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Philippines

Angara Abello Concepcion Regala & Cruz (ACCRALAW)

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Law and Practice

Contributed by Angara Abello Concepcion Regala & Cruz (ACCRALAW)

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Angara Abello Concepcion Regala & Cruz (ACCRALAW) has grown from a core group of seven lawyers at its inception in 1972 into a prestigious service organisation of more than 160 lawyers and 160 non-legal personnel, with principal offices in Bonifacio Global City, Taguig, Metro Manila, and full-service branches in the Visayas and Mindanao. Its Intellectual Property department offers innovative solutions in all areas of intellectual property rights protection and management, representing local and foreign clients in the registration and maintenance of patents, trade marks and

copyrights in the Philippines, with an established network of correspondent law firms in other countries. ACCRALAW is at the forefront in the fight against counterfeiting, piracy and unfair competition, having successfully prosecuted criminal, civil and administrative cases for trade mark infringement and unfair competition on behalf of owners of well-known marks. The firm is active in national as well as international associations involved in the protection of intellectual property rights and is consistently cited worldwide for its quality work and excellent track record.

Authors



Victor Basilio N De Leon is a partner and former monitor of the IP department who is highly experienced in IP, particularly in the areas of trade mark enforcement, prosecution, management, and licensing.

He is a member of the International

Association for the Protection of Intellectual Property (AIPPI), Intellectual Property Association of the Philippines (IPAP), Asian Patent Attorneys Association (APAA) and the Licensing Executives Society Philippines, where he is currently treasurer and director.



Richmond K Lee is a partner and monitor of the firm's IP department who handles the full spectrum of IP work, including non-contentious and contentious work in the areas of trade marks, copyrights, patents and designs. Mr Lee advises clients

on licensing and technology transfer arrangements, regulatory and advertising-related issues, data protection and trade secrets, custom recordation and seizure, and IP portfolio management and audit. He handles the protection of domain names, plant varieties and integrated circuit layout designs, has been involved in the prosecution of trade mark applications, and handles trade mark infringement and unfair competition cases. Mr Lee has argued before trial and appellate courts, including various administrative agencies such as the Intellectual Property Office, and is a member of the Asian Patent Attorneys Association and the Intellectual Property Association of the Philippines.



Jose Eduardo T Genilo is a partner of the firm and practises in its IP department.

His work covers IP enforcement and litigation, including search and seizure, civil and criminal litigation before the

courts, administrative litigation before the

Philippine IP Office, injunction proceedings, appellate proceedings and customs enforcement. He is also active in trade mark and patent prosecution and licensing, as well as the drafting of patent specifications and claims. Mr Genilo is a member of the Intellectual Property Association of the Philippines, the Pharmaceutical Trade Marks Group, the Intellectual Property Alumni Association and the Association of Patent Agent Qualifying Examination Passers.



Joan Janneth M Estremadura is an associate in the IP department who specialises in trade mark, patent and copyright prosecution and litigation, she has spoken on the subject of patent

prosecution and protection of the

motorcycle industry in the Philippines at the Intellectual Property Rights Symposium in Pasig City, and attended a training course for practitioners specialising in patents in Tokyo in 2018 sponsored by the Japan Patent Office.

1. Types of Intellectual Property Rights & Grant Procedure

1.1 Types of Intellectual Property Rights

The law on patents protects inventions and utility models. The protection is primarily based on statutory rights under the Intellectual Property Code of the Philippines (IP Code) and its implementing rules and regulations. The provisions of the IP Code are further elaborated and explained through precedent case law.

Trade secret protection may be available for inventions that are not disclosed to the public. The IP Code expressly recognises 'protection of undisclosed information' as an intellectual property right. Although there is no law governing trade secrets, they are recognised and protected by case law.

1.2 Grant Procedure

Protection for invention is granted once it is registered with the Intellectual Property Office of the Philippines (IPOPHL). The Philippines follows the first-to-file rule in determining who has a better right over a patent.

Inventions

The application for registration of inventions has two phases: the first is the formality examination phase, and the second is the substantive examination phase.

During the formality examination phase, the documents accompanying the application such as the priority documents (if applicable), proof of authority, deeds of assignment, identification of inventors, formal drawings, among others, are examined and evaluated. If the documents are found to be in order and complete, the invention application will be published together with the search document (the first publication). The written request for substantive examination and payment for the request must be made within six months from the date of the first publication. The failure to request substantive examination and pay the requisite fee will result in the withdrawal of the application.

The invention application will then undergo substantive examination to determine the invention's patentability. Substantive examination phase typically lasts 32 months on average. When the applicant overcomes the issues raised by the examiner, the grant of the patent will undergo publication (the second publication). A patent takes effect on the date of the publication of the grant of the patent in the IPOPHL's Electronic Gazette (E-Gazette).

Utility Models

Utility model applications do not undergo substantive examination. Upon filing of an application, it will undergo formal examination. The examiner will only determine the adequacy of the application and the formal documents submitted. If the documents are satisfactory, the application will

be published in the IPOPHL's E-Gazette. Any objection to the application must be filed within 30 days from the date of publication. If no objection is filed within 30 days, the utility model will be granted registration.

The Philippines is a contracting state to the Patent Cooperation Treaty (PCT).

1.3 Timeline for Grant Procedure

As of 2018, the average turnaround before an invention is granted is 47.4 months or almost four years. For utility models, the average turnaround time from application to registration is 7.8 months.

An applicant who is not a resident of the Philippines needs to appoint and maintain a resident agent or representative in the Philippines upon whom notice or process for judicial or administrative procedure relating to the application for a patent may be served. A resident applicant may represent his or her own application for registration.

In the Philippines, the IPOPHL distinguishes between a small and big entity applicant. A big entity refers to a natural or a legal entity whose assets are more than PHP100 million or approximately USD2 million.

The approximate government fee until the grant of an invention patent (assuming that there are no more than five claims) is PHP8,000 (USD160) for small entities and PHP14,000 (USD280) for big entities.

The approximate government fee until the registration of a utility model (assuming that the claims do not exceed five) is PHP3,200 (USD64) for small entities and PHP6,700 (USD134) for big entities.

1.4 Term of Each Intellectual Property Right

An invention is protected for a term of 20 years from the date of filing the application. This period may not be extended.

A utility model is protected for a term of seven years from the date of filing the application. This term may also not be extended.

For PCT national phase entry applications, the term is counted from the international filing date.

1.5 Rights and Obligations of Owner of Intellectual Property Right

A patent shall provide the owner exclusive rights to restrain, prohibit, and prevent any unauthorised person to make, use, offer for sale, sell or import any patented product or any product obtained from a patented process.

The patent-holder may file a civil action for patent infringement. Further, the patent-holder may recover damages sus-

tained by the act of infringement, plus lawyers' fees and other expenses of litigation. The patent-holder may also secure an injunction to prevent further acts of infringement, and to protect his or her rights.

If the damages cannot be readily ascertained with certainty, the court or any competent authority may award as damages a sum equivalent to a reasonable royalty. Depending on the circumstances of the case, the court may also award damages over and above the actual damages, although no more than three times that amount. The court may also order the infringing goods or any material used for the infringement to be disposed of or destroyed without compensation.

If infringement is repeated by the infringer or by anyone in connivance with him after finality of the judgment of the court against the infringer, the offenders shall, without prejudice to the institution of a civil action for damages, be criminally liable of patent infringement.

An annual fee shall be paid upon the expiration of four years from the date the application was first published, and on each subsequent anniversary of that date until the expiration of the patent. Failure to pay the annual fee will result in the withdrawal of the patent application or the lapsing of the patent registration.

1.6 Further Protection After Lapse of Maximum Term

The term of protection for invention patents and utility model registrations may not be extended. Once the term has lapsed, the invention or utility model forms part of the public domain.

1.7 Third-Party Rights to Participate in Grant Proceedings

Third-party observation is available for invention patent applications. Following the first publication of the patent application, any person may present observations in writing concerning the patentability of the inventions. These observations shall be communicated to the applicant who may comment on them. The IPOPHL will note the comments made by third parties and place its observations and comments in the file wrapper of the relevant application.

For utility model applications, any third party may file an objection to the application up to 30 days from when it is published in the IPOPHL's E-Gazette.

