Manual for Substantive Examination Procedure

CHAPTER I – INTRODUCTION

1. General

1.1 The present Manual for the examination of patent applications has been written with the aim of providing a comprehensive reference guide for both IPO patent examiners and the general public on matters of patent law and interpretation. The Manual gives instructions as to the practice and procedure to be followed in the various aspects of the substantive examination of Philippine patent applications in accordance with Republic Act No. 8293 ("IP-code") and the implementing Rules and Regulations ("IRR"). They are addressed primarily to the staff in the IPO, but it is hoped that they will also be of assistance to the parties to the proceedings and patent practitioners.

1.2 The Manual is intended to cover normal occurrences. It is therefore to be considered only as general instruction. The application of this Manual to individual patent application is the responsibility of the examining staff and they may depart from these instructions in exceptional cases. Nevertheless, the parties can expect the Office to act as they are revised. It should be noted also that the Manual does not constitute legal provisions. For the ultimate authority on practice in the IPO, it is necessary to refer firstly to the IPO-code and the IRR.

2. Format

2.1 It will be noted that in this Manual, the text has been divided into Chapters, each sub-divided into numbered Sections which are further sub-divided into paragraphs. Cross-references to other paragraphs within this part are in a standard form quoting in each case the Chapter, Section and paragraph number (thus e.g., III, 6.5 means paragraph 6.5 in Section 6 of Chapter III).

2.2 Marginal references indicate the relevant Sections of the IPO-code or the relevant Rules of the IRR, which provide authority to what is stated. It is believed that such references avoid the need for extensive quotation from the IP-code and the IRR themselves.

2.3 In this part of the Manual, the term "**examiner**" is used to mean the **Examiner** entrusted with **substantive examination**.

2.4 In this part also, an attempt has been made to deal with the requirements of the application in earlier Chapters and to concentrate matters of procedure in Chapter VI. However, it has not always proved practicable to draw a hard and fast line between these aspects of the work.

	3. Work at the Bureau of patents 3.1 It is important that the various departments of the Office and various staff in the same department should not attempt to duplicate one another's efforts. For example, the substantive examiner should not attempt to check the formalities work performed by his colleague in the formality division. One of the purposes of the Manual is to make clear where the demarcations of the responsibility lie. 3.2 The attitude of the examiner is very important. He should always try to be constructive and be helpful. While it would of course be quite wrong for an examiner to over look any major deficiency in an application, he should have a sense of proportion and not to pursue unimportant objections. He should bear in mind that, subject to the requirements of the IP-code and the IRR, the drafting of the descriptions and claims of an application is the responsibility of the applicant or his representative. 3.3 It should hardly need stating that all patent applications, regardless of their country of origin should receive equal treatment. .

CHAPTER II - CONTENT OF THE APPLICATION (OTHER THAN CLAIMS)

	1. General
Sec. 32.1 Rule 400	The requirements of the Philippine patent application are set out in Section 32.1 and Rule 400. The application must contain: (a) a request for the grant of a Philippine patent; (b) a description of the invention; (c) drawings necessary for the understanding of the invention; (d) one or more claims; (e) an abstract. This chapter deals with all these requirements, in so far as they are the concern of the examiner carrying out substantive examination, with the exception of item (d) which is the subject of Chapter III. Item (e) is dealt with first.
	2. Abstract
Sec. 37 Rule 411	2.1 The purpose of the abstract is to give brief technical information about the disclosure as contained in the description, claims and drawings. It useful as a searching tool for the examiner. Therefore, it should give sufficient information to make it possible to judge whether there is a need to consult the description claims and drawings. It must be drafted in a way which allows the clear understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use of the invention. 2.2 The abstract relates to the application as filed and published and its final form is settled before publication of the application. It is therefore not necessary to bring it into conformity with the content of the published patent even if this should differ in substance from that of the application. The examiner should therefore not seek any amendment of the abstract after publication of the application. He should, however, note that the abstract "shall merely serve for technical information". It should also provide guidance to reader in order to obtain additional information from the description, claims and drawings. It has no legal effect on the application containing it; for instance, it cannot be used to interpret the scope of protection or to justify the addition to the description of new subject-matter.

	2.3 More particularly, the abstract should (a) commence with the title of the invention, (b) indicate the technical field to which the invention relates, (c) preferably not contain more than one hundred fifty words, (d) if necessary, contain the chemical formula which, among those contained in the application, best characterises the invention, (e) not contain statements on the value of the invention or on its speculative application, (f) be accompanied by a figure, if appropriate, and (g)comprise reference signs between parenthesis following each main technical feature mentioned in the abstract and illustrated by a drawing.
	3. Request for grant and title
Sec. 34	3.1 The items making up this request are dealt with in Section 34, Rules 403 and 404.
Rule 403	3.2 The request shall be made on a form drawn up by the Office (Rule 403). For the convenience of applicants, the Office shall draw up and make available a standard application form which may be reproduced at will by applicants and other persons at their own cost.
Rule 404	3.3 The request shall contain the following: (a) Petition for the grant of a patent; (b) Applicant's name and address; (c) Title of the invention; (d) Inventor's name; (e) If with claim for convention priority it shall contain the file number, country of origin and the date of filing in the said country where the application was first filed; (f) name and address of the resident agent/representative (if any); and (g) Signature of the applicant or resident agent/representative. The requirements are checked during formality examination .

Rule 410	3.4 The title should be "as short and specific as possible". It should also be indicated on the first page of the specification. The title should clearly and concisely state the technical designation of the invention and should exclude all fancy names which do not define the technical subject with which the invention is concerned. Very long titles and vague titles such as “chemical process” or “electric circuit” are objectionable. They do not give an adequate indication of the technical designation of the invention. Examples of fancy names: “wonderful new product" or "improved machine" The examiner should bear in mind that the title is also used for search and documentation purposes.
	4. Description
Sec.35.1 R.405	4.1 The application must "disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art". The meaning of "person skilled in the art" is discussed in IV, 9.6.
R.406	The test for enabling disclosure is whether the persons to whom it is addressed could, by following the directions therein, put the invention into practice. The sufficiency of the disclosure is to be assessed on the basis of the application as a whole, including the information given in the claims, description and drawings, if any.
R.407(1)	The provisions relating to the content of the description are set out in Rule 407(1). In particular, the description shall: (a) specify the technical field to which the invention relates; (b) indicate the background art which, as far as known to the applicant, can be regarded as useful for understanding the invention, for drawing up the search report and for the examination, and, preferably, cite the documents reflecting such art; (c) disclose the invention, as claimed, in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood, and state any advantageous effects of the invention with reference to the background art; (d) briefly describe the figures in the drawings, if any; (e) when there are drawings, there shall be a brief description of the several views of the drawings and the detailed description of the invention shall refer to its different parts, as shown in the views, by use of reference letters or numerals (preferably the latter); (f) describe in detail at least one way of carrying out the invention claimed using examples where appropriate and referring to the drawings, if any; and

	g) indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is capable of exploitation in industry.
R.407(2)	The description shall be presented in the manner and order specified here above, unless because of the nature of the invention, a different manner or a different order would afford a better understanding and a more economic presentation. The purpose of the provisions of Sec.35.1 and Rule 407 is: (i) to ensure that the application contains sufficient technical information to enable a skilled person to put the invention as claimed into practice; and (ii) to enable the reader to understand the contribution to the art which the invention as claimed has made.
R.410 R.407(1)(a)	4.2 The title of the invention should appear as a heading on the first page of the description (R.410). The invention should then be placed in its setting by specifying the technical field to which it relates.
R.407(1)(b) R.416(b) Sec.49 Sec.35.1	4.3 The description should also mention any background art of which the applicant is aware, and which can be regarded as useful for understanding the invention and its relationship to the prior art; identification of documents reflecting such art, especially patent specifications, should preferably be included. This applies in particular to the background art corresponding to the first or "prior art" portion of the independent claim or claims (see III, 2.2). The insertion into the statement of prior art of references to documents identified subsequently, for example by the search report, may be required, where necessary, to put the invention into proper perspective. For instance while the originally filed description of prior art may give the impression that the inventor has developed the invention from a certain point, the cited documents may show that certain stages in, or aspects of, this alleged development were already known. In such a case the examiner may require a reference to these documents and a brief summary of the relevant contents. The subsequent inclusion of such a summary in the description does not contravene the proviso of Sec.49. The latter merely lays down that, if the application is amended, for example by limiting it in the light of additional information on the background art, its subject-matter must not extend beyond the content of the application as filed. But the subject-matter of the Philippine patent application within the meaning of Section 49 is to be understood – starting off from the prior art – as comprising those features which, in the framework of the disclosure required by Sec.35.1, relate to the invention (see also VI, 5.3). References to the prior art introduced after filing must be purely factual. Any alleged advantages of the invention must be adjusted if necessary in the light of the prior art. New statements of advantage are permissible provided that they do not introduce into the description matter which could not have been deduced from the

	application as originally filed (see VI, 5.4).
Sec.24.2 R.204(b)	If the relevant prior art consists of another published Philippine patent application falling within the terms of Sec. 24.2, the fact that this document falls under Section 24.2 (see also Rule 204(b)) may be explicitly acknowledged, thus making clear to the public that the document is not relevant to the question of inventive step (see IV, 9.2).
	4.4 Since the reader is presumed to have the general background technical knowledge appropriate to the art, the examiner should not require the applicant to insert anything in the nature of a treatise or research report or explanatory matter which is obtainable from textbooks or is otherwise well known. Likewise the examiner should not require a detailed description of the content of cited prior documents. It is sufficient that the reason for the inclusion of the reference is indicated, unless in a particular case a more detailed description is necessary for a full understanding of the invention of the application (see also II, 4.18 below). Lists of several reference documents relating to the same feature or aspect of the prior art are not required; only the most appropriate need be referred to. On the other hand the examiner should not insist upon the excision of any such unnecessary matter, except when it is very extensive (see II. 7.3 below).
R.407(1)(c)	4.5 The invention as claimed should be disclosed in such a way that the technical problem, or problems, with which it deals can be appreciated and the solution can be understood. To meet this requirement, only such details should be included as are necessary for elucidating the invention. In cases where the subject matter of a dependent claim can be understood either by the wording of the claim itself or by the description of a way of performing the invention, no additional explanation of this subject matter will be necessary. A mention in the description that a particular embodiment of the invention is set out in the dependent claim will then be sufficient.
R.412(a)(ii)	Where the invention lies in realising what the problem is, this should be apparent, and, where the means of solving the problem (once realised) are obvious, the details given of its solution may, in practice, be minimal. When there is doubt, however, as to whether certain details are necessary, the examiner should not insist on their excision. It is not necessary, moreover, that the invention be presented explicitly in problem and solution form. Any advantageous effects which the applicant considers the invention to have in relation to the prior art should be stated, but this should not be done in such a way as to disparage any particular prior product or process. Furthermore, neither the prior art nor the applicant's invention should be referred to in a manner likely to mislead. This might be done, e.g. by an ambiguous presentation which gives the impression that the prior art had solved less of the problem than was actually the case. Fair comment as referred to in II, 7.2 below is, however, permitted. Regarding amendment to, or addition of, a statement of problem (VI, 5.7c).

