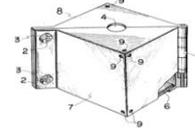
Non-Patentable Inventions (Rule 202,IRR)

1. Discoveries, scientific theories
2. Mathematical methods
3. Abstract Ideas
4. Schemes, rules and methods of
 - performing mental acts
 - playing games
 - doing business
 - programs for computers
5. Methods for treatment of the human or animal body by surgery or therapy & diagnostic methods practiced on the human & animal body



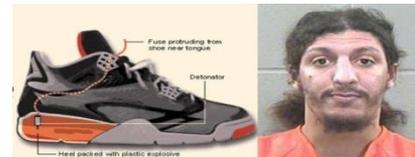
Non-Patentable Inventions (Rule 202,IRR)

6. Plant varieties or animal breeds or essentially biological processes for the production of plants and animals.



7. Aesthetic creations.

8. Anything which is contrary to public order or morality



Basic Requirements for Filing Invention

- **Rule 400,IRR. The Patent Application**
- **Can be filed in Filipino or English**



Hand written



Type written



Computer printed



Filed directly with the Bureau of Patents
= submitted to the BOP Duty Officer for New Applications



Filed by post
= mailed via the Philippine Post Office

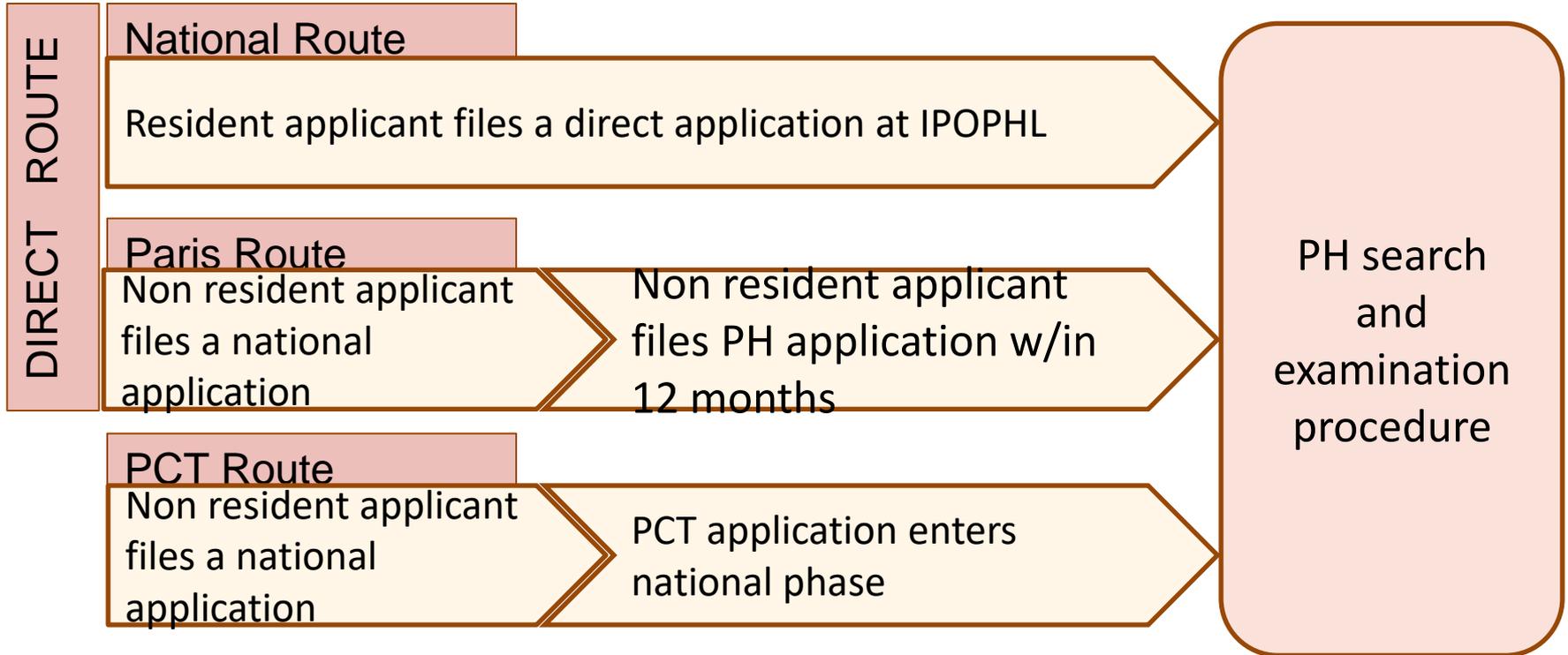


Filing in electronic format or via internet
= the office accepts electronic filing