1.8 Remedies Against Refusal to Grant Intellectual Property Right

Where the patent application has been refused, the applicant may request a review of the application by the examiner. The request must be made in writing and the applicant must point out specifically the examiner's errors. The application will be re-examined and the examiner may require amendments to

be made or the examiner may rule that the refusal stands and is final.

In the case of a final refusal from the examiner, the applicant may appeal the matter to the Director of Patents. Should the Director still refuse the application, an appeal may be filed with the IPOPHL's Director General. If the decision of the IPOPHL's Director General is still negative, the applicant may file an appeal with the Court of Appeals and thereafter to the Supreme Court.

1.9 Consequences of Failure to Pay Annual Fees

Failure to pay the annual fee will result in the withdrawal of the patent application or the lapse of the patent registration. A notice that the application is deemed withdrawn or has lapsed shall be published in the E-Gazette of the IPOPHL. The notice will also be mailed to the patent owner or the agent.

A grace period of six months counted from the publication of the withdrawal or lapse will be granted. The patent-owner or holder must pay the required annual fees, publication fees and surcharge fees in full within the six-month period. The amount of the surcharge fee is 50% of the total annual fee. Failure to pay will result in the withdrawal of the patent application or the lapsing of the registration as of the date following the expiry of the original period within which the annual fee was due. It will again be published in the IPOPHL's E-Gazette, and this will be recorded in the IPOPHL's Register.

2. Initiating a Lawsuit

2.1 Actions Available Against Infringement

A patent-holder may file a civil action against a patent infringer where damages may be recovered. The court may order the destruction of the infringing product, without compensation. The patent-holder may also request the issue of an injunction to prevent further acts of infringement.

If infringement is repeated by the infringer or by anyone in collusion with the infringer after the final judgment of the court in the civil action for infringement, the infringers shall be criminally liable without prejudice to the filing of a civil action for damages.

2.2 Third-Party Remedies to Remove Effects of Intellectual Property Rights

For inventions, any interested person may petition to cancel a patent or any connected claim, or parts of the claim on any of the following grounds:

- the invention is not new or patentable;
- the patent does not disclose the invention in a manner sufficiently clear and complete to be carried out by a

- person skilled in art; or
- the patent is contrary to public order or morality.

Utility model registrations may sought to be cancelled by any interested person if:

- the claimed invention does not qualify for registration as a utility model and does not meet the registration requirements;
- the description and claims do not comply with prescribed requirements;
- any drawing which is necessary for understanding the invention has not been furnished; or
- the owner of the utility model is not the inventor or his successor in title.

Any person who has shown his capability to exploit the invention patent or utility model registration may file an action for compulsory licence under certain circumstances.

2.3 Courts with Jurisdiction

A patent infringement action may be filed with the designated commercial courts of the Regional Trial Court (RTC) where the principal office of either the complainant or the defendant is located. The case may also be filed with the Bureau of Legal Affairs (BLA) of the IPOPHL. The decision of the RTC may be appealed to the Court of Appeals and thereafter the Supreme Court. The decision of the BLA may be elevated to the IPOPHL Director General, whose decisions may then be brought to the Court of Appeals and then to the Supreme Court.

2.4 Specialised Bodies/Organisations for the Resolution of Disputes

Apart from the specialised commercial courts in each jurisdiction designated by the Supreme Court to hear and decide intellectual property cases (ie, patent infringement cases), the IPOPHL is likewise mandated to receive and hear such cases (as administrative cases).

Civil search and seizure applications involving patent infringement are filed with, and heard by, the specialised commercial courts.

2.5 Prerequisites to Filing a Lawsuit

Generally, there is no prerequisite prior to filing a patent infringement suit. No damages, however, can be recovered for acts of infringement committed before the defendant knew, or had reasonable grounds to know, of the patent. It is presumed that the defendant knew of the patent if on the product, or on its container or packaging, or on the advertising material relating to it, there are the words 'Philippine patent' with a patent number.

2.6 Legal Representation

In proceedings involving patent infringement before the court or the IPOPHL, the parties must be represented by counsel.

