

[IPO OFFICE ORDER NO. 129, s. 2003, December 17, 2003]

RULES AND REGULATIONS ON THE OPTIONAL REGISTRATION OF TRADEMARK AGENTS, PATENT AGENTS, PATENT AND TRADEMARK AGENTS AND RESIDENT REPRESENTATIVES

WHEREAS, the Intellectual Property Office of the Philippines (IPOPhil) desires to grant strong intellectual property rights and for this purpose continues to pursue its program on the modernization of the IP system in the country;

Whereas, modernization encompasses development and continuing education of the country's human resource responsible for the creation, protection, utilization and enforcement of intellectual property rights;

Whereas, the successful prosecution of industrial property applications depends on regular compliance with certain formal, technical, substantive and procedural requirements requiring adequate knowledge and proficiency by agents representing or assisting applicants;

Whereas, the prosecution time and quality of industrial property rights granted depend largely on the professional ability or skill of the agents in the preparation and prosecution of their applications lodged before the Office, and, accordingly there is a need to continuously improve their capability;

Whereas, the Intellectual Property Office of the Philippines (IPOPhil), desiring to enhance the capability of person practicing before the Office, finds it necessary to establish and develop registries of agents, on optional basis, willing to comply with the educational, training and experience requirements for registration;

NOW, THEREFORE, the following rules and regulations on the optional registration of trademark agents, patent agents, patent & trademark agents and resident representatives, are hereby promulgated:

SECTION 1. Title - These rules and regulations shall be referred to as the " Patent and Trademark Agents Regulations".

SECTION 2. Voluntary Registration; Practice before the Office - Registration under these rules shall be voluntary and is not a pre-requisite to appearance as applicant, agent, representative, counsel or other capacity before the Office or any of its Bureaus; provided that, only members of the Philippine bar in good standing shall be allowed to appear as counsel in any inter partes case or any case for violation laws involving intellectual property rights filed before the Office or the Bureau of Legal Affairs.

SECTION 3. Definition of Terms - Unless otherwise specified, the following terms and acronyms shall mean or refer to:

(a) "Agent" refers to Trademark Agent, Patent Agent, Patent & Trademark Agent registered with the Office in accordance with these regulations.

(b) "Bureau" refers to any or all of the bureaus of the IPO namely:

- Bureau of Legal Affairs or BLA
- Bureau of Patents or BOP
- Bureau of Trademarks or BOT
- Documentation, Information and Technology Transfer Bureau or DITTB
- Management Information Systems and EDP Bureau or MIS-EDPB
- Administrative, Financial and Human Resource Development Services Bureau or AFHRDSB

(c) "Director General" refers to the Director General of the IPO Phil.

(d) "Examiner" refers to an Intellectual Property Rights Specialist in the Bureau of Patents or Bureau of Trademarks

(e) "Fees" refer the appropriate fees provided for in the regulations establishing the fee structure of the Office

(f) "IP Code" means Republic Act No. 8293 or the Intellectual Property Code of the Philippines

(g) "IPOPhil" or "Office" refers to the Intellectual Property Office of the Philippines created by the IP Code

(h) "Representative" refers to Resident Representative registered with the Office in accordance with these regulations

SECTION 4. The Registries. Listings - The following registries are hereby established:

- 1) Trademark Agent Registry
- 2) Patent Agent Registry
- 3) Patent and Trademark Agent Registry
- 4) Resident Representative Registry

The registries shall have on-line or web-based, and, off-line or non-web-based, listings which shall contain the Names, Permanent Codes and other necessary data of qualified agents.

SECTION 5. Disqualification - The following shall be disqualified from registration under these rules:

- a) employees of the IPOPhil;
- b) former employees of the IPOPhil who are disqualified under Section 19 of the IP Code;
- c) relatives of (a) and (b) to the fourth degree of consanguinity or affinity, and,
- d) juridical entities where any of (a), (b), or (c) is a member, stockholder, partner or employee.

SECTION 6. General Qualification Requirements, Resident Representative - An applicant for registration under these rules whether natural or juridical must be a resident of or domiciled in the Philippines; and, must have completed at least forty hours of training organized or sponsored by the Office, provided that in the case of a juridical entity, the training requirement shall have been completed by at least one of its senior officers. Other than applicants for registration as Resident Representative, all applicants shall also comply with the Specific Requirements herein provided.

SECTION 7. Specific Requirements - An applicant must comply with the following specific requirements:

7.1 Trademark Agent:

- a) If a natural person, must be a member of the Bar in good standing
- b) If a juridical entity, must have at least one registered Trademark Agent as one of its senior officers.

7.2 Patent Agent:

- a. If a natural person, must:

- i) EDUCATION: be a professional holding a Bachelor's Degree or post-graduate degree in the following fields of study: Chemical, Electrical, Electronic and Communication, Mechanical, Civil, or Genetic Engineering; Biology, BioChemistry, Chemistry, MicroBiology, Molecular Biology, Medicine or any allied medical course, Pharmacy, Physics, or such other existing and emerging technical fields approved by the Director-General.
 - ii) TRAINING: have obtained technical training for a period of at least twelve (12) consecutive months necessarily in the area of patents which must include at least six (6) months of basic formality examination and six (6) months of basic patent search;
 - iii) EXPERIENCE: have experience in patent processing for at least six (6) continuous years consisting of: twelve (12) months combined advanced patent search and formality examination, one (1) year basic substantive examination and four (4) years advanced substantive examination.

The TRAINING and EXPERIENCE requirement, when applied to former employees of the IPOPhil such as patent examiners, shall be complete and shall not include the periods spent for attendance as a participant in any seminar, workshop, symposium or other training wherever held.

- b) If a juridical entity, must have at least one registered Patent Agent as one of its senior officers.

7.3 Patent and Trademark Agent: