



THE NATIONAL PATENT SYSTEM AND PROCEDURE IN THE PHILIPPINES: ESSENTIALS FOR PATENT DRAFTING

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REPUBLIC ACT NO. 8293

An Act Prescribing the Intellectual Property Code and Establishing the Intellectual Property Office, Providing For Its Powers and Functions, and for Other Purposes

lays down the rules and regulations that grant, and enforce **patents in the Philippines.**

IPOPHL's MISSION



We are a knowledge-driven government organization that works towards economic, technological, and socio-cultural development by communicating, enabling, and ensuring the effective use of the Intellectual Property System in all levels of society for the creation, protection, utilization, and enforcement of Intellectual Property

TOPICS FOR DISCUSSION:



- ❑ What is a Patent?
- ❑ Patentable & Non-patentable inventions
- ❑ Requirements for patentability
- ❑ Requirements for acquiring a patent
- ❑ Drafting the specification, claims and drawings
- ❑ Patent Granting Procedure
- ❑ Who may apply for a patent
- ❑ Rights of patent holders
- ❑ Filing patent applications in foreign countries

PATENT PRINCIPLES



- ❑ **TERRITORIALITY** - patents are only valid in the country or region in which they have been granted
- ❑ **FIRST-TO-FILE** –applicant who files first will get the patent
- ❑ **DISCLOSURE** –applicant shall disclose the invention in a manner sufficiently clear and complete .

Quid pro quo principle – protection in exchange for disclosure
- ❑ **CONDITIONAL** – patents are granted only upon compliance with the criteria of patentability



DIFFERENT TYPES OF PATENTS

- ❑ Inventions
- ❑ Utility Models
- ❑ Industrial Designs

WHAT IS A PATENT ?



A temporary monopoly granted to an inventor by the government (territorial) in return for disclosing an invention.

The exclusive right to exploit the invention for 20 years from the filing date, i.e. to make, use, sell or import an invention.

PATENTABLE INVENTIONS

(Sec. 21, IP Code & Rule 200, IRR)

- A patent is an exclusive right (for 20 years) granted for an invention, which is a **product** or a **process** that provides, in general, a **new** way of doing something, or offers a **new technical solution to a problem.**
- To get a patent, technical information about the invention **must be disclosed to the public** in a patent application.

PATENTABLE INVENTIONS

Examples:



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

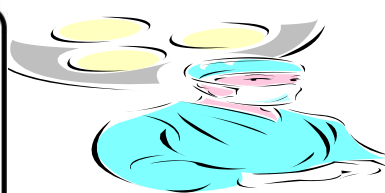


NON-PATENTABLE INVENTIONS

(Sec. 22, IP Code & Rule 202, IRR)



1. Discoveries
2. Scientific theories
3. Mathematical methods
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 practised on the human & animal body



REQUIREMENTS FOR PATENTABILITY



INTELLECTUAL PROPERTY
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Substantive Requirements:

1.) **NOVEL**

2.) **INVENTIVE STEP**

3.) **INDUSTRIAL APPLICABILITY**

Formal Requirements:

- a) Patentable subject matter
- b) Sufficiency of disclosure/enablement

REQUIREMENTS FOR PATENTABILITY



1. NOVELTY

(Sec. 23, R.A.8293)

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

WHAT IS A “PRIOR ART”?

- everything made available to the public by means of:



**...before the FILING DATE
of the application...**

GRACE PERIOD or NON PREJUDICIAL DISCLOSURE



- If you have already disclosed or published your inventions in a journal, demonstrate, sell or discuss your invention in public, you can still file a patent within one (1) year from the date of disclosure or publication.

TEST OF NOVELTY



Only one prior art document/disclosure is to be considered.

Combination of separate items of prior art document/disclosure is not permissible.

TEST OF NOVELTY



Generic vs Specific disclosure

A **generic disclosure** does not take away the novelty of any specific example falling within the terms of that disclosure.

However,

A **specific disclosure** does take away the novelty of a generic claim embracing that disclosure.

GENERIC vs SPECIFIC DISCLOSURES



Examples:

Prior Art

1. water

2. beverage

3. tea

4. coffee

Application

1. beverage

2. fruit juice

3. coffee

4. tea

Novelty

X

✓

✓

} **(equivalents)**

EQUIVALENTS



- A liquid beverage made of tea.
- A liquid beverage made of coffee.

