

28 March 2022

MS. LISA JORGENSON

Deputy Director General, Patents and Technology Sector
World Intellectual Property Organization
34, chemin des Colombettes
CH-1211 Geneva 20, Switzerland

Dear **Deputy Director General Jorgenson**:

This refers to Circular C. 9089 dated 18 January 2022 inviting Member States and Regional Patent Offices to send additional inputs for the preparation of documents pursuant to the decision on the thirty-third session of the Standing Committee on the Law of Patents (SCP).

We thank WIPO for this opportunity to provide information and updates on the following: exemption regarding exhaustion of patent rights, sufficiency of disclosure, national and regional laws on opposition systems and other administrative revocation and invalidation mechanisms, international work-sharing and collaborative activities for search and examination of patent applications, and confidentiality between clients and patent advisors.

In this regard, we submit the following responses and updated information:

- (i) **DRAFT REFERENCE DOCUMENT ON THE EXCEPTION REGARDING EXHAUSTION OF PATENT RIGHTS. THE INPUTS MAY RELATE TO, FOR EXAMPLE, RELEVANT COURT CASES, CHALLENGES FACED BY MEMBER STATES IN IMPLEMENTING THE EXCEPTION, AND THE RESULTS OF THE NATIONAL/REGIONAL IMPLEMENTATION AVAILABLE AT: <http://www.wipo.int/scp/en/exceptions>**

With regard to the implementation of Republic Act No. 9502 or the Cheaper Medicines Act of 2008 which expounded on the research exceptions provisions, we have not received any new Court cases since the last update for SCP.

- (ii) **STUDY ON THE SUFFICIENCY OF DISCLOSURE, AS PROPOSED IN DOCUMENT SCP/31/8 REV. ACCORDINGLY, INPUTS ARE REQUESTED WITH RESPECT TO INVENTIONS IN THE TECHNOLOGY SECTORS IN WHICH THE FULFILLMENT OF THE SUFFICIENCY OF DISCLOSURE MAY DESERVE SPECIAL ATTENTION, FOR EXAMPLE:**
- **INORGANIC AND ORGANIC CHEMISTRY, INCLUDING PHARMACEUTICALS;**
 - **MICRO-ORGANISMS; AND**
 - **ARTIFICIAL INTELLIGENCE.**

We are pleased to share that **Rule 406.1** of the Revised Implementing Rules and Regulations for Patents, Utility Models and Industrial Designs (the "IRR")

provides for the requirement of Enabling Disclosure in patent applications regarding chemical substances and pharmaceuticals.

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.

In the case of chemical substances and pharmaceutical subject matter, the disclosure must include one or more representative embodiments or working examples, a description of the result of the pharmacological test, and all compounds must include their claimed activity.

Further, the IRR contains the following provisions relating to microorganisms and biological materials:

Rule 408. Requirements of Application relating to Biological Materials and Microorganisms. – Where the application concerns a microbiological process, or the product thereof, involving the use of a microorganism which cannot be sufficiently disclosed in the application in such a way as to enable the invention to be carried out by a person having ordinary skills in the art and such material is not available to the public, the invention shall only be regarded as disclosed if:

- (a) A culture of the microorganism has been deposited in a depository institution before filing the application;
- (b) The depository institution and the file number of the culture deposit are stated in the application. If this information is not yet available at the time of filing the application, the said information shall be submitted within two (2) months from the request of the Examiner. Publication of the application under Section 44 of the IP Code shall be held pending until submission of the information;
- (c) The application as filed gives relevant information as is available to the applicant on the characteristics of the microorganism.

Rule 409. Requirements of Application relating to Biological Materials and Microorganisms before Allowance. – An application that concerns a microbiological process, or the product thereof, involving the use of any novel strain of microorganism shall be allowed only when the following conditions are met:

- (a) A deposit was made in a recognized international depository authority;
- (b) Proof of such deposit together with the proper identification or deposit number assigned by the depository; and
- (c) That the depository should be under the contractual obligation to place the culture in permanent collection and to provide access to persons who shall have interest therein with regard to matters relating to the patent application as published.

