

## [ IPO, December 02, 1998 ]

### **RULES AND REGULATIONS ON UTILITY MODELS AND INDUSTRIAL DESIGNS**

WHEREAS, the State recognizes that an effective industrial property system is vital to the development of domestic creativity, facilitates transfer of technology attracts foreign investments and ensures, market access for our products;

WHEREAS, it is the policy of the State to streamline administrative procedures in granting patents and enhance the enforcement of intellectual property rights in the Philippines;

NOW, therefore, pursuant to the provisions, of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines, the following rules and regulations on utility models and industrial designs are hereby promulgated:

#### **PART 1 Definitions**

*Rule 100. Definitions.* Unless otherwise specified, the following terms shall have the meaning provided in this Rule:

- (a) *"Bureau"* means the Bureau of Patents of the Office;
- (b) *"Director"* means the Director of the Bureau of Patents;
- (c) *"Director General"* means the head of the Intellectual Property Office;
- (d) *"Examiner"* means any officer or employee of the Bureau of Patents authorized to examine applications. The title or official designation of such officer or employee may change as the structure of the Office may be set;
- (e) *"IP Code"* means Republic Act No. 8293 otherwise known as the Intellectual Property Code of the Philippines;
- (f) *"IPO Gazette"* means the Intellectual Property Office's own publication where all matters required to be published under the IP Code shall be published;
- (g) *"Office"* means the Intellectual Property Office; and
- (h) *"Regulations"* means this set of rules and regulations and such Rules of Practice at may be formulated by the Director of Patents and approved by the Director General.

#### **PART 2**

## Utility Models

*Rule 200. Registrable Utility Models.* Any technical solution of a problem in any field of human activity which is new and industrially applicable shall be registrable.

*Rule 200.1 Non-Registrable Utility Models.* The following shall be excluded from protection as utility models:

- (a) Discoveries, scientific theories and mathematical method;
- (b) Schemes, rules and methods of performing mental acts, playing games or doing business, and programs for computers;
- (c) Methods for treatment of the human or animal body by surgery or therapy, and diagnostic methods practiced on the human or animal body. This provision shall not apply to products and compositions for use in any of these methods;
- (d) Plant varieties or animal breeds or essentially biological process for the production of plants or animals. This provision shall not apply to microorganisms and non-biological and microbiological processes;
- (e) Aesthetic creations; and
- (f) Anything which is contrary to public order or morality.

*Rule 200.2 Industrial Applicability.* A utility model which can be produced and used in any industry shall be industrially applicable.

*Rule 201. Statutory Classes of Utility Models.* A utility model may be, or may relate to

- (a) a useful machine;
- (b) an implement or tool;
- (c) a product or composition; or
- (d) an improvement of any of the foregoing.

*Rule 202. First to File Rule.* If two or more persons have made the same utility model separately and independently of each other, the right to the utility model registration shall belong to the person who filed an application for such utility model, or where two or more applications are filed for the same utility model to the applicant who has the earliest filing date or the earliest priority date.

*Rule 203. Filing Date of Utility Model Application.* The filing date of a utility model application shall be the date on which the Office received the following requirements:

- (a) A property filled-out request for registration as prescribed by the Bureau;
- (b) A description of the utility model;
- (c) Claim or claims;

- (d) Drawings or a pictorial representation disclosing completely the utility model, if there is/are any; and
- (e) Payment for the filing fee

If the application does not meet these requirements, the Bureau may receive the incomplete utility model application; provided it contains at least a filled-out request, a disclosure and the prescribed filing fee. The Bureau shall accord as filing date the date when all the elements specified in this Rule are filed or the mistakes corrected.

*Rule 204. Right of Priority for Utility Model.* An application for utility model filed by any person who has previously applied for the same utility model in another country which by treaty, convention, or law affords similar privileges to Filipino citizens, shall be considered as filed as of the date of filing the foreign application: Provided, That: (a) the local application expressly claims priority; (b) it is filed within twelve [12] months from the date the earliest foreign application was filed; and (c) a certified copy of the foreign application together with an English translation is filed within six [6] months from the date of filing in the Philippines.

*Rule 205. Registration of Utility Model.* A utility model application shall be registered without substantive examination provided all fees such as filing, excess claims and publication fees are paid on time and all formal requirements set forth in these Regulations are filed. Furthermore, in order to help the applicant consider his options under the IP Code and these Regulations, the application shall likewise be classified and a search conducted to determine prior art.

*Rule 206. Formality Examination of Utility Model Application.* The utility model application shall be examined as to the completeness of the formal requirements prescribed in these Regulations. The formality examination report shall be submitted to the applicant together within two (2) months from filing date. The formality examination shall take into account the parts of these Regulations on: (a) the right to a patent, (b) who may apply for a patent, (c) filing date requirements and (d) formality examination.