To employ an equivalent to what is disclosed would be a matter of **obviousness**, not a question of novelty.

2. INVENTIVE STEP (NON-OBVIOUS)

(Sec. 26, R.A.8293)

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

DEFINITION OF “OBVIOUS” IN PATENTING



What is “obvious”?

The claimed invention is obvious if the person skilled in the art on the relevant date would have been motivated or prompted to realize the claimed invention by substituting, combining, or modifying one or more of those items of prior art with a reasonable likelihood of success.

The term “*obvious*” is used as equivalent to the expression “*lacking an inventive step*”

PERSON SKILLED IN THE ART



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- Fictional person with no inventive ability
- Aware of common general knowledge in specific art
- Has access to everything disclosed as the state of the art
- Can observe developments in related technical field

UNDERSTANDING OBVIOUSNESS

Claimed invention

A cellular phone which
body is made with
aluminum

APPLICATION

Is the solution to a problem
“**Obvious**”
to a skilled person?

=

Prior art 1

A cellular phone which
body is made with
magnesium



+

Prior art 2

A portable music player which
body is made with aluminum.
We adopt aluminum because
magnesium has a problem in
cooling performance.



DETERMINATION OF INVENTIVE STEP (1):



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THE PROBLEM-SOLUTION APPROACH (1)

Steps:

- Identify the technical feature of the invention & prior art documents
- Determine the closest prior art
- Evaluate the difference between the closest prior art and the invention (*distinguishing features*)
- Identify the technical problem to be solved (*by the invention*)

DETERMINATION OF INVENTIVE STEP : THE PROBLEM-SOLUTION APPROACH (2)



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- Analyse whether the technical solution to the problem represents an unexpected or non-obvious advance (advantages of the invention) over the closest prior art when combined with either a second prior art reference or common general knowledge in the art
- Decide whether the invention is obvious or not

DETERMINATION OF INVENTIVE STEP(3)



- Making the decision involves answering the question:

What would a person skilled in the art do, when faced with that objective technical problem and being aware of the state-of-the-art or prior art?

INDUSTRIAL APPLICABILITY

(Sec. 27 R.A. 8293)



An invention that can be produced and used in any industry shall be industrially applicable.

- Should have practical and real-life benefit in any field of human endeavour.**

POINTS TO CONSIDER IN DRAFTING THE SPECIFICATION, CLAIMS AND DRAWINGS

REQUIREMENT OF PATENT SPECIFICATION

VERIFY THE FOLLOWING:

Conduct patent search

- Enlist problems in prior art
- What is the problem sought to be solved by the invention?
- Is it a patentable subject matter?
- What is novel?
- Is the solution obvious?
- Has publication ensued?
- Decide the area and nature of protection – Domestic application, Paris convention, PCT

EXAMPLES OF DATABASES FOR PRIOR ART SEARCH



Patent databases (free)

<http://onlineservices.ipophil.gov.ph>

<https://patents.google.com/advanced>

<https://worldwide.espacenet.com>

<https://www.uspto.gov/patent>

Non-patent databases (free)

Google scholar ; Pudmed, Scientific journals etc.

Proprietary databases: CAS STN; EPOQUEnet;
WIPS, IEEE, etc.

THE PATENT APPLICATION

(Rule 404)



The application shall contain the following:

- a) a duly accomplished request for the grant of patent
- b) a description of the invention
- c) one or more claims
- d) drawings if necessary for the understanding of the invention
- e) an abstract

Rule 401. Fees should be paid within one (1) month from the filing date

Disclosure and description of the invention

(Sec.35, IP Code & Rule 405, IRR)



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

Enabling Disclosure

(Rule 406.1, IRR)



The enabling disclosure shall contain a clear and detailed description of at least one way of doing the invention using working examples. It shall contain a sufficient and clear disclosure of the technical features of the invention including the manner or process of making, performing, and using the same, leaving nothing to conjecture.



AMENDMENT OF THE DISCLOSURE

(Rule 919)

No deletion or addition shall broaden the disclosure of an application to include new matter after the filing date of the application.