With regard to computer-implemented inventions (CII) which may include AI, the technical character of CII is implicitly stipulated by the following provisions of the IP Code and its implementing rules and regulations:

- Any "technical solution" to a problem - Section 21 of the IP Code and Rule 200 of the IRR
- Shall contain a clear disclosure of the "technical features" of the invention - Rule 406.1 of the IRR
- Specify the "technical field" to which the invention relates - Rule 407 (a) of the IRR
- Disclose the invention in such terms that the "technical problem" can be understood - Rule 407 (c) of the IRR

In this regard, an invention is considered to have technical character when it explicitly or implicitly manifests technical consideration in providing a solution to a problem (*Guidelines on the Examination of ICT and CII, Jan. 2018*). Where a tangible or concrete means is involved, the manner by which the invention operates must indicate that information technology and ICT and computer-related technical aspects or considerations are applied in realizing the invention.

- (i) **CERTAIN ASPECTS OF THE APPLICABLE NATIONAL OR REGIONAL PATENT LAW, RELATED TO PRIOR ART, NOVELTY, INVENTIVE STEP (NON-OBVIOUSNESS), GRACE PERIOD, SUFFICIENCY OF DISCLOSURE, EXCLUSIONS FROM PATENTABLE SUBJECT MATTER AND/OR EXCEPTIONS AND LIMITATIONS OF THE RIGHTS AVAILABLE AT:** http://www.wipo.int/scp/en/annex_ii.html;

There are no updates on these subject matters. The applicable national laws can be accessed in the said link.

- (ii) **NATIONAL AND REGIONAL LAWS ON OPPOSITION SYSTEMS AND OTHER ADMINISTRATIVE REVOCATION AND INVALIDATION MECHANISMS, AVAILABLE AT:** http://www.wipo.int/scp/en/revocation_mechanisms/;

- National Law on Opposition Systems

The IP Code and its IRR provides for opposition systems and other administrative revocation and invalidation mechanisms. The following pre-grant provisions apply:

- Sec. 47, Republic Act No. 8293: Observation by Third Parties
- Rule 802 (Revised IRR). Community Review of Patent Applications
- Rule 1700. Community Review of Utility Model and Industrial Design Applications

Kindly note that the information on these mechanisms was part of the IPOPHL's submission to the scp.forum@wipo.int dated 09 March 2018.

- The existing rules on *Inter Partes* Proceedings were further amended in 2019 in order to achieve a more efficient and expeditious resolution of *Inter Partes* cases in the Bureau of Legal Affairs. Attached is the IPOPHL Memorandum Circular No. 19-024 on the Amendments to the Rules and Regulations on *Inter Partes* Proceedings.

(iii) **INTERNATIONAL WORKSHARING AND COLLABORATIVE ACTIVITIES FOR SEARCH AND EXAMINATION OF PATENT APPLICATIONS, AVAILABLE AT: <http://www.wipo.int/patents/en/topics/worksharing/>;**

IPOPHL has been collaborating with other patent offices through different partnerships, programs, trainings, and seminars/webinars, such as but not limited to the following:

- IPOPHL initially joined the Patent Prosecution Highway (PPH) program in 2012 thru the bilateral partnership with JPO and subsequently with USPTO, KIPO, and EPO.
- In the same year, IPOPHL started the implementation of the ASEAN Patent Examination Cooperation (Regional Work-Sharing for ASEAN IP Offices).
- In 2013, IPOPHL started participating in the RPET Program (Regional Patent Examination Training Program) initiated and implemented by IP Australia to primarily build the patent examination capabilities of new examiners by improving their competency in conducting search and examination to international or PCT standards.
- IPOPHL joined WIPO CASE in July of 2014 as an accessing office.
- Several Patent Search and Examination Trainings/Webinars in efficient searching in the different proprietary databases, advance trainings in substantive examination, PCT and related IP Services, Women in IP (IP webinars on gender equality), and determining the similarity of designs, were conducted by WIPO, EPO, and JPO.