R.407(1)(c)	4.6 If it is decided that an independent claim defines a patentable invention, it must be possible to derive a technical problem from the application. In this case the requirement of Rule 407(1) (c) is fulfilled.
R.407(1)(d) R.407(1)(e)	4.7 If drawings are included they should first be briefly described, in a manner such as: "Figure 1 is a plan view of the transformer housing; Figure 2 is a side elevation of the housing; Figure 3 is an end elevation looking in the direction of the arrow `X' of Figure 2; Figure 4 is a cross-section taken through AA of Figure 1." When it is necessary to refer in the description to elements of the drawings, the name of the element should be referred to as well as its number, i.e. the reference should not be in the form:"3 is connected to 5 via 4" but, "resistor 3 is connected to capacitor 5 via switch 4".
R.414.13	4.8 The description and drawings should be consistent with one another, especially in the matter of reference numbers and other signs, and each number or sign must be explained. However, where as a result of amendments to the description whole passages are deleted, it may be tedious to delete all superfluous references from the drawings and in such a case the examiner should not pursue an objection under Rule 414.13, as to consistency, too rigorously. The reverse situation should never occur, i.e. all reference numbers or signs used in the description or claims must also appear on the drawings.
R.407(1)(f) Sec. 35.1	4.9 A detailed description of at least one way of carrying out the invention must be given. Since the application is addressed to the person skilled in the art it is neither necessary nor desirable that details of well-known ancillary features should be given, but the description must disclose any feature essential for carrying out the invention in sufficient detail to render it obvious to the skilled person how to put the invention into practice. In many cases a single example or single embodiment will suffice, but where the claims cover a broad field the description should not usually be regarded as satisfying the requirements of Sec.35.1 unless it gives a number of examples or describes alternative embodiments or variations extending over the area protected by the claims. However, regard must be had to the facts of the particular case. There are some instances where even a very broad field is sufficiently exemplified by a limited number of examples or even one example (see also III, 6.3). In these latter cases the application must contain, in addition to the examples, sufficient information to allow the person skilled in the art, using his common general knowledge, to perform the invention over the whole area claimed without undue burden and without needing inventive skill. If the examiner is able to make out a reasoned case that the application lacks sufficient disclosure, the onus of establishing that the invention may be performed and repeated over substantially the whole of the claimed range lies with the applicant (see VI, 2.4).
Sec.35.1	4.9a In order that the requirements of Sec.35.1 and Rule 407(1) (c) and

R.407(1)(c) R.407(1)(f)	(f) may be fully satisfied it is necessary that the invention is described not only in terms of its structure but also in terms of its function, unless the functions of the various parts are immediately apparent. Indeed in some technical fields (e.g. computers), a clear description of function may be much more appropriate than an over-detailed description of structure.
Sec.35.1 Sec.49	4.10 It is the responsibility of the applicant to ensure that he supplies, when he first files his application, a sufficient disclosure, i.e. one that meets the requirements of Sec. 35.1 in respect of the invention as claimed in all of the claims. If the claims define the invention, or a feature thereof, in terms of parameters (see III, 4.7a), the application as first filed must include a clear description of the methods used to determine the parameter values, unless a person skilled in the art would know what method to use or unless all methods would yield the same result (see III, 4.10, 2nd paragraph). If the disclosure is seriously insufficient, such a deficiency cannot be cured subsequently by adding further examples or features without offending against the proviso of Sec. 49, which requires that the subject-matter content of the application must not be extended (see VI, 5.3 to 5.8b). Therefore in such circumstances the application must normally be refused. If however the deficiency arises only in respect of some embodiments of the invention and not others, it could be remedied by restricting the claims to correspond to the sufficiently described embodiments only, the description of the remaining embodiments being deleted.
Sec.35.1	4.11 Occasionally applications are filed in which there is a fundamental insufficiency in the invention in the sense that it cannot be carried out by a person skilled in the art; there is then a failure to satisfy the requirements of Sec. 35.1 which is essentially irreparable. Two instances thereof deserve special mention. The first is where the successful performance of the invention is dependent on chance. That is to say, the skilled person, in following the instructions for carrying out the invention, finds either that the alleged results of the invention are unrepeatable or that success in obtaining these results is achieved in a totally unreliable way. An example where this may arise is a microbiological process involving mutations. Such a case should be distinguished from one where repeated success is assured even though accompanied by a proportion of failures - as can arise, e.g. in the manufacture of small magnetic cores or electronic components; in this latter case, provided the satisfactory parts can be readily sorted by a non-destructive testing procedure, no objection arises under Sec. 35.1. The second instance is where successful performance of the invention is inherently impossible because it would be contrary to well-established physical laws – this applies e.g. to a perpetual motion machine. If the claims for such a machine are directed to its function, and not merely to its structure, an objection arises not only under Sec. 35 but also under Sec. 21 and Sec.27 that the invention is not susceptible of industrial application
Sec.21 Sec.27	

Sec.35.1	(see also IV, 4.1).
R.407(1)(g) Sec. 21	4.12 The description should indicate explicitly the way in which the invention is “industrially applicable”, if this is not obvious from the description or from the nature of the invention. The expression “industrially applicable” (Sec.21 and Sec.27) means the same as "capable of exploitation in industry” (Rule 407(1)(g)). In view of the broad meaning
Sec. 27	given to the expression by Sec. 27 (see IV, 4.1), it is to be expected that, in most cases, the way in which the invention can be exploited in industry will be self-evident, so that no more explicit description on this point will be required; but there may be a few instances, e.g. in relation to methods of testing, where the manner of industrial exploitation is not apparent and must be made so.
R.407(2)	4.13 The manner and order of presentation of the description should be that specified in Rule 407(1), i.e. as set out above, "unless, because of the nature of the invention, a different manner or a different order would afford a better understanding and a more economic presentation". Since the responsibility for clearly and completely describing the invention lies with the applicant, the examiner should not object to the presentation unless satisfied that such an objection would be a proper exercise of his discretion. Some departure from the requirements of Rule 407(2) is acceptable, provided the description is clear and orderly and all the requisite information is present. For example, the requirements of Rule 407(1)(c) may not be applicable where the invention is based on a fortuitous discovery, the practical application of which is recognised as being useful, or where the invention breaks entirely new ground. Also, certain technically simple inventions may be fully comprehensible with the minimum of description and but slight reference to prior art.
	4.14 Although the description should be clear and straightforward with avoidance of unnecessary technical jargon, the use of recognised terms of art is acceptable, and will often be desirable. Little known or especially formulated technical terms may be allowed provided that they are adequately defined and that there is no generally recognised equivalent. This discretion may be extended to foreign terms when there is no equivalent in the language of the proceedings. Terms already having an established meaning should not be allowed to be used to mean something different if this is likely to cause confusion. There may, however, be circumstances where a term may legitimately be borrowed from an analogous art. Terminology and signs must be consistent throughout the application.
	4.14a In the particular case of inventions in the computer field (see IV, 2.3), program listings in programming languages cannot be relied on as the sole disclosure of the invention. The description, as in other technical fields, should be written substantially in normal language, possibly accompanied by flow diagrams or other aids to understanding, so that the invention may be understood by those skilled in the art who are deemed not to be programming specialists. Short excerpts from programs written

	in commonly used programming languages can be accepted if they serve to illustrate an embodiment of the invention. 4.15 When the properties of a material are referred to, the relevant units should be specified if quantitative considerations are involved. If this is done by reference to a published Standard (e.g. a Standard of sieve sizes), and such Standard is referred to by a set of initials or similar abbreviation, it should be adequately identified in the description.
R.418(e)	Physical values must be expressed in the units recognised in international practice, wherever appropriate in terms of the metric system using system international (SI) units. Any values not meeting this requirement must also be expressed in the units recognised in international practice. As Rule 418(e) indicates, for mathematical formula the symbols in general use must be employed. For chemical formula, the symbols, atomic weights and molecular formula in general use shall be employed. In general, use should be made of the technical terms, signs and symbols generally accepted in the field in question. 4.16 The use of proper names, trademarks or similar words to refer to materials or articles is undesirable in so far as such words merely denote origin or where they may relate to a range of different products. If such a word is used, then where it is necessary in order to satisfy the requirements of Sec.35.1, the product must be sufficiently identified, without reliance upon the word, to enable the invention to be carried out by the skilled person. However, where such words have become internationally accepted as standard descriptive terms and have acquired a precise meaning (e.g. "Bowden" cable, "Belleville" washer, "Panhard" rod) they may be allowed without further identification of the product to which they relate. 4.17 If the examiner has reason to suspect that a word used in the description is a registered trade mark, he should ask the applicant either to acknowledge the word as such or to state that, so far as he is aware, the word is not a registered trade mark. If, on the other hand, an applicant states that a word is a registered trade mark and the examiner happens to know that this statement is incorrect, he should ask the applicant to amend accordingly. 4.18 References in Philippine patent applications to other documents may relate either to the background art or to part of the disclosure of the invention. Where the reference relates to the background art, it may be in the application as originally filed or introduced at a later date (see II, 4.3 and 4.4 here above). Where the reference relates directly to the disclosure of the invention (e.g. details of one of the components of a claimed apparatus) then the

	examiner should first consider whether knowing what is in the document is in fact essential for carrying out the invention as meant by Sec. 35.1. If not, the usually used expression "which is hereby incorporated by reference", or any expression of the same kind should be deleted from the description. If matter in the document referred to is indeed essential to satisfy the requirements of Sec. 35.1, the examiner should require the relevant passage to be expressly incorporated into the description, because the patent specification should, regarding the essential features of the invention, be self-contained, i.e. capable of being understood without reference to any other document. Such incorporation is, however, subject to the following restrictions: (a) it must not contravene the proviso of Sec. 49 (b) documents not available to the public on the date of filing of the application can only be considered when: (i) a copy of the document was furnished to the Office on or before the date of filing of the application; and (ii) the document was made available to the public no later than on the date of publication of the application under Sec.44.1 (e.g. by being present in the application file at the IPO and therefore made public under Sec.44.2.)
Sec.24.2	If, for the disclosure of the invention, another document is referred to in the application as originally filed, the relevant content of the other document is to be considered as forming part of the content of the application for the purpose of citing the application under Sec. 24.2 against later applications. For documents not available to the public before the filing date of the application this applies only if conditions (i) and (ii) above are fulfilled. Because of this effect under Sec.24.2 it is very important that, where a reference is directed only to a particular part of the document referred to, that part should be clearly identified in the reference.
	5. Drawings
R.413 R.414	5.1 The requirements relating to the form and content of drawings are set out in Rules 413 and 414.1 to 414.16. Most of these are formal but the substantive examiner may sometimes need to consider some of them, e.g. the requirements of Rule 414.13 (consistency in the use of reference signs).
R.414.16 R.923	5.2 In case of amendments or replacement of drawings (Rules 414.16 and 923), if the quality of the drawing is insufficient for photolithographic reproduction, then the examiner must request the applicant to present the drawings of sufficient quality, before the application will be allowed (Rule 414.16). Thus, objection should e.g. be raised where the drawings are not

	made upon paper which is flexible, strong, white, smooth, non-shiny and durable.
R.919 Sec.49	5.3 After the application has been accorded a filing date, submission of drawings of corrected or amended form or contents is not admissible and has to be refused in case of broadening of the disclosure or addition of new matter (see proviso of Sec.49 and Rule 919).
	6. Inventions relating to micro-organisms and biological material
Sec.22.4	6.1 According to Section 22.4, “plant varieties and animal breeds or essentially biological process the production of plants and animals” are excluded from patentability. This provision does not apply to “microorganisms and non-biological and microbiological processes”. For other biological materials not falling under the matter excluded from patentability as referred to in section 22.4 the same provisions apply as for inventions implying microorganisms, where recognised depository institutions for such other biological material exist. This has particular importance for plant seeds and cell lines deposited with recognised depositories. The term "biological material" can be considered to mean any material containing genetic information and capable of self-reproducing or of being reproduced in a biological system. It includes both micro-organisms and seeds.
R.408 R.409	6.2 Applications relating to micro-organisms are subject to the special provisions set out in Rules 408 and 409. If an invention concerns a microbiological process or the product thereof and involves or relates to the use of a micro-organism or other biological material which is not available to the public and which cannot be described in the patent application in such a manner as to enable the invention to be carried out by a person skilled in the art, then the disclosure is not considered to have satisfied the requirements of sufficiency (Sec.35.1) unless the requirements of Rules 408 and 409 have been met. In particular, (a) a culture of the biological material must have been deposited with a international depositary institution recognised by the IPO, such as the ones recognised by the Budapest Treaty on the International Recognition of the Deposit of Biological material for the Purposes of Patent Protection of 28 April 1977, not later than the date of filing of the application, (b) the depositary institution and the file number of the culture deposit are stated in the application, (c) the deposited culture is made available upon request to any person from the date of publication of the patent application.

	A list of recognised depository institutions is available at the Bureau of Patents. 6.3 The examiner must form an opinion as to whether or not the biological material is available to the public. Alternatively the biological material may be known to be readily available to those skilled in the art, e.g. a biological material such as baker's yeast or Bacillus natto which is commercially available; or it may be a standard preserved strain, or other biological material which the examiner knows to have been preserved in a recognised depository and to be available to the public. Alternatively the applicant may have given in the description sufficient information as to the identifying characteristics of the biological material and as to the prior availability in a depositary institution recognised by the IPO. In any of these cases no further action is called for. If however the applicant has given no information, or insufficient information, on public availability, and the microorganism or other biological material is a particular one not falling within the known categories such as those already mentioned, then the examiner must assume that the microorganism or biological material is not available to the public. He must also examine whether the micro-organism or other biological material could be described in the patent application in such a manner as to enable the invention to be carried out by a person skilled in the art (see II, 4.11 here above and IV, 3.5. 6.4 If the biological material is not available to the public and if it could not be described in the application in such a manner as to enable the invention to be carried out by a person skilled in the art, the examiner must check: (i) whether the application as filed gives such relevant information as is available to the applicant on the characteristics of the biological material. The relevant information under this provision concerns the classification of the biological material and significant differences from known biological material. For this purpose, the applicant must, to the extent available to him, indicate morphological and biochemical characteristics and the proposed taxonomic description. The annexed list (see Annex 1 to the present Chapter II) contains in this respect indications for certain types of biological material to guide the applicant in the normal case. The information on the microorganism or other biological material in question which is generally known to the skilled person on the date of filing is as a rule presumed to be available to the applicant and must therefore be provided by him. If necessary it has to be provided through experiments in accordance with the relevant standard literature. For characterising bacteria, for example, the relevant standard work would be R.E. Buchanan, N.E. Gibbons: Bergey's Manual of Determinative Bacteriology.