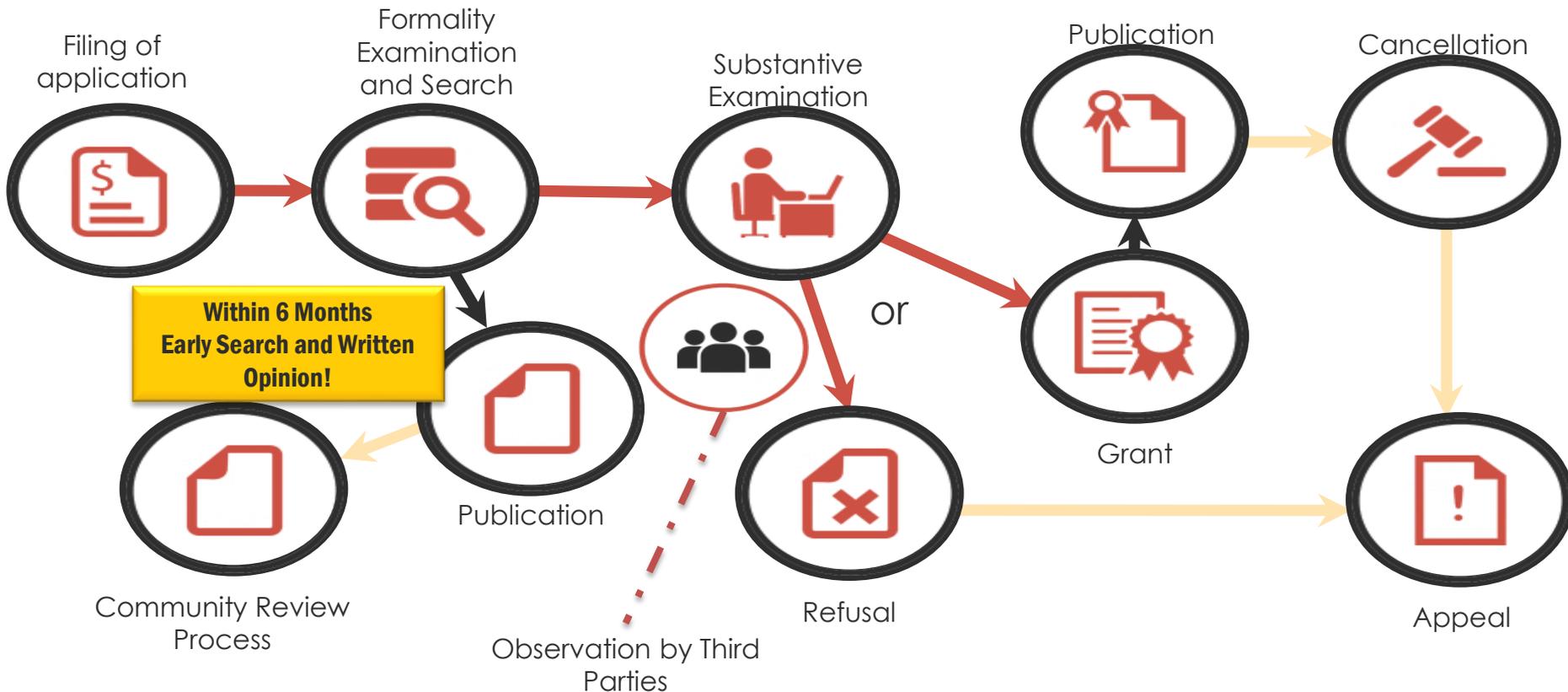


NOTE: All applications shall be addressed to the Director of Patents

Possible Routes to File a Patent

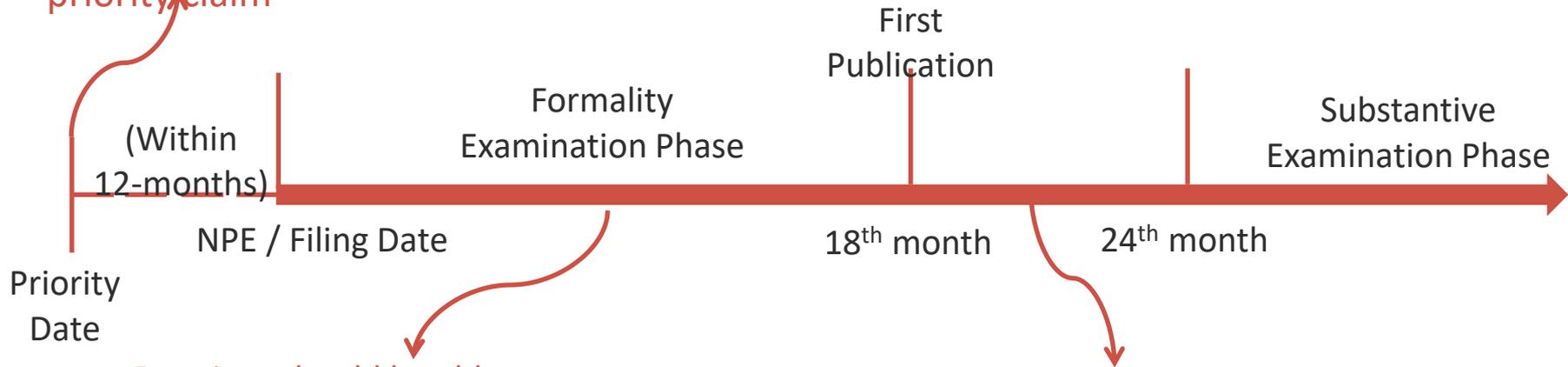


Procedure for Direct Applications



Direct Route Application Time Frame

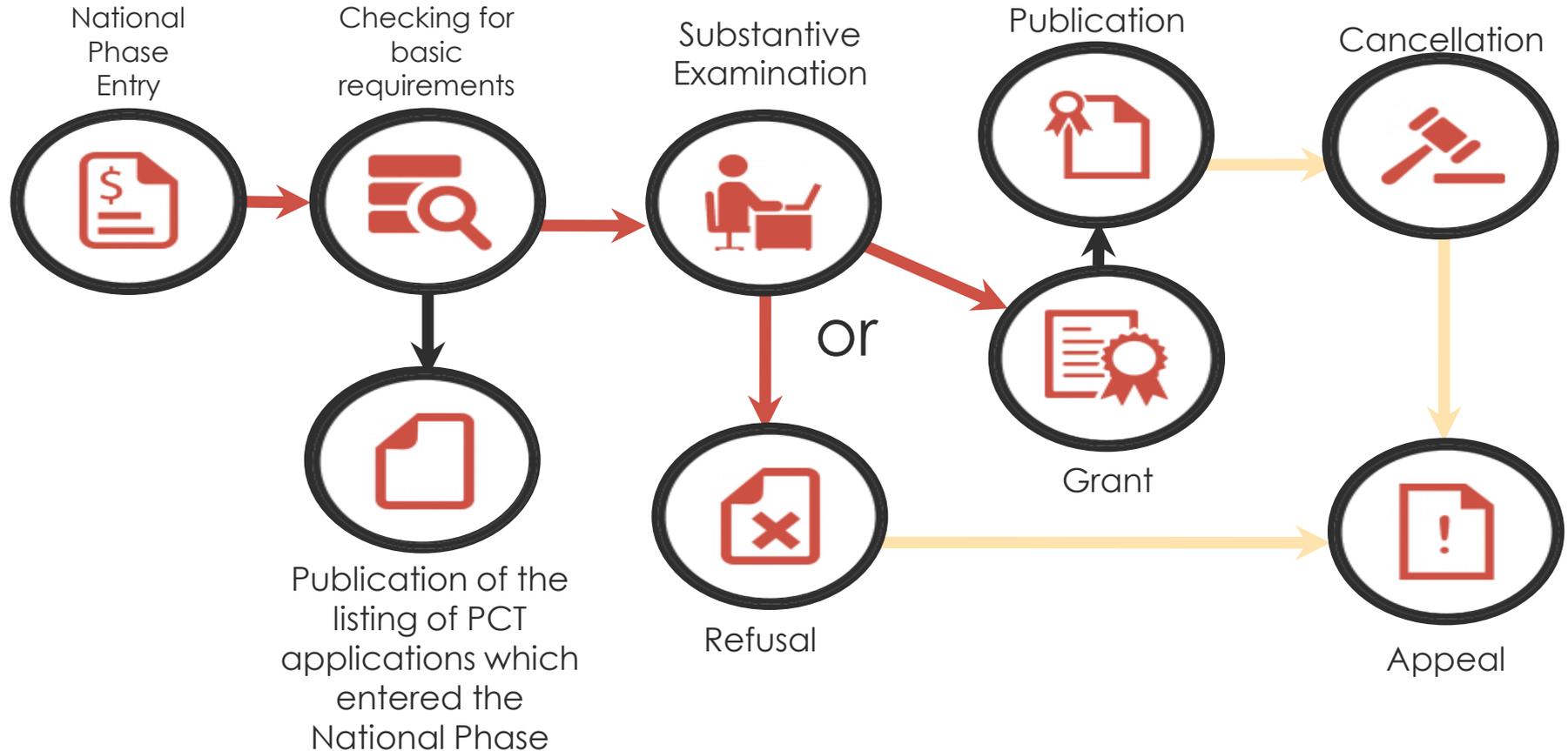
If application has a foreign
priority claim