(iv) **COMPILATION OF LAWS AND PRACTICES REGARDING THE SCOPE OF CLIENT-ATTORNEY PRIVILEGE AND ITS APPLICABILITY TO PATENT ADVISORS, AVAILABLE AT:**

https://www.wipo.int/scp/en/confidentiality_advisors_clients/national_laws_practices.

Kindly note that there are no updates on this subject matter. Please refer to IPOPHL's response to Circular Note C. 8728 dated 09 March 2018 posted at scp.forum@wipo.int regarding the Scope of Client-Attorney Privilege covered in the relevant provisions of the Revised Penal Code (Article 29, as amended by R.A. No. 10951) and Article 21 of the Civil Code of the Philippines.

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

Thank you for your continued support and partnership.

Sincerely yours,



ROWEL S. BARBA
Director General



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

IPOPHL MEMORANDUM CIRCULAR NO. 2019 024
Series of 2019

SUBJECT: Amendments to the Rules and Regulations on Inter Partes Proceedings

WHEREAS, the Intellectual Property Office of the Philippines ("IPOPHL") aims to provide speedy, quality and effective legal remedies to resolve IP disputes;

WHEREAS, to achieve the aforementioned goal, the Bureau of Legal Affairs ("BLA") continuously reviews and streamlines its operations, systems, processes and procedures;

WHEREAS, the IPOPHL adopted a policy requiring all inter partes cases to be submitted to mediation;

NOW, THEREFORE, pursuant to the authority of the Director General under Sections 7.1 and 10.3 of RA 8293, also known as the Intellectual Property Code of the Philippines, as amended ("IP Code"), the rules on expedited proceeding for trademark opposition and cancellation cases are hereby promulgated, as follows:

SECTION 1. Rule 2, Section 5 is hereby amended, as follows:

Section 5. Modes of **FILING AND SERVICE**. –

(a) **FILING AND SERVICE OF PLEADINGS, MOTIONS, MANIFESTATIONS, SERVICE OF** interlocutory orders, notices, summons and other processes shall be **MADE personally, OR VIA COURIER, OR BY** registered mail, or other similar means as the Director General may deem appropriate. **THESE MODES OF FILING AND SERVICE APPLY ALSO TO DELIVERY OF COPIES OF DECISIONS AND FINAL ORDERS SUBJECT TO RULE 9.**

(b) **IF A PARTY, COUNSEL OF RECORD OR REPRESENTATIVE OF RECORD REFUSES TO RECEIVE A COPY OF THE NOTICE TO ANSWER AND OTHER INTERLOCUTORY ORDERS ISSUED BY THE BUREAU; OR HAS MOVED OUT OF THE ADDRESS WITHOUT INFORMING THE OFFICE OF THE NEW ADDRESS; OR THE ADDRESS PROVIDED IS INCOMPLETE, THE BUREAU SHALL POST THE NOTICE TO ANSWER AND OTHER INTERLOCUTORY ORDERS IN THE IPOPHL WEBSITE. THE CONCERNED PARTY SHALL HAVE THE PERIOD PRESCRIBED IN THE NOTICE TO ANSWER OR INTERLOCUTORY ORDER TO COMPLY WITH THE ORDER, RECKONED FROM THE DATE OF POSTING IN THE WEBSITE.**

SECTION 2 .Rule 2 Section 7 (a) is hereby amended, to read:

Section 7. Filing Requirements for Opposition and Petition. — xxx

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- (a) The opposition or petition must be in writing, verified and accompanied by a certification of non- forum shopping, and in due form as prescribed by these Rules. The opposer or petitioner shall file only the original of the opposition or petition, with proof of service to the respondent or representative/agent on record. The periods to file the opposition or petition are provided in the succeeding rules.

