

09 March 2018

**Mr. FRANCIS GURRY**

Director General  
World Intellectual Property Organization  
34, chemin des Colombettes  
1211 Geneva 20, Switzerland

Dear **DG Gurry**:

This refers to the Circular Note C. 8728 dated 9 February 2018 concerning matters from the decision at the SCP/27 held last 11-15 December 2017.

We thank WIPO for this opportunity to provide information regarding information on the existing national patent laws.

In this regard, we submit the following responses /requested information relative to the document SCP/27/9, paragraph 25:

Examination Guidelines/Manuals

IPOPHL has completed and made available in its website the following patent examination manuals and guidelines:

- Manual for Patent Examination Procedure (MPEP);
- Guidelines on the Examination of Information Communications Technology and Computer-Implemented Inventions;
- Guidelines on the Examination of Biotechnological Applications;
- Revised Guidelines on the Examination of Pharmaceutical Applications Involving Known Substances (Quality Universal Accessible Medicines Act).

These manuals and guidelines have been adopted starting January 2018, and are accessible through our official website, under services on patents, or specifically at <http://www.ipophil.gov.ph/services/patents/examinatio-procedures-and-guidelines>

Provisions of National Law on Prior, Novelty, Inventive Step, Sufficiency of Disclosure, Description, Exclusions from Patentable Subject Matter, Exceptions and Limitations of the rights are as follow:

Sec. 24 of Republic Act 8293 defines prior art as:

Prior art shall consist of:

24.1. Everything which has been made available to the public anywhere in the world, before the filing date or the priority date of the application claiming the invention and

24.2. The whole contents of an application for a patent, utility model, or industrial design registration, published in accordance with this Act, 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 this Act, 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. 23 of Republic Act 8293 defines Novelty as:

An invention shall not be considered new if it forms part of the prior art.

- Sect. 26 of Republic Act 8293 defines Inventive Step as:

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. 25 of Republic Act 8293 provides for non-prejudicial disclosure as:

Non-Prejudicial Disclosure. —

25.1. 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 patent 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.

25.2. For the purposes of Subsection 25.1, "inventor" also means any person who, at the filing date of application, had the right to the patent.

- Sec. 35 of Republic Act 8293 provides for Sufficiency of Disclosure as:

Disclosure and Description of the Invention. —

35.1. Disclosure. — The application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. Where the application concerns a microbiological process or the product thereof and involves the use of a micro-organism which cannot be sufficiently disclosed in the application in such a way as to enable the invention to be carried out by a person skilled in the art, and

such material is not available to the public, the application shall be supplemented by a deposit of such material with an international depository institution.

35.2. Description. — The Regulations shall prescribe the contents of the description and the order of presentation.

- Sec. 22 of Republic Act 8293 provides the Exclusions from Patentable Subject Matter as:

Non-Patentable Inventions. — The following shall be excluded from patent protection:

22.1. Discoveries, scientific theories and mathematical methods, and in the case of drugs and medicines, the mere discovery of a new form or new property of a known substance which does not result in the enhancement of the known efficacy of that substance, or the mere discovery of any new property or new use for a known substance, or the mere use of a known process unless such known process results in a new product that employs at least one new reactant;

For the purpose of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations, and other derivatives of a known substance shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy;

22.2. Schemes, rules and methods of performing mental acts, playing games or doing business, and programs for computers;

22.3. 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 composition for use in any of these methods;

22.4. Plant varieties or animal breeds or essentially biological process for the production of plants or animals. This provision shall not apply to micro-organisms and non-biological and microbiological processes.

Provisions under this subsection shall not preclude Congress to consider the enactment of a law providing sui generis protection of plant varieties and animal breeds and a system of community intellectual rights protection:

22.5. Aesthetic creations; and

22.6. Anything which is contrary to public order or morality.

- Sec. 72 of Republic Act 8293 provides the Exceptions and Limitations of the Rights as:

Limitations of Patent Rights. — The owner of a patent has no right to prevent third parties from performing, without his authorization, the acts referred to in Section 71 hereof in the following circumstances:

72.1.Using a patented product which has been put on the market in the Philippines by the owner of the product, or with his express consent, insofar as such use is performed after that product has been so put on the said market; enumerate

72.2.Where the act is done privately and on a non-commercial scale or for a non-commercial purpose: Provided, That it does not significantly prejudice the economic interests of the owner of the patent;

72.3.Where the act consists of making or using exclusively for the purpose of experiments that relate to the subject matter of the patented invention;

72.4.Where the act consists of the preparation for individual cases, in a pharmacy or by a medical professional, of a medicine in accordance with a medical prescription or acts concerning the medicine so prepared;

72.5.Where the invention is used in any ship, vessel, aircraft, or land vehicle of any other country entering the territory of the Philippines temporarily or accidentally: Provided, That such invention is used exclusively for the needs of the ship, vessel, aircraft, or land vehicle and not used for the manufacturing of anything to be sold within the Philippines.

