



OFFICE OF THE DIRECTOR GENERAL

SEKISUI ENVIRONMENT CO., LTD.,
Appellant,

Appeal No. 1-2012-0002

- versus -

Application No. 1-2003-000174

**DIRECTOR OF THE BUREAU OF
PATENTS,**

For: Rotating Biological
Contractor-Type
Sewage...

Appellee.

X-----X

DECISION

Appellant **SEKISUI ENVIRONMENT CO, LTD.** appeals the decision issued by the Director of the Bureau of Patents, issued on 28 June 2012, which affirmed the denial by the patent examiner of Applicant-Appellant's Petition for Revival, in an Office Action Paper No. 16.

Records show that the patent examiner issued a Notice of Withdrawn Application with a mailing date of 15 November 2006, and thus Applicant-Appellant had a four (4) month period, or up to 15 March 2007, within which to file a petition for revival.

On 15 March 2007, Applicant-Appellant seasonably filed a Petition for Revival, however, as admitted, its messenger failed to pay the revival fee. The said messenger remitted the revival fee on 30 April 2007, or one and a half (1 & 1/2) months after the last day of filing.

On 31 August 2010, herein Appellant received Office Action Paper No. 16 from the examiner, who considered the Notice of Withdrawn Application as final for non-payment of the required fee. The patent examiner likewise recommended that the petition for revival be denied. The Denial of Applicant's Petition for Revival was appealed to the Director of Patents on 28 June 2012.

In the appeal from the final recommendation for denial of the Petition for Revival, the Director of Patents affirmed the action of the patent examiner, citing Rule 930 of the Rules and Regulations on Inventions, which provides:

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 Revival of application.- An application deemed withdrawn for failure to prosecute may be revived as a pending application within a period of four (4) months from the mailing date of the notice of withdrawal if it is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.

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A petition to revive an application deemed withdrawn must be accompanied by (1) a showing of the cause of the failure to prosecute, (2) a complete proposed response, and (3) the required fee.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

The Director noted that the Applicant-Appellant was not able to comply with all the requirements for the revival of this withdrawn application in consonance with the aforementioned Rule, as it only paid the revival fee one and a half months after the last day allowed by the Rule.

The issue to be resolved in this appeal is whether the Decision of the Director of Patents, in affirming the denial of the petition for revival by the examiner is erroneous and unjust.

In this regard, it is not disputed that the applicant-appellant failed to pay the required fee during the reglementary period, which is one of the requirements for the revival of a withdrawn application under Rule 930.

The Appellants argue that the IP rules of practice, particularly belated payment of fees, should be construed liberally. Also, it is the Appellants opinion that Rule 1103 and 1104 of the Rules and Regulations on Inventions, which provides for a grace period of six (6) months from the due date for the payment of the annual fee, as a fitting analogy which should be applied in this present case.

However, this Office is not convinced. 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.¹ Rule 930 specifically states that an application not revived in accordance with the said Rule shall be deemed forfeited. Likewise, had the intention of the Rules been to extend the same leniency with regard to the belated payment of fees, it would have specified the same instead of emphasizing forfeiture. Hence, this Office sees no cogent reason to disturb the Decision made by the Director of Patents.

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 Regulations 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.²

¹ 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.

² *Lazaro v. Court of Appeals*, 330 SCRA 208 (2000).

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.³

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 13 2013 Taguig City.


RICARDO R. BLANCAFLOR
Director General

³ *Schuartz v. Court of Appeals*, G.R. No. 113407, 12 July 2000.