2.7 Interim Injunctions

Injunctions may be granted when it is established that:

- the applicant is entitled to the relief demanded, and the whole or part of such relief consists in restraining the commission or the continuance of the act or acts complained of, or in requiring the performance of an act or acts, either for a limited period or perpetually;
- the commission, continuance or non-performance of the act or acts complained of during the litigation would probably work injustice to the applicant; or
- a party or any person is doing, threatening, or is attempting to do, or is procuring or suffering to be done, some act or acts probably in violation of the rights of the applicant respecting the subject of the action or proceeding and tending to render the judgment ineffectual.

2.8 Protection for Potential Opponents

Before the issue of a writ of civil search and seizure or a writ of injunction involving patent infringement, the courts or the IPOPHL will require the applicant or complainant to post a bond, the amount of which to be determined by the court or hearing officer. The bond shall answer for any damage the defendant may suffer due to the litigation.

2.9 Special Limitation Provisions

With respect to patent infringement cases, no damages may be recovered for acts of infringement committed more than four years prior to the filing of the action for infringement.

In criminal cases there is a limit of three years from the date of commission of the crime in which to bring an action for repetition of patent infringement.

2.10 Mechanisms to Obtain Evidence and Information

In patent infringement cases, the complainant may avail of different modes of discovery, eg, a motion to produce and inspect documents, interrogatories and/or requests for admissions. These discovery procedures must be filed within 30 days from the joinder of issues, which is usually when the defendant files his answer to the complaint.

Also, an intellectual property right-holder in a pending civil action for infringement, or one who intends to commence such an action, may apply (ex parte) for the issue of a writ of search and seizure directing the defendant or expected adversary to admit into his or her premises the persons named by the court (hearing the application). The writ also allows for the search, inspection, copying, photographing,

audio and audiovisual recording or seizure of any document and article specified by the court.

This may be resorted to where any delay is likely to cause irreparable harm to the intellectual property right-holder or where there is demonstrable risk of evidence being destroyed.

2.11 Initial Pleading Standards

As far as formality requirements for patent infringement actions are concerned, the initial pleading (complaint) filed with the courts or IPOPHL must be verified by the complainant. Verification means that the complainant has read the complaint and the allegations are true and correct to the best of his knowledge and belief. The complaint must also be accompanied by a certificate of non-forum shopping, which states that the complainant has not filed any action involving the same issues before any tribunal or agency, and that if any action of the same nature has been filed, the complainant shall inform the relevant court of agency within five days of knowledge of the filing.

The complaint must contain the names and addresses of the parties, and a concise statement of the ultimate facts constituting the complainant's cause of action. The complaint must also specify the relief sought and must be accompanied by the required filing fees.

Supplemental pleadings or complaints are allowed only upon a motion by a party and it must allege transactions, occurrences or events that have happened since the date of the pleading sought to be supplemented.

2.12 Representative or Collective Action

Class suits are generally allowed in the Philippines. However, there are no patent infringement cases decided by the Supreme Court that involve this type of claim.

2.13 Restrictions on Assertion of Intellectual Property Right

The owner of a patent has no right to prevent third parties from performing, without his or her authorisation, the rights conferred by a patent, in the following circumstances:

- using a patented product which has been put on the market in the Philippines by the owner of the product, or with his express consent, insofar as such use is performed after that product has been placed on the market;
- where the act is done privately and on a non-commercial scale or for a non-commercial purpose – provided that it does not significantly prejudice the economic interests of the owner of the patent;
- where the act consists of making or using exclusively for experimental use of the invention for scientific purposes or educational purposes, and such other activities

directly related to such scientific or educational experimental use;

- where the act consists of the preparation for individual cases, in a pharmacy or by a medical professional, of a medicine in accordance with a medical prescription or acts concerning the medicine so prepared;
- where the invention is used in any ship, vessel, aircraft, or land vehicle of any other country entering the territory of the Philippines temporarily or accidentally – provided that such invention is used exclusively for the needs of the ship, vessel, aircraft, or land vehicle and not for the manufacturing of anything to be sold within the Philippines.

A prior user who, in good faith, was using the invention or has undertaken serious preparations to use the invention in his business before the filing date or priority date of the application on which the patent is granted, shall have the right to continue its use within the country of manufacture.

