



OFFICE ORDER NO. 13

Series of 2012

SUBJECT: ESTABLISHMENT OF IPOP HL'S PATENT PROTECTION INCENTIVE PACKAGE (PPIP), ALSO KNOWN AS THE "JUAN'S THOUSAND INVENTIONS"

Whereas, Republic Act No. 8293 provides that "The State recognizes that an effective intellectual and industrial property system is vital to the development of domestic and creative activity, facilitates transfer of technology, attracts foreign investments, and ensures market access for our products. It shall protect and secure the exclusive rights of scientists, inventors, artists and other gifted citizens to their intellectual property and creations, particularly when beneficial to the people, for such periods as provided in this Act.";

Whereas, for decades, patent applications filed by Filipino scientists and inventors comprises only 2-5% of the total yearly patent filings while outputs from researches by Philippine High Educational Institutions continue to be indiscriminately disclosed through publications without benefit of patent protection;

Whereas, to promote a widespread culture of innovation and creativity, IPOP HL established a franchise system of patent libraries known as the Innovation and Technology Support Office (ITSO) to build the institutional capacity of the schools and universities to conduct their own patent searches, draft their patent applications and prosecute the same before the IPOP HL;

Whereas, to further encourage patent activities among the ITSO members and their collaborators as well as encourage the commercialization of the patented invention, an incentive package was established by IPOP HL to lessen the cost of obtaining patent protection by providing the necessary incentive in financing official fees associated with patent filing and prosecution as well as in the maintenance of patents through annuities after the patent grant;

Now, Therefore, IPOP HL hereby **ESTABLISHES** the Patent Protection Incentive Package (PPIP), also known as the "*Juan's Thousand Inventions*" as a Project Component of the ITSO Franchise. Under the incentive package, IPOP HL shall **WAIVE ITS FEES** for the first 1,000 patent applications/registrations subject to the Rules for eligibility/qualification herein promulgated. The establishment of *Juan's Thousand Inventions* is without prejudice to IPOP HL's other forms of incentives.

Section 1. Eligibility

1. Patent applications eligible for PPIP shall be:
 - a. Applications filed on or after March 22, 2012 covering inventions derived from work within an HEI which is an ITSO Franchisee;
 - b. Applications filed on or after March 22, 2012 covering inventions of resident inventors who have collaborated with or contracted the services of an HEI which is an ITSO Franchisee for patent search and prosecution; and
 - c. Applications filed on or after March 22, 2012 arising from collaborations between and among HEI's, including foreign HEI's, provided that at least one (1) HEI is an ITSO Franchisee.
2. In order to continue PPIP eligibility, the HEI involved should be an ITSO Franchisee throughout the payment period of the corresponding fees.
3. The decision of the Director of IPOPHL-DITTB on an application's eligibility for the PPIP shall be final.

Section 2. Fees Covered

1. The PPIP shall cover the waiver of the following fees:
 - a. Filing Fees and fees for excess claims;
 - b. Fees for Formality Examination;
 - c. Fees for Substantive Examination;
 - d. Fees for Publication;
 - e. Annuities from the 5th to the 15th year;
 - f. Fees charged by and payable to IPOPHL in connection with the PCT application; and
 - g. Fees relating to assigning of rights from the inventor to an HEI.
2. All other fees shall be paid for by the applicant.

Section 3. Effectivity Period

1. The implementation of PPIP shall commence on March 22, 2012. All applications availing of the PPIP should be filed with IPOPHL from March 22, 2012 to December 20, 2013.
2. An extension of time to file the application after December 20, 2013 may be requested on justifiable grounds. The request shall be signed by the President of the HEI and submitted to the Director General of IPOPHL on or before December 02, 2013.

Section 4. General Conditions

1. The subject of the application must be an invention coming out of research from or in collaboration with HEI, or involves patent search or prosecution services rendered by HEI which is an ITSO Franchisee.

