

**[ IPO OFFICE ORDER NO. 99, S. 2011, June 29, 2011 ]**

**AMENDMENTS TO THE RULES AND REGULATIONS ON INTER PARTES PROCEEDINGS**

**Whereas**, one of the strategic goals of the Intellectual Property Office of the Philippines ("IPPHIL") is to provide speedy, quality and effective legal remedies and be the forum of choice to resolve IP dispute;

**Whereas**, in support of the aforementioned goal, the Bureau of Legal Affairs ("BLA") continuously reviews and streamlines its operations, systems, processes, including administrative procedures, in resolving disputes and controversies involving IP rights;

**Whereas**, under Sec. 10.3 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), the Director General may by regulations establish the procedure to govern *Inter Partes* cases;

**Whereas**, the Rules and Regulations on *Inter Partes* Proceedings were amended per Office Order No. 79, s. 2005 which took effect on 01 September 2005 and modified by Office Order No. 12, s. 2009 entitled "Amendments to the IPO Uniform Rules on Appeal";

**Whereas**, there is a need to further amend the existing rules in order to achieve a more efficient and expeditious resolution of *Inter Partes* cases in the Bureau of Legal Affairs;

**Now, Wherefore**, the Regulations on *Inter Partes* Proceedings, as amended, is hereby further amended, as follows:

**SECTION 1.** Rule 1, Section 1 is hereby amended, to read, as follows:

Section 1. *Definition of Terms* — Unless otherwise indicated, the following terms shall be understood as follows:

- (a) "Bureau" means the Bureau of Legal Affairs of the Intellectual Property Office;
- (b) "Court" means a court of general jurisdiction such as Regional Trial Court;
- (c) "Director" means the Director of the Bureau of Legal Affairs;
- (d) "Director General" means the head of the Intellectual Property Office;

- (e) "Hearing Officer" or "Adjudication Officer" refers to a lawyer in the Bureau who is assigned to hear the case;
- (f) "IP Code" means Republic Act No. 8293 otherwise known as the Intellectual Property Code of the Philippines;
- (g) "Office" means the Intellectual Property Office;
- (h) "Regulations" means this set of rules and regulations and such Regulations as may be formulated by the Director of the Bureau of Legal Affairs and approved by the Director General;

SECTION 2. Rule 2 is hereby amended to read, as follows:

RULE 2  
*GENERAL PROVISIONS; PROCEEDINGS*

Section 1. *What are the Inter Partes Cases.* — The following are the *Inter Partes* cases:

- (a) Oppositions to applications for the registration of trademark or service mark;
- (b) Petitions to cancel the registrations of trademarks or service marks;
- (c) Petitions to cancel invention patents, utility model registrations, industrial design registrations, or any claim or parts of a claim, and registrations of topography or layout design of integrated circuits based on Rule 402, paragraphs (a) and (b) of the Layout Design (Topography) of Integrated Circuits Regulations (Office Order No. 19, s. 2002), and
- (d) Petitions for Compulsory Licensing.

Section 2. *Parties in Inter Partes proceedings.* — The opposer or the petitioner shall be deemed to be in the position of plaintiff while the patentee, registrant or applicant shall be in the position of defendant.

Section 3. *Original jurisdiction over Inter Partes proceedings.* — The Bureau shall have original jurisdiction over *Inter Partes* proceedings. The Director, the Assistant Director, and/or the Hearing/Adjudication Officers shall issue and sign orders and other processes. However, all decisions and final orders shall be issued and signed by the Director, or by the Committee of Three in petitions to cancel patents as the case may be.

Section 4. *Right of foreign corporation to sue in Inter Partes Cases.* — Any foreign national or juridical person whether or not engaged in business in the Philippines may bring a petition for opposition, cancellation or compulsory licensing: Provided, that the country of which he or it is a national, or domiciled, or has a real and effective industrial

establishment is a party to any convention, treaty or agreement relating to intellectual property rights or the repression of unfair competition, to which the Philippines is also a party, or extends reciprocal rights to nationals of the Philippines by law.

Section 5. *Applicability of the Rules of Court.* — In the absence of any applicable rules, the Rules of Court may be applied in suppletory manner.

Section 6. *Authority of the Hearing/Adjudication Officers.* — The Hearing/Adjudication Officers are authorized to administer oaths and affirmations, issue summons, subpoena duces tecum and ad testificandum, interlocutory orders and preliminary rulings on questions raised, to conduct preliminary and clarificatory hearings, and perform other functions as provided in these Rules.