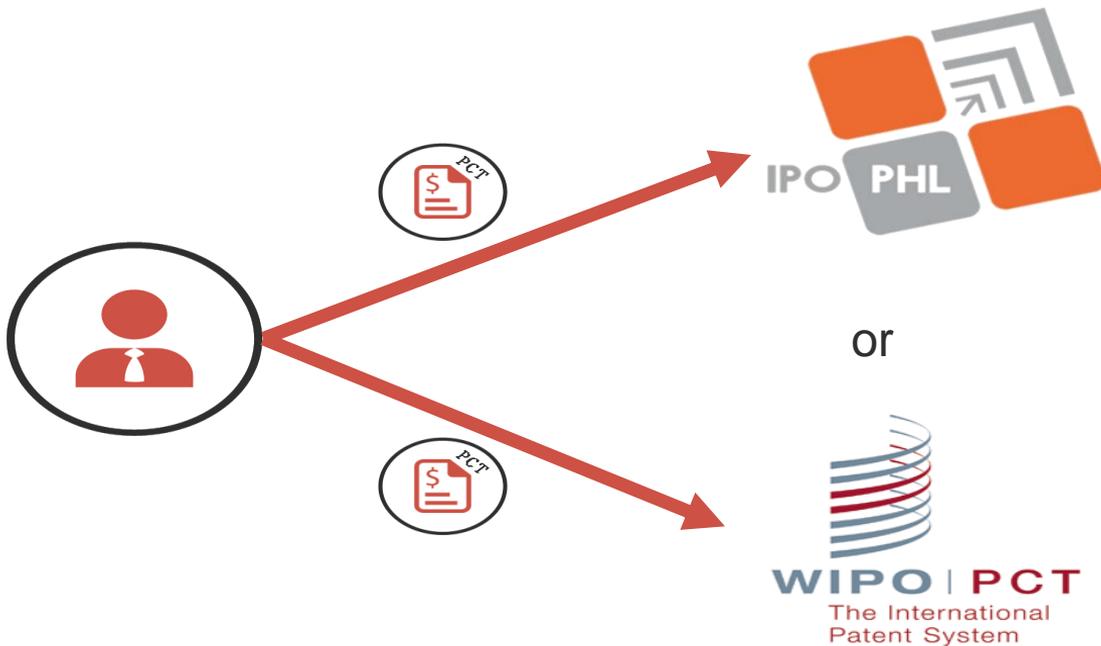
Examiner should be able to
conduct a Formality Examination,
Classification of the application,
and Search for Prior Art

If RSE is not yet paid, applicant is
given 6-months from the date of
first publication to pay the RSE.
Otherwise, application is
withdrawn

