

Questions

Groups are invited to answer the following questions under their national laws:

I. Analysis of current law and case law

1. Please provide a brief description of your law concerning publication of patent applications and identify the statute, rule or other authority that establishes this law.

Republic Act No. 8293, as amended, or otherwise known as the Intellectual Property Code ("IP Code") is the law on intellectual property in the Philippines, and provides for the publication of patent applications. It was approved on 06 June 1997 and took effect on 01 January 1998. Specific details on patent publication are found in the Revised Implementing Rules and Regulations for Patents, Utility Models and Industrial Designs ("IRR"), which became effective in 2011.

Under Sec. 44 of the IP Code, a pending patent application is published together with the search report established by the IPO within 18 months from the filing date or priority date.

2. Does publication of patent applications occur automatically in your jurisdiction? If so, when does publication take place? If not, what are the requirements to effect publication?

Under the IP Code, publication of patent application should occur 18 months from the filing date or priority date. [Sec. 44, IP Code; Rule 800, IRR] However, we have observed that some pending patent applications are published beyond the said period. It appears that the delays are sometimes caused by the lack of search report which should also be published together with the patent application. In any event, publication takes place automatically and without need of further act from the applicant.

3. If a patent application claims priority from or the benefit of an earlier application how, if at all, does this affect the timing of publication?

If a patent application claims priority, the reckoning period for the 18-month period will be the priority date. [Sec. 44, IP Code; Rule 800(a), IRR] However, as stated in item 2 above, the publication of pending application may take place after the said period.

4. Is there a specific point in time up to which the applicant can withdraw its application without it being published?

The IP Code does not provide for a specific point in time up to which the applicant can withdraw its application without it being published. However, the application will not be published if it has been withdrawn, or deemed to be withdrawn before the technical preparation for publication. [Rule 800(b), IRR] Thus, it would be prudent to voluntarily file a written declaration of withdrawal within 2-3 months before the 18-month period to avoid publication.

5. What parts of a pending patent application are published?

The application is published in the IPO Gazette together with a search document. It includes the bibliographical data, any drawing as filed, and abstract. [Sec. 44, IP Code; Rule 800(a) and (c), IRR.]

6. Does a published pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?

Yes, a published patent application confers rights under Sec. 46 of the IP Code and Rule 805 of the IRR. These are all the rights of a patentee under Section 76 of the IP Code against any person who, without his authorization, exercises any of the rights conferred under Section 71 of the IP Code in relation to the invention claimed in the published application, as if a patent has been granted for that invention; provided, that the said person had: (a) actual knowledge that the invention that he was using is the subject matter of a published application; or (b) received a written notice that the invention that he was using was the subject matter of a published application being identified in the said notice by its serial number; provided further, that the action may not be filed until after the grant of a patent on the published application and within four (4) years from the commission of the acts complained of.

7. Does an unpublished pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?

Sec. 46 of the IP Code and Rule 805 of the IP Code refer to provisional rights conferred after the publication of an application. Thus, the rights of the patentee under Section 76 of the IP Code against any person who, without his authorization, exercises any of the rights conferred under Section 71 of the IP Code, will not apply in favor of the applicant of an unpublished application.

However, Rule 204 of the IRR provides that where two or more applications are independently filed with respect to the same invention, and the later applications are filed before the first application or earlier application is published, the whole contents of the first or earliest filed application published on or after the filing date or priority date of the later filed application shall be novelty destroying with respect to the later application filed.

8. Is 'early publication' allowed in your jurisdiction? If so, what are the conditions for

such early publication? How is the request for early publication made? What is the effect of an early publication on a pending patent application?

Yes. The early publication of a patent application is allowed before eighteen (18) months but not earlier than six (6) months from the filing date of such application. [Rule 800.1, IRR]

For a patent application to be granted early publication, the following conditions must first be satisfied:

- (a) A written request for an early publication is filed;
- (b) The applicant attaches thereto a waiver on the confidentiality disclosures of the application, under oath;
- (c) The applicant agrees to have the application published without a search report; and
- (d) Full payment has been made of the early publication fees.

An early publication of a pending patent application grants the applicant all the rights of a patentee under Section 76 of the IP Code against any person who, without his authorization, exercises any of the rights conferred under Section 71 of the IP Code.

9. Is non-publication possible in your jurisdiction? In other words, can a pending patent application remain confidential? If so, under what conditions is such allowed? How is the request for non-publication made?

Yes. A patent application may not be published if to do so would be prejudicial to the national security and interests of the Republic of the Philippines.

The Director General, subject to the approval of the Secretary of Trade and Industry, shall determine if a patent application would not be published. [Sec. 44.3, IP Code]

The applicant may also voluntarily request that his application not be published. However, the application will not undergo substantive examination until it is published.

10. Will a lapsed, abandoned or withdrawn patent application be published? If not, is that automatic or by the request of the applicant? If it would otherwise be published, can the applicant request non-publication?

An application which has been finally refused, withdrawn or deemed to be withdrawn will not be published under the IRR. [Rule 800 (b), IRR] However, for those abandoned shortly before the 18th month period before the filing date or priority date, it would be prudent to request for non-publication, if so preferred, in case the technical preparations for publication have already been commenced or completed.

11. What is the position in your jurisdiction regarding the publication of continuation, continuation-in-part and divisional applications?

In practice, the timing for the publication of divisional applications depends on the examiner.

II. Policy considerations and proposals for improvements to your current system

12. Should there be a requirement for automatic publication of pending applications by a particular deadline?

Yes. While the law currently provides a period for publication, in practice, there are pending applications that are published beyond the 18 month period. This causes delay in the prosecution process.