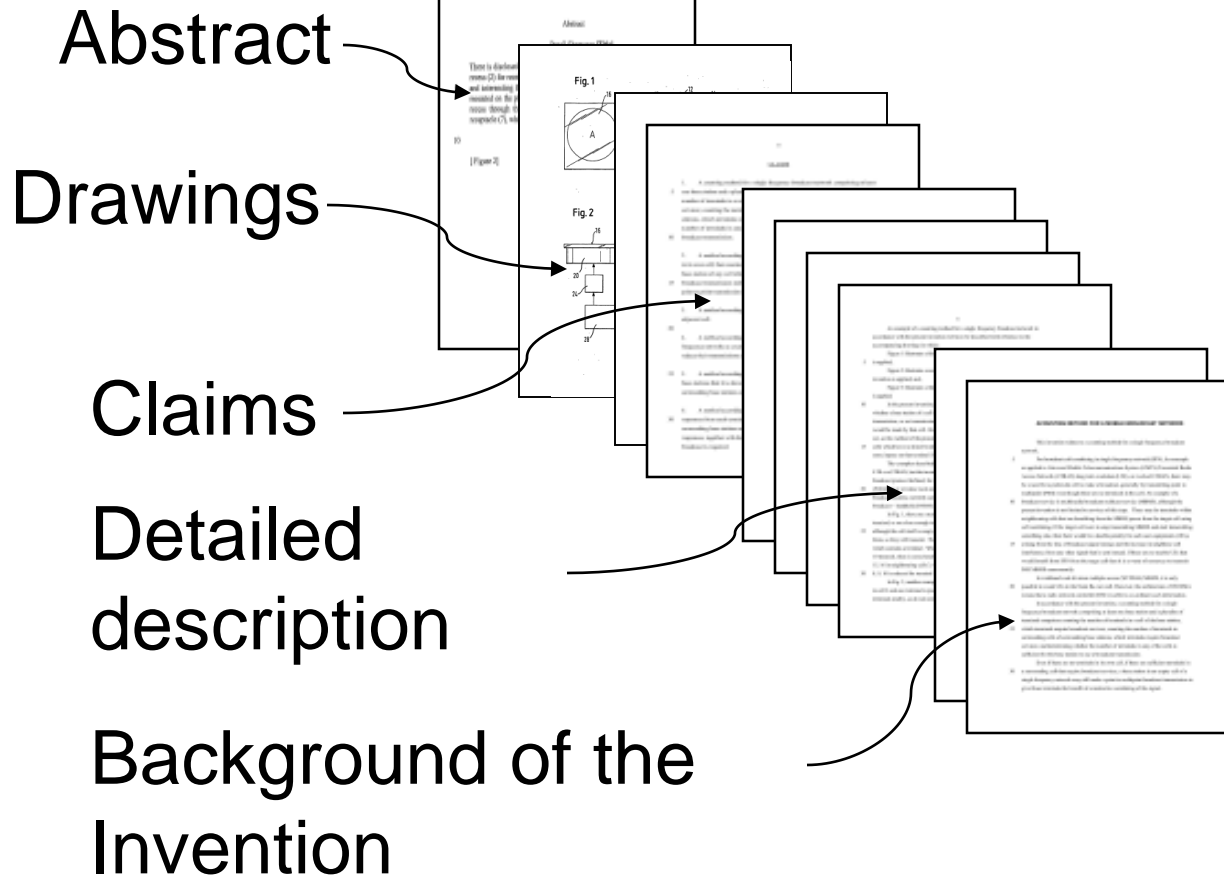
CONTENTS OF THE DESCRIPTION

(Rule 407)



1. Title
3. Technical Field
4. Background Art
5. Summary
6. Brief description of the several views of the drawings
7. Detailed Description
8. Claim/s
9. Abstracts
10. Drawings

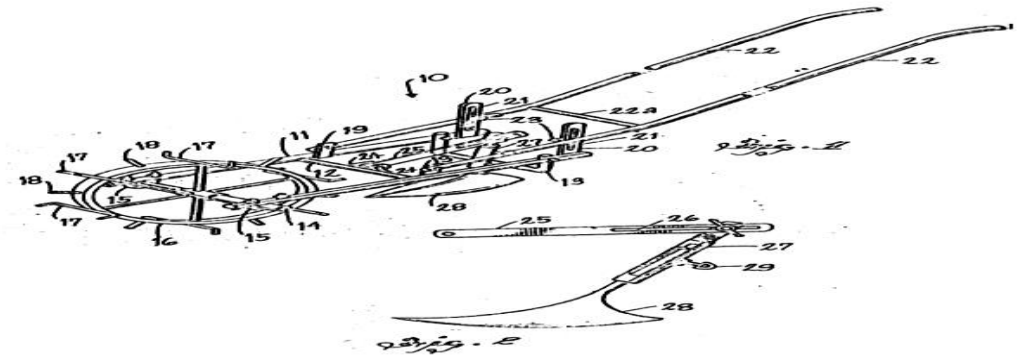
CONTENTS OF THE DESCRIPTION



DRAWINGS

(Rules 413-414, IRR)

