



OFFICE OF THE DIRECTOR GENERAL

E. I. DUPONT NEMOURS &
COMPANY,
Appellant,

Appeal No. 01-2010-0003
Patent Application No. 36095
Date Filed: 20 November 1987

-versus-

For: HERBICIDAL SULFONAMIDES

DIRECTOR OF BUREAU OF
PATENTS,
Appellee.

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DECISION

On 27 September 2010, E. I. DUPONT NEMOURS & COMPANY (“Appellant”) filed a “MEMORANDUM ON APPEAL” seeking the reversal and setting aside of the decision of the Director of Bureau of Patents (“Director”) sustaining the decision of the Examiner-in-Charge (“Examiner”) which denied the Appellant’s petition to revive Patent Application No. 36095 for “HERBICIDAL SULFONAMIDES”.

Records show that the Appellant filed on 08 October 2001 a “PETITION FOR REVIVAL WITH COST” stating in part the following:

1. On August 27, 2001, the Bureau mailed Paper No. 10 informing the undersigned that the present application was declared abandoned as of April 28, 1989 for failure of the applicant to respond to an office action within the reglementary period.
2. Applicant does not intend to abandon the subject patent application and is in fact, still very much interested in its further prosecution and the grant of a corresponding Letters Patent. The failure to file the response on time was due to the Bureau’s notices not having come to the attention of the applicant (including the Notice of Abandonment) due to the ill-health and incapacity and subsequent death of applicant’s then agent, Atty. Mapili. This circumstance was not known to applicant and is a circumstance of a nature not within applicant’s control. We submit that the circumstances constitute valid grounds to revive this application as they constitute “accident” among the grounds of fraud, accident, mistake or excusable negligence under the Rules.

Subsequently, the Examiner issued a "RESOLUTION" dated 17 November 2006 denying the Appellant's petition. The Examiner held that "it is hard to believe that the applicant has not known of the ill health, incapacity and subsequent death of the agent-counsel for such a very long period of time – (almost seven years)". According to the Examiner, the Appellant displayed contributory negligence for being not assertive or active enough to follow up its interest in the patent application. The Examiner maintained that the rules on patent application impose upon the applicant the duty to look after its interest and that ill health, incapacity and subsequent death of an agent especially in his twilight years cannot be qualified as an accident.

The Appellant filed on 26 January 2007 a "NOTICE OF APPEAL" with the Director claiming that the denial of its petition for revival is improper since the recognized grounds of fraud, accident, mistake or excusable negligence as bases for granting revival are present in this case. The Appellant contended that its failure to receive notices which led to abandonment of its patent application is not attributable to its negligence but to the incapacity and/or death of its counsel that qualifies as an "accident".

On 13 August 2010, the Director denied the appeal and affirmed the finding of the Examiner that the ill health or incapacity and death of the Appellant's agent is not an "accident". The Director held that the Appellant has not shown that the delay in the prosecution of the patent application is justified under the circumstances and that the act of the Appellant's agent binds it. The Director ruled that an application shall be deemed abandoned for failure by the applicant or its authorized representative to perform the required act/s or file a responsive communication.

Not satisfied, the Appellant appealed to this Office citing the following errors:

ASSIGNMENT OF ERRORS

A.

THE DIRECTOR OF PATENTS ERRED IN NOT CONSIDERING THE CIRCUMSTANCE OF THE DEATH AND/OR INCAPACITY OF APPELLANT'S THEN COUNSEL AS VALID GROUND FOR REVIVAL OF APPELLANT'S PATENT APPLICATION

B.

THE DIRECTOR OF PATENTS ERRED IN NOT RULING THAT THE DEATH AND/OR INCAPACITY OF APPELLANT'S THEN COUNSEL WAS UNKNOWN AND UNFORESEEN, AND THUS, IS A CIRCUMSTANCE THAT QUALIFIES AS "ACCIDENT".

C.

THE DIRECTOR OF PATENTS ERRED IN NOT RULING THAT THE DEATH OR PERMANENT INCAPACITY OF AN AGENT TERMINATES ANY AGENCY BETWEEN PATENT APPLICANT AND SUCH AGENT.