Section 7. *Filing Requirements for Opposition and Petition.* — (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 in these Rules. The petition or opposition must be filed in duplicate with proof of service to the respondent.

The periods to file the opposition or petitions are provided in the succeeding rules.

The petition or opposition must indicate the following:

- (1) names and addresses of the petitioner or opposer and the other parties, including the respondent;
- (2) the assigned application number and the filing date of the trademark application opposed, or of the registration number, the name of the registrant, and the date of the registration of the trademark, patent, utility model, industrial design or layout design sought to be cancelled; and
- (3) the ultimate facts constituting the opposer's or petitioner's cause or causes of action and the relief sought.

(b) The opposer or petitioner shall attach to the opposition or petition the affidavits of witnesses, 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. The execution and authentication of these documents must have been done before the filing of the opposition or petition.

(c) For the purpose of the filing of the opposition, the opposer may attach, in lieu of the originals or certified copies, photocopies of the

affidavits of its witnesses and other documentary evidence, and photographs of object evidence subject to the presentation or submission of the originals and/or certified true copies thereof under Section 13 of this Rule.

*Section 8. Action on the Notice of Opposition or Motion for Extension to File Notice of Opposition, and Petition.* — (a) A case is deemed to have commenced upon the filing of a notice of opposition, or a motion for extension of time to file .a notice of opposition, or a petition for cancellation or compulsory licensing.

(b) The notice of opposition or petition may be dismissed outright and/or motu proprio for having been filed out of time, due to lack of jurisdiction, and/or failure to state a cause of action. Likewise, a motion for extension of time to file notice of opposition shall be denied outright if the opposer fails to state meritorious grounds.

(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 complete 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 the originals of the following documents:

(i) Verification;

(ii) Certification of non-forum shopping;

(iii) Special Power of Attorney of representative(s) who signed the pleadings, the verification, and the certification of non-forum shopping; the proof of authority to issue or execute the Special Power of Attorney; and

(iv) Proof of authentication by the appropriate Philippine diplomatic or consular office, of the foregoing documents, if executed abroad.

The 5-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 must be explicitly stated in the motion, and upon payment of the applicable fees.

Failure to complete or cure the defect shall cause the dismissal of the case.

(d) If the opposition or petition is determined to be compliant with the requirements, or, upon compliance with the order provided in par. (c), the Bureau shall immediately issue a Notice to Answer, for the respondent to file an answer.

*Section 9. Answer.* — (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 document showing the authority of the signatory thereto, the affidavits and other pertinent documents, if executed and notarized abroad, must be authenticated by the appropriate Philippine diplomatic or consular office. The execution and authentication of these documents must have been done before the filing of the answer.

(b) Upon proper motion founded on meritorious grounds, and the payment of the applicable fees, the Bureau may grant an additional period of 30 days within which to file the answer. A second motion for extension of 30 days may be granted on compelling grounds and upon payment of the applicable fees; *Provided*, that in no instance shall the filing of the answer exceed ninety (90) days from the date of the receipt of the copy of the Notice to answer; *Provided, further*, that if the last day for filing of the answer or motion for extension falls on a Saturday, Sunday, holiday, non-working day or on a day when the Office or the Bureau is closed for business as may be declared by the Director General, the filing must be done the next succeeding working day.

(c) For the purpose of the filing of the opposition, the respondent may attach, In lieu of the originals or certified copies, photocopies of the affidavits of its witnesses and other documentary evidence, and photographs of object evidence subject to the presentation or submission of the originals and/or certified true copies thereof under Section 13 of this Rule.

(d) The respondent shall be given a period of five (5) days from receipt of the order to complete or to cure the following defects:

- (1) Non-payment in full or in part of the applicable fees, for motions for extensions to file answer;
- (2) Failure to attach the originals of the following documents:
  - (i) Verification;
  - (ii) Special Power of Attorney of representative(s) who signed the pleadings, the verification, and the certification of non-forum shopping; the proof of authority to issue or execute the Special Power of Attorney; and
  - (iii) Proof of authentication by the appropriate Philippine diplomatic or consular Office, for the foregoing documents executed abroad

The 5-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 must be explicitly stated in the motion, and upon payment of the applicable fees.