- the drawing must be signed by the applicant or his name may be on the drawing by his attorney or agent
- Must show every feature of the invention
- Figures must be consecutively numbered
- The elements must be designated by way of reference numerals corresponding to the elements in the description



CLAIMS :

DEFINES THE SCOPE/BOUNDARY OF PROTECTION

Claims must be : a) Clear (clarity)

Your claim must be clear and concise so that you do not cause the reader to speculate about the claim. If you find yourself using words such as "thin", "strong", "a major part", "such as", "when required" and grammatical errors then you are probably not being clear enough.

b) Complete (enablement)

Each claim should be complete, so that it covers the inventive feature and enough elements around it to put the invention in the proper context.

c) Supported (support)

The claims have to be supported by the description. This means that all the characteristics of your invention that form part of the claims must be fully explained in the description.

CATEGORIES OF CLAIMS:



1. Physical Entity

- a. Apparatus claims/also includes devices
- b. Product claim

2. Activity

Method claims covering operations comprising one or more steps performed as part of, e.g. manufacturing process, chemical process or software operation

KINDS OF CLAIMS:



1. INDEPENDENT CLAIM

- a. Broadly describes the invention
- b. Typically written with very broad terms
- c. Avoids permitting competitors to circumvent the claims
- d. Stands on its own/broadest expression of the invention and usually numbered as Claim 1

. DEPENDENT CLAIM

- a. Describes the invention in a narrower aspect
- b. Clarifies independent claim language
- c. Expresses particular embodiments as “fall-back positions”/other aspects of the invention

PARTS OF A CLAIM



1. The PREAMBLE provides the name of the subject matter, or prior art environment associated with the subject matter.
2. The BODY contains
 - a. The recital of elements (structures, steps, parts or ingredients) which define the invention
 - b. The recitation of the manner in which the elements cooperate or co-act together.
3. The TRANSITION
 - a. Links the preamble and body of the claim
 - b. Generally take's the form “comprising” or “which comprises”
 - c. A “colon” (:) is inserted after the Transition