	Against this background, information should then be given on every further specific morphological or physiological characteristic relevant for recognition and propagation of the microorganism or other biological material, e.g. suitable media (composition of ingredients), in particular where the latter are modified. Abbreviations for biological material or media are often less well known than the applicant assumes and should therefore be avoided or written in full at least once. If biological material is deposited that cannot replicate itself but must be replicated in a biological system (e.g. viruses, bacteriophages, plasmids, vectors or free DNA or RNA), the above-mentioned information is also required for such biological system. If, for example, other biological material is required, such as host cells or helper viruses, that cannot be sufficiently described or is not available to the public, this material must also be deposited and characterised accordingly. In addition, the process for producing the biological material within this biological system must be indicated. In many cases the above required information will already have been given to the depositary institution (see Rule 6.1(a)(iii) and 6.1(b) Budapest Treaty) and need only be incorporated into the application. (ii) whether the name of the depositary institution and the accession number of the deposit have been supplied at the date of filing. If the name of the depositary institution and the accession number of the deposit have been submitted later it should be checked whether they have been filed within the relevant period. If that is the case it should then further be checked whether on the filing date any reference has been supplied which allows to relate the deposit with the later filed accession number. Normally the identification reference which the depositor himself gave to his deposit is used in the application documents. The relevant document for later filing the missing data could be a letter containing the name of the depositary institution, the accession number and the above mentioned identification reference or alternatively the deposit receipt, which contains all these data. In addition, the depositary institution named must be an international institution recognised by the IPO. (iii) whether the deposit was made by a person other than the applicant and, if so, whether the name and the address of the depositor are stated in the application or have been supplied within the relevant period. In such a case the examiner must also check whether the depositor gave his unreserved and irrevocable consent to the deposited material being available to the public. A document will be required confirming that the depositor has authorised the applicant to refer to the deposited biological material in the application and has given his unreserved and irrevocable

	consent to the deposited material being made available to the public. (iv) The examiner, in addition to the checks referred to under (i) to (iii) above, may ask for the deposit receipt issued by the depositary institution (see Rule 7.1 Budapest Treaty) or for equivalent proof of the deposit of a biological material if such proof has not been filed before (see (ii) above). This is to provide evidence for the indications concerning the depositary institution and the accession number made earlier by the applicant. If any of these requirements (i) – (iv) is not satisfied the application should be refused (Sec.51) for lack of sufficient disclosure of the invention (Sec.35.1), since the biological material in question cannot be considered as having been disclosed pursuant to Sec.35.1 by way of reference to the deposit. Concerning inventions relating to micro-organisms and biological material, reference is also made to the examples comprised in VII, 5.7. **7. Prohibited matter**
R.412(a)	7.1 There are three categories of specifically prohibited matter identified in R.412(a): - statements or other matter contrary to “public order” or morality; - statements disparaging the products or processes of any particular person other than the applicant, or the merits or validity of applications or patents of any such person., with mere comparison with the prior art not being considered as disparaging per se; and - any statement or other matter obviously irrelevant or unnecessary under the circumstances.
R.412(b)	If an application contains prohibited matter within the meaning of this Rule, the Bureau shall omit it when publishing the application, indicating the place and number of words or drawing omitted (R.412(b). The omission, from the publication of the application, of the first category is the most important one. Examples of the kind of matter coming within this category are: incitement to riot or to acts of disorder; incitement to criminal acts; racial, religious or similar discriminatory propaganda; and grossly obscene matter. 7.2 It is necessary to discriminate in the second category between libellous or similarly disparaging statements, which are not allowed, and fair comment, e.g. in relation to obvious or generally recognised disadvantages, or disadvantages stated to have been found and substantiated by the applicant, which, if relevant, is permitted. 7.3 The third category is irrelevant matter. It should be noted however that

	such matter is specifically prohibited under the (R.412(b) iii)) only if it is "obviously irrelevant or unnecessary", for instance, if it has no bearing on the subject-matter of the invention or its background of relevant prior art. The matter to be removed may already be obviously irrelevant or unnecessary in the original description. It may, however, be matter which has become obviously irrelevant or unnecessary only in the course of the examination proceedings, e.g. owing to a limitation of the claims of the patent to one of originally several alternatives. 7.4 When matter is removed from the description, it must not be incorporated into the patent specification by reference to the corresponding matter in the published application or in any other document. 7.5 Generally, matter falling under the first category will be dealt with during formality examination, as well as matter obviously falling within the second category. Although this is not explicitly mentioned in R.412, if any such matter has not been so recognised and has therefore not been omitted from the publication of the application, it should be removed during substantive examination of the application, i.e. before publication of the granted patent, together with any other prohibited matter.

CHAPTER III - THE CLAIMS

	1. General
Sec.32.1 (d) R.400	1.1 The application must contain "one or more claims".
Sec.36.1	1.2 These must: (i) "define the matter for which protection is sought"; (ii) "be clear and concise"; (iii) "be supported by the description".
Sec. 75	1.3 Since the terms of the claims determine the extent of the protection conferred by a **Philippine** patent or application, clarity of claim is of the utmost importance. The claims do not, however, stand in isolation and are not to be interpreted in a strictly literal sense. For a full understanding of how claims should be interpreted it is necessary to refer to Sec.75 (see also III, 4.1 – 4.3 here below), which specifies
Sec.75.1	- that the extent of protection conferred by the patent shall be determined by the claims, which are to be interpreted in the light of the description and drawings, and
Sec.75.2	- that, for the purpose of determining the extent of protection conferred by the patent, due account shall be taken of elements which are equivalent to the elements expressed in the claims, so that a claim shall be considered to cover not only all the elements as expressed therein, but also equivalents. A generally accepted approach is to interpret the claims having regard to the description and any drawings in such a way that fair protection to the patentee for his contribution to the art is combined with a reasonable degree of certainty for third parties. Thus the area of protection should not, in one extreme be interpreted as that defined by the strict literal meaning of the wording of the claims with the description and drawings being used only to resolve any ambiguity in the claims, nor in the other extreme, as what might be deduced from the description and drawings by a person skilled in the art, with the claims serving only as guide.
	2. Form and content of claims
R.416(a)	2.1 The claims must be drafted in terms of the "technical features of the invention". This means that claims should not contain any statements relating, for example, to commercial advantages or other non-technical matters, but statements of purpose should be allowed if they assist in

	defining the invention. It is not necessary that every feature should be expressed in terms of a structural limitation. Functional limitations may be included provided that a person skilled in the art would have no difficulty in providing some means of performing this function without exercising inventive skill. Claims to the use of the invention in the sense of the technical application thereof are allowable.
R.416(a)(b)	2.2 Rule 416 (a) and (b) defines the two-part form which a claim should adopt “wherever appropriate”. The first part or preamble should contain a statement indicating "the designation of the subject-matter of the invention" i.e. the category or general technical class of apparatus, product, process, use etc., to which the invention relates, followed by a statement of "those technical features which are necessary for the definition of the claimed subject-matter but which, in combination, are part of the prior art". This statement of prior art features is applicable only to independent claims and not to dependent claims (see III, 3.5 here below). It is clear from the wording of R.416 that it is necessary only to refer to those prior art features which are relevant to the invention. For example, if the invention relates to a photographic camera but the inventive step relates entirely to the shutter, it would be sufficient for the first part of the claim to read: "A photographic camera including a focal plane shutter" and there is no need to refer also to the other known features of a camera such as the lens and view-finder. The second part or "characterising portion" should state the "technical features which, in combination with the features stated in sub-paragraph (a) (the first part), it is desired to protect" i.e. the features which the invention adds to the prior art. If a single document in the state of the art according to Sec. 24.1, e.g. cited in the search report, reveals that one or more features in the second part of the claim were already known in combination with all the features in the first part of the claim and in that combination have the same effect as they have in the full combination according to the invention, the examiner should require that such feature or features be transferred to the first part. Where however a claim relates to a novel combination, and where the division of the features of the claim between the prior art part and the characterising part could be made in more than one way without inaccuracy, the applicant should not be pressed, unless there are very substantial reasons, to adopt a different division of the features from that which he has chosen, if his version is not incorrect. 2.3 Subject to what is stated in paragraph 2.3b here below, final sentence, the applicant should be required to follow the above two-part formulation in his independent claim or claims, where, for example, it is clear that his invention resides in a distinct improvement of an old combination of parts or steps. However as is indicated by R.416, this form need be used only in “appropriate” cases. The nature of the invention may be such that this form of claim is unsuitable, e.g. because it would give a distorted or misleading picture of the invention or the prior art. Examples of the kind of invention which may require a different

	presentation are: (i) the combination of known integers of equal status, the inventive step lying solely in the combination; (ii) the modification of, as distinct from addition to, a known chemical process e.g. by omitting one substance or substituting one substance for another; and (iii) a complex system of functionally interrelated parts, the inventive step concerning changes in several of these or in their inter-relationships. In examples (i) and (ii) the two-part R.416 form of claim may be artificial and inappropriate, whilst in example (iii) it might lead to an inordinately lengthy and involved claim. Another example in which the two-part R.416 form of claim may be inappropriate is where the invention is a new chemical compound or group of compounds. It is likely also that other cases will arise in which the applicant is able to adduce convincing reasons for formulating the claim in a different form.
Sec.24.2	2.3a There is also another special instance in which the two-part R.416 form of claim should be avoided. This is when the only relevant prior art is another Philippine patent application falling within the terms of Sec. 24.2. Such prior art should however be clearly acknowledged in the description (see II, 4.3).
Sec. 24.2 R.407.1(b)	2.3b When determining whether or not a claim is to be put in the form provided by R.416, second sentence, it is important to assess whether this form is "appropriate". In this respect, it should be borne in mind that the purpose of the two-part form of claim is to allow the reader to see clearly which features necessary for the definition of the claimed subject matter are, in combination, part of the closest prior art. If this is sufficiently clear from the indication of prior art made in the description, to meet the requirement of R.407.1(b), the two-part form of claim should not be insisted upon (see II, 4.3).
R.418(d)	The claims, as well as the description, "may contain chemical or mathematical formulas" but not drawings. "The claims may contain tables" but "only if their subject-matter makes the use of tables desirable". In view of the use of the word "desirable" in R.418(d), the examiner performing substantive examination should not object to the use of tables in claims where this form is convenient.
R.418(e)	Physical values shall be expressed in the units recognised in international practice, wherever appropriate in terms of the metric system using system international (SI) units. Any data not meeting this requirement must also be expressed in the units recognised in international practice. For mathematical formula, the symbols in general use shall be employed. For chemical formula the symbols, atomic weights and molecular formula in general use shall be employed. In

	general, use should be made of the technical terms, signs and symbols generally accepted in the field in question. **3. Kinds of claim – Categories** **Categories**
Sec.21	3.1 Sec.21 of the IP-code defines a patentable invention as “any technical solution of a problem in any field of human activity which is new, involves an inventive step and is industrially applicable”. It may be, or may relate to, a product, or process, or an improvement of any of the
R.201	foregoing. The IRR classify inventions according to the following types (“statutory classes of inventions”, R.201): a) a useful machine; b) a product; c) or process or an improvement of any of the foregoing; d) microorganism; and e) non-biological and microbiological processes.
R.415(b)	Inventions may be claimed using different "categories" of claims, i.e. "products, process, apparatus or use" claims. For many inventions, claims in more than one category are needed for full protection. In fact, there are only two basic kinds of claim, viz, claims to a physical entity (product, apparatus) and claims to an activity (process, use). The first basic kind of claim ("product claim") includes a substance or compositions (e.g. chemical compound or a mixture of compounds) as well as any physical entity (e.g. object, article, apparatus, machine, or system of co-operating apparatus) which is produced by man's technical skill. Examples are: "a steering mechanism incorporating an automatic feed-back circuit...” "a woven garment comprising...” "an insecticide consisting of X, Y, Z"; or "a communication system comprising a plurality of transmitting and receiving stations". The second basic kind of claim ("process claim") is applicable to all kinds of activities in which the use of some material product for effecting the process is implied; the activity may be exercised upon material products, upon energy, upon other processes (as in control processes) or upon living things (see however IV, 3.4 and 4.3). 3.2 In addition an applicant may sometimes wish to have claims which, although worded differently, really fall within the same category and apparently have effectively the same scope. The examiner should bear in mind that the presence of such different claims might assist an applicant in obtaining full protection for his invention. Consequently, while an examiner should not allow an unnecessary proliferation of independent claims (see III, 5 concerning conciseness here below), he should not adopt an over-academic or rigid approach to the presence of a number of claims which are differently worded but apparently of similar effect.