#### National law on Opposition Systems

Republic Act 8293 provides for opposition systems and other administrative revocation and invalidation mechanisms, the following pre-grant provisions apply:

Sec. 47, RA 8293: Observation by Third Parties. –

Following the publication of the patent application, any person may present observations in writing concerning the patentability of the invention. Such observations shall be communicated to the applicant who may comment on them. The Office shall acknowledge and put such observations and comment in the file of the application to which it relates.

Rule 802 (Revised IRR). Community Review of Patent Applications. – In the interest of transparency in granting patents and quality of patents granted, the concerned community shall be notified by the Office upon publication of the patent application.

For utility model and industrial design applications, the following regulations apply:

Rule 1700. Community Review of the Utility Model and Industrial Design Applications. – In the interest of transparency in registering utility models or industrial designs and quality of utility models or industrial designs registered, the concerned community shall be notified by the Office upon publication of the utility model or industrial design applications.

Rule 1701. Adverse Information. – Within thirty (30) days from the date of publication of the utility model or industrial design application, any person may present written adverse information concerning the registrability of the utility model or industrial design including matters pertaining to novelty and industrial applicability while citing relevant prior art. The adverse information shall be in the form of a sworn statement stating the personal information and circumstance of the affiant and the grounds for objecting to the registration. The sworn statement shall be substantiated by evidence or proof and a registrability report of the application may be attached thereto. The Office shall not consider any submission that fails to comply with the foregoing requirements. Additionally, a conference at the Office may be requested by the interested party to obtain a better understanding of the application, the registration process, and the registration system in general. For this purpose, the party shall indicate three possible dates within thirty (30) days from request when the party is available for the conference. The Office shall acknowledge the receipt of the request for the conference and may request for additional information or clarifications on the adverse information filed. Within ten (10) days after the conference, parties may file a supplemental Adverse Information, in the form of a sworn statement, to include new information. All adverse information shall be communicated to the applicant who may comment on them within thirty (30) days from the mailing date of the communication. Copies of any adverse information filed and comments thereto by the applicant shall form part of the file wrapper in the subject application.

Only the adverse information as filed in accordance with these Regulations shall be taken into consideration in deciding the registrability of the utility model and industrial applications. The Office shall notify the parties who have submitted adverse information of the decision of the Office involving the utility model and industrial design applications.

#### Scope of Client-Attorney Privilege

There exist some national legislation that relate to the scope of protection in client-attorney relationships. Those most applicable to patent advisors are as follows:

- If the patent advisor is a lawyer:
  - the “attorney cannot, without the consent of his client, be examined as to any communication made by the client to him, or his advice given thereon in the course of, or with a view to, professional employment.” In addition, “an attorney’s secretary, stenographer, or clerk” may not testify as to “any fact the knowledge of which has been acquired in such capacity” without first securing the consent of the attorney and the client. (Rule 130 of the Rules of Court, Section 24(b))
  - It is likewise prohibited for any attorney-at-law or any person duly authorized to represent and/or assist a party to a case, who, “by any malicious breach of professional duty or of inexcusable negligence or ignorance, shall prejudice his client, or reveal any of the secrets of the latter learned by him in his professional capacity”. The penalty for such revelation of secrets is *prisión mayor* in its medium period, or

imprisonment from between 2 years, 4 months and 1 day to 4 years and 2 months, or a fine ranging from PhP40,000-PhP200,000, or both. (Revised Penal Code, Article 209, as amended by Republic Act No. 10951)

- If the patent advisor is not a lawyer, the client may take in the provisions of the Civil Code of the Philippines, which pertinent provision states:

**Article 21.** Any person who willfully causes loss or injury to another that is contrary to morals, good customs, or public policy shall compensate the latter for the damage.

We appreciate this opportunity to provide and share our existing national patent laws and practices.

Thank you for the continued support and partnership.

Sincerely,

  
**JOSEPHINE R. SANTIAGO, LL.M.**  
Director General 