



OFFICE OF THE DIRECTOR GENERAL

UNI-CHARM CORPORATION, INC.,
Appellant,

APPEAL NO. 01-2013-0002
Application No. 1-2005-501061
Date Filed: 03 June 2005

-versus-

DIRECTOR OF THE BUREAU OF
PATENTS,
Appellee.

For: DISPOSABLE DIAPER

x-----x

NOTICE

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EPIFANIO M. EVASCO
Director, Bureau of Patents
Intellectual Property Office
Taguig City

IPOPHL LIBRARY
Documentation, Information
and Technology Transfer Bureau
Intellectual Property Office
Taguig City

GREETINGS:

Please be informed that on 23 April 2014, the Office of the Director General issued a Decision in this case (copy attached).

Taguig City, 24 April 2014.

Very truly yours,

ROBERT NEREO B. SAMSON
Attorney V

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DATE: _____

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DECISION

UNI-CHARM CORPORATION, INC. ("Appellant") appeals the decision of the Director of Bureau of Patents ("Director") dated 30 April 2013 the dispositive portion of which reads:

"WHEREFORE, premises considered, the *Petition to Question Authority of the Patent Examiner to Deny Petition for Revival* is hereby DENIED for being filed out of time. The Request for Revival is hereby DENIED for applicant's failure to comply with the requirements of the Examiner's Office Action Paper Nos. 4, 7 and 10. The Records Officer's (sic) Final Action denying the Request for Revival is hereby AFFIRMED.

SO ORDERED."

Records show that the Appellant filed on 03 June 2005 a request for national phase entry of International Application No. PCT/JP2003/015021 for disposable diaper. The international application was given a domestic application number 1-2005-501061. Subsequently, the Examiner-in-Charge ("Examiner") issued an official action¹ requiring the Appellant to submit a power of attorney or the appointment of a resident agent. The Appellant requested extensions of time² to submit the response to the official action.

The Appellant, however, did not submit the required power of attorney or appointment of a resident agent within the requested extensions of time. Consequently, the Examiner issued another official action³ inviting the Appellant to fulfill the requirement of submitting the power of attorney or appointment of a resident agent. The Appellant requested again extensions of time⁴ to respond to the official action.

¹ Paper No. 4 with mailing date of 01 March 2006.

² Letters dated 02 May 2006 and 03 July 2006.

³ Paper Number 7 with mailing date of 13 October 2006.

⁴ Letters dated 13 December 2006 and 13 February 2006.

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For failure of the Appellant to comply with the official action within the requested period of time, the Examiner issued another official action⁵ inviting the Appellant to comply with the requirement of submitting a power of attorney or the appointment of a resident agent. Again, the Appellant submitted letters of extension of time⁶ to respond to the official action.

Subsequently, for failure of the Appellant to comply with the requirements to submit a power of attorney or the appointment of a resident agent, the Examiner issued a "NOTICE OF WITHDRAWN APPLICATION" on Application No. 1-2005-501061.⁷

On 16 September 2008, the Appellant filed a "Request for Revival With Cost" maintaining that it would like to maintain the application and would need additional period to prepare a suitable response to the official action Paper No. 15. The Examiner denied the request for revival for failure of the Appellant to submit the complete requirements.⁸

On 12 July 2012, the Appellant filed a petition⁹ questioning the authority of the "Records Officer" to deny the petition for revival. The Appellant maintained that it has executed a general power of attorney in favor of its counsel which was submitted to the Office on 29 June 2007 in connection with Application No. 3-2007-000337. The Appellant contended that a petition for revival can only be acted upon by the Director and, thus, the Records Officer has no authority to act on the petition.

On 30 April 2013, the Director issued the assailed decision affirming the action of the Records Officer and denying the Appellant's petition for revival. Not satisfied, the Appellant filed on 10 June 2013 and 10 July 2013 a "NOTICE OF APPEAL" and "APPELLANT'S BRIEF" seeking the reversal of the Director's decision and the granting of its petition for revival.

The Appellant contends that the Intellectual Property Code of the Philippines ("IP Code") and the implementing rules do not state that the untimely resubmission of a power of attorney is among the grounds to declare an application as withdrawn. The Appellant maintains that the provision on the Rules and Regulations on Inventions referring to revival of application that was cited by the Director pertains to substantive examination and not on a mere non-submission of a power of attorney. The Appellant argues that had the Records Officer exercised the diligence of a reasonable man in the conduct of his duties, he would have readily determined that the Appellant had already submitted its power of attorney or appointment of resident agent. The Appellant reiterates its argument that the Records Officer has no authority to deny the

⁵ Paper Number 10 with mailing date of 08 August 2007.

⁶ Letters dated 08 October 2007 and 10 December 2007.

⁷ Paper Number 15 with mailing date of 16 May 2008.

⁸ Paper Number 18 with mailing date of 23 August 2010.

⁹ PETITION TO QUESTION AUTHORITY OF RECORDS OFFICER TO DENY PETITION FOR REVIVAL.