2. IPOPHL is the office of first filing or the first application covering the invention is filed in the Philippines after which subsequent filings in other countries may be commenced.
3. The request for fee waiver shall be signed by the President of the HEI which is an ITSO Franchisee or his/her designated official, and said request, together with the documents required in Section E herein, shall be submitted to the IPOPHL-DITTB for the filing fees to be waived.
4. A corresponding PCT application must be filed within twelve (12) months from the filing date of the application in order for subsequent fees to be waived. Proof of the same shall be submitted to IPOPHL-DITTB prior to the time for payment of the subject fees for the corresponding fees to be waived. The cost for filing and processing the PCT application shall be shouldered by the applicant but the latter may avail of the 90% reduction rate for developing countries with the assistance of IPOPHL.
5. The applicant must actively pursue the commercialization of the invention through various actions or initiatives in order for subsequent fees to be waived. Proof that such actions or initiatives are undertaken shall be submitted to IPOPHL-DITTB prior to the time for payment of each annuity fee for said fees to be waived.
6. IPOPHL-DITTB shall issue a separate approval note for the waiver of each particular fee. If the application fulfills all of the requirements set forth herein, the approval note shall be issued not later 5 working days from the submission of said requirements. The applicant shall submit the approval note to the cashier of IPOPHL in lieu of the payment to be made. It shall be the responsibility of the applicant to submit the complete requirements at the earliest practicable time to avoid missing the mandatory payment dates required by RA 8293 and the Revised Implementing Rules and Regulations for Patents.
7. Should the ownership of the patent or the rights to the patent application be assigned or transferred to an individual other than the inventor, or to another entity which is not a subsidiary of the HEI, at any time during the application or patent life, all fees subsequent to the assignment or transfer shall be paid for by the assignee or transferee. The latter shall not be entitled to avail of PPIP. The assignor or transferor shall notify IPOPHL-DITTB of such assignment or transfer not later than 5 days from the assignment or transfer.

Section 5. Prior Art Search and Preparation of the Patent Application

1. Prior to drafting and filing the patent application, a prior art search and preliminary evaluation of the invention to be patented must have been conducted by the ITSO of the HEI (hereinafter referred to merely as the "ITSO") without prejudice to any findings by the patent examiner during substantive examination of the patent application. A patent search report, signed by the patent searcher of ITSO and indicating the related prior art and findings in the preliminary examination shall be submitted together with the approval document of the HEI president or his/her designated officer to be submitted to IPOPHL-DITTB. HEI's which are not ITSO Franchisees shall have the inventions searched by any of the HEI's which are ITSO Franchisees subject to service agreements between the HEI's on patent search.
2. After the patent search, the patent specifications comprising of the abstract and description of the invention, claims and formal drawings (if any), must be drafted by an accredited patent agent of IPOPHL or one who has taken the Patent Agent's Qualifying Examination (PAQE). For this purpose, HEI's are encouraged to send their science and technology experts to PAQE training and examination. One who has

drafted the patent application shall certify that he/she has drafted the patent specifications and is a PAQE passer or PAQE taker.

Section 6. Filing and Prosecution of the Application

1. Applications must be filed in the name of the inventor but the rights thereto, in whole or in part, may be assigned to the HEI in accordance with law or contract between the inventor and the HEI.
2. The patent prosecution shall be handled by ITSO but the latter may engage a service provider for counsel or assistance. However, all prosecution-related documents such as, but not limited to, the request form, responses to Official Actions, shall be signed by ITSO, and all communications from IPOPHL shall be sent only to ITSO's. For this purpose, HEI's which are not ITSO Franchisees shall have the patent applications prosecuted by an HEI which is an ITSO Franchisee subject to service agreements between the HEI's on patent prosecution.
3. During the formality and substantive examination stages, the responses to the Official Actions shall be prepared by ITSO and submitted to IPOPHL within the required period to file the response in order to avoid the abandonment or withdrawal of the application.
4. All optional fees-incurring proceedings such as, but not limited to, early publication, request for 1st and 2nd extension of time to respond to the examiners action, conversion of patent to utility model, payment of revival fee, and other similar proceedings with fees must be avoided to prevent unnecessary costs. However, in the event that the applicant makes such requests, the cost thereof shall be paid for by the applicant. PPIP does not include the fees for such optional proceedings.
5. If the patent application is converted into an application for utility model, then it shall no longer be covered by the PPIP and all fees subsequent to the conversion shall be paid by the applicant. In such a case, ITSO shall furnish the IPOPHL-DITTB with a copy of the request for conversion.
6. IPOPHL reserves the right to cancel or stop PPIP privileges of an application for violation of these rules.

Section 7. Program Monitoring

1. The HEI who is an ITSO Franchisee availing of PPIP shall submit an annual report to IPOPHL-DITTB enumerating the applications enjoying PPIP privileges with a brief description of the invention, the fees thus far waived and the status of the applications or registrations. Such report shall be submitted not later than December 10 of every year.
2. The IPOPHL-DITTB shall prepare the consolidated report of all applications and registrations enjoying PPIP privileges for submission to the Director General not later than January 30 of the following year.

Done this 19 day of March 2012, Taguig City.


RICARDO R. BLANCAFLOR
Director General