



OFFICE OF THE DIRECTOR GENERAL

OTB SOLAR B.V.,

Appellant,

- versus -

DIRECTOR OF THE BUREAU OF
PATENTS,

Appellee.

X-----X

Appeal No. 1-2012-0003

Application No. 1-2006-0500324

For: Method and Apparatus for
Applying a Coating on a
Substrate

DECISION

Appellant **OTB SOLAR B.V.** appeals the decision issued by the Director of the Bureau of Patents, issued on 25 June 2012, which affirmed the denial by the Records Officer of the BOP Support Group (PCT) of Applicant-Appellant's Petition for Revival, in an Office Action Paper No. 14.

Records show that as early as 10 November 2006, pursuant to the PCT Application National Phase, the records officer required applicant to submit, among others, a Power of Attorney/Appointment of Resident Agent duly signed by the applicant, as provided in Action Paper No. 5.

On 10 January 2007, within the two (2) month reglementary period, Applicant-Appellant requested a first extension within which to submit its response to Office Action Paper No. 5 issued by the records officer. On 12 March 2007, a second extension was filed.

On 5 November 2007, Applicant-Appellant received Office Action Paper No. 10, which required Applicant-Appellant to submit the duly signed power of attorney/appointment of resident agent on or before 31 December 2007.

On 8 February 2008, Applicant-Appellant received the Notice of Withdrawn Application under Paper No. 11, issued by the records officer, for failure to respond to Paper No. 10. On 6 June 2008, Applicant-Appellant filed its request for Revival with Cost. On 23 July 2010, Applicant-Appellant submitted to the Appellee a photocopy of a Notarized Deed of Assignment, Power of Attorney, and paid the filing fee.

On 24 September 2010, Applicant-Appellant received its copy of the assailed Paper No. 14 which denied the request for revival.

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On 29 February 2012, Applicant-Appellant filed before the Appellee its Petition to Question Authority of Records Officer to Deny Petition for Revival. Appellee treated the same as an Appeal from the denial of the Request for Revival with Cost.

On 25 June 2012, the Appellee rendered a Decision upholding the authority of the records officer to act upon the Petition for Revival, as well as upholding the said officer's decision as provided in Paper No. 14 which denied the said petition for revival.

The issues in this case are whether the untimely submission by the applicant-appellant of the requested duly signed power of attorney/appointment of resident agent should merit the declaration of a patent application as withdrawn, and whether the records officer has jurisdiction to act upon and deny applicant-appellants's request for revival with cost.

As to the first issue, applicant-appellant claims that the untimely submission of the aforementioned requested documents is not among the grounds for withdrawal of a patent application. Furthermore, they invoke Section 40 of the IP Code, which pertain to Filing Date Requirements, Section 42 of the IP Code, which pertains to Formality Examination, and Rules 600 and 601 of the Rules and Regulations on Inventions, to show that the non-submission of the said documents on time would not merit a withdrawal of the patent application.

In his Decision, the Director of Patents sustained the records officer in that Office Action Paper No. 10 reiterated the request for the power of attorney/appointment of resident agent, in order to avoid abandonment of the patent application. As the records show, applicant-appellant still did not produce the said documents, even after two (2) extensions, thus the records officer was constrained to send the notice of withdrawn application. It was only on 23 July, 2010 or more than twenty five (25) months from the expiration of the reglementary period for revival, did the applicant-appellant comply with the requirement.

The Director of Patents likewise submits that the applicant's failure to comply with Office Action Nos. 5 and 10 on the submission of the aforementioned documents within the reglementary period, cannot be attributed to fraud, accident, mistake, or excusable negligence within the import of Rule 930. Applicant-Appellant was given enough time and notice to comply with the requirements, knowing fully well that failure to comply with the Office Action carries with it the corresponding abandonment of the application, as expressly stated therein. Thus, the denial of the appeal, as well as applicant's request for revival with cost.

This Office sees no cogent reason to disturb the assailed Decision of the Appellee. The failure to submit the requested documents would fall squarely under failure to submit a complete proposed response within the prescribed period, as required by Rule 930:

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.


Anent the second issue regarding the jurisdiction of the records officer, this Office finds the contention of the Applicant-Appellant to be without merit. Rule 100 (d) of the Rules and Regulations on Inventions provide that an "examiner" means any officer or employee of the Bureau of Patents authorized to examine applications. Thus, the Appellee was correct in ruling that while the authority to grant or deny petitions for revival rests solely with the Director of the Bureau of Patents under Rule 930, the denial of the Request for Revival made by the records officer may be properly considered as the "Final Action" of the patent examiner for purposes of Appeal to the Director of Patents. Likewise, the Office Action Papers indicate that the said records officer was the Examiner-In-Charge of the application, giving her the authority and jurisdiction to handle the patent application and to issue the related Office Action Papers.

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 submission of the required documents within the prescribed reglementary periods fixed in the Regulations are essential for the effective and orderly administration and disposition of patent applications. Aply, 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.¹

WHEREFORE, premises considered, the appeal is hereby **DISMISSED**. Let a copy of this Decision and the records of this case 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.

NOV 18 2013 Taguig City.


RICARDO R. BLANCAFLOR
Director General

¹ *Lazaro v. Court of Appeals*, 330 SCRA 208 (2000).