	3.3 Subject to the conditions for unity of invention being satisfied (see III, 7 here below), R.415(b) states that an application may contain more than one independent claims in the same category "where it is not appropriate, having regard to the subject-matter of the application, to cover this subject-matter by a single claim". This means that the examiner may allow two or more independent claims in the same category in appropriate cases provided that there is a unifying inventive concept (Sec.38) and that the claims as a whole satisfy the requirement of Sec. 36 that they should be concise (see III, 5.1 here below). In applying this principle the examiner should have regard to the remarks made in III, 3.2 here above concerning claims of apparently similar scope. However, there are other circumstances where it may not be appropriate to cover the subject-matter of an invention by a single independent claim in a particular category, for example, where the invention relates to an improvement in two separate but inter-related articles which may be sold separately, but each carry out the same inventive idea, such as an electric plug and socket or transmitter and receiver. As another example, for an invention concerned with electrical bridge-rectifier circuits it might be necessary to include separate independent claims to a single-phase and poly-phase arrangements incorporating such circuits since the number of circuits needed per phase is different in the two arrangements. Justification for two independent claims in the product-category may also be present in the case of an invention residing in a part of a more complex apparatus where the various parts thereof are separately manufactured, and the part and the whole apparatus may be sold separately (e.g. an incandescent body for a lamp, and the lamp provided with such a body). Further examples are where the invention resides in a group of new chemical compounds and there are a number of processes for the manufacture of such compounds. **Independent and dependent claims**
R415(b)(c)	3.4 All applications will contain one or more "independent" claims directed to the essential features of the invention. Any such claim may be followed by one or more claims concerning "particular embodiments" of that invention. It is evident that any claim relating to a particular embodiment must effectively include also the essential features of the invention, and hence must include all the features of at least one independent claim. The term "particular embodiment" should be construed broadly as meaning any more specific disclosure of the invention than that set out in the main claim or claims.
R.415(c)	3.5 Any claim which includes all the features of any other claim is termed a "dependent" claim. Such a claim must contain, if possible at the beginning, a reference to the other claim, all of whose features it includes (see, however, III, 3.7a here below for claims in different categories).

	Since a dependent claim does not by itself define all the characterising features of the subject matter which it claims, expressions such as "characterised in that" or "characterised by" are not necessary in such a claim but are nevertheless permissible. A claim defining further particulars of an invention may include all the features of another dependent claim and should then refer back to that claim. Also, in some cases a dependent claim may define a particular feature or features which may appropriately be added to more than one previous claim (independent or dependent). It follows that there are several possibilities: a dependent claim may refer back to one or more independent claims, to one or more dependent claims, or to both independent and dependent claims. 3.5a According to R.415(c), any dependent claim which refers to more than one other claim ("multiple dependent claim") shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. Claims in dependent form shall be construed to include all the limitations of the claims incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered. 3.6 All dependent claims, however referred back, must be grouped together to the extent and in the most appropriate way possible. The arrangement must therefore be one which enables the association of related claims to be readily determined and their meaning in association to be readily construed. The examiner should object if the arrangement of claims is such as to create obscurity (Sec.36.1) in the definition of the subject-matter to be protected. In general, however, when the corresponding independent claim is allowable, the examiner should not concern himself unduly with the subject-matter of dependent claims, provided he is satisfied that they are truly dependent and thus in no way extend the scope of protection of the invention defined in the corresponding independent claim (see III, 3.7a here below).
R.416(a)(b)	3.6a If the two-part form is used for the independent claim(s), dependent claims may relate to further details of features not only of the characterising portion but also of the preamble. 3.7 A claim, whether independent or dependent, can refer to alternatives provided those alternatives are of a similar nature and can fairly be substituted one for another and provided also that the number and presentation of alternatives in a single claim does not make the claim obscure or difficult to construe (see also III, 7.4 here below). 3.7a A claim may also contain a reference to another claim even if it is not a dependent claim as defined in R.415(c). One example of this is a claim referring to a claim of different category (e.g. "Apparatus for

	carrying out the process of claim 1...", or "Process for the manufacture of the product of claim 1..."). Similarly, in a situation like the plug and socket example of III, 3.3 here above, a claim to the one part referring to the other co-operating part (e.g. "plug for cooperation with the socket of claim 1...") is not a dependent claim. References from one claim to another may also occur where alternative features which may be substituted for one another are claimed in separate claims. Thus there may be a first independent claim 1 for a machine including, inter alia, a feature X followed by further claims for alternatives such as "A machine according to claim 1 modified in that feature X is replaced by feature Y". In all these examples, the examiner should carefully consider the extent to which the claim containing the reference necessarily involves the features of the claim referred to and the extent to which it does not. In the case of a claim for a process which results in the product of a product claim or a claim for the use of that product, if the product claim is patentable then no separate examination for the obviousness of the process or use claim is necessary (see IV, 9.5a). In all other instances, the patentability of the claim referred to does not necessarily imply the patentability of the independent claim containing the reference.
	4. Clarity and interpretation of claims
Sec.36.1	4.1 The requirement that each claim shall be clear applies to individual claims and also to the claims as a whole. The clarity of the claims is of the utmost importance in view of their function in defining the matter for which protection is sought. In view of the differences in the scope of protection (Sec.75) which may be attached to the various categories of claims, the examiner should ensure that the wording of a claim leaves no doubt as to its category (process, apparatus, product, use). 4.2 Each claim should be read giving the words the meaning and scope which they normally have in the relevant art, unless in particular cases the description gives the words a special meaning, by explicit definition or otherwise. Moreover, if such a special meaning applies, the examiner should, so far as possible, require the claim to be amended whereby the meaning is clear from the wording of the claim alone. The claim should also be read with an attempt to make technical sense out of it. Such a reading may involve a departure from the strict literal meaning of the wording of the claims.
R.418(f)	The terminologies used in the claims and the description have to be consistent with each other.
Sec.75 Sec.36.1 R.415(d)	4.3 Any inconsistency between the description and the claims should be avoided if having regard to Sec. 75, it may throw doubt on the extent of protection and therefore render the claim unclear (Sec.36.1). Such

R.918	inconsistency can be of the following kinds: (i) Simple verbal inconsistency. For example, there is a statement in the description which suggests that the invention is limited to a particular feature but the claims are not so limited; also, the description places no particular emphasis on this feature and there is no reason for believing that the feature is essential for the performance of the invention. In such a case the inconsistency can be removed either by broadening the description or by limiting the claims. Similarly, if the claims are more limited than the description, the claims may be broadened or the description may be limited. (ii) Inconsistency regarding apparently essential features. For example, it may appear, either from general technical knowledge or from what is stated or implied in the description, that a certain described technical feature not mentioned in an independent claim is essential to the performance of the invention, or in other words is necessary for the solution of the problem to which the invention relates. In such a case the claim is unclear (Sec. 36.1), because an independent claim must not only be comprehensible from a technical point of view but it must also define clearly the object of the invention, that is to say indicate all the essential features thereof. If, in response to this objection, the applicant shows convincingly, e.g. by means of additional documents or other evidence, that the feature is not in fact essential, he may be allowed to retain the unamended claim and, where necessary, to amend the description instead. The opposite situation in which an independent claim includes features which do not seem essential for the performance of the invention is not objectionable. This is a matter of the applicant 's choice. The examiner should therefore not suggest that a claim be broadened by the omission of apparently inessential features. (iii) Part of the subject-matter of the description and/or drawings is not covered by the claims. For example, the claims all specify an electric circuit employing semi-conductor devices but one of the embodiments in the description and drawings employs electronic tubes instead. In such a case, the inconsistency can normally be removed either by broadening the claims (assuming that the description and drawings as a whole provide adequate support for such broadening) or by removing the "excess" subject-matter from the description and drawings. However if examples in the description and/or drawings which are not covered by the claims, are presented, not as embodiments of the invention, but as background art or examples which are useful for understanding the invention, the retention of these examples may be allowed. 4.3a General statements in the description which imply that the extent of protection may be expanded in some vague and not precisely defined way should be objected to. In particular, objection should be raised to

	any statement which refers to the extent of protection being expanded to cover the "spirit" of the invention; objection should likewise be raised, in the case where the claims are directed to a combination of features, to any statement which seems to imply that protection is nevertheless sought not only for the combination as a whole but also for individual features or sub-combinations thereof.
R.415(a)(b) R.416(a)	4.4 An independent claim should specify clearly all of the essential features needed to define the invention except in so far as such features are implied by the generic terms used, e.g. a claim to a "bicycle" does not need to mention the presence of wheels. If a claim is to a process for producing the product of the invention, then the process as claimed should be one which, when carried out in a manner which would seem reasonable to a person skilled in the art, necessarily has as its end result that particular product; otherwise there is an internal inconsistency and therefore lack of clarity in the claim. In the case of a product claim, if the product is of a well-known kind and the invention lies in modifying it in certain respects, it is sufficient if the claim clearly identifies the product and specifies what is modified and in what way. Similar considerations apply to claims for apparatus. Where patentability depends on a technical effect, the claim must be so drafted as to include all the technical features of the invention which are necessary for obtaining this technical effect and therefore essential. 4.5 Relative or similar term such as "thin", "wide" or "strong" in a claim may render the scope of the claim vague and uncertain and should not in general be used. However, if the term has a well-recognised meaning in the particular art, e.g. "high-frequency" in relation to an amplifier, and this is the meaning intended its use is permissible. Where the term has no well-recognised meaning it should be replaced by a more precise wording found elsewhere in the original disclosure. Where there is no basis in the disclosure for a clear definition, and the term is not essential having regard to the invention, it should normally be retained in the claim, because to excise it would generally lead to an extension of the subject-matter beyond the content of the application as filed - in contravention of the proviso in Sec. 49. However an unclear term cannot be allowed in a claim if the term is essential having regard to the invention. Equally, an unclear term cannot be used by the applicant to distinguish his invention from the prior art. 4.5a Particular attention is required whenever the word "about" or similar terms such as "approximately" are used. Such a word may be applied, for example, to a particular value (e.g. "about 200°C") or to a range (e.g. "about x to about y"). In each case, the examiner should use his judgement as to whether the meaning is sufficiently clear in the context of the application read as a whole. However, the word can only be permitted if its presence does not prevent the invention from being unambiguously distinguished from the prior art with respect to novelty

	and inventive step. 4.5b The use of trade marks**,** trade names, proper names and similar expressions in claims should not be allowed unless their use is unavoidable; they may be allowed exceptionally if they are generally recognised as having a precise meaning (see also II, 4.16 and 4.17). They may be used exceptionally if their use is unavoidable and they are generally recognised as having a precise meaning. 4.6 Expressions, like "preferably", "for example", "such as" or "more particularly" should be looked at carefully to ensure that they do not introduce ambiguity. Expressions of this kind have no limiting effect on the scope of a claim; that is to say, the feature following any such expression is to be regarded as entirely optional. 4.7 The monopoly defined by the claims must be as precise as the invention allows. As a general rule, claims which attempt to define the invention or a feature thereof by a result to be achieved should not be allowed, in particular if they only amount to claiming the underlying technical problem. However, they may be allowed if the invention either can only be defined in such terms or cannot otherwise be defined more precisely without unduly restricting the scope of the claims and if the result is one which can be directly and positively verified by tests or procedures adequately specified in the description and involving nothing more than trial and error or known to the person skilled in the art and which do not require undue experimentation. For example, the invention may relate to an ashtray in which a smouldering cigarette end will be automatically extinguished due to the shape and relative dimensions of the ashtray. The latter may vary considerably in a manner difficult to define whilst still providing the desired effect (for functional features see III, 2.1 and 6.5). So long as the claim specifies the construction and shape of the ashtray as clearly as possible, it may define the relative dimensions by reference to the result to be achieved, provided that the specification includes adequate directions to enable the reader to determine the required dimensions by routine test procedures not involving ingenuity. However claims of this kind are generally undesirable and should be allowed only when the invention does not admit of precise definition independently of the result achieved. Any claim which includes a subordinate clause prefaced by words such as “so that” or “the arrangement being such that” requires special consideration from this point of view. 4.7a Where the invention relates to a product, e.g. a chemical compound, it may be defined in a claim in various ways, viz., by its chemical formula, as a product of a process (if no clearer definition is possible) or exceptionally by its parameters. Parameters are characteristic values, which may be values of directly measurable properties (e.g. the melting point of a substance, the flexural strength of a steel, the resistance of an electrical conductor) or may be defined as more or less complicated mathematical combinations of several variables in the form of formulae.