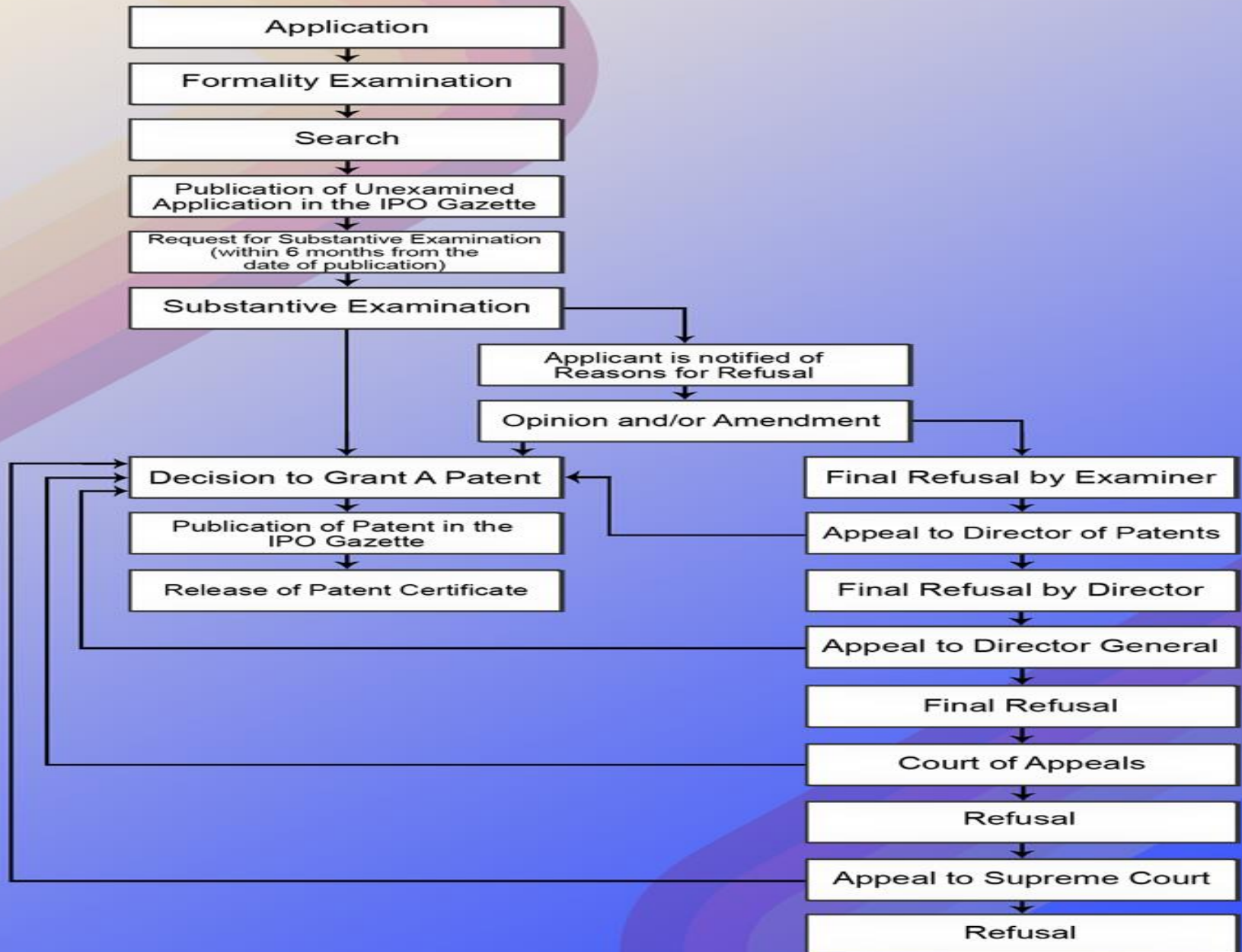
PARTS OF A CLAIM



EX:

A cleaning device comprising: a sweeping member; an elongated rod connected to the sweeping member; and a handle connected at the upper end of the rod.

PATENT APPLICATION FLOW CHART



WHO MAY APPLY FOR A PATENT



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



FIRST-TO-FILE SYSTEM

The Right to a Patent shall belong to:

the 1st Person/Applicant who filed an application

In what language must the Philippine patent application be presented?

The Philippine patent application must be presented in either the Filipino or English language.

DIFFERENT MODES OF FILING PATENT APPLICATIONS:



- Manual filing
- Thru Mails
- On-line services: E-filing

www.ipophil.gov.ph

**eINVENTION
file**

**eUMfile
(Utility Model)**

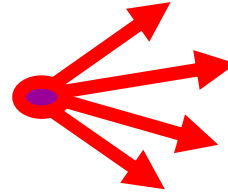
**eIDfile
(Design)**

RIGHTS OF PATENT HOLDER

- ❑ A patent owner has the right to decide who may – or may not – use the patented invention for the period during which it is protected.
- ❑ Patent owners may give permission to, or license, other parties to use their inventions on mutually agreed terms.
- ❑ Owners may also sell their invention rights to someone else, who then becomes the new owner of the patent.
- ❑ Once a patent expires, protection ends and the invention enters the public domain. This is also known as becoming off patent, meaning the owner no longer holds exclusive rights to the invention, and it becomes available for commercial exploitation by others.

DIRECT ROUTE (without claim for priority)

Home Application



PARIS CONVENTION ROUTE (with priority claim)

Priority Date

12 mos.

Home Application



PCT Route

Priority Date

Home Application

12
PCT
Application
RO

WO-ISA/
ISR

16

18

Int'l Pub.
By IB
(WIPO)

DEMAND
optional

22

IPEA
IPER/IPRP
If no
demand

28

30

National Phase



REFERENCES:

- Republic Act No. 8393 (IP Code of the Philippines)
- The Revised Implementing Rules and Regulations for Patents, Utility Model and Industrial Designs
- Manual for Patent Examination Procedure



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*Towards a Creative
and Innovative Philippines*



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THANK YOU