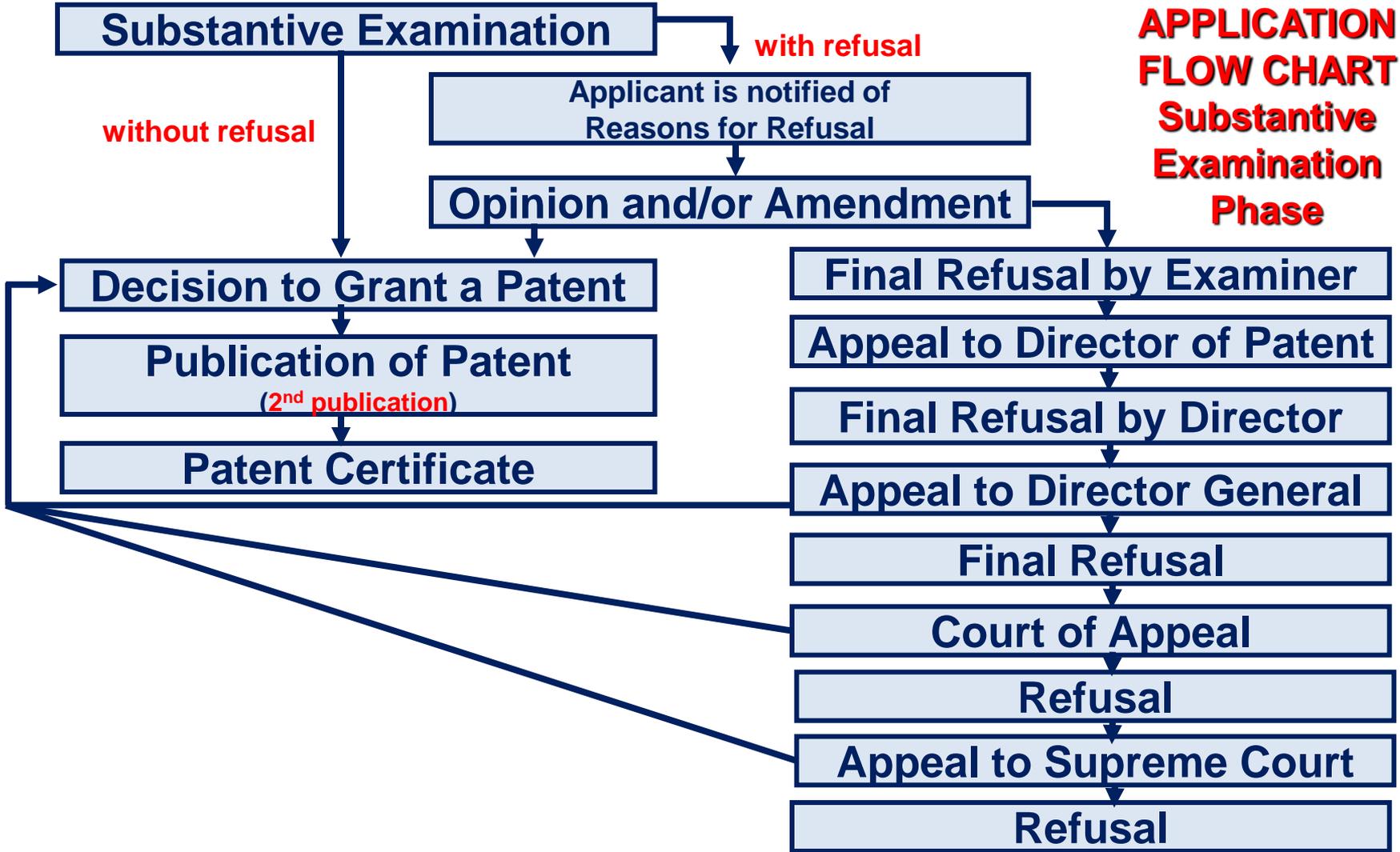
Procedure for PCT Applications



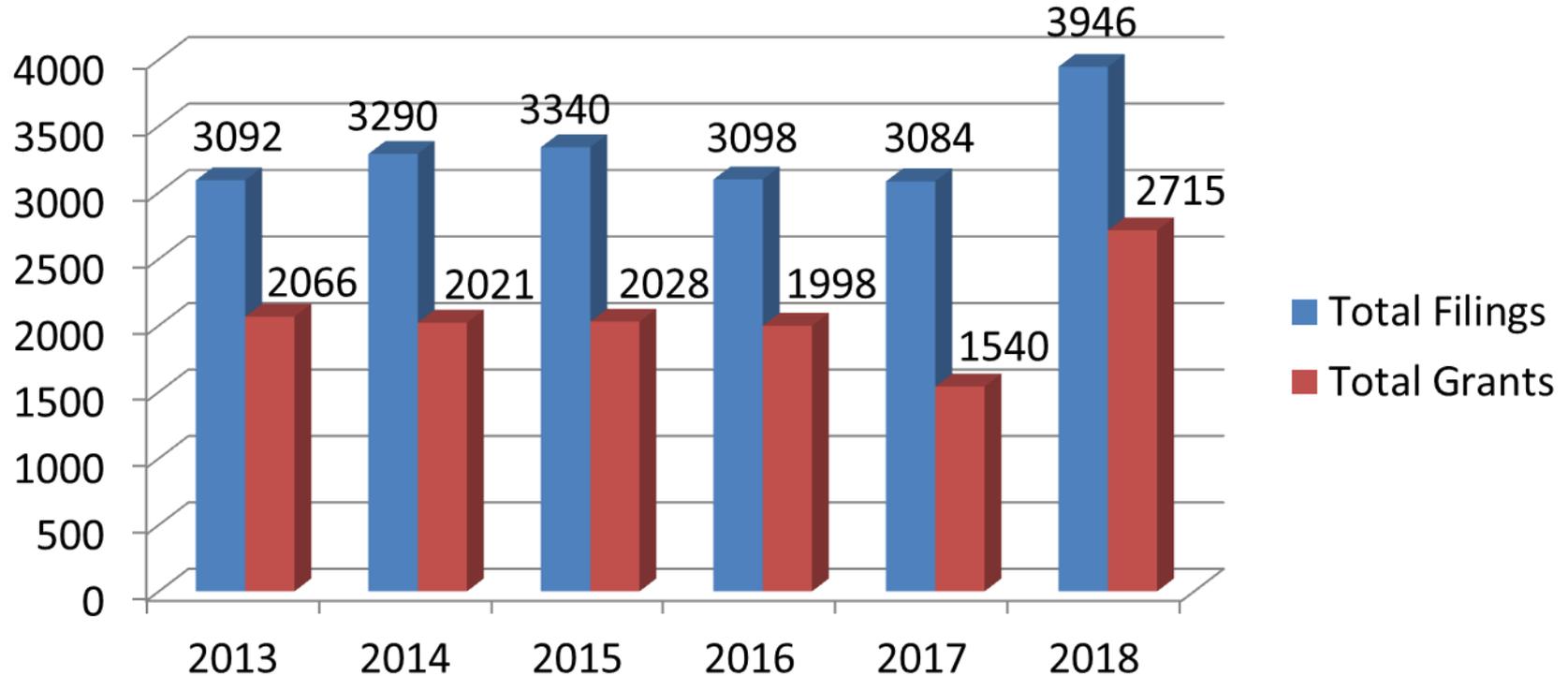
Where to File a PCT Application?



**APPLICATION
FLOW CHART
Substantive
Examination
Phase**

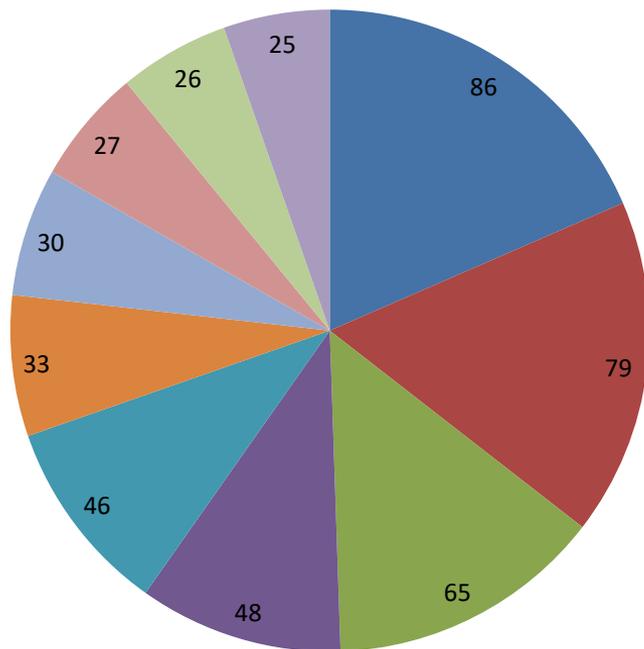


Patent Grants vs Filings



COMPANIES WITH MOST PATENT FILINGS

(2018)



- ALIBABA GROUP HOLDING LIMITED KY - Cayman islands
- NESTEC S.A. CH - Switzerland
- UNILEVER N.V. NL - Netherlands
- SUMITOMO METAL MINING CO., LTD. JP - Japan
- PHILIP MORRIS PRODUCTS S.A. CH - Switzerland
- TOYOTA JIDOSHA KABUSHIKI KAISHA JP - Japan
- GE VIDEO COMPRESSION, LLC US - United States of America
- NOVARTIS AG CH - Switzerland
- TELEFONAKTIEBOLAGET LM ERICSSON (PUBL) SE - Sweden
- HONDA MOTOR CO., LTD. JP - Japan

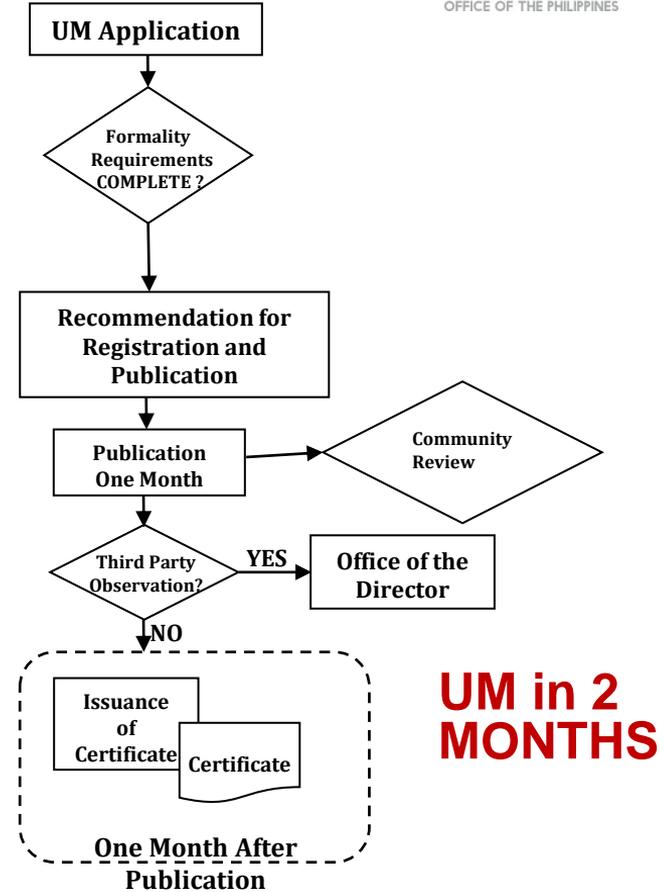
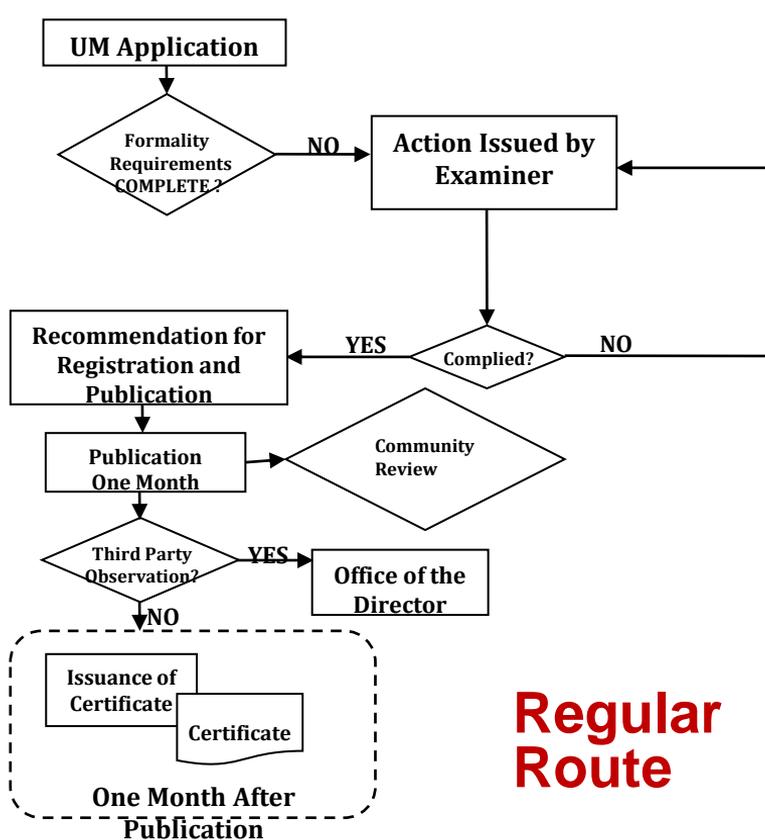
DISTINCTION BETWEEN AN INVENTION AND UTILITY MODEL