	Characterisation of a product, i.e. a chemical compound, solely by its parameters should, as a general rule, not be allowed. It may however be allowable in those cases where the invention cannot be adequately defined in any other way, i.e. independently of the result to be achieved, provided that those parameters are usual in the art and can be clearly and reliably determined either by indications in the description or by objective procedures which are usual in the art. This can arise, e g. in the case of macromolecular chains. The same applies to a process related feature which is defined by parameters. Whether the methods of and the means for measuring the parameters need also to be in the claims is treated in III, 4.10 here below. Cases in which unusual parameters or a non-accessible apparatus for measuring the parameter(s) are employed should be closely examined, as they might disguise lack of novelty (see IV, 7.5). 4.7b Claims for products defined in terms of a process of manufacture are admissible only if the products as such fulfil the requirements for patentability, i.e. inter alia that they are new and inventive. A product is not rendered novel merely by the fact that it is produced by means of a new process. A claim defining a product in terms of a process is to be construed as a claim to the product as such and the claim should preferably take the form "Product X obtainable by process Y", or any wording equivalent thereto, rather than "Product X obtained by process Y".
Sec.78	Concerning the protection afforded by process claims see Sec.78. 4.8 If a claim commences with such words as: "Apparatus for carrying out the process etc..." this must be construed as meaning merely apparatus suitable for carrying out the process. Apparatus which otherwise possessed all of the features specified in the claims, but which would be unsuitable for the stated purpose, or which would require modification to enable it to be so used, should not normally be considered as anticipating the claim. Similar considerations apply to a claim for a product for a particular use. For example, if a claim refers to a "mould for molten steel", this implies certain limitations for the mould. Therefore a plastic ice cube tray with a melting point much lower than that of steel would not come within the claim. Or for example if a claim refers to "A hook for a construction site crane" this implies e.g. particular dimensions and strength in the hook. Therefore a “fish-hook for catching small fish” could never anticipate the claim, but a hook having the necessary dimensions and strength and possessing all the other features specified in the claim would deprive the claim of novelty whether it was stated to be for use in a crane or not. Similarly, a claim to a substance or composition for a particular use should be construed as meaning a substance or composition which is in fact suitable for the stated use; a known product which prima facie is the same as the substance or composition defined in the claim, but which is in a form which would

	render it unsuitable for the stated use, would not deprive the claim of novelty, but if the known product is in a form in which it is in fact suitable for the stated use, though it has never been described for that use, it would deprive the claim of novelty.
Sec.22.3	An exception to this general principle of interpretation is provided by Sec. 22.3 which allows a claim to a known product (substance) or composition where the claim is to a known product (substance) or composition for use in a surgical, therapeutic or diagnostic method, provided that its use in any such method is not comprised in or rendered obvious by the prior art. 4.8a Where a claim in respect of a physical entity (product, apparatus) seeks to define the invention by reference to features relating to the entity's use, a lack of clarity can result. This is particularly the case where the claim not only defines the entity itself but also specifies its relationship to a second entity which is not part of the claimed entity (for example, a cylinder head for an engine, where the former is defined by features of its location in the latter). Before considering a restriction to the combination of the two entities, it should always be remembered that the applicant is normally entitled to independent protection of the first entity per se, even if it was initially defined by its relationship to the second entity. Since the first entity can often be produced and marketed independently of the second entity, it will usually be possible to obtain independent protection by wording the claims appropriately (for example, by substituting "connectable" for "connected"). If it is not possible to give a clear definition of the first entity per se, then the claim should be directed to a combination of the first and second entities (for example, "engine with a cylinder head" or "engine comprising a cylinder head"). It may also be allowable to define the dimensions and/or shape of a first entity in an independent claim by general reference to the dimensions and/or corresponding shape of a second entity which is not part of the claimed first entity but is related to it through use. This particularly applies where the size of the second entity is in some way standardised (for example, in the case of a mounting bracket for a vehicle number-plate, where the bracket frame and fixing elements are defined in relation to the outer shape of the number-plate). However, references to second entities which cannot be seen as subject to standardisation may also be sufficiently clear in cases where the skilled person would have little difficulty in inferring the resultant restriction of the scope of protection for the first entity (for example, in the case of a covering sheet for an agricultural round bale, where the length and breadth of the covering sheet and how it is folded are defined by reference to the bale's circumference, width and diameter). It is neither necessary for such claims to contain the exact dimensions of the second entity, nor do they have to refer to a combination of the first and second entities. Specifying the length, width and/or height of the first entity without reference to the second would lead to an unwarranted restriction of the scope of protection.

	4.8b To avoid ambiguity, particular care should be exercised when assessing claims which employ the word "in" to define a relationship between different physical entities (product, apparatus), or between entities and activities (process, use), or between different activities. Examples of claims worded in this way include the following: (i) cylinder head in a four-stroke engine (ii) In a telephone apparatus with an automatic dialer, dial tone detector and feature controller, the dial tone detector comprising ... (iii) In a process using an electrode feeding means of an arc-welding apparatus, a method for controlling the arc welding current and voltage comprising the following steps:... (iv) In a process/system/apparatus ... the improvement consists of ... In examples (i) to (iii) the emphasis is on the fully functioning sub-units (cylinder head, dial tone detector, method for controlling the arc welding current and voltage) rather than the complete unit within which the sub-unit is contained (four-stroke engine, telephone, process). This can make it unclear whether the protection sought is limited to the sub-unit per se, or whether the unit as a whole is to be protected. For the sake of clarity, claims of this kind should be directed either to "a unit with (or comprising) a sub-unit" (e.g., "four-stroke engine with a cylinder head"), or to the sub-unit per se, specifying its purpose (for example, "cylinder head for a four-stroke engine"). The latter course may be followed only at the applicant's express wish and only if there is a basis for it in the application as filed, in accordance with the proviso of Sec.49. With claims of the type indicated by example (iv), the use of the word "in" sometimes makes it unclear whether protection is sought for the improvement only or for all the features defined in the claim. Here, too, it is essential to ensure that the wording is clear. However, claims such as "use of a substance ... as an anticorrosive ingredient in a paint or lacquer composition" are acceptable on the basis of second non-medical use (see IV, 7.6, second paragraph).
R.415(b)	4.9 For the purposes of examination, a "use" claim of a form such as "the use of substance X as an insecticide" should be regarded as equivalent to a "process" claim of the form "a process of killing insects using substance X". Thus a claim of the form indicated should not be interpreted as directed to the substance X recognisable (e.g. by further additives) as intended for use of an insecticide. Similarly, a claim for "the use of a transistor in an amplifying circuit" would be equivalent to a process claim for the process of amplifying using a circuit containing the transistor and should not be interpreted as being directed to "an amplifying circuit in which the transistor is used", nor to "the process of

	using the transistor in building such a circuit". 4.9a A claim to an apparatus or substance “when used in” a particular process should be construed as a claim confined to the use of the apparatus or substance in such a process, and its novelty is therefore destroyed only by a disclosure to such use. Preferably, the claims wording should be amended to read “Use of the apparatus/substance for/in ...(process features)...”. If the apparatus or substance per se is known to be old, this fact should be acknowledged in the description in order to ensure that the nature of the invention in its proper perspective.
R.415(d)	4.10 The claims must not, in respect of the technical features of the invention, rely on references to the description or drawings "except where absolutely necessary". In particular they must not normally rely on such references as "as described in part... of the description", or "as illustrated in Figure 2 of the drawings", or substantially as described and illustrated in the accompanying drawings”. A claim containing the latter phrase is known as an omnibus claim. The emphatic wording of the excepting clause precluding such references should be noted. The onus is upon the applicant to show that it is "absolutely necessary" to rely on reference to the description or drawings in appropriate cases. An example of an allowable exception would be that in which the invention involved some peculiar shape, illustrated in the drawings, but which could not be readily defined either in words or by a simple mathematical formula. Another special case is that in which the invention relates to chemical products some of whose features can be defined only by means of graphs or diagrams. A further special case is where the invention is characterised by parameters. Provided that the conditions for defining the invention in this way are met (see III, 4.7a here above), then the definition of the invention should appear completely in the claim itself whenever this is reasonably practicable. In principle the method of measurement is necessary for the unambiguous definition of the parameter. The method of and means for measurement of the parameter values need not be in the claims when: (a) the description of the method is so long that its inclusion would make the claim unclear through lack of conciseness or difficult to understand; in that case the claim should include a reference to the description, in accordance with R.415(d), (b) a person skilled in the art would know which method to employ, e.g. because there is only one method, or because a particular method is commonly used, or (c) all known methods yield the same result (within the limits of measurement accuracy).] In all other cases the method of and means for measurement should be included in the claims as the claims shall define the matter for which protection is sought Sec. 36.1

R.416(c) R.413(b) R.414.13	4.11 The use of references in the claims to features of the drawings is not prohibited. On the contrary, if there are drawings, and the technical features of the claims would be rendered more intelligible by relating these features to the corresponding features of the drawings (e.g. where a complete machine has been illustrated), then this should preferably be done by placing the appropriate reference signs in parentheses after the features in the claims. This should be done in both parts of claims having the two-part form specified in R.416(a)(b). These reference signs are not, normally construed as limiting the scope of a claim, but merely act as aids to an easier understanding of the claimed invention. However, the use of reference signs is however not always necessary in order to meet the requirements of Sec. 36. If the absence of reference signs makes it very difficult to relate a claim to the particular description, it is often possible to amend the wording of the claim as an alternative to inserting reference signs therein. Another acceptable alternative is to put the reference signs in a corresponding statement of invention in the description. If text is added to reference signs in parentheses in the claims, lack of clarity can arise Sec. 36.1. Expressions such as "securing means (screw 13, nail 14)" or "valve assembly (valve seat 23, valve element 27, valve seat 28)" are not reference signs in the sense of R.416(c) but are special features, to which the last sentence of R.416(c) is not applicable. Consequently it is unclear whether the features added to the reference signs are limiting or not. Accordingly, such bracketed features are generally not permissible. However, additional references to those figures where particular reference signs are to be found, such as "(13 - Figure 3; 14 - Figure 4)", are unobjectionable.
R.416(c)	A lack of clarity can also arise with bracketed expressions that do not include reference signs, e.g. "(concrete) moulded brick". In contrast, bracketed expressions with a generally accepted meaning are admissible, e.g. "(meth)acrylate" which is known as an abbreviation for "acrylate and methacrylate". The use of brackets in chemical or mathematical formulae is also unobjectionable. 4.12 Generally, the subject-matter of a claim is defined by means of positive features. However, the extent of a claim may be limited by means of a "disclaimer"; in other words, an element clearly defined by technical features may be expressly excluded from the protection claimed, for example in order to meet the requirement of novelty (over a document belonging to a different technical field), or to exclude technically impossible or insufficiently disclosed subject-matter . A disclaimer may be used only when the claim's remaining subject-matter cannot be defined more clearly and concisely by means of positive features . A disclaimer is generally a way of trying to preserve the patentability of a generic claim by excluding from its scope one or more

	particular examples in the prior art. There is no standard wording or phrase in the description or claims for a disclaimer. A specific prior art may be excluded by a disclaimer even in the absence of support for the excluded matter in the original application documents. However, care should be taken that the wording of the disclaimer does not infringe the proviso of Sec. 49. For example, a disclaimer should not be accepted in case that the disclosure of a document belonging to the same technical field as the invention is to be excluded, and the inventive step for the remaining subject-matter is argued on the basis of an exclusion not originally disclosed in the application under examination. 4.13 "Comprising" vs. "consisting" While in everyday language the word "comprise" may have both the meaning "include", "contain" or "comprehend" and "consist of", in drafting patent claims legal certainty normally requires it to be interpreted by the broader meaning "include", "contain" or "comprehend". On the other hand, if a claim for a chemical compound refers to it as "consisting of components A, B and C" by their proportions expressed in percentages, the presence of any additional component is excluded and therefore the percentages should add up to 100%. **5. Conciseness, number of claims**
Sec.36.1	5.1 The requirement that “each claim shall be concise” refers to the claims in their entirety as well as to the individual claims. The number of claims must be considered in relation to the nature of the invention the applicant seeks to protect. Undue repetition of wording, e.g. between one claim and another, should be avoided by the use of the dependent form. Regarding independent claims in the same category see III, 3.3 here above. As for dependent claims, while there is no objection to a reasonable number of such claims directed to particular preferred features of the invention, the examiner should object to a multiplicity of claims of a trivial nature. **6. Support in description**
Sec.36.1	6.1 Each claim must be supported by the description. This means that there must be a basis in the description for the subject-matter of every claim and that the scope of the claims must not be broader than is justified by the extent of the description and drawings. 6.2 Most claims are generalisations from one or more particular examples. The extent of generalisation permissible is a matter which the examiner must judge in each particular case in the light of the relevant prior art. Thus an invention which opens up a whole new field is entitled to more generality in the claims than one which is concerned with

	advances in a known technology. A fair statement of claim is one which is not so broad that it goes beyond the invention nor yet so narrow as to deprive the applicant of a just reward for the disclosure of his invention. The applicant should be allowed to cover all obvious modifications, equivalents to and uses of that which he has described; after the date of filing, however, he should be allowed to do so only if this does not introduce subject-matter which goes beyond the disclosure of the initial application, i.e. does not contravene the proviso of Sec. 49. In particular, if it is reasonable to predict that all the variants covered by the claims have the properties or uses the applicant ascribes to them in the description he should be allowed to draw his claims accordingly. Where there is any serious inconsistency between the claims and the description amendment to remove this will be required.
Sec.35.1 Sec.36.1	6.3 However, claims are sometimes speculative, in that their scope extends beyond the description to embrace possibilities not yet explored by the applicant, the effects of which cannot be readily predetermined or assessed and the description gives merely an indication of the full breadth of scope of the invention but no, or inadequate, directions of how to put it into practice. In this case the examiner may object that the invention in this respect is not sufficiently disclosed (Sec.35.1) and that, consequently such claims are not supported by description (Sec.36.1). For instance, a claim in generic form, i.e. relating to a whole class e.g. of products or machines, may be acceptable even if of broad scope, if there is a fair support in the description, and there is no reason to suppose that the invention cannot be worked through the whole of the field claimed. Where the information given appears insufficient to enable the person with ordinary skill in the art to extend the teaching of the description to parts of the field claimed, but not explicitly described by using routine methods of experimentation or analysis, the examiner should require the applicant to satisfy him that the invention can in fact be readily applied, on the basis of the information given, over the whole field claimed or, failing this, to restrict the claim to accord with the description. As a general rule, a claim should be regarded as supported by the description unless exceptionally there are well-founded reasons for believing that the skilled person would be unable, on the basis of the information given in the application as filed, to extend the particular teaching of the description to the whole of the field claimed by using routine methods of experimentation or analysis. Support must however be of a technical character; vague statements or assertions having no technical content provide no basis. The examiner should raise an objection, or require further evidence, only if he has strong, well-founded reasons for believing that the description as filed provides inadequate support for that claim. It follows that in other cases the applicant should be given the benefit of the doubt. Where

objection is raised, the reasons should preferably be supported specifically by a published document.