Moreover, the government or a party duly authorised by the government may exploit a patented invention even without a patent-holder's consent where:

- the public interest, in particular, national security, nutrition, health or the development of other sectors, as determined by the appropriate agency of the government, so requires;
- a judicial or administrative body has determined that the manner of exploitation by the owner of the patent or his licensee is anti-competitive;
- in the case of drugs and medicines, there is a national emergency or other circumstance of extreme urgency requiring the use of the invention;
- in the case of drugs and medicines, there is a public non-commercial use of the patent by the patentee, without satisfactory reason; or
- in the case of drugs and medicines, the demand for the patented article in the Philippines is not being met to an adequate extent and on reasonable terms, as determined by the Secretary of the Department of Health.

3. Infringement

3.1 Necessary Parties to an Action for Infringement

The party bringing the infringement action must be the patentee, or anyone possessing any right, title or interest in and to the patented invention, whose rights have been infringed.

3.2 Direct and Indirect Infringement

Any of the following acts constitute direct infringement of a patented product or a patented process:

- the making, using, offering for sale, selling, or importing a patented product or a product obtained directly or indirectly from a patented process without the authorisation of the patentee; or
- the use of a patented process without the authorisation of the patentee.

Indirect infringement may be by way of contributory infringement. Anyone who actively induces the infringement of a patent or provides the infringer with a component of a patented product or of a product produced because of a patented process, knowing it to be especially adopted for infringing the patented invention and not suitable for substantial non-infringing use, shall be liable as a contributory infringer and shall be jointly and severally liable with the infringer.

3.3 Scope of Protection for an Intellectual Property Right

The extent of protection conferred by the patent shall be determined by the claims, which are to be interpreted in the light of the description and drawings.

For the purpose of determining the extent of protection conferred by the patent, due account shall be taken of elements that are equivalent to the elements expressed in the claims, so that a claim shall be considered to cover not only all the elements as expressed therein, but also equivalents.

3.4 Defences Against Infringement

Defences against patent infringement include the following:

- the patent, or any claim on it, is invalid, based on the following grounds:
 - (a) what is claimed as the invention is not new or patentable;
 - (b) the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by any person skilled in the art; or
 - (c) the patent is contrary to public order or morality;
- using a patented product that has been put on the market in the Philippines by the product owner, or with his or her express consent, where such use is performed after the product has been put on the market. This is provided that, with regard to drugs and medicines, the limitation on patent rights shall apply after a drug or medicine has been introduced in the Philippines or anywhere else in the world by the patent owner, or by any party authorised to use the invention. The right to import the drugs and medicines shall be available to any government agency or any private third party;
- where the act is done privately and on a non-commercial scale or for a non-commercial purpose, provided that it does not significantly prejudice the economic interests of the owner of the patent;
- where the act consists of making or using exclusively for experimental use of the invention for scientific purposes or educational purposes and other activities directly related to such scientific or educational experimental use;
- in the case of drugs and medicines, where the act includes testing, using, making or selling the invention, including any data related to it, solely for purposes reasonably related to the development and submission of information and issue of approvals by government regulatory agencies required under any law of the Philippines or of another country that regulates the manufacture, construction, use or sale of any product;
- where the act consists of the preparation for individual cases, in a pharmacy or by a medical professional, of a medicine in accordance with a medical prescription or acts concerning the medicine so prepared;
- where the invention is used in any ship, vessel, aircraft, or land vehicle or any other country entering the territory of the Philippines temporarily or accidentally; provided that such invention is used exclusively for the needs of the ship, vessel, aircraft, or land vehicle and not for the manufacturing of anything to be sold within the Philippines;
- any prior user, who, in good faith was using the invention or has undertaken serious preparations to use the invention in his or her enterprise or business, before the filing date or priority date of the application on which a patent is granted, shall have the right to continue the use thereof as envisaged in such preparations within the territory where the patent produces its effect; and
- a government agency or third person authorised by the government may exploit the invention even without agreement of the patent owner where:
 - (a) the public interest, in particular, national security, nutrition, health or the development of other sectors, as determined by the appropriate agency of the government, so requires;
 - (b) a judicial or administrative body has determined that the manner of exploitation by the owner of the patent or his licensee is anti-competitive;
 - (c) in the case of drugs and medicines, there is a national emergency or other circumstance of extreme urgency requiring the use of the invention;
 - (d) in the case of drugs and medicines, there is a public non-commercial use of the patent by the patentee, without satisfactory reason; or
 - (e) in the case of drugs and medicines, the demand for the patented article in the Philippines is not being met to an adequate extent and on reasonable terms, as determined by the Secretary of the Department of Health;
- the issue of a compulsory licence or (in the case of patented drugs and medicines) a special compulsory licence by the Director General of the Intellectual Property Office of the Philippines.