*Rule 207. Applicant's Action of the Formality Examination Report and the Search Report.* Within two (2) months from the mailing date of the formality examination report and the search report, the applicant may: (1) voluntarily withdraw the application, (2) amend the application, (3) convert the application to an application for an invention patent, or (4) upon payment of the required fee, request for a registrability report.

*Rule 207.1. Voluntary Withdrawal.* The application shall be deemed withdrawn and all files expunged from the record of the Bureau upon receipt of the applicant's voluntary, withdrawal.

*Rule 207.2. Amended Applications.* The amended application shall be subjected to formality examination, search and classification. Report thereon shall be submitted to the applicant within two (2) months from receipt of the amended application. Within two (2) months from mailing date of the formality examination report and the search report on the amended application, the applicant may: (1)

withdraw the application, (2) convert the same to an application for an invention patent, or (3) upon payment of the required fee, request for a registrability report. The application shall be deemed withdrawn and all files expunged from the records of the Bureau upon receipt of the applicant's withdrawal.

*Rule 207.3. Application Converted to an Application for Inventions Patent.* The application or amended application which is converted into an application for an invention patent shall be processed as an invention patent application upon receipt of notice from the applicant.

*Rule 207.4. No Action on the Part of Applicant where Formal Requirements are Complete.* Where the application meets all the formal requirements for registrability and the Bureau fails to receive any action from the applicant, the utility model shall be deemed registered upon the expiration of two (2) months from the mailing date of the search report.

*Rule 207.5. No Action on the Part of Applicant where Formal Requirements are not Complete.* Where the application fails to meet any of the formal requirements for registration and the Bureau fails to receive any action from the applicant, the application shall be deemed withdrawn and all files thereon shall be expunged from the records of the Bureau upon the expiration of two (2) months from the mailing date of the formality examination report. The Bureau may return to the applicant all the files expunged from its records.

*Rule 207.6. Registrability Report.* The report shall contain citations of relevant prior art documents with appropriate indications as to their degree of relevance which will serve as an aid to the applicant in the determination of the validity of the utility model claim(s) in respect to newness.

The registrability report shall be given to the applicant within two (2) months from receipt of the request from the applicant. It shall be included in the publication of the registered utility model.

*Rule 208. Requirements for Applications for Utility Model.* An application for Utility Model registration and other correspondences shall be in Filipino or English and must be addressed to the Director of the Bureau of Patents of the Intellectual Property Office (IPO).

The application shall contain the following:

- a) A duly accomplished request for registration as prescribed by the Bureau
- b) Description containing the following:
  - 1. title
  - 2. technical field
  - 3. background of the Utility Model
  - 4. brief description of the several views of the drawings, if any
  - 5. detailed description
  - 6. claim or claims
  - 7. drawings, if any

*Rule 208.1. Title.* The title should be as short and specific as possible, and should appear as heading on the first page of the specification. All fancy names are not permissible in the title.

*Rule 208.2. Technical Field.* A statement of the technical field of the art to which the utility pertains. The statement should be directed to the subject matter of the claimed utility model.

*Rule 208.3. Background of the Utility Model.* It is a description which indicates the so-called "background art" constituting the related prior art or state of the art or known technology for the utility model sought to be registered, including references to specific documents where appropriate. Where applicable, the problems involved in the information which may be solved by the applicant's utility model should be indicated.

*Rule 208.4. Brief Description of the Several Views of the Drawings, if there be any.* Every view of the drawings should be briefly described, and indicated with corresponding figure numbers.

*Rule 208.5. Detailed Description.* The detailed description must specifically include a complete description of the manner or making and using the utility model. It must set forth the precise or exact utility model for which registration is sought, in such manner as to distinguish the utility model from the prior art it pertains to and the technical problem solved by the utility model should be indicated.

*Rule 208.6. Claim or Claims.*

a) The claim(s) must define the subject matter of the utility model for which registration is sought. Such claim(s) should be clear and concise and fully supported by the description.

b) If the utility model application relates to an improvement, the claim(s) should specifically point out and distinctly claim the improvement in combination with a preamble statement indicating the prior art features which are necessary for the definition of the claimed subject matter.

*Rule 209. Unity of Utility Model.* Only one independent genus or generic claim is permissible in a utility model application. However, specific variations of the utility model may be claimed in a reasonable number of dependent claims in a single application, provided such variations fall under a single statutory class provided in these Regulations and are embodied under a single general innovative concept. Such specific variations of the claimed utility model must fall within the scope of the generic claim.

*Rule 209.1. Claims Incurring Fee.* (a) Any utility model application comprising more than five (5) claims, independent and/or multiple/alternative dependent claims at the time of filing, or added claims after the filing date in respect of each claim over and above five (5) incurs payment of a claims fee. The claims fee shall be payable within one (1) month after the filing of the application. If the claim fees have not been paid in due time, they may still be validly paid within a grace period of one (1) month from notice pointing out the failure to observe the time limit. If the claims fee is not paid within the time limit and the grace period referred to in this