The Director filed his comment on the appeal maintaining the position that ill health or incapacity or death of the Appellant's counsel and agent is not an "accident" which is one of the grounds for revival of an abandoned application. The Director reiterates his findings that the application was declared abandoned as early as 28 April 1989 and that the Appellant allowed an unreasonable length of time to make inquiries into the status of the application.

The main issue in this appeal is whether the Director was correct in upholding the decision of the Examiner to deny the petition to revive the patent application of the Appellant.

The appeal is not meritorious.

Rule 929 of the Revised Implementing Rules and Regulations for Patents, Utility Models and Industrial Designs provides in part that:

Rule 929. 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.¹

The Appellant is not disputing that its patent application is deemed abandoned but is maintaining that there is a valid ground for revival of its application which is the incapacity or death of its agent which according to it qualifies as an "accident".

In this regard, the circumstances of this case show that the abandonment of the Appellant's application was not due to accident or to the other recognized grounds that would allow the revival of a withdrawn application. The abandonment is due to the Appellant's own negligence in following up the status of its patent application. The Appellants' failure to promptly inquire from its agent or from this Office the status of the application shows its lack of due diligence in ensuring the patent protection for its invention. The Appellant should have been in contact with its agent from time to time, in order that it may be informed of the progress of application, thereby exercising that standard of care, which an ordinarily prudent man bestows upon his important business.²

¹ This Rule is similar to Rule 113 of the Rules of Practice in Patent Cases which was mentioned in the decision of the Director.

² Fernandez vs. Tan Tiong Tick, G. R. No. L-15877, 28 April 1961.

Moreover, as the Appellant placed its “reliance and trust” to its counsel or authorized agent, it must suffer the consequences of the failure of its agent to comply with the official communications issued by this Office.

Considering the lapse of time in the prosecution of the patent application, the Appellant should have checked its application with this Office in view of the failure of its agent to give proper communication on the status of the patent application. The Appellant’s patent application has a filing date of 20 November 1987 and as alleged by the Appellant itself in its appeal, it only attempted to contact its agent in 1996³ or almost ten (10) years from the filing date of its application. This betrays the diligence required of an applicant seeking to secure patent protection for its invention.

The country’s policy to promote patent protection includes the recognition of streamlining administrative procedures in registering patents. The rules and regulations on patent applications and examinations are intended to streamline the administrative procedures in granting patents. Hence, reglementary periods fixed in the rules and regulations are essential for the effective and orderly administration and disposition of patent applications.

In this instance, the official communications issued by the Office in the course of the examination of the patent applications must be answered within the time limits, otherwise, the application is deemed withdrawn or abandoned. Accordingly, the failure of the Appellant’s agent to comply with the official communications resulted to the abandonment of the Appellant’s patent application. Consequently, the Appellant must suffer the result of this failure.

A patent application is prosecuted *ex parte* by the applicant and the proceedings are like a lawsuit in which there is a plaintiff, but no defendant, the Office itself acting as the adverse party. The Office, represented by the Examiner is not supposed to look after the interest of an applicant. The law imposes that duty upon the applicant. In addition, just like in lawsuits, reglementary period and time limits must strictly be followed as they are considered indispensable interdictions against needless delays and for orderly discharge of patent examinations. 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.⁴

In addition, to allow the revival of the Appellant’s patent application that was deemed abandoned way back in 1989 is certainly not in accordance to the policy of providing intellectual property protection. A possibility of giving patent protection to a product that may already be in the market would go against the rationale of providing a balanced intellectual property right protection system. Accordingly, the denial of the petition to revive the Appellant’s patent application is proper.

WHEREFORE, premises considered, the instant appeal is hereby dismissed.


³ MEMORANDUM ON APPEAL dated 27 September 2010, page 4.

⁴ Lazaro v. Court of Appeals, 330 SCRA 208 (2000).

Let a copy of this decision and the records of this case be furnished and returned to the Director of the Bureau of Patents for appropriate action. Let also a copy of this decision be furnished to the library of the Documentation, Information and Technology Transfer Bureau for its information and records purposes.

SO ORDERED.

03 NOV 2014 Taguig City.


RICARDO R. BLANCAFLOR
Director General