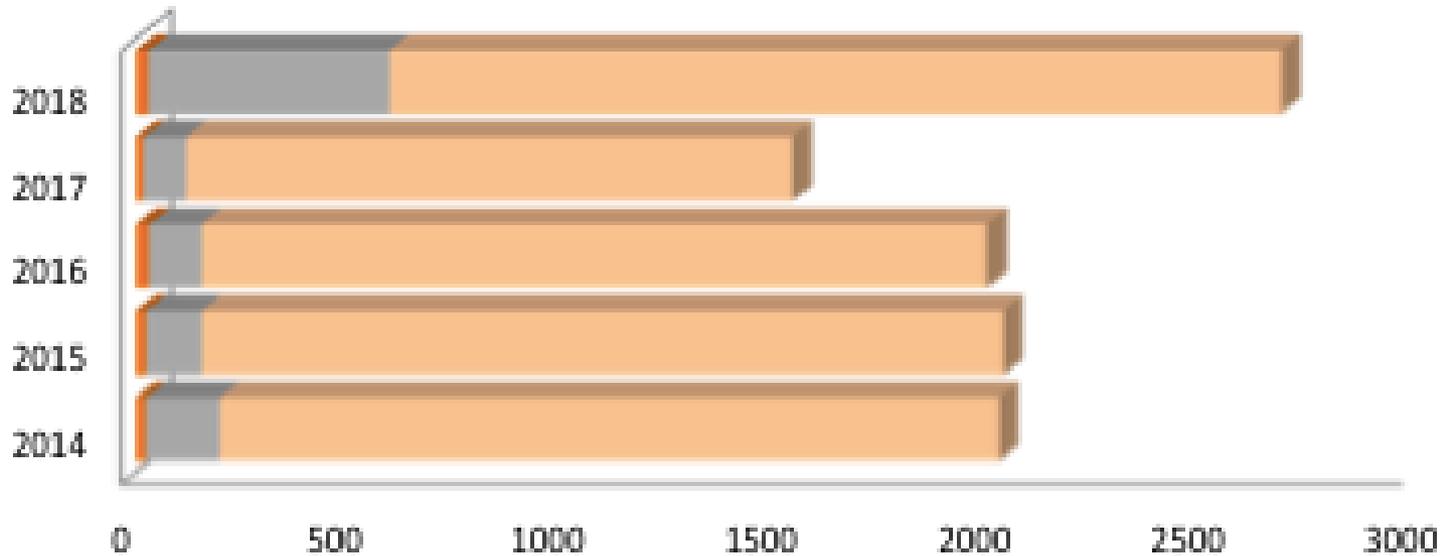


Patent matters of concern when investing in Philippines



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Patent Grants



	2014	2015	2016	2017	2018
Resident	23	24	31	18	29
Non-Res Direct	174	130	123	99	565
PCT	1822	1875	1837	1420	2088

From IPOPHL website

Obtaining Registrations

Choosing between a Patent Invention
or a Utility Model



Obtaining Registrations

Invention or Utility Model?

a. Cost to register

Annuity Fee

Big Entity / Small Entity / Youth filer



Obtaining Registrations

Invention or Utility Model?

b. Length of protection

20 years vs. 7 years



Obtaining Registrations

Invention or Utility Model?

c. Determine reason for getting a patent

Enforcement is immediately needed?

Are you building a patent portfolio? (for licensing, transfer, enforcement against competitors, defense [counter-claim] against accusations of infringements)



Rights prior to registration

Inchoate Rights – can only sue upon registration and recover damages 4 years prior to filing of the complaint