3.5 Role of Experts

Assessors

Two or more assessors may be appointed by the court. The assessors shall be possessed of the necessary scientific and technical knowledge required by the subject matter in litigation. Either party may challenge the fitness of any assessor proposed for appointment.

Committee of Three

The court, of its own volition or upon a motion by a party, may order the creation of a committee of three experts to provide advice on the technical aspects of the patent in dispute. Within 30 days from receipt of the order creating the committee, each side shall nominate an expert, who shall then be appointed by the court. The court shall appoint the third expert from a list submitted by the experts on each side.

Expert evidence

In patent infringement proceedings, each party usually presents its own expert witness or witnesses. The affidavit of the expert witness must be attached to the complaint. The affidavit shall serve as the direct testimony of the expert during trial, subject to cross-examination by the adverse party.

3.6 Procedure for Construing the Terms of the Patent's Claim

There is no separate procedure for construing the claims of a patent. Claim construction issues are determined in the same proceedings as other issues, eg, validity and infringement.

4. Revocation/Cancellation

4.1 Reasons and Remedies for Revocation/Cancellation

The Bureau of Legal Affairs of the Intellectual Property Office of the Philippines has the exclusive jurisdiction to hear and decide patent cancellation proceedings. However, the invalidity of the patent may be raised as a defence in a patent infringement case. If, in an action for infringement filed before the court, the court finds the patent or any claim to be invalid, it shall cancel it. An order of cancellation shall be forwarded to the Director of the Bureau of Legal Affairs.

4.2 Partial Revocation/Cancellation

Where the grounds for cancellation relate to some of the claims or parts of the claim, cancellation may be effected to that extent only. In this case, the Intellectual Property Office shall reissue the amended patent.

4.3 Amendments in Revocation/Cancellation Proceedings

Amendment by the patentee is allowed during cancellation proceedings. In such a case, the Bureau of Legal Affairs of the Intellectual Property Office may decide to maintain the pat-

ent as amended. If the patent is amended, the Bureau shall, at the same time as it publishes the mention of the cancellation decision, publish the abstract, representative claims and drawings, indicating clearly what the amendments contain.

4.4 Revocation/Cancellation and Infringement

An invalidity defence raised in a patent infringement case is heard and decided together with the case. An inter partes case for cancellation of patent is heard and decided separately from an infringement action.

5. Trial & Settlement

5.1 Special Procedural Provisions for Intellectual Property Rights

Cases for patent infringement filed in courts apply the Rules of Procedure in Intellectual Property Rights Cases 2011, while similar cases filed before the Bureau of Legal Affairs of the Intellectual Property Office apply the Rules and Regulations on Administrative Complaints for Violation of Laws Involving Intellectual Property Rights 2001.

Cases for cancellation of patent filed before the Bureau of Legal Affairs of the Intellectual Property Office apply the Regulations on Inter Partes Proceedings.

5.2 Decision Makers

There is no trial by jury in the Philippines. Cases filed in court are heard and decided by judges while cases filed before the Bureau of Legal Affairs of the Intellectual Property Office are heard and decided by hearing officers. Judges and hearing officers are members of the Philippine Bar. Often they do not possess technical backgrounds. Thus, they are allowed to create a committee of three experts or appoint assessors to assist them on technical matters.

5.3 Settling the Case

The parties may settle the case at any stage of the proceedings. However, for cases filed before both the court and the Intellectual Property Office, there are formal mediation procedures before the commencement of trial to encourage the parties to arrive at an amicable settlement.

5.4 Other Court Proceedings

Based on jurisprudence, the earlier institution of a case for patent cancellation does not bar the subsequent filing of an infringement case by the patent-holder. However, the court trying an infringement action has the power to stay the proceedings before it until resolution of the cancellation action pending before the Intellectual Property Office.

