



OFFICE OF THE DIRECTOR GENERAL

DCA DESIGN INTERNATIONAL
LIMITED,

Appellant,

-versus-

DIRECTOR OF THE BUREAU OF
PATENTS,

Appellee.

x-----x

Appeal No. 01-2010-0002

Application No. 1-2004-501107

Title: Improvements in and Relating to a
Medicament Delivery Device

DECISION

DCA DESIGN INTERNATIONAL LIMITED ("Appellant") appeals the decision of the Director of the Bureau of Patents ("Director") denying the Appellant's petition for revival of its patent application.¹

Records show that the Appellant filed on 22 July 2004, a National Phase Philippine Patent Application for "Improvements in and Relating to a Medicament Delivery Device". Subsequently, the Examiner-in-Charge ("Examiner") issued an official action² requiring the Appellant to adopt the claims as contained in the Australian Patent No. 2003 202072 B2. The Appellant did not file a response to the official action.

Consequently, the Examiner issued a Notice of Withdrawn Application.³ The Appellant, however, claimed that it has not officially received this notice and was only able to know the abandonment or withdrawal after a verification of the current status of the application. On 13 January 2010, the Appellant filed a "PETITION FOR REVIVAL" which was denied by the Examiner.⁴ The Appellant filed a "MOTION FOR RECONSIDERATION" on 29 July 2010 which was denied by the Director on 11 August 2010. Not satisfied, the Appellant filed an "APPEAL MEMORANDUM" on 13 September 2010 with the following assignment of errors:

¹ Application No. 1-2004-501107.

² Marked as Paper No. 8 with mailing date of 08 August 2008.

³ Official Action marked as Paper No. 9 with mailing date of 27 October 2008.

⁴ DENIAL OF PETITION FOR REVIVAL marked as Paper No. 11 with mailing date of 13 July 2010.

- I. The Honorable Director committed serious error in disregarding Appellant-Applicant's evidence consisting of sworn notarial affidavits of witnesses clearly showing that the Notice of Withdrawn Application was never received by the Appellant-Applicant which has resulted in its failure to file a Petition for Revival within the reglementary period;
- II. The Honorable Director committed serious error in relying on Annex A of its Resolution which presumably showed the Appellant-Applicant's receipt of the Notice of Withdrawn Application when the supposed signatories of said Annex A are not even identified or presented and the entries therein showed glaring irregularities which should have prompted any reasonable man to inquiry;
- III. The Honorable Director committed serious error in applying the presumption that Appellant-Applicant's Counsel received the Notice of Withdrawn Application in the regular course of business when presumption of regularity cannot be invoked to justify an encroachment of the rights secured by the Constitution which in this case is the Appellant-Applicant's right to due process;
- IV. The Honorable Director committed serious error in denying the Appellant-Applicant's Petition for Revival despite the undisputed fact that the IPO Box system is by its very nature susceptible to cases of misposting, non-posting, accidental or erroneous posting of official actions which resulted in the non-receipt by the Appellant-Applicant of the Notice of Withdrawn Application; and
- V. The Honorable Director committed serious error in not giving the Implementing Rules liberal construction resulting in the denial to the Appellant-Applicant of its Constitutional right to property without due process of law.

On 06 October 2010, the Appellant filed a "MANIFESTATION" stating that another misposting of official action has happened in its "IPO Box" when an official action addressed to another law office was placed in its IPO Box. According to the Appellant, this only buttresses its position of erroneous posting of official actions in the IPO Box.

The Director filed on 22 October 2010 his "COMMENTS TO THE APPLICANT-APPELLANT'S APPEAL MEMORANDUM and MANIFESTATION" contending that he did not disregard the sworn notarial affidavits of the Appellant's witnesses which maintained that the Appellant has not received the Notice of

99

Withdrawn Application. According to the Director, after consulting and investigating the circumstances of this case, he is convinced that the Notice of Withdrawn Application was sent to the Appellant through the IPO Box. The Director maintains that no violation of due process was committed against the Appellant and that his adherence to the provisions of the rules on a petition for revival of an application deemed withdrawn or abandoned is to prevent a precedent that would render these rules ineffective and useless. The Director asserts that it is only now that the Appellant is claiming the erroneous postings in the IPO Box and if the Appellant had experiences of misposting/non-posting, the Appellant should have exercised more diligence in the prosecution of its patent application.

The issue in this appeal is whether the Director was correct in denying the Appellant's petition for revival.