6.4 The question of support is illustrated by the following examples:

(a) A broad claim for “a process for influencing substances by high-frequency electrical energy” may not be adequately supported by the disclosure of a single example of such an influence (e. g. removing dust from a gas) nor of influences on a single substance.

(b) A claim relates to a process for treating all kinds of "plant seedlings" by subjecting them to a controlled cold shock of such duration and intensity that the specified results would follow, whereas the description discloses the process applied to one kind of plant only. Since it is well known that plants vary widely in their properties, there are well-founded reasons for believing that the process is not applicable to all plant seedlings. Unless the applicant can provide convincing evidence that the process is nevertheless generally applicable, he must restrict his claim to the particular kind of plant referred to in the description. A mere assertion that the process is applicable to all plant seedlings is not sufficient.

Such a claim might thus only be permissible if it clearly emanates from the description that the conditions set forth in relation to that plant applied to other plants generally; but otherwise the claim would not be adequately supported unless the description gave a sufficient range of examples, relating to different kind of plants, to enable a horticulturist to deduce how the process should be applied to virtually any plant.

(c) A claim relates to a specified method of treating "synthetic resin mouldings" to obtain certain changes in physical characteristics. All the examples described relate to thermoplastic resins and the method is such as to appear inappropriate to thermosetting resins.

Unless the applicant can provide evidence that the method is nevertheless applicable to thermosetting resins, he must restrict his claim to thermoplastic resins.

It should be noted that, although an objection of lack of support is an objection under Sec.36.1, it can often, as in the above examples, also be considered as an objection of insufficient disclosure of the invention under Sec.35, the objection being that the disclosure is insufficient to enable the skilled person to carry out the "invention" over the whole of the broad field claimed (although sufficient in respect of a narrow "invention"). Whether the objection is raised as lack of support or as insufficiency is unimportant in examination proceedings; but it is important in cancellation proceedings since there only the latter ground is available (-> Sec.61.1).

6.5 A claim may broadly define a feature in terms of its function, even

	where only one example of the feature has been given in the description, if the skilled reader would appreciate that other means could be used for the same function (see also III, 2.1 here above). For example, "terminal position detecting means" in a claim might be supported by a single example comprising a limit switch, it being obvious to the skilled person that e.g. a photoelectric cell or a strain gauge could be used instead. In general, however, if the entire contents of the application are such as to convey the impression that a function is to be carried out in a particular way, with no intimation that alternative means are envisaged, and a claim is formulated in such a way as to embrace other means, or all means, of performing the function, then objection arises. Furthermore, it may not be sufficient if the description merely states in vague terms that other means may be adopted, if it is not reasonably clear what they might be or how they might be used. 6.6 Where certain subject-matter is clearly disclosed in a claim of the application as filed, but is not mentioned anywhere in the description, it is permissible to amend the description so that it includes this subject-matter. Where the claim is dependent, it may suffice if it is mentioned in the description that the claim sets out a particular embodiment of the invention (see II, 4.5)]. **7. Unity of invention** **Independent claims**
Sec. 38.1 R.604(a)	7.1 The Philippine application must "relate to one invention only, or to a group of inventions forming a single general inventive concept". The second of these alternatives, i.e. the single-concept linked group, may give rise to a plurality of independent claims in the same category (as in the examples given in III, 3.3 here above), but the more usual case is a plurality of independent claims in different categories. The following guidelines, and in particular R.605, are consistent with internationally harmonised unity of invention practices of many patent offices. Concerning examples for the assessment of unity, reference is made to III, Annex 1 and to VII, 4.
R.605(a) R.605(b)	7.2 R.605(a) indicates how one determines whether or not the requirement of Sec. 38.1 is fulfilled when more than one invention appears to be present. The link or “single general inventive concept” between the inventions required by Sec.38.1 must be a technical relationship which finds expression in the claims in terms of the same or corresponding special technical features. The expression "special technical features" means, in any one claim, the particular technical feature or features that define a contribution that the claimed invention

	considered as a whole makes over the prior art. Once the special technical features of each invention have been identified, one must determine whether or not there is a technical relationship between the inventions and, furthermore, whether or not this relationship involves these special technical features. Moreover, it is not necessary that the special technical features in each invention be the same. R.605(a) makes it clear that the required relationship may be found between corresponding technical features. An example of this correspondence might be the following: In one claim the special technical feature which provides resilience might be a metal spring, whereas in another claim the special technical feature which provides resilience might be a block of rubber.
R.605(c)	A plurality of independent claims in different categories may constitute a group of inventions so linked as to form a single general inventive concept.
R.605(d)	In particular, the inclusion of any one of the following combinations of claims of different categories in the same application is permissible: (1) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product, or (2) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process, or (3) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product and an independent claim for an apparatus or means specifically designed for carrying out the said process. It should be noted that a "product" need not be a substance or composition but can be any physical thing resulting from man's technical skill. It can be, for example, a device, a machine or an assembly or a system. Example (a): 1. Flame-retarding agent X, 2. Method of preparation of X 3. Use of X to treat a textile fabric. Example(b) 1. Method of making a cable by twisting the cores together in a particular way.

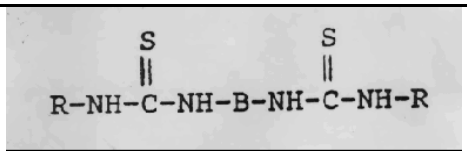
R.415(b)	2. Apparatus particularly designed to twist the cores in the particular way (of claim 1). Sub-combinations of these groups of claims are also possible such as, for example, product and process, product and use and process and apparatus. Evidently these may be admitted within the framework of unity of invention. However, while a single set of independent claims according to any one of the combinations (1), (2) or (3) above is always permissible, an examiner is not obliged to accept a plurality of such sets which could arise by additionally applying the provisions of R.415(b). The proliferation of claims arising out of a combined effect of this kind should be allowed only exceptionally. 7.3 It is essential that a single general inventive concept link the claims in the various categories. The presence in each claim of expressions such as "specially adapted" or "specifically designed" does not necessarily imply that a single general inventive concept is present. The requirement that the process be specially adapted for the manufacture of the product is fulfilled if the claimed process inherently results in the claimed product. The expression "specially adapted" does not imply that the product could not also be manufactured by a different process. It also does not imply that a similar process of manufacture could not also be used for the manufacture of other products. The requirement that the apparatus or means be specifically designed for carrying out the process is fulfilled if the apparatus or means is suitable for carrying out the process and if there is a technical relationship as defined in R.605(a) between the claimed apparatus or means and the claimed process. It is not sufficient for unity that the apparatus or means is merely capable of being used in carrying out the process. However, the expression "specifically designed" does not exclude that the apparatus or means could also be used for carrying out another process, or that the process could also be carried out using an alternative apparatus or means. 7.3a Unity of invention should be considered to be present in the context of intermediate and final products where: (i) the intermediate and final products have the same essential structural element, i.e. their basic chemical structures are the same or, their chemical structures are technically closely interrelated, the intermediate incorporating an essential structural element into the final product, and (ii) the intermediate and final products are technically interrelated, this meaning that the final product is manufactured directly

	(iii) from the intermediate or is separated from it by a small number of intermediates all containing the same essential structural element. Unity of invention may also be present between intermediate and final products of which the structures are not known - for example, as between an intermediate having a known structure and a final product with unknown structure or as between an intermediate of unknown structure and a final product of unknown structure. In such cases, there should be sufficient evidence to lead one to conclude that the intermediate and final products are technically closely interrelated as, for example, when the intermediate contains the same essential element as the final product or incorporates an essential element into the final product. Different intermediate products used in different processes for the preparation of the final product may be claimed provided that they have the same essential structural element. The intermediate and final products should not be separated, in the process leading from one to the other, by an intermediate which is not new. Where different intermediates for different structural parts of the final product are claimed, unity should not be regarded as being present between the intermediates. If the intermediate and final products are families of compounds, each intermediate compound should correspond to a compound claimed in the family of the final products. However, some of the final products may have no corresponding compound in the family of the intermediate products so that the two families need not be absolutely congruent. The mere fact that, besides the ability to be used to produce final products, the intermediates also exhibit other possible effects or activities should not prejudice unity of invention.
R.605(b)	7.4 Alternative forms of an invention may be claimed either in a plurality of independent claims (as indicated in III, 7.1 here above) or in a single claim (but see III, 3.7 here above). In the latter case the presence of the two alternatives as independent forms may not be immediately apparent. In either case, however, the same criteria should be applied in deciding whether or not there is unity of invention, and lack of unity of invention may then also exist within a single claim. 7.4a Where a single claim defines (chemical or non-chemical) alternatives, i.e. a so-called "Markush grouping", unity of invention should be considered to be present when the alternatives are of a similar nature (see III, 3.7 here above). A "Markush claim" can be considered as a shortened formulation of a claim which claims "A compound selected from the group of compounds consisting of .....", wherein a very large number of compounds would then be specified. It is a generic formulation of chemical compounds each having a common basic structure plus variable substituents, the

substituents having a common property or activity.

An example of such a Markush claim is:

> A composition comprising a copper compound and a dimerised thiourea derivative of Formula



> wherein the two substituents R, which may be the same or different, are each independently selected from a substituted or unsubstituted alkyl group having 1 to 18 carbon atoms, a substituted or unsubstituted cycloalkyl group having 3 to 18 carbon atoms, a substituted or unsubstituted aralkyl group having 7 to 30 carbon atoms, a substituted or unsubstituted aryl group having 6 to 30 carbon atoms, a substituted or unsubstituted acyl group having 2 to 20 carbon atoms, a substituted or unsubstituted alkenyl group having 2 to 20 carbon atoms, and a substituted or unsubstituted alkoxycarbonyl group having 2 to 20 carbon atoms; and B denotes substituted or unsubstituted benzene ring, a naphthalene ring, or a biphenyl ring; the molar ratio of dimerised thiourea derivative to copper compound being from 8:2 to 1:2.

When the Markush grouping is for alternatives of chemical compounds, they should be regarded as being of a similar nature where:

(i) all alternatives have a common property or activity, and

(ii) a common structure is present, i.e. a significant structural element is shared by all of the alternatives, or all alternatives belong to a recognised class of chemical compounds in the art to which the invention pertains.

