

[IPO OFFICE ORDER NO. 123, S. 2003, December 15, 2003]

AMENDMENTS TO THE PHILIPPINE RULES ON PCT APPLICATIONS

WHEREAS, the Intellectual Property Office (IPO) promulgated the Philippine Rules on Patent Cooperation Treaty (PCT) Applications (Pro-PCT), which entered into effect on 22 October 2001;

WHEREAS, the IPO issued Office Order No. 13, series of 2002 amending the Pro-PCT, effective 01 April 2002, in view of the modifications adopted by the PCT Assembly during the thirteenth (13th) ordinary session held from 24 September to 03 October 2001;

WHEREAS, the PCT Assembly during its thirty-second (14th Ordinary) session held from 22 September to 01 October 2003 adopted amendments to the Regulations under the PCT;

WHEREAS, the PCT Assembly decided that the aforementioned amendments to the Regulations under the PCT shall take effect 01 January 2004;

NOW, THEREFORE, in view of the foregoing, the Pro-PCT, as amended, are hereby further amended, as follows:

SECTION 1. Rule 4 is amended to read, as follows:

Rule 4. *Effect of an International Application* - 4.1. **An international application, which has been accorded an international filing date in accordance with the Treaty and PCT regulations**, shall have the effect of a national application for a patent or utility model, respectively, regularly filed with the Intellectual Property Office as of the International filing date, which date shall be considered to be the actual filing date in the Philippines. (PCT Article 11(3) and PCT Rule 4.9)

4.2 Subject to Review by the IPO under Rule 37, **an international application that is withdrawn or considered withdrawn under the Treaty and PCT Regulations**, before the application has entered the national phase in the Philippines as provided in Part 3 of these Rules, that international application is likewise withdrawn or considered withdrawn in the Philippines (PCT Article 24)

SECTION 2. Rule 25 is amended to read, as follows:

Rule 25. According of International Filing Date and its Effect - 25.1 The IPO, as the competent receiving Office, shall accord as the international filing date the date of receipt of the international application, provided that, at the time of receipt:

- 1) at least one applicant is a resident or national of the Philippines;
- 2) the international application is in the Filipino or English language; and
- 3) **the international application contains at least the following elements:**

- i) an indication that it is intended as an international application;**
- ii) the name of the applicant;**
- iii) a part which on the face of it appears to be a description; and**
- iv) a part which on the face of it appears to be a claim or claims. (PCT Article 11 (1))**

25.2 If the IPO finds that the applicant or not one of the applicants is a resident or national of the Philippines or that the language is neither Filipino nor English, the international application shall be treated and transmitted to the IB in accordance with PCT Rule 14, subject to payment of the transmittal fee under PCT Rule 14.

25.3 If the IPO finds that the international applications did not, at the time of receipt, contain the elements listed in Rule 25.1 item (3), it shall invite the applicant to file the required correction within thirty (30) days from the date of the invitation. If the applicant complies with the invitation, the IPO shall accord as the international filing date, the date of receipt of the required correction. If the applicant does not comply with the invitation, the IPO shall promptly in accordance with PCT Rule 20.7 (i) notify the applicant that his application is not and will not be treated as an international application and shall indicate the reasons therefor.

SECTION 3. Rule 28 is amended, including the deletion of sub-rule 28.3. Accordingly, sub-rule 28.4 becomes the new sub-rule 28.3 to read, as follows:

Rule 28. *Demand for International Preliminary Examination* - 28.1 On filing of a demand under PCT Article 31, the international application shall be the subject of an international preliminary examination.

28.2 The demand for international preliminary examination shall be filed directly by the applicant with the competent IPEA prior to the **expiration of whichever of the following periods expires later:**

- a) 3 months from the date of transmittal to the applicant of the international search report (or of the declaration referred to in PCT Article 17 (2) (a) that no international search report will be established) and the written opinion by the ISA; or
- b) 22 months from the priority date (*PCT Rule 54bis*)