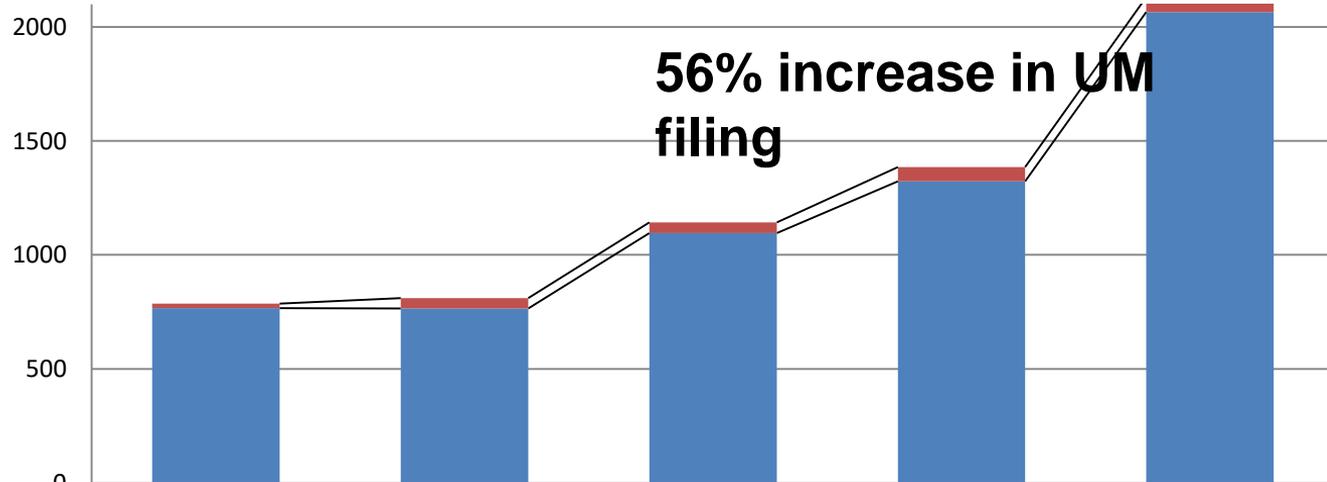
INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

Invention	Utility Model
Applications published with search report after 18 months	Published for 1 month prior to issuance of certificate
Formality Examination Substantive Examination	Formality Examination No Substantive Examination
Requires inventive step	Does not require Inventive Step
20 years from filing date	7 years from filing date
Can be enforced after grant	Enforcement is determined by the Registrability Report
With annual (maintenance) fees	No annual fees

UTILITY MODEL REGISTRATION PROCESS

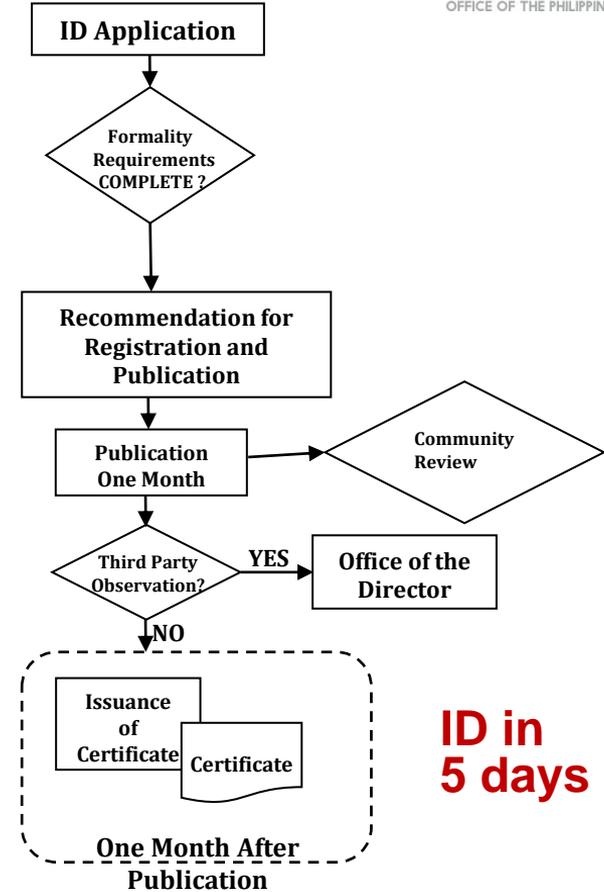
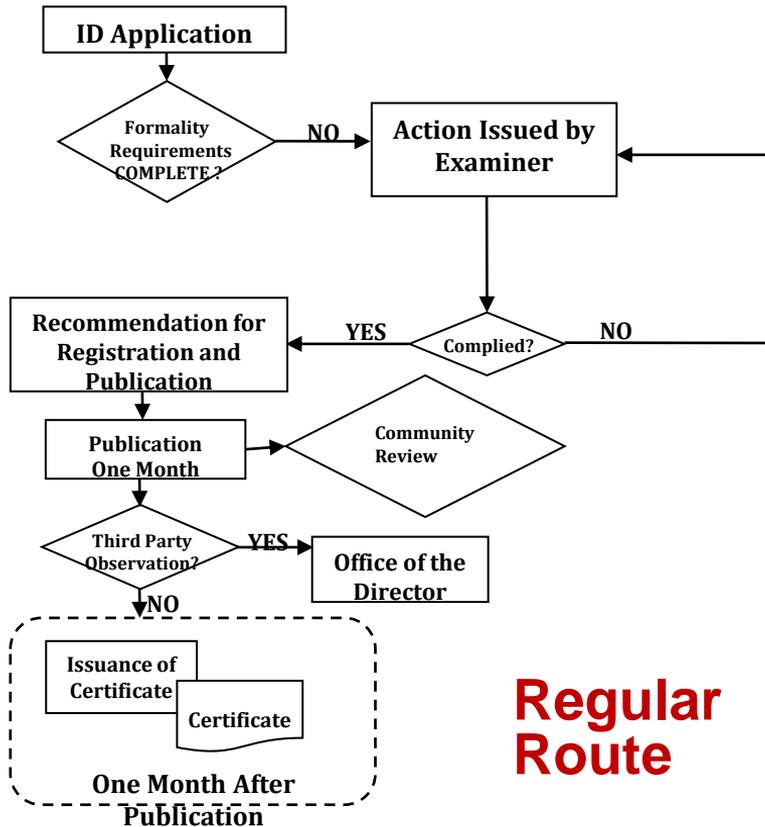