A "significant structural element is shared by all of the alternatives" where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art. The structural element may be a single component or a combination of individual components linked together. The alternatives belong to a "recognised class of chemical compounds" if there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention, i.e. that each member could be substituted one for the other, with the expectation that the same intended result would be achieved. If it can be shown that at least one Markush alternative is not novel, unity of invention should be

	reconsidered. 7.5 Objection of lack of unity does not normally arise because a claim contains a number of individual features whether presenting a technical interrelationship (combination) or not (juxtaposition) 7.6 Lack of unity may be directly evident a priori, i.e. before considering the claims in relation to the prior art or may only become apparent a posteriori, i.e. after taking the prior art into consideration - e.g. a document within the state of the art as defined in Sec. 24.1 shows that there is lack of novelty or inventive step in a main claim thus leaving two or more independent claims without a common inventive concept.
Sec.38.3	7.7 Although lack of unity may arise a posteriori as well as a priori, it should be remembered that lack of unity is not a ground of cancellation in later proceedings. Therefore, although the objection should certainly be made and amendment insisted upon in clear cases, it should neither be raised nor persisted in on the basis of a narrow, literal or academic approach. This is particularly so where the possible lack of unity does not necessitate a further search. There should be a broad, practical consideration of the degree of interdependence of the alternatives presented, in relation to the state of the art as revealed by the search report. If the common matter of the independent claims is well-known, and the remaining subject-matter of each claim differs from that of the others without there being any unifying novel concept common to all, then clearly there is lack of unity. If, on the other hand, there is a common concept or principle which is novel and inventive then objection of lack of unity does not arise. For determining what is allowable between these two extremes, rigid rules cannot be given and each case should be considered on its merits, the benefit of any doubt being given to the applicant. For the particular case of claims for a known substance for a number of distinct medical uses, see IV, 4.2. **Dependent claims** 7.8 No objection on account of lack of unity a priori is justified in respect of a dependent claim and the claim from which it depends only because the general concept they have in common is the subject-matter of the independent claim, which is also contained in the dependent claim. For example, suppose claim 1 claims a turbine rotor blade shaped in a specified inventive manner, while claim 2 is for a "turbine rotor blade as claimed in claim 1 and produced from alloy Z". The common general concept linking the dependent with the independent claim is "turbine rotor blade shaped in a specified manner", irrespective of whether the alloy Z is novel and inventive or not. As another example, suppose that a main claim defines a process for the preparation of a Product A starting from a product B and the second claim reads: Process according to claim 1 characterised by producing B by a reaction using the product C. In this case, too, no objection arises

	under Sec.38.1, whether or not the process for preparation of B from C is novel and inventive, since claim 2 contains all the features of claim 1. The subject matter of claim 2 therefore falls within claim 1. Hence, there is no question of plurality of invention when one claim is within the scope of another, even though the additional matter in the narrower claim would have been capable of being claimed as further invention. Where, however, a claim is presented as dependent on another, but in fact states that one or more features of the other claim are omitted or are replaced by other features, there is the possibility of lack of unity of invention. Likewise when alternatives are specified in a single claim, the claim should be notionally rewritten as a series of independent claims which then can be assessed for unity of invention in the usual way. If the independent claim appears to be not patentable, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered (see III, 7.7 here above, non-unity "a posteriori"). It may be that the "special technical features" of one claim dependent on this non-patentable independent claim are not present in the same or corresponding form in an other claim dependent on that claim. 7.9 Concerning the procedure to be followed in case of lacking unity, reference is made to Sec.38.2 and R.606 to 611. 7.10 The Bureau may raise objections under Sec.38 during the stage preceding publication (e.g. upon search) or during the subsequent substantive examination. **8. Calculation of claims fees**
R.417	The claims incurring fees are calculated in accordance with R.417.

ANNEX to CHAPTER III, 7

Guidance for the assessment of unity

1. General

An application should relate to one invention only. The reason for this is that an applicant should file a separate application for each invention, and pay corresponding fees for each application. If he includes more than one invention in an application he might avoid the fee payment.

2. Two approaches for examining unity of invention:

There are two ways of examining for unity of invention. The first method is called the "common subject-matter approach", and is the traditional method used, and the second method, for purpose of explanation, is here called the "Rule 605 approach", and is relatively new. This rule says that unity of invention exists only if there is technical relationship between the claimed inventions and they involve one or more of the same or corresponding special technical features."
The above two methods should give the same result, but nevertheless both are explained below.

2.1 The Rule 605 approach comprises the following steps:

Step 1:

Compare the subject-matter of the first invention (1st independent claim) with the relevant prior art to determine which are the "special technical feature(s)" defining the contribution the invention, considered as a whole, makes over the prior art. This means identify those features that make the claim novel and inventive.

Step 2: Compare the "special technical features" of the first invention identified in step 1 with the subject-matter of the second invention (2nd independent claim), and determine whether or not one or more of the same or corresponding special technical features are present, i.e. do the two claims contain the same features that are novel and inventive. If they do, there is a technical relationship among the two inventions.

Step 3:

Conclude that there is a single general inventive concept if such technical relationship is present. If on the other hand, no such technical relationship exists, conclude that there is no single general inventive concept, and, consequently, that unity of invention is lacking.

Step 4:

Repeat the above for the remaining independent claims.

2.2 The "common subject-matter approach"

The "common subject-matter" of two inventions (claims) is the technical features which are common to the two inventions (claims). In certain cases, two apparently different technical features may have a common technical effect, which contributes to the "common subject-matter".

The "common subject-matter approach" involves the following steps:

(i) identify the common subject-matter (CSM) of the independent claims. Thus if claim 1 has the features a, b, c, d, e, and f, and claim 10 has the features a, b, d, e, g, and h, the common subject-matter comprises a, b, d, and e;

(ii) compare this CSM with the disclosure of the closest prior art document to determine whether or not it is known (and, possibly, also whether or not it is obvious) and

(iii) decide that there is no single inventive concept between the independent claims, if said CSM is known (or obvious, and vice versa).

3. "A priori" and "a posteriori" lack of unity

A lack of unity **"a priori"** is based on general knowledge of the skilled person, whereas **"a posteriori"** is based on knowledge from a particular prior art document.

To illustrate these terms in more detail, consider the following set of claims:

1. A telephone
2. A telephone having a cradle switch
3. A telephone having a dial
4. A telephone having a rotary dial
5. A telephone having a pushbutton dial

Suppose that an application contains all of these claims. They are all linked by a single general concept i.e. a telephone. If the telephone is new and involves an inventive step, then these claims form a group of linked inventions and are free from an objection of non-unity.

If the telephone is not new or lacks an inventive step, Claim 1 would not be allowable, for lack of novelty. Claims 2 to 5 are then no longer linked by a single general inventive concept. Consequently, an objection of non-unity would arise, it being assumed that both the cradle switch and a dial themselves are inventive.

If the claims had been in the form:

1. A telephone
2. A cradle switch
3. A dial
4. A rotary dial

5. A pushbutton dial,

It would have been clear from the start that there was non-unity. The second example indicates what is meant by "a priori". In the first example however, it was necessary to know whether the concept of a telephone was or was not new and inventive before one could decide as to the unity, so that here the case of "a posteriori" arose. This is the much more common case.

4. Claim containing alternatives (see III, 3.7).

Non-unity can sometimes arise where there appears to be only one claim, for example:

A thermoplastic moulding composition which comprises a polyphenylene etherstyrene resin composition (A); and as a conductive material, aluminium flakes (B), a combination of aluminium flakes (B) with carbon fibres (C) or conductive carbon black (D), or a combination of carbon fibres (C) and conductive carbon black (D), or carbon fibres (C), in an amount sufficient to make the composition shielding against electromagnetic interference when moulded.

It must be first recognised that this claim should be regarded as not one but five independent claims, i.e.:

1. A + B
2. A + B + C
3. A + B + D
4. A + C + D
5. A + C

If the combination of A with any conductive material is known, then at first sight (a priori) there is non-unity. It must nevertheless be considered whether the known combination is such as to make the composition shielding against electromagnetic interference when moulded. It must also be considered whether, having regard to the problem to be solved, the materials B (aluminium flakes) and C (carbon fibres) have something in common which makes these materials particularly suitable for use in combination with the particular resin composition A. Finally it should also be considered whether, having regard to the state of the art, any of the combinations involves an inventive step. It would be wrong to raise only a non-unity objection if some of the combinations did not involve an inventive step.

5. Independent claims for related articles

Having dealt with a few examples of claims which sometimes looked alike but nevertheless exhibited non-unity, it may be instructive to look at some claims which do not look at all alike but which do exhibit unity.

1. A transmitter including carrier-frequency-hopping generating means (16) for generating as an output a distinct sequence of carrier frequencies (f(t)), modulating means (12,14,18) responsive to both a message signal and the

distinct sequence of carrier frequencies for modulating the message signal to produce as an output of the transmitter a carrier-frequency-hopped single sideband signal, characterised in that the distinct sequence of carrier frequencies is generated in response to an assignment code (c(t)) received from a remote receiver and representative of the distinct sequence of carrier frequencies.

2. A receiver including carrier-frequency-hopping generating means (24) for generating as an output a distinct sequence of carrier frequencies related to a received carrier-frequencyhopped single sideband signal, and demodulating means (22,26,28) responsive to both the received carrier-frequencyhopped single sideband signal and the distinct sequence of carrier frequencies for demodulating the received carrier-frequency-hopped single sideband signal to produce as an output of the receiver the message signal related thereto, and characterised by means (24) for generating for transmission an assignment code (c(t)) representative of the distinct sequence of carrier frequencies.

In this case a single general inventive concept can be recognised in the transmission of an assignment code representative of the distinct sequence of carrier frequencies. These claims are an example of independent claims in the same category.

6. Claims in different categories

Independent claims

See examples a) and b) in Chapter III, 7.1 – 7.2

7. "Markush" claims

The assessment of unity in case of Markush claims is dealt with under Chapter III, 7.4a

8. Different medical uses of a known substance

If an application discloses different medical uses of a known substance, and the uses are new, then independent claims for the substance having the different uses may be claimed. There is no lack of unity since the unifying concept is the first medical use of the substance, which is novel and inventive.

9. Further examples

Further examples concerning the assessment of unity can be found in Chapter VII, 4 (Unity of invention).

CHAPTER IV - PATENTABILITY

	1. General
Sec.21 R.200	1.1 There are four basic requirements for patentability: (i) There must be an "invention" that can be considered as a “technical solution of a problem in any field of human activity”. (ii) The invention must be "industrially applicable". (iii) The invention must be "new". (iv) The invention must involve an "inventive step". These requirements will be dealt with in turn in the following sections IV, 2 and 3, 4, 5 to 8, and 9, respectively.
	1.2 In addition to these four basic requirements, the examiner should be aware of the following two requirements that are implicitly contained in the IP-code and the Implementing Rules and Regulations:
Sec.35.1 R.909(c)	(i) The invention must be such that it can be carried out by a person skilled in the art (after proper instruction by the application); this follows from Sec.35.1. Instances where the invention fails to satisfy this requirement are given in C-II, 4.11.
R.407(1)(a) R.407(1)(c) R.416	(ii) The invention must be a “technical solution to a problem”, hence of a "technical” character", to the extent that it must relate to a technical field (R.407(1)(a)), must be concerned with a technical problem (R.407(1)(c)), and must have technical features in terms of which the matter for which protection is sought can be defined in the claim (R.416(a)(b)), see also C-III, 2.1).
	1.3 Sec.21 of the IP-code Convention does not require explicitly or implicitly that an invention to be patentable must entail some technical progress or even any useful effect. Nevertheless, advantageous effects, if any, with respect to the prior art should be stated in the description (R.407(1)(c)), and any such effects are often important in determining "inventive step" (see IV, 9 here below).
	2. Inventions
Sec.21 Sec.22	2.1 Sec.21 gives a definition of what is meant by "invention", but Sec.22 contains a non-exhaustive list of things which shall not be regarded as patentable inventions. It will be noted that the exclusions in Sec.22.1 and

	Sec.22.2 are abstract (e.g. discoveries, scientific theories etc.) and the exclusions in Sec.2.5 are non-technical (e.g. aesthetic creations). In contrast to this, an "invention" within the meaning of Sec.21 must be of both a concrete and a technical character (see IV, 1.2 (ii) here above). The exclusions under Sec.22.1, 22.2 and 22.5 are dealt with under IV, 2.2 and 2.3 here below. The exclusions under Sec.22.4 (inventions in the biological field) and 22.6 (public order and morality) are dealt with under IV, 3 here below. The exclusions under Sec.22.3 (inventions in the medical field) and under Sec.27 (industrial applicability) are dealt with under IV, 4 here below.
Sec.21 R.201 R.415	2.1a Examples of what an invention may be are given in Sec.21, R.201 and R.415, i.e. a) a useful machine; b) a product; c) or process or an improvement of any of the foregoing; d) microorganism; and e) non-biological and microbiological processes, or the use of an item in a specific process and/or for a specific purpose. 2.2 In considering whether the subject-matter of an application is an invention within the meaning of Sec.21, there are two general points the examiner must bear in mind. Firstly, any exclusion from patentability under Sec.22.1 or Sec.22.2 will in general apply only to the extent to which the application relates to the excluded subject-matter as such. Secondly, the examiner should disregard the form or kind of claim and concentrate on its content in order to identify the real contribution which the subject-matter claimed, considered as a whole, adds to the known art. If this contribution is not of a technical character, there is no invention within the meaning of Sec.21. Thus, for example, if the claim is for a known manufactured article having a painted design or certain written information on its surface, the contribution to the art is as a general rule merely an aesthetic creation or presentation of information. Similarly, if a computer program is claimed in the form of a physical record, e.g. on a conventional tape or disc, the contribution to the art is still no more than a computer program. In these instances the claim relates to excluded subject-matter as such and is therefore not allowable. If, on the other hand, a computer program in combination with a computer causes the computer to operate in a different way from a technical point of view, the combination might be patentable. It must also be borne in mind that the basic test of whether there is an invention within the meaning of Sec.22, is separate and distinct from the questions whether the subject-matter is susceptible of industrial application, is new and involves an inventive step.