Conversion of Invention to UM

Patent Invention to UM

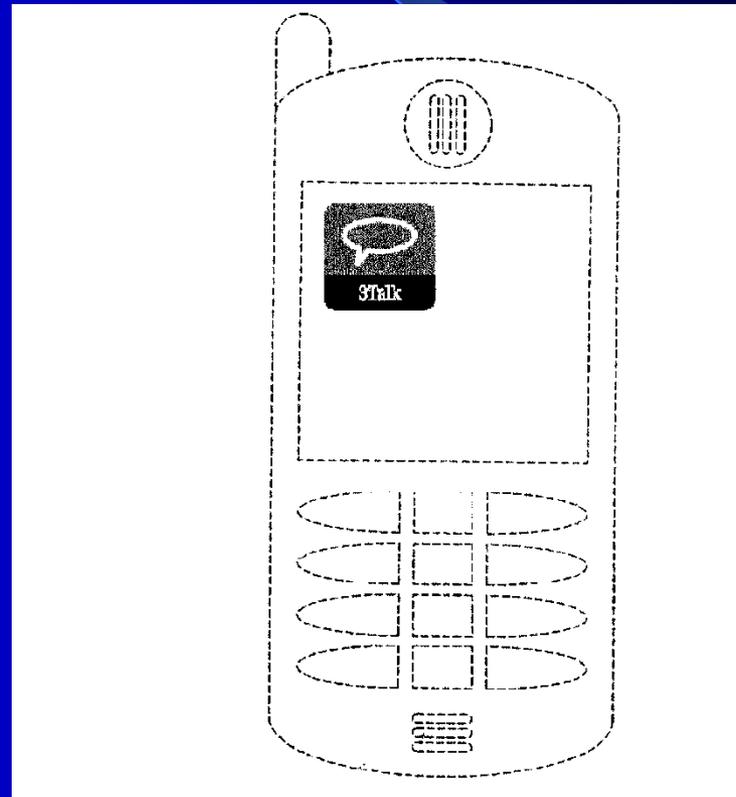
UM to Patent Invention



Design Registrations

icons

GUI



Expediting the patent prosecution process



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A. Early publication

After 6 months (but before 18 months) from filing date



B. ASPEC Request

ASPEC Countries:

Brunei

Cambodia

Indonesia

Lao PDR

Malaysia

Philippines

Singapore

Thailand

Vietnam



ASPEC: Actual Case

PCT National Phase Entry: 2017

ASPEC Request (based on Singapore): January 2019

1st Substantive Examination Report: February 2019

Registration Date: July 09, 2019

Total time from ASPEC Request: 6 months



C. PPH Request

Countries available:

Japan (JPO)

US (USPTO)

Korea (KIPO)

Europe (EPO)



Enforcement of Patents

Remedies/Actions available:

a. Civil/Administrative case

b. Criminal case (2nd offense)

c. Temporary Restraining Order/Preliminary Injunction

d. Search Warrant (even if civil/administrative case)



Enforcement concerns

Better to file cases with the IP Office or with the Regular Courts?

- a. Damages that can be awarded
- b. Venue
- c. Expertise in IP law
- d. TRO/Preliminary Injunction
- e. Search Warrant
- f. Degree of proof required
- g. Length of time before case reaches decision



Enforcement concerns

- h. Expert witness
- i. Invalidity as a defense
- j. Notice required for damages



Enforcement concerns

a. Damages that can be awarded

Damages – actual damages / reasonable royalty, attorney's fees, expenses of litigation



Enforcement concerns

b. Location/Venue

IPO

Regular Courts – address of plaintiff or defendant



Enforcement concerns

c. Expertise in IP law

IPO – specialized court

Regular Courts – Specialized Commercial
Courts



Enforcement concerns

d. TRO/Preliminary Injunction

IPO

Regular Courts



Enforcement concerns

e. Search Warrant

SW for Regular Courts only

Subsequent infringement case – IPO or
Regular Courts



Enforcement concerns

f. Degree of proof required

IPO – substantial evidence

Regular Courts – preponderance of evidence



Enforcement concerns

g. Length of time before case reaches decision

IPO - mediation

Regular Courts – mediation and JDR



Enforcement concerns

Other concerns in enforcement of patents

- a. Invalidity as a defense
- b. Counterclaims
- b. Notice required for damages
- c. Formal requirements – verification, authentication



Enforcement concerns

Other concerns in enforcement of patents

a. Invalidity as a defense

Novelty

Inventive Step



Enforcement concerns

Other concerns in enforcement of patents

b. Counterclaims

Damages

Infringement



Case Study: Defense of having own registration

Nature of the Case: Industrial Design Infringement

Facts of the Case:

- **Complainant filed a design infringement case against Defendant.**
- **Both parties have industrial registrations for their respective products.**



Ruling of the IPO: Defendant did not commit industrial design infringement.

Ratio:

- Designs involved do not appear similar**
- Since Defendant holds a valid industrial design registration, a direct action for cancellation, i.e., Petition for Cancellation, should have been filed first for the Infringement to proceed.**



Enforcement concerns

Other concerns in enforcement of patents

c. Notice required for damages

Notice of Registration must be on the product or actually given to defendant

cease & desist letter considerations



Enforcement concerns

Other concerns in enforcement of patents

d. Formal requirements –

Verification

Authorization by corporation (Sec Cert)

Authorization to lawyers

Notarization & Authentication – consider in
defining timeline for the enforcement
action



General IP enforcement concerns

Apart from infringement cases, remedies available to enforce IP are:

- a. Customs enforcement
- b. IPO Visitation



Anti-Trust / Competition Issues

Obtaining Market Dominance through IP
rights

Abuse of Dominant Position and IP rights



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Licensing Concerns

Mandatory and Prohibited clauses

- a. Philippine laws
- b. Arbitration venue is Philippines or neutral country
- c. Philippine taxes borne by licensor



Licensing Concerns

Mandatory and Prohibited clauses

- d. Licensee not required to transfer improvements to invention to licensor
- e. Restricting licensee to use technology after the expiration of the contract
- f. Restricting licensee from contesting the validity of the licensor's patent



Licensing Concerns

Registration of License Agreement

Can make agreement unenforceable

Pre-Clearance allowed



Thank you!

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