Utility Model Filings



	2014	2015	2016	2017	2018
■ Non-Resident Direct	19	46	46	62	66
■ Resident	767	765	1096	1323	2065

INDUSTRIAL DESIGN REGISTRATION PROCESS



Statistics on Industrial Designs

NUMBER OF APPLICATIONS FILED & REGISTERED

YEAR	NUMBER OF APPLICATIONS FILED & REGISTERED								
	ID Applns Received			ID in 5 Days			ID Applns Registered		
	Local	Foreign	Total	Local	Foreign	Total	Local	Foreign	Total
2010	415	432	847				318	642	960
2011	518	598	1116				326	270	596
2012	480	745	1225				529	531	1060
2013	462	875	1337	297	35	332	461	849	1310
2014	791	530	1321	266	48	314	667	452	1119
2015	529	555	1084	227	61	288	446	458	904
2016	969	519	1488	146	33	324	457	427	884
2017	679	663	1342	340	242	582	592	597	1189
2018	829	626	1455	269	126	395	332	268	600

Accelerated Examination

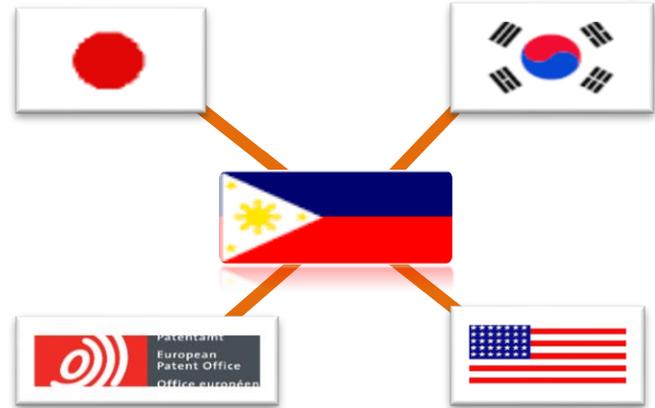
Patent Prosecution Highway (PPH)



The Patent Prosecution Highway (PPH) is a work-sharing initiative which provides patent applicants whose applications have been determined allowable by a Patent Office are entitled to request, through a simple procedure, for accelerated examination of the corresponding applications in another Patent Office.

IPOPHL website

- Must be requested before Substantive Examination has begun



Benefits:

**faster prosecution of patent applications and
acquisition of higher quality patent rights**

Accelerated Examination

ASEAN Patent Examination Cooperation (ASPEC)



Benefits:

- Obtain patents faster
- Reduce duplication
- Operates in the English language and
- FREE of charge

Patent Quality Mechanisms



In-Process

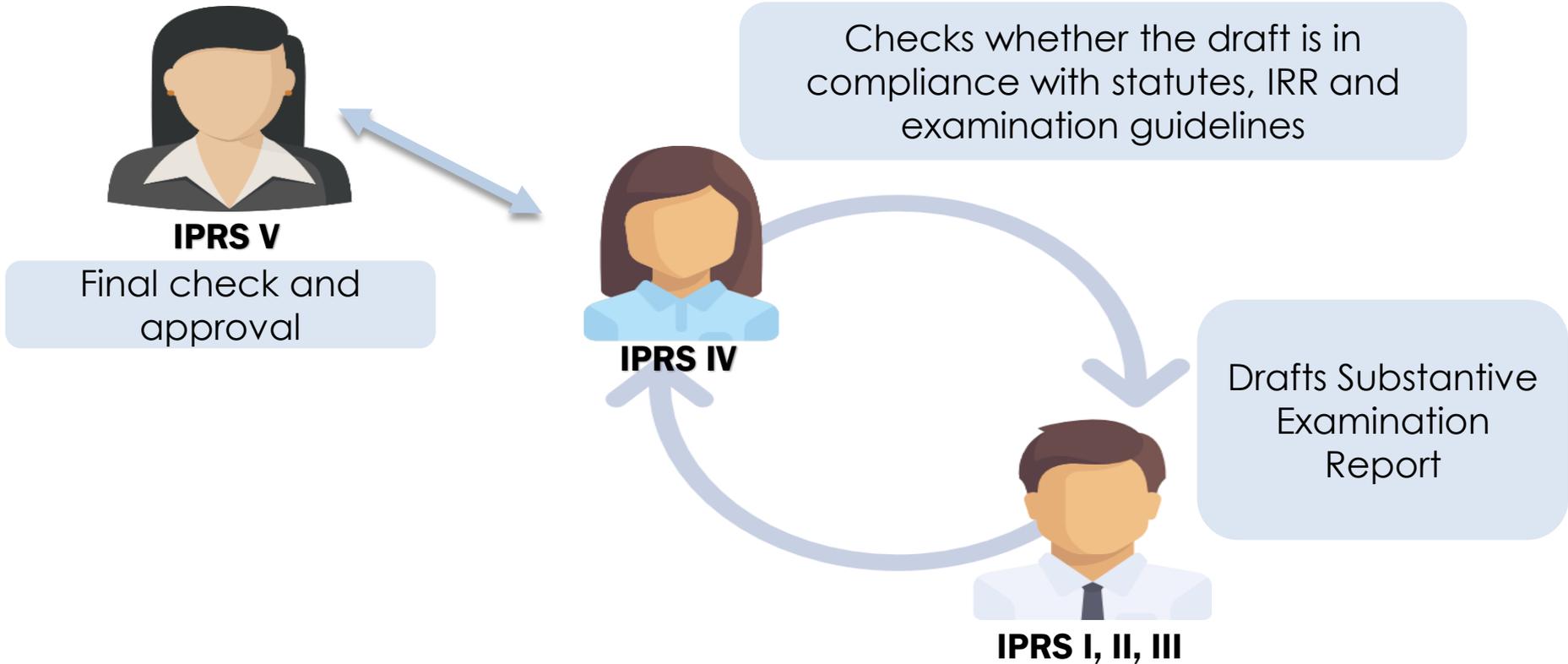


ISO QMS



**Patent Quality Review
System (PQRS)**

In-Process (within Examining Divisions)