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SECTION 3. Rule 2 Section 7 is hereby amended by including new subsections (d) and (e), to read:

Section 7. Filing Requirements for Opposition and Petition. — x xx

(D) UNLESS OTHERWISE REQUIRED BY THE BUREAU OF LEGAL AFFAIRS (BLA) FOR OTHER FILINGS WITH IT OR EXEMPTED FROM THIS REQUIREMENT, PDF AS WELL AS WORD FILES OF ALL PLEADINGS, TOGETHER WITH THE PDF FILES OF ALL SUPPORTING DOCUMENTS STORED IN A FLASH DRIVE, SHALL ALSO BE FILED.

(E) FILINGS WHICH ARE NOT IN COMPLIANCE WITH THESE RULES, MAY BE REJECTED WITHIN FIFTEEN (15) DAYS AFTER FILING OR ACTUAL RECEIPT BY THE BUREAU. IF REJECTED, THE BUREAU SHALL ISSUE AN ORDER WITH AN INDICATION OF THE DEFICIENCIES THEREIN. THE PARTY CONCERNED WILL BE GIVEN A PERIOD OF FIVE (5) DAYS WITHIN WHICH TO COMPLY WITH THE ORDER TO COMPLY WITH SUCH DEFICIENCIES. REJECTION OF SUCH PLEADINGS AND DOCUMENTS IS NOT A BAR TO THE RE-SUBMISSION OF THE SAME WITH THE BUREAU PROVIDED THAT THE SAME IS FILED WITHIN THE PERIOD TO FILE THE OPPOSITION OR CANCELLATION CASE. ACCEPTANCE OF A PLEADING OR DOCUMENT FOR FILING IS NOT A DETERMINATION THAT THE PLEADING OR DOCUMENT COMPLIES WITH ALL THE REQUIREMENTS OF THE BUREAU AND IS NOT A WAIVER OF SUCH REQUIREMENTS.

SECTION 4. Rule 2 Section 7 (b) is hereby amended, to read:

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- (a) The documentary or object evidence, which must be duly-marked starting from Exhibit "A", and other supporting documents mentioned in the notice of opposition or petition together with the translation in English, if not in the English language. The verification and certification of non-forum shopping as well as the documents showing the authority of the signatory or signatories thereto, affidavits and other supporting documents, if executed and notarized abroad, must have been authenticated by the appropriate Philippine diplomatic or consular office **OR APOSTILLIZED BY THE APPROPRIATE AUTHORITY OF THE**

MEMBER COUNTRIES. The execution and authentication **OR APOSTILLE** of these documents must have been done before the filing of the case. For purposes of filing an opposition, however, the authentication **OR APOSTILLE** may be secured after the filing of the case provided that the execution of the documents aforementioned are done prior to such filing and provided further, that the authentication **OR APOSTILLE** must be submitted before the issuance of the order of default or conduct of the preliminary conference under Section 14 of this Rule. [*as amended by Memorandum Circular No. 7 (2016)*]

SECTION 5. Rule 2, Section 8 (c) is hereby amended, as follows:

Section 8. x xx

- (c) The opposer, including those who file a motion for extension of time to file notice of opposition, or the petitioner shall be given a period of five (5) days from receipt of the order to comply or to cure any of the following defects:
- (1) Non-payment in full or in part of the filing fees and other applicable fees;
 - (2) Failure to attach any of the following documents:
 - (i) Verification;
 - (ii) Certification of non-forum shopping.
 - (3) Special Power of Attorney of representative(s) who signed the pleadings, the verification and the certification of non-forum shopping; and the proof of the authority to issue or execute the Special Power of Attorney; and
 - (4) **FAILURE TO ATTACH TO THE OPPOSITION OR PETITION THE ORIGINALS OF THE ABOVEMENTIONED DOCUMENTS.**

The 5 [~~10~~]day period to complete or cure the defects in the filing may be extended for another 5 days upon motion by the opposer or petitioner based on meritorious grounds which shall be explicitly stated in the motion, and upon payment of the applicable fees. A second 5-day extension may be granted based on the aforementioned condition.

No further extension shall be allowed.