13. Should there be a right for the patentee to request early publication? If so, on what basis and with what consequence?

Yes. Under the IP Code, early publications of pending patent applications are allowed subject to certain conditions: (a) the applicant attaches thereto a waiver on the confidentiality disclosures of the application, under oath; (b) the applicant agrees to have the application published without a search report; and (c) full payment has been made of the early publication fees.

Early publication expedites the grant of provisional rights in favor of the applicant. Likewise, early publication expedites the prosecution process.

14. If your answer to question 13 is yes, should all the applications deriving from the same priority application be subject to the early publication if one application is published early?

No. The applicant should be given the option to choose which application should be granted early publication. Publication affects the deadline for the filing of substantive examination and the applicant should have the option of deciding when to file the request for each application, even if arising from the same priority application.

15. Should there be a right for the patentee to withdraw the application before publication?

Yes. The applicant should have the right to withdraw the application before publication, provided it has not yet been allowed or issued a patent. A patent application cannot be issued a patent if it has not been published to afford the public the right to file a third party observation.

16. If your answer to question 15 is yes, what should be the consequence of such withdrawal:

a. with respect to the patentee's own subsequent patent applications; and

The withdrawal of an application should have no effect on the patentee's own subsequent patent applications.

b. with respect to third party patent applications?

The withdrawn and unpublished application should have no effect to third party applications. The former cannot be novelty destroying as against any subsequent patent application.

17. If your answer to question 15 is yes, should the patent office be required to provide its initial assessment of the validity of the patent (if granted) before the applicant is required to decide whether to withdraw?

Yes, the patent office should be required to provide its initial assessment of the validity of the patent before the applicant is required to decide whether to withdraw. However, the search report may be considered such initial assessment, provided the search report is given to the applicant before publication.

18. In light of your answers to the previous policy questions, what would be appropriate time limits for:

a. the patent office to provide the results of its initial assessment?;

Within sixteen months from the filing date, or in any event not less than two months before publication. The search report may be considered such initial assessment, provided the search report is given to the applicant before publication.

b. the applicant to decide whether to withdraw the application?; and

At any time before allowance. However, should the applicant prefer that the application not be published, withdrawal should be made not less than two months before publication.

c. the application to be published?

Eighteen months from filing date.

19. Should there be any exceptions to automatic publication, and if so what on what grounds, for example:

a. on the initiative of the patentee;

The applicant may ask for early publication or non-publication, provided that the application will not undergo substantive examination unless published. The applicant may also voluntarily withdraw the application before publication.

b. on the initiative of the patent office; or

An application will not be published if it has been finally refused, withdrawn, or deemed to be withdrawn before the technical preparation for publication. [Rule 800 (b), IRR] Also, the Director General, subject to the approval of the Secretary of Trade and Industry, may prohibit or restrict the publication of an application, if in his opinion, to do so would be prejudicial to the national security and interests of the Republic of the Philippines. [Sec. 44.3, IP Code; Rule 800(e), IRR]

c. on the initiative of third parties (such as other governmental agencies)?

None.

20. If your answer to question 19 is yes, who should decide on whether such exception is applied?

The patent office.

21. Should there be different rules for the publication of continuation, continuation-in-part and divisional applications?

There are currently no continuation and continuation-in-part publications of patents in the Philippines. There is only divisional application.

22. What proposals would you make to improve your current system?

Time for publication of pending application should strictly adhere to what is provided under the law. Moreover, the search report should be provided to the applicant before it is published.

III. Proposals for harmonization

Groups are invited to put forward proposals for the adoption of harmonized rules in relation to the publication of patent applications. More specifically, the Groups are invited to answer the following questions:

23. Should patent offices be required to provide examination results or at least search results prior to publication so that applicants can make an informed decision whether to pursue obtaining a patent or to withdraw the application and protect the invention idea as a trade secret?

Yes. The search report may be considered such initial assessment, provided the search report is given to the applicant before publication.

24. Should there be any exception to publication of applications, for example by the applicant's opt-out?

Yes. In fact, the IP Code and the IRR provide for several exceptions. An application will not be published if it has been finally refused, withdrawn, or deemed to be withdrawn before the technical preparation for publication. [Rule 800(b), IRR] Also, the Director General, subject to the approval of the Secretary of Trade and Industry, may prohibit or restrict the publication of an application, if in his opinion, to do so would be prejudicial to the national security and interests of the Republic of the Philippines. [Sec. 44.3, IP Code; Rule 800(e), IRR]

Moreover, the applicant may ask for early publication or non-publication, provided that the application will not undergo substantive examination unless published. The applicant may also voluntarily withdraw the application before publication.

25. How should exceptional circumstances be defined, e.g., public order, morality or national security where the patent office delays or suppresses publication? To what extent should these exceptional circumstances be specifically defined?

To date, public order, morality or national security has not been invoked to delay or suppress a publication of a patent application. It is submitted that the said exceptional circumstances not be given a narrow definition so as to give the President, acting through the Secretary of Trade and Industry, sufficient discretion. However, the IPO should also provide specific rules on the effect of such applications that are not published on the government's initiative and without any request for non-publication or any similar action from the applicant.

26. What is an appropriate period for publication after filing an application or after the priority date? Is 18 months an appropriate period?

The period of eighteen (18) months as provided for in the law is considered appropriate.

27. Please make any other comments or proposals for harmonization in relation to publication of patent applications that you consider appropriate.