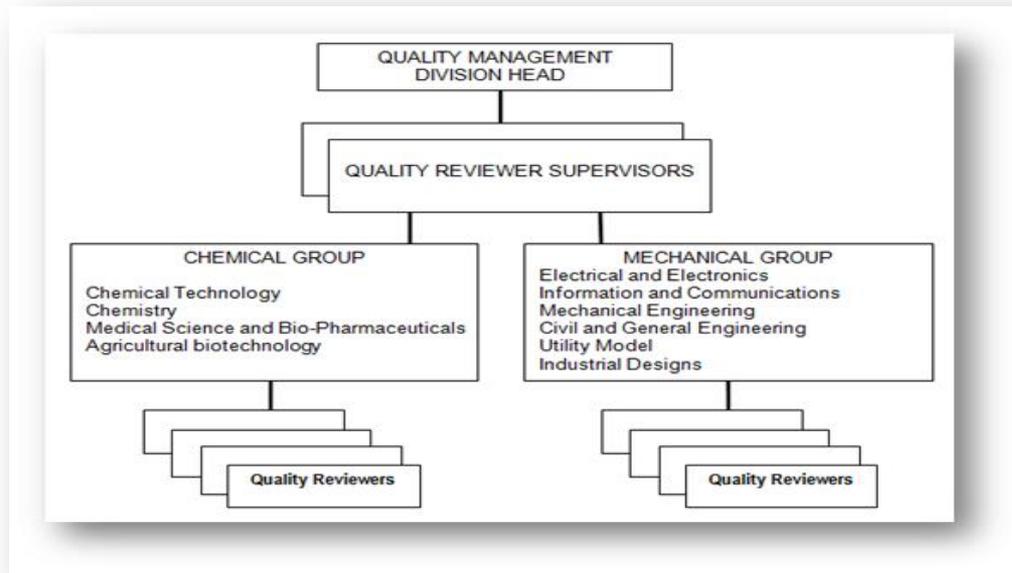


ISO Certification 9001:2015

- Covers the processes of Patents, Utility Models, Industrial Designs, and Trademarks registration
- Institutionalizes structures, mechanisms and standards for a systematic approach in managing business processes
- Provides for an internal quality audit

Patent Quality Review System

- **Quality Management Division (QMD) ensures the quality and consistency of work products such as formality, search, as well as substantive examination reports**
- **QMD reviews and checks work products of examiners**
- **Continuously update the Patent Quality Manual**
- **Recommend training needs of the examiners**



Formulation of Examination Guidelines

**Examination of
Pharmaceutical
Applications
Involving
Known
Substances**

**Revised
Implementing
Rules &
Regulations**

***Manual of
Patent
Examination
Practice***

***Examination
Guidelines for
Applications in
the Field of
Biotechnology
(2017)***

**Examination
Guidelines for
Computer- &
ICT-Related
Applications
(2017)**

INTERNATIONAL SEARCHING AUTHORITY/INTERNATIONAL PRELIMINARY EXAMINATION AUTHORITY (ISA/IPEA)

- ❖ 23RD ISA/IPEA in the world
- ❖ 2nd in the ASEAN Region



IPOP HL Director Josephine R. Santiago (center) is shown with IPOP HL Director of Patents Lolibeth R. Medrano (right) and Ambassador Evan P. Garcia (left) at WIPO Assembly

Appointment endorsed by Japan Patent Office and Australian Patent Office

- Over 70 years of experience of patent search and substantive examination
- Extensive experience as a PCT Receiving Office
- Patent Examination Practice Comparable to International Standards (PCT)

EARLY SEARCH REPORT (ESR) and WRITTEN OPINION (WO):

2018 Best Government Practice Awarded by the Development Academy of the Philippines

SEARCH REPORT (SR)



A document citing prior references relevant to the patentability of the invention.

WRITTEN OPINION (WO)



Interpretation of the findings of the Search Report

FEATURES

- expedited service, no need for request
- without additional cost
- **Search Reports issued within 6 months instead of 18 months or longer**
- applicants have 6 more months to decide whether to file an international application (Patent Cooperation Treaty) which needs to be filed within 12 months from filing date
- covers Filipino and foreign applications first filed with IPOPHL.

ESR & WO: Innovating Patent Administration

IPOPHL is the only IP Office in ASEAN Region adopting this best practice in the service of local inventors

- Drastic reduction in Search Report preparation, from 18 months or longer to only 6 months, Applicant need not request
- Same number of patent examiners
- Same subscription to proprietary databases
- Similar IT tools
- ESR & WO mailed to applicants. SR published on the 18th month. The WO is an added service to assist applicants to ascertain their chance of securing a patent.

Innovation Drawn From
European Patent Office
(EPO)

Inspired by the EPO's practice of issuing Extended European Search Report (EESR) with Written Opinion within 6 months from filing date. Applicant has to request.

EPO - one of the 5 biggest IP Offices in the world and an established international authority of the PCT.

ESR & WO: Innovating Patent Administration



IPOPHL Doing ESR & WO with Less

- 112 patent examiners
- limited IT tools & systems
- limited subscription to databases

Pilot implementation in November 2016

full implementation starting in 2018

ESRs & Written Opinions Issued

146 of 182 applications

filed from July – December 2017

191 of 239 applications

filed from January – June 2018

Around 80%

Pilot 2016 – 26%

Pilot 2017 – 52%, 69%

Competency-Based Training Program for Patent Examiners

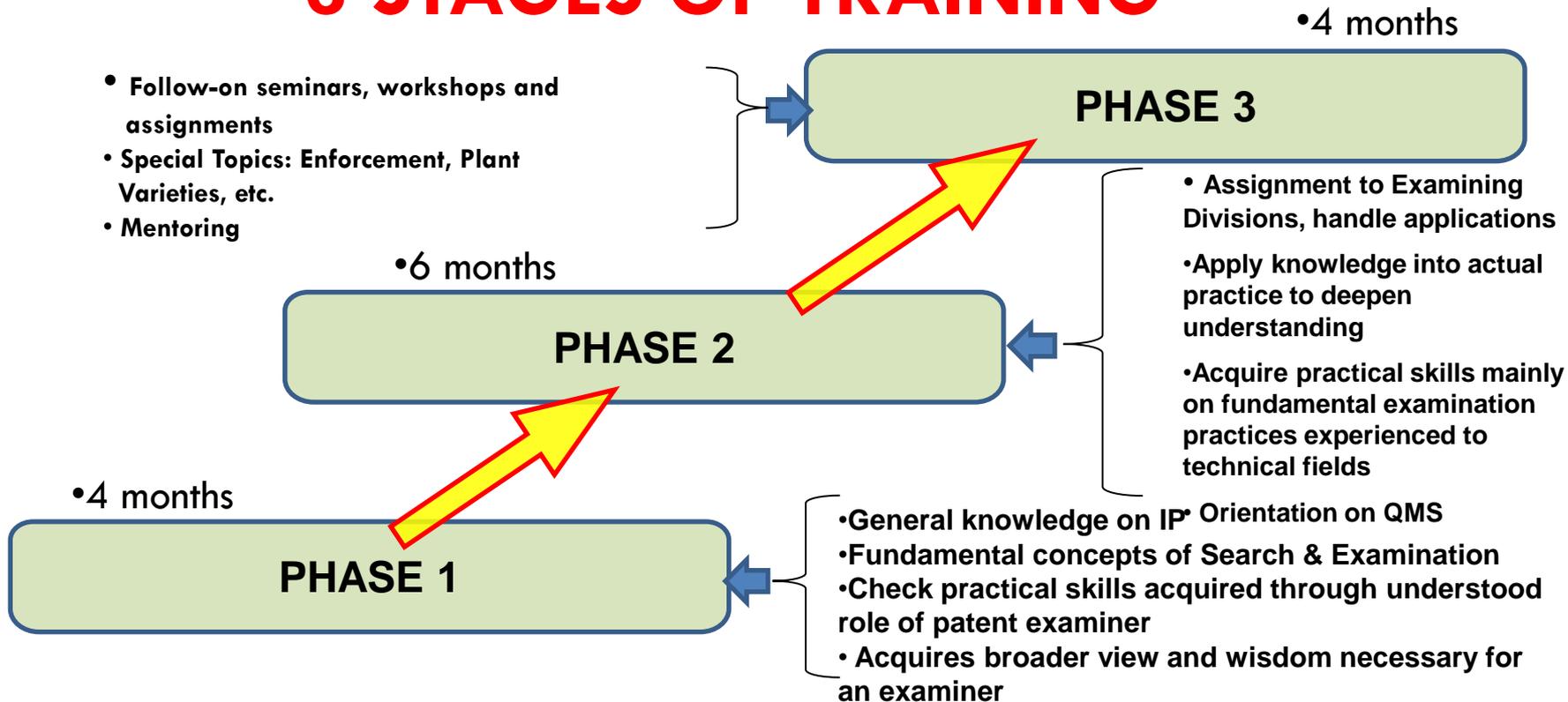
IPOPHL PATENT EXAMINERS SKILLS TRAINING (IPEST)