6. Appeal

6.1 Special Provisions for Intellectual Property Proceedings

Regular courts and the IPOPHL have equal jurisdiction over patent infringement cases. Only civil remedies can be sought before these bodies, such as payment of damages and injunctions. If the case is filed with the IPOPHL instead of the regular court, the case takes the form of an administrative complaint instead of a civil case.

In civil cases filed with the regular courts, appeals are to be filed with the Court of Appeals. From the Court of Appeals, an appeal can be filed with the Supreme Court.

In administrative cases filed with the IPOPHL, the decision at the first level (ie, the Bureau of Legal Affairs) can be appealed to the Director General of the IPOPHL. The Decision of the Director General can then be appealed to the Court of Appeals. From the Court of Appeals, an appeal can be filed with the Supreme Court.

In case of a patent cancellation case, it must be filed with the Bureau of Legal Affairs of the IPOPHL. The decision of the Adjudication Officer may be appealed to the Director of the Bureau of Legal Affairs. Once the Director renders a decision, appeals may then be brought to the Director General of the IPOPHL, then the Court of Appeals and finally the Supreme Court.

6.2 Type of Review

Appeals at any stage may involve a full review of the facts. However, as a rule, appeals to the Supreme Court are normally limited to questions of law only.

7. Costs

7.1 Costs Before Filing a Lawsuit

Possible costs that may be incurred even before a lawsuit is filed are costs related to warning letters.

When the case is filed, filing fees will be required. If preliminary injunction is sought, a bond must be deposited with the court in order to implement the injunction.

7.2 Calculation of Court Fees

Court fees are determined based on the amount of damages the complainant is seeking to recover. This is regardless of the number of parties and patents involved, or whether an injunction is sought.

7.3 Responsibility for Paying Costs of Litigation

The complainant will shoulder litigation costs such as court fees, lawyers' fees, etc. However, the court, in its discretion

and after presentation of evidence, may order the defendant to reimburse the complainant for litigation costs.

8. Alternative Dispute Resolution

8.1 Type of Actions for Intellectual Property

Mediation is mandatory in civil cases filed with the regular courts, as well as in administrative cases filed with the Intellectual Property Office of the Philippines. Arbitration is also allowed, but the consent of all the parties is needed.

9. Assignment and Licensing

9.1 Requirements or Restrictions for Assignment of Intellectual Property Rights

An assignment of a patent must be in writing and notarised. Recording of the assignment with the Intellectual Property Office of the Philippines is advised since it is deemed to be a notice to the public.

Non-recording of the assignment will make the agreement void for subsequent assignees of the patent who have no knowledge or no notice of the existence of the earlier assignment.

Assignments may apply to the whole or to part of the patent.

9.2 Procedure for Assigning an Intellectual Property Right

An assignment document is executed by both parties and then notarised. Either party must then file a request to record the assignment in question with the IPOPHL.

After examining the request and the assignment document, the IPOPHL will issue a notice evidencing the registration of the assignment.

9.3 Requirements or Restrictions to License an Intellectual Property Right

In order for a licensing agreement of a patent to become enforceable, it must contain the various mandatory provisions required by the law on patents. The licensing agreement must also not contain any of the provisions prohibited by the law on patents.

A certificate of compliance may be sought from the IPOPHL so that the parties can ensure their compliance with the patent law's requirements. Another option is to obtain a pre-clearance from the IPOPHL, which option is available even to draft or unsigned licensing agreements. A third option is to request an exemption from the IPOPHL from any of the prohibited or mandatory clauses of the law on patents for licensing agreements.

9.4 Procedure for Licensing an Intellectual Property Right

When licensing a patent, the parties may first pre-clear the draft agreement with the IPOPHL. This will allow the parties to amend the agreement where there are provisions that are lacking or do not comply with the requirements of the patent law.

If the parties already have a signed licensing agreement, they may register the said agreement with the IPOPHL. However, they would need to amend the agreement if there are findings of non-compliance with the requirements of the patent law.

The parties may seek reconsideration or also appeal the initial findings on the agreement.

Angara Abello Concepcion Regala & Cruz

22/F ACCRALAW TOWER
Second Avenue corner 30th Street
Crescent Park West
Bonifacio Global City
1635 Taguig, Metro Manila
Philippines

Tel: +632 830 8000
Fax: +632 403 7007
Email: accra@accralaw.com
Web: www.accralaw.com