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petition for revival and it is the Director who is vested with the jurisdiction and duty to review the Appellant's request for revival with cost.

This Office issued on 22 July 2013 an Order giving the Director thirty (30) days from receipt of the Order to submit comment on the appeal. The Director did not file his comment and the case was deemed submitted for decision.

The issue in this case is whether the Director was correct in denying the Appellant's request for revival of Application No. 1-2005-501061.

The appeal is not meritorious.

Sections 33 and 42 of the IP Code provide that:

SEC. 33. Appointment of Agent or Representative.- An applicant who is not a resident of the Philippines must 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 patent or the patent may be served.

SEC. 42. Formality Examination.- 42.1. After the patent application has been accorded a filing date and the required fees have been paid on time in accordance with the Regulations, the applicant shall comply with the formal requirements specified by Section 32 and the Regulations within the prescribed period, otherwise the application shall be considered withdrawn.

42.2. The Regulations shall determine the procedure for the re-examination and revival of an application as well as the appeal to the Director of Patents from any final action by the examiner.

On the other hand, Rule 929 of the Rules and Regulations on Inventions,¹⁰ which was the applicable rule at the time of the Appellant's request for national phase entry of its international application, provides that:

RULE 929. Withdrawal of Application for Failure to Respond Within Time Limit.- (a) If an applicant fails to prosecute his application within the required time as provided in these Regulations, the application shall be deemed withdrawn.

(b) The time for reply may be extended only for good and sufficient cause, and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the applicant is due. The Examiner may grant a maximum of two (2) extensions, provided that the aggregate period granted inclusive of the initial period allowed to file the response, shall not exceed six (6) months from mailing date of the official action requiring such response.

(c) Prosecution of an application to save it from withdrawal must include such complete and proper action as the condition of the case may require. Any amendment not responsive to the last official action shall not operate to save the application from being deemed withdrawn.

(d) When action by the applicant is a bona fide attempt to advance the case to final action, and is substantially a complete response to the Examiner's action, but consideration of some matter or compliance with some requirements has been

¹⁰ The Rules and Regulations on Inventions was amended by the Revised Implementing Rules and Regulations for Patents, Utility Models and Industrial Designs that was approved on 20 April 2011.



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inadvertently omitted, opportunity to explain and supply the omission may be given before the question of withdrawal is considered.

(e) Prompt ratification or filing of a correctly signed copy may be accepted in case of an unsigned or improperly signed paper.

In this case, the Appellant is not a resident of the Philippines and, thus, the Examiner issued an official action requiring the Appellant to submit a power of attorney or the appointment of a resident agent duly signed by the Appellant. Moreover, the request form for entry into the national phase of the Appellant's international application expressly provides that if the request is signed by a resident agent, the Appellant must submit a separate power of attorney or appointment of a resident agent duly signed by the Appellant.

Despite several extensions of time given to the Appellant, it failed to comply with the Examiner's official action and did not submit the required power of attorney or appointment of a resident agent. Accordingly, the Examiner was correct in issuing the official action stating that the Appellant's application is deemed withdrawn.

The Appellant also knew that the Examiner was correct in considering its application as deemed withdrawn, hence, it filed a request for revival of the application. However, the Appellant, still did not comply with the requirement to submit the power of attorney or the appointment of a resident agent, and therefore, the request for revival was denied.

Rule 930 of the Rules and Regulations and Inventions 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.

Surprisingly, and after two years after the denial of the request for revival, the Appellant argues that it is the Director and not the Examiner who has the authority to deny its request for revival. In this instance, however, the Director himself has ruled to deny the Appellant's request for revival. As stated by the Director in his decision:

For these reasons, this Office sought to DENY the applicant's Petition cum appeal, as well as applicant's Request for Revival.

The Appellant has been given several extensions of time to submit the required power of attorney or appointment of a resident agent. This Office cannot comprehend why the Appellant is taking such a long period of time to fulfill this requirement. Its belated allegation that it had submitted a general power of attorney in another application only betrays its lack of diligence in processing its application.



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Worse, the Appellant is now blaming the Examiner to excuse its negligence in the prosecution of its application. As the applicant for patent registration, the Appellant is supposed to look after its interest and not the Examiner.


Significantly, from the time it filed its request for national phase entry of its patent application in June 2005 and when it filed the request for revival on September 2008, it has over three years to comply with the requirement to file the power of attorney or appointment of a resident agent for Application No. 1-2005-501061. For failure to do so, the Director and the Examiner correctly denied the revival of the Appellant's application that was considered withdrawn.



Moreover, it is emphasized that the time limits provided for in the Rules and Regulations on Inventions were promulgated to enhance the examination procedures on patent examination and must be complied with in good faith. The time limits fixed in the Rules and Regulations are essential for the effective and orderly administration and disposition of patent applications.

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 their appropriate action, information, guidance, and records purposes.

SO ORDERED.

23 APR 2014 Taguig City.


RICARDO R. BLANCAFLOR
Director General


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