- For **new** recruits
- 3 phases
- Assistance from IP Australia
(Developed under REGIONAL PATENT EXAMINATION MENTORING PROGRAM)

Continuous Training Program

- Advanced trainings, workshops, and seminars.
- Updates on patent-related legislation, practices and procedures, plant visits to industries employing advanced technologies.
- **Capacity building activities** on search and examination in partnership with other IP Offices such as USPTO, EPO, JPO as well as WIPO
- **Scholarship** for advanced academic studies

3 STAGES OF TRAINING



FILING FEES

Type of Fee	Small Entity	Big Entity
Filing Fee (inclusive of 5 claims)	Php 2,000.00	Php 4,320.00
Excess Claims (per claim)	Php 180.00	Php 360.00
First Publication	Php 920.00	Php 960.00
Second Publication	Php 920.00	Php 960.00
Issuance	Php 600.00	Php 1,200.00

plus 1% Legal Research Fund

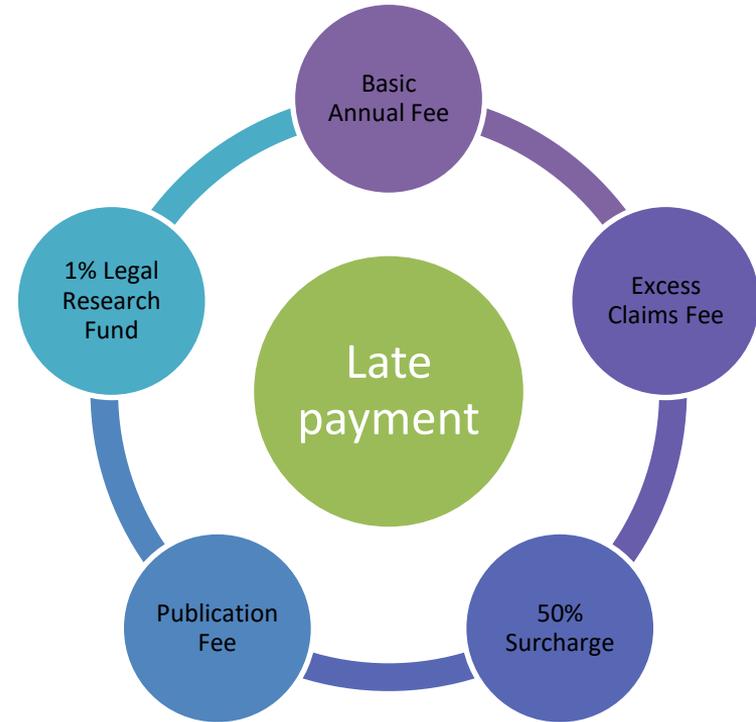
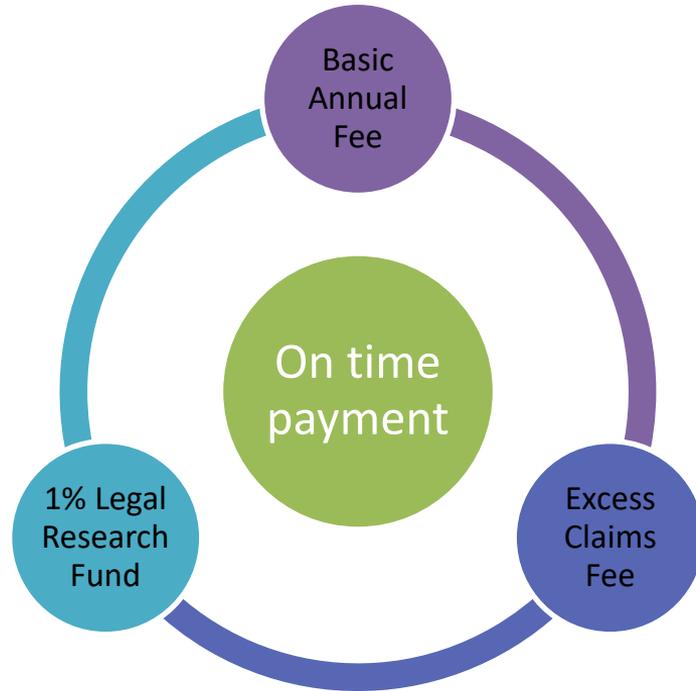
within one (1) month from date of filing

FILING FEE

Student/Youth Filer's discount
(21 years and below)

75 % OFF!
on all fees under big entity

ANNUAL FEES



CHALLENGES/DEVELOPMENTS



PCT Filing Assistance Program
Search and preliminary examination fees will be waived for the **first 100 international search requests.**

Save as much as \$600 for small entities, \$1,500 for big entities **APPLY NOW**

Program runs from May 20 to December 31, 2019 or after 100 requests for ISRs have been filed, whichever comes first.

[f](#) [t](#) [in](#) [@](#) [v](#) IPOPHL | www.ipophil.gov.ph

IPOPHL shall provide the PCT Filing Assistance:

- Waive IPOPHL Search Fee of US\$400 for small entities and US\$1,000 for big entities;
- Waive IPOPHL Preliminary Examination Fee of US\$ 200 for small entities and US \$500 for big entities; and
- Provide information and technical consultation regarding the PCT system and process.

Eligible for the PCT Filing Assistance Program:

- Individual Filipino inventor/applicant;
- Higher Education Institutions which are members of the Innovation and Technology Support Offices(ITSO)network;and,
- Foreign inventor/applicant from States included in the WIPO List of Eligible Nationals or Residents for 90% Reduction in Certain PCT Fees where IPOPHL is the Office of First Filing from January – December 2019 which designated IPOPHL as a competent International Searching and Preliminary Examining Authority (ISA/IPEA).

CHALLENGES/DEVELOPMENTS

Patent/Utility Model/Industrial Designs Women Incentive Package (also known as “*Juana Invent/UM/ID*”)

Waive Fees in favour of One Thousand (1000) qualified Applicants the following fees:

- a. Filing Fees for Invention/UM/ID applications;
- b. Filing Fees for excess claims/ additional embodiments for ID;
- c. First (1st) Publication Fee; and
- d. Priority Fee, if any.

- All other fees shall be paid for by the Applicant.

Eligible for the Incentive Package:

Philippine Nationals only or Philippine Micro-, Small-, and Medium- Sized Enterprises only



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

*Towards a Creative
and Innovative Philippines*

Contact Us:

Trunkline: (+632) 238.6300

Public Information Desk Local: 5405 to 5406

Website: www.ipophil.gov.ph

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<https://twitter.com/ipophl>