Failure to complete or cure the defect shall cause the dismissal of the case. The Director or Assistant Director shall issue the final order of dismissal; **PROVIDED, THAT THE FINAL ORDER ISSUED BY THE ASSISTANT DIRECTOR IS APPEALABLE TO DIRECTOR IN ACCORDANCE WITH RULE 9.**

SECTION 6. Rule 2, Section 9 (a) is hereby amended, as follows:

- (a) The respondent must file a verified answer within 30 days from receipt of a copy of the Notice to Answer, with proof of service thereof to the opposer or petitioner. The respondent shall attach to the answer the affidavits of witnesses

and other documentary or object evidence, which must be duly-marked starting from Exhibit "1". The verification and the documents showing the authority of the signatory thereto, the affidavits and other pertinent documents, if executed and notarized abroad, must **HAVE BEEN APOSTILLIZED BY THE APPROPRIATE AUTHORITY OF THE MEMBER COUNTRIES, OR** authenticated by the Philippine diplomatic or consular office **IN APPROPRIATE CASES.** The execution, authentication **AND APOSTILIZATION** of these documents must have been done before the filing of the answer. **FOR PURPOSES OF FILING THE ANSWER, HOWEVER, THE AUTHENTICATION OR APOSTILIZATION MAY BE SECURED AFTER THE FILING OF THE ANSWER PROVIDED THAT THE EXECUTION OF THE DOCUMENTS AFOREMENTIONED ARE DONE PRIOR TO SUCH FILING AND PROVIDED FURTHER, THAT THE AUTHENTICATION OR APOSTILIZATION MUST BE SUBMITTED BEFORE THE CONDUCT OF THE PRELIMINARY CONFERENCE UNDER SECTION 14 OF THIS RULE.**

x x x

- (b) The respondent shall be given a period of five (5) days from receipt of the order to comply or to cure any of the following defects:
- (1) Non-payment in full or in part of the applicable fees, for motions for extension to file answer;
 - (2) Failure to attach any of the following documents:
 - (i) Verification;
 - (ii) Special Power of Attorney of representative(s) who signed the pleadings, the verification and the proof of the authority to issue or execute the Special Power of Attorney; and
 - (3) **FAILURE TO ATTACH TO THE ANSWER THE ORIGINALS OF THE ABOVEMENTIONED DOCUMENTS.**

The 5 day period to complete or cure the defects in the filing may be extended for another 5 days upon motion by the respondent based on meritorious grounds which shall be explicitly stated in the motion, and upon payment of the applicable fees. A second 5-day extension may be granted based on the aforementioned condition.

No further extension shall be allowed.

SECTION 7. Rule 2, Section 11 is hereby amended, as follows:

Section 11. **SUBMISSION** to Alternative Dispute Resolution. – If the Answer is filed on time and/or the defects are completed or cured, the case shall be **SUBMITTED** to the Alternative Dispute Resolution ("ADR") in accordance with the applicable IOPHL rules.

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SECTION 8. Rule 2, Section 14 is hereby amended, as follows:

Section 14. **ASSIGNMENT/Raffle of Cases; Preliminary Conference.-**

- (a) If the respondent is in default, or if the case is not resolved or dismissed through ADR, the Director, **OR IN HIS ABSENCE THE** Assistant Director shall **ASSIGN OR** raffle the case to the Hearing Officer/Adjudication Officers.

Section 9. Section 14, Rule 2 is hereby amended by including a new subsection (d), to read:

Section 14. Raffle of Cases; Preliminary Conference. — xxx

(c) If the case was referred to but was not resolved or dismissed through ADR, the Hearing/Adjudication Officer shall, immediately after receiving the records of the case, issue an order setting the conduct of the preliminary conference for the purpose of facilitating the resolution of the case through stipulations, clarifications and simplification of issues, and the submission and/or presentation of the original or certified true copies of affidavits, documents, ~~and other evidence~~ if necessary.

