

# INVENTIONS & *Innovations*

*A Glimpse of the Filipino Legacy*



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# **PATENT ATTORNEYS AND AGENTS IN THE PHILIPPINES**

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**WITH THE “GLOBALIZATION” OF COMMERCE AND TRADE** and the advancement and sophistication of technology, the Philippines, as member of the international community, has now come to terms not only with the need to afford protection to intellectual property rights, but also with the promotion of intellectual activity, including the effective transfer of applicable technology.

In the light of the foregoing, the role of patent attorneys and agents in the country has become all the more significant and vital to ensure that the rights of local and foreign intellectual property owners or proprietors are efficiently maintained and duly respected.

Members of the Philippine Bar in good standing may apply and accordingly register as patent attorneys with the Intellectual Property Office (IPO). In accordance with the existing rules of practice in trademark and patent cases, nonmembers of the Philippine Bar may be registered as patent agents provided they possess the following qualifications: a bachelor's degree in Natural Science or **Engineering**, at least five years of employment with the IPO as examiner of patent applications, assistance in the preparation and prosecution of patent applications for at least two years, and membership with the Philippine Association of Certified Patent Agents (PACPA). Only Filipino citizens may act as patent attorneys and agents in the Philippines.

Essentially, the scope of patent attorneys and agents includes (a) the filing and prosecution of applications for trademark, servicemark, or copyright registration; (b) the review and registration of licensing agreements and maintenance of trademarks, patent and copyright registrations; (c) the institution of actions and suits for the protection of intellectual property protection such as infringement, unfair competition, injunction, opposition to application for trademark registration, cancellation of registered patent or mark and the like; and (d) the rendering of routinary advice on any and all matters related to intellectual property protection.

Clients of patent attorneys and agents usually consist of foreign and domestic corporations and enterprises as well as individuals, more particularly authors and inventors, who are all interested in obtaining ample protection for their intellectual creations and in learning how they can derive benefit, financial or otherwise, from these.

The first thing patent attorneys and agents normally explain to their clients is the need to recognize their property rights as mandated by existing laws and to understand the importance of protecting their rights from those who would like to copy, use, and profit from their works without their authorization.

Once this has been settled and the clients are convinced of the relevance of seeking protection, the patent attorneys and agents will then proceed to apprise the clients of the manner by which their creation can be protected, how their applications for registration or recordal of their works can be properly prepared and duly filed with the appropriate government agency, the length of time of the entire procedure and the costs entailed in undertaking the same.

## ***Patent Procedure***

Under Section 21 of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines which took effect on January 1, 1998, a patentable invention is any technical solution of a problem in any field of human activity which is new, involves an inventive step, and is industrially applicable. Such may relate to a product, or process, or an improvement of either of the foregoing.

A patent attorney or agent is tasked to initially assist a client in arriving at a preliminary opinion as to whether or not his invention is capable of being



patented based on the conditions set forth by law. A "search for prior art"—or knowledge of the relevant technical field which has been made available to the public anywhere in the world prior to the invention applied for—may be conducted by the patent attorney or agent to determine if the said invention is, in fact, new or not.

The patent attorney or agent is responsible for the proper preparation and timely filing of the client's patent application which shall contain: (a) a request for the grant of a patent; (b) a description of the invention; (c) drawings; (d) claims; (e) the abstract; (f) a certified copy of the foreign patent application with English translation, if the application claims the prior filing date of the said foreign application for the same invention; and (g) payment of filing fees. The request for the grant of a patent may be signed by the patent

attorney or agent in behalf of the client provided the latter authorizes the former by way of a special power of attorney to act as such.

In the Philippines, the description of the invention, drawings, claims, and the abstract are drafted by those skilled in the applicable art and are oftentimes already provided by the client, with the patent attorney or agent strictly concerned with the execution of formal papers in the prescribed form and the compliance with filing procedures. The description of the invention should be appropriate and sufficient to enable the reader to understand and use it. The claims, on the other hand, define the scope and actual embodiment of the invention, and are skillfully drafted in technical terms.

After the application has been filed and the registration issued, it is the duty of the patent attorney or agent to ensure that the patent application or registration is maintained during its twenty-year duration and that all requirements of the IPO relative thereto are monitored and completely relayed to the client for his compliance and/or eventual submission to the IPO through the patent attorney or agent. The patent attorney or agent is further tasked to keep track of the relevant dates when these requirements are to be submitted in order not to deny the client of his patent rights in any respect and to ultimately follow the instructions of the client in accordance with law.

For domestic clients interested in filing patent applications in other countries, the patent attorney or agent takes on the job of looking for and appointing responsible associate patent attorneys or agents who may be willing to handle and process the client's applications in their countries, as well as monitoring the applications' movements in due course through formal communications or oral instructions.

## *Trademark Procedure*

The patent attorney or agent is similarly duty-bound to assist the client in preparing and filing his trademark application and thus secure the trademark's protection. A trademark search is usually recommended to be conducted by the patent attorney or agent, first and foremost, to find out if there is any existing trademark being applied for or registered in the name of other entities which may be confusingly similar to the client's proposed mark.

Being familiar with the law and applicable rules of trademark, the patent attorney or agent is in the best position to advise the client regarding the mark's non-registrability for being descriptive, misleading, contrary to public order, or confusingly similar with another mark or on the other hand, its registrability for being distinct, different, or internationally well-known.

The patent attorney or agent is also responsible for the preparation and filing of the client's trademark application which shall contain among other requirements: (a) a request for registration; (b) the name and address of the applicant; (c) the name of the state of which the applicant is a national or where he has domiciled and the name of the state in which the applicant has a real and effective industrial or commercial establishment, if any; (d) where the applicant is a juridical entity, the law under which it is organized and existing; (e) the appointment of an agent or representative, if the applicant is not domiciled in the Philippines; (f) where the applicant claims the priority of earlier application, information regarding said earlier application; and (g) reproductions of the mark (Section 124, RA 8293).

Once the trademark application is filed, the patent attorney or agent is likewise responsible for communicating to the client all subsequent actions of the IPO, including possible objections relative to the trademark application and oppositions thereto soon after the application is allowed for publication.

After the registration certificate is issued, the patent attorney's or agent's attention turns to maintaining the same for its entire ten-year duration or its renewal after its expiration, if so authorized by the client. The patent attorney or agent should also monitor the unauthorized use by others of the client's mark or any mark similar to it, and report to the client such misuse without delay.