Under the Rules and Regulations on Inventions a patent application will be deemed withdrawn if an applicant fails to prosecute the application within the required time limits.⁵ In this case, the subject patent application was deemed withdrawn for failure of the Appellants to file a timely response to the Examiner's official action requiring it to adopt the claims as contained in the Australian Patent No. 2003 202072 B2.

The Appellant is not disputing that it received this official action marked as Paper No. 8. Accordingly, the Appellant had two (2) months from the mailing date of 08 August 2008, within which to submit its response to the official action. The Appellant, however, did not file its response and, therefore, its patent application is deemed withdrawn. Nonetheless, the patent application can still be revived subject to the provision of Rule 930 of the Rules and Regulations on Inventions which provides that:

Rule 930. Revival of application.- An application deemed withdrawn for failure to prosecute may be revived as a pending application within a period of four (4) months from the mailing date of the notice of withdrawal if it is shown to the satisfaction of the Director that the failure was due to fraud, accident, mistake or excusable negligence.

A petition to revive an application deemed withdrawn must be accompanied by (1) a showing of the cause of the failure to prosecute, (2) a complete proposed response, and (3) the required fee.

An application not revived in accordance with this rule shall be deemed forfeited.

gl

⁵ Rule 929 of the applicable Rules and Regulations on Inventions. The Rules and Regulations on Inventions was amended by the Revised Implementing Rules and Regulations for Patents, Utility Models and Industrial Designs, Office Order No. 67, Series of 2011, signed on 20 April 2011.

Still, the Appellant neither submitted any response nor filed a petition for revival within the period allowed by the Rules and Regulations on Invention. The Appellant filed a Petition for Revival only on 13 January 2010 or over 13 months from the time that the patent application is deemed withdrawn. This is also after almost 16 months from the time that the Examiner issued the official action requiring the Appellant to adopt the claims as contained in the Australian Patent No. 2003 202072 B2. Accordingly, from these circumstances, the Appellant's patent application is deemed forfeited and the Director was correct in denying the petition to revive the Appellant's patent application.

This Office adheres to the policy of securing protection to inventors and promoting patent protection and recognizes the need to have an effective industrial property system. The Rules and Regulations on Inventions that streamlined the administrative procedures in granting patents were promulgated to achieve this policy and objective. The reglementary periods fixed in the Rules and Regulations on Inventions are essential for the effective and orderly administration and disposition of patent applications. Aptly, procedural rules are not to be belittled or disregarded simply because their non-observance may have resulted in prejudice to a party's substantive rights.⁶

In this regard, it is in the interest of justice that in patent examinations there should be strict implementation of the time limits and reglementary periods within which applicants must prosecute their applications. The grant of patent protection is an exception to the general rule of prohibiting monopoly. It is, thus, in the interest of the public that in order to balance this privilege and private interests of the inventors, that patent laws should provide a stringent application process which inventors should strictly comply with in order to secure patent protection.

In one case, the Supreme Court of the Philippines has ruled that the lapse of an unreasonable period of time prior to the filing of a petition for revival of an abandoned application due to the negligence of the applicant's counsel would result in the forfeiture of the right to revive the patent application, to wit:

However, petitioners lost sight of the fact that the petition could not be granted because of laches. Prior to the filing of the petition for revival of the patent application with the Bureau of Patents, an unreasonable period of time had lapsed due to the negligence of petitioners' counsel. By such inaction, petitioners were deemed to have forfeited their right to revive their applications for patent.⁷

Moreover, the Appellant also failed to exercise due diligence or exert reasonable efforts in prosecuting the patent application. The Appellant did not even bother to follow up in the patent office the status and development of its application. In this regard it has to suffer the consequences of this act or omission that is lacking

⁶ *Lazaro v. Court of Appeals*, 330 SCRA 208 (2000).

⁷ *Schultz v. Court of Appeals*, G.R. No. 113407, 12 July 2000.

in the exercise of standard care, which an ordinarily prudent person bestows upon the person's important business.⁸

WHEREFORE, premises considered, the instant appeal is hereby DISMISSED. Let a copy of this Decision be furnished to the Director of the Bureau of Patents and the library of the Documentation, Information and Technology Transfer Bureau for information, guidance, and records purposes.

SO ORDERED.

DEC 17 2012 Taguig City.


RICARDO R. BLANCAFLOR
Director General 

⁸ *Fernandez v. Tan Tiong Tick*, G. R. No. L-15877, 28 April 1961.