(D) THE FOREGOING NOTWITHSTANDING, IN THE INTEREST OF JUSTICE OR THE EXIGENCY OF THE SERVICE OR EFFICIENCY, CASES MAY ALSO BE REASSIGNED OR RAFFLED TO ANOTHER HEARING/ADJUDICATION OFFICER.

SECTION 6. Rule 9, Sections 1 and 2 are hereby amended, as follows:

Section 1. Decisions and Final Orders.- A decision or final order shall be duly signed by the appropriate authority, in writing, stating clearly and distinctly the facts, evidence, records, the provisions of law, rules and regulations as well as principles and doctrines if applicable, on which it is based. The approval of a compromise agreement shall be deemed decision on the merits and shall be treated and enforced accordingly. **NO MOTION FOR RECONSIDERATION OF THE DECISION OR FINAL ORDER OF THE HEARING/ADJUDICATION OFFICER OR THE ASSISTANT DIRECTOR SHALL BE ALLOWED.**

Section 2. Appeal to the Director.-

- (a) Within ten (10) days after receipt of the decision or final order **OF THE HEARING/ADJUDICATION OFFICER OR THE ASSISTANT DIRECTOR**, a Party may file **A MEMORANDUM OF APPEAL** to the Director together with the payment of the applicable fees. The appeal shall be immediately denied if it is filed out of time and/or is not accompanied by the payment of the applicable fee. **THE PERIOD TO FILE APPEAL, HOWEVER, MAY BE EXTENDED UPON MOTION OF THE PARTY CONCERNED WHICH MUST STATE MERITORIOUS GROUND; PROVIDED, THAT THE MOTION IS FILED WITHIN THE PERIOD TO FILE THE APPEAL AND IS ACCOMPANIED BY THE PAYMENT OF THE APPEAL FEE AND OTHER APPLICABLE FEES.**

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After receipt of the appeal, the Director shall issue an order for the adverse party to file comment within a period of ten (10) days from receipt of the order. **THE PERIOD TO FILE COMMENT, HOWEVER, MAY BE EXTENDED UPON MOTION OF THE APPELLEE WHICH MUST STATE MERITORIOUS GROUND; PROVIDED, THAT THE MOTION IS FILED WITHIN THE PERIOD TO FILE COMMENT AND IS ACCOMPANIED BY THE PAYMENT OF THE APPLICABLE FEES.** The Director shall **ENDEAVOR TO** decide on the appeal within thirty (30) days from the lapse of the period for the filing of a comment. Within thirty (30) days after receipt of the decision by the Director, a party may file an appeal to the Director General; **PROVIDED THAT NO MOTION FOR RECONSIDERATION OF THE DECISION OF THE DIRECTOR SHALL BE ALLOWED.**

- (b) If a party, counsel of record or representative of record refuses to receive a copy of the decision, final order or resolution promulgated by the Hearing/Adjudication Officer, or Assistant Director, or Director; or has moved out of the address, said party, counsel of record or representative of record indicated in the pleadings of other records in the Bureau and/or IOPHL, the Bureau shall post the decision, final order or resolution in the IOPHL website. Within ten (10) days after posting the decision or final order in the IOPHL website, the party concerned may file together with the payment of the applicable fees, the appropriate appeal.

SECTION 7. Separability Clause. - Any portion or provision of this Memorandum Circular that may be declared invalid shall not have the effect of nullifying other portions or provisions hereof as long as such remaining portion or provision can still subsist and be given effect in their entirety.

SECTION 8. Repealing Clause. - All rules and regulations or parts thereof inconsistent herewith are hereby repealed or modified accordingly.

SECTION 9. Filing of Certified Copies. - Certified copies of this Memorandum Circular shall be filed with the University of the Philippines Law Center, Department of Trade and Industry, the Senate of the Philippines, the House of Representatives, the Supreme Court of the Philippines and The National Library.

SECTION 10. Effectivity. - These amendments shall become effective fifteen (15) days after publication in a newspaper of general circulation

SIGNED this 20 th of December 2019, at Taguig City, Philippines


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