	2.3 The items of Sec.22.1, 22.2 and 22.5 will now be dealt with in turn, and further examples will be given in order better to clarify the distinction between what is patentable and what is not.
Sec.22.1 R.202(a)	**Discoveries** If a person finds out a new property of a known material or article, that is a mere discovery and therefore not patentable. If however a person puts that property to practical use, an invention has been made which may be patentable. For example, the discovery that a particular known material is able to withstand mechanical shock would not be patentable, but a railway sleeper made from that material could well be patentable. To find a substance freely occurring in nature is also mere discovery and therefore not patentable. However, if a substance found in nature has first to be isolated from its surroundings and a process for obtaining it is developed, that process is patentable. Moreover, if the substance can be properly characterised either by its structure, by the process by which it is obtained or by other parameters (see III, 4.7a) and it is "new" in the absolute sense of having no previously recognised existence, then the substance per se may be patentable (see also IV, 7.3 here below). An example of such a case is that of a new substance which is discovered as being produced by a micro-organism.
Sec.22.1 R.202(a)	**Scientific theories** These are a more generalised form of discoveries, and the same principle applies. For example, the physical theory of semiconductivity would not be patentable. However, new semiconductor devices and processes for manufacturing these may be patentable.
Sec.22.1 R.202(a)	**Mathematical methods** These are a particular example of the principle that purely abstract or intellectual methods are not patentable. For example, a shortcut method of division would not be patentable but a calculating machine constructed to operate accordingly may well be patentable. A mathematical method for designing electrical filters is not patentable; nevertheless filters designed according to this method could be patentable provided they have a novel technical feature to which a product claim can be directed.
Sec.22.2 R.202(b)	**Schemes, rules and methods for performing mental acts, playing games or doing business** These are further examples of items of an abstract or intellectual character. In particular, a scheme for learning a language, a method of solving cross-word puzzles, a game (as an abstract entity defined by its rules) or a scheme for organising a commercial operation would not be patentable. However, novel apparatus for playing a game or carrying out a scheme might be patentable.

Sec.22.2 R.202(b)	**Programs for computers** The basic patentability considerations here are exactly the same as for the other exclusions listed in Sec.22. However a data-processing operation can be implemented either by means of a computer program or by means of special circuits, and the choice may have nothing to do with the inventive concept but be determined purely by factors of economy or practicality. With this point in mind, examination in this area should be guided by the following approach: A computer program claimed by itself or as a record on a carrier, is not patentable irrespective of its content. The situation is not normally changed when the computer program is loaded into a known computer. If however the subject-matter as claimed makes a technical contribution to the known art, patentability should not be denied merely on the ground that a computer program is involved in its implementation. This means, for example, that program-controlled machines and program-controlled manufacturing and control processes should normally be regarded as patentable subject-matter. It follows also that, where the claimed subject-matter is concerned only with the program-controlled internal working of a known computer, the subject-matter could be patentable if it provides a technical effect. As an example consider the case of a known data-processing system with a small fast working memory and a larger but slower further memory. Suppose that the two memories are organised under program control, in such a way that a process which needs more address space than the capacity of the fast working memory can be executed at substantially the same speed as if the process data were loaded entirely in that fast memory. The effect of the program in virtually extending the working memory is of a technical character and might therefore support patentability.
Sec.22.5 R.202(e)	**Aesthetic creations** An aesthetic creation relates to an article (e.g. a painting or sculpture) having aspects which are other than technical and the appreciation of which is essentially subjective. If, however, the article happens also to have technical features, it might be patentable, a tyre tread being an example of this. The aesthetic effect itself is not patentable, neither in a product nor in a process claim. For example a book characterised by the aesthetic or artistic effect of its information contents, of its layout or of its letterfont, would not be patentable, and neither would a painting characterised by the aesthetic effect of its subject or by the arrangement of colours, or by the artistic (e.g. Impressionist) style. Nevertheless, if an aesthetic effect is obtained by a technical structure or other technical means, although the aesthetic effect itself is not patentable, the means of obtaining it may be. For example, a fabric may be provided with an attractive appearance by means of a layered structure not previously used

for this purpose, in which case a fabric incorporating such structure might be patentable. Similarly, a book characterised by a technical feature of the binding or pasting of the back, may be patentable, even though the effect thereof is solely aesthetic, similarly also a painting characterised by the kind of cloth, or by the dyes or binders used. Also a process of producing an aesthetic creation may comprise a technical innovation and thus be patentable. For example, a diamond may have a particularly beautiful shape (not of itself patentable) produced by a new technical process. In this case, the process may be patentable. Similarly, a new printing technique for a book resulting in a particular layout with aesthetic effect, may well be patentable, together with the book as a product of that process. Again a substance or composition characterised by technical features serving to produce a special effect with regard to scent or flavour, e.g. to maintain a scent or flavour for a prolonged period or to accentuate it, may well be patentable.

Presentations of information

Although there is no corresponding, explicit provision in the IP-code and the IRR, mere representation of information characterised **solely** by the content of the information will not usually be patentable since it cannot be considered as a **technical** solution to a problem. This applies whether the claim is directed to the presentation of the information per se (e.g. by acoustical signals, spoken words, visual displays), to information recorded on a carrier (e.g. books characterised by their subject), gramophone records characterised by the musical piece recorded, traffic signs characterised by the warning thereon, magnetic computer tapes characterised by the data or programs recorded), or to processes and apparatus for presenting information (e.g. indicators or recorders characterised solely by the information indicated or recorded). If, however, the presentation of information has new technical features there could be patentable subject-matter in the information carrier or in the process or apparatus for presenting the information. The arrangement or manner of representation, as distinguished from the information content, may well constitute a patentable technical feature. Examples in which such a technical feature may be present are: a telegraph apparatus or communication system characterised by the use of a particular code to represent the characters (e.g. pulse code modulation); a measuring instrument designed to produce a particular form of graph for representing the measured information; a gramophone record characterised by a particular groove form to allow stereo recordings; or a diapositive with a soundtrack arranged at the side of it.

2.4 Under certain circumstances, protection for non-patentable items may be sought for by means of a utility model application or an industrial design application (aesthetic aspects of an article of manufacture) or by means of the law relating to copyright (computer software as such).
Reference is made to the corresponding provisions in the IP-code and the IRR.

	3. Further exclusions from patent protection – Sec.22.6 and 22.4
Sec.22.6	3.1 Any invention, the publication or exploitation of which would be contrary to "public order or morality" is specifically excluded from patentability. The purpose of this is to exclude from protection inventions likely to induce riot or public disorder, or to lead to criminal or other generally offensive behaviour (see also II, 7.1); one obvious example of subject-matter which should be excluded under this provision is a letter-bomb. This provision is likely to be invoked only in rare and extreme cases. A fair test to apply is to consider whether it is probable that the public in general would regard the invention as so abhorrent that the grant of patent rights would be inconceivable. If it is clear that this is the case, objection should be raised under Sec.22.6; otherwise not.
	3.2 Exploitation is not to be deemed to be contrary to "public order" or morality merely because it is prohibited by law or regulation in the Philippines. For example, a product could still be manufactured under a Philippine patent for export to states in which its use is not prohibited.
R.412	3.3 In some cases refusal of a patent may not be necessary. This may result when the invention has both an offensive and a non-offensive use: e.g. a process for breaking open locked safes, the use by a burglar being offensive but the use by a locksmith in the case of emergency inoffensive. In such a case no objection arises under Sec.22.6, but if the application contains an explicit reference to a use which is contrary to "public order or morality", deletion of this reference should be required under the terms of R.412.
Sec.22.4	3.4 Also excluded from patentability are "plant or animal breeds varieties or essentially biological processes for the production of plants or animals". One reason for this exclusion is that, at least for plant varieties, other means of obtaining legal protection are available in most countries. The question whether a process is "essentially biological" or "non-biological" (Sec.22.4, 2nd sentence) is one of degree depending on the extent to which there is technical intervention by man in the process; if such intervention plays a significant part in determining or controlling the result it is desired to achieve, the process would not be excluded. To take some examples, a method of crossing, inter-breeding, or selectively breeding, say, horses involving merely selecting for breeding and bringing together those animals having certain characteristics would be essentially biological and therefore not patentable. On the other hand, a process of treating a plant or animal to improve its properties or yield or to promote or suppress its growth e.g. a method of pruning a tree, would not be essentially biological since although a biological process is involved, the essence of the invention is technical; the same could apply to a method of treating a plant characterised by the application of a growth-stimulating substance or radiation. The treatment of soil by technical means to suppress or promote the growth of plants is also not excluded from

	patentability (see also IV, 4.3).
Sec.22.4, 2nd sentence	3.5 As expressly stated in Sec.22.4, 2nd sentence, the exclusion from patentability referred to in the preceding paragraph does not apply to microorganisms and non-biological and microbiological processes. The term "microbiological process" is to be interpreted as covering not only industrial processes using micro-organisms but also processes for producing new micro-organisms, e.g. by genetic engineering. The product of a microbiological process may also be patentable per se (product claim). A micro-organism can also be protected per se (Sec.22.4, 2nd sentence). The term micro-organism in general includes not only bacteria and yeasts, but also fungi, algae, protozoa and human, and possibly animal and plant cells, i.e. all generally unicellular organisms with dimensions beneath the limits of vision which can be propagated and manipulated in a laboratory, including plasmids and viruses. 3.6 In the case of microbiological processes, particular regard should be had to the requirement of repeatability referred to in II, 4.11. As for biological material to be deposited under the terms of R.408 and R.409, repeatability is assured by the possibility of taking samples, and there is thus no need to indicate another process for the production of the biological material.
	4. Industrial application Sec.27 - Medical inventions Sec.22.3
Sec.27 R.208	4.1 An invention shall be considered “industrially applicable” if it can be produced and used in any kind of industry. Agriculture is in general considered as an industry as well. "Industry" should be understood in its broad sense as including any physical activity of "technical character" (see IV, 1.2 here above), i.e. an activity which belongs to the useful or practical arts as distinct from the aesthetic arts; it does not necessarily imply the use of a machine or the manufacture of an article and could cover e.g. a process for dispersing fog, or a process for converting energy from one form to another. Thus, Sec.27 excludes from patentability very few "inventions" which are not already excluded by the list in Sec.22 (see IV, 2.1 here above). One further class of "invention" which would be excluded, however, would be articles or processes alleged to operate in a manner clearly contrary to well-established physical laws, e.g. a perpetual motion machine. Objection could arise under Sec.27 only in so far as the claim specifies the intended function or purpose of the invention, but if, say, a perpetual motion machine is claimed merely as an article having a particular specified construction then objection should be made under Sec.35.1 (see II, 4.11).
Sec.22.3	4.2 "Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body” are excluded from patent protection. Moreover, they will not in general be regarded as inventions which are industrially applicable. “Products and composition for use in any of these methods” are not excluded from patent

	protection. Patents may, however, also be obtained for surgical, therapeutic or diagnostic instruments or apparatus for use in such methods. Also the manufacture of prostheses or artificial limbs, as well as taking measurements therefor on the human body, would be patentable, so that a method of manufacturing a prosthetic tooth which involves making a model of a patient's teeth in the mouth would not be excluded from patentability either, provided the prosthetic tooth is fabricated outside of the body. Patents may also be obtained for new products for use in these methods of treatment or diagnosis, particularly substances or compositions. However in the case of a known substance or composition, this may only be patented for use in these methods if the known substance or composition was not previously disclosed for use in surgery, therapy or diagnostic methods practised on the human or animal body ("first medical use"). The same substance or composition cannot subsequently be patented for any other use of that kind. A claim to a known substance or composition for the first use in surgical, therapeutic and/or diagnostic methods should be in a form such as: "substance or composition X" followed by the indication of the use, for instance"... for use as a medicament", "... as an antibacterial agent " or "... for curing disease Y". In contrast to what is stated in III, 4.8 these types of claims will be regarded as restricted to the substance or composition when presented or packaged for the specified use. This constitutes an exception from the general principle that product claims can only be obtained for (absolutely) novel products. However this does not mean that product claims for the first medical use need not fulfil all other requirements of patentability, especially that of inventive step. A claim in the form "Use of substance or composition X for the treatment of disease Y..." will be regarded as relating to a method for treatment explicitly excluded from patentability by Sec.22.3 and therefore will not be accepted. If an application discloses for the first time a number of distinct surgical, therapeutic or diagnostic uses for a known substance or composition, normally in the one application independent claims each directed to the substance or composition for one of the various uses may be allowed; i.e. objection should not, as a general rule, be raised that there is lack of unity of invention. A claim in the form "Use of a substance or composition X for the manufacture of a medicament for therapeutic application Z" is allowable for either a first or "subsequent" (second or further) such application, if this application is new and inventive. The same applies to claims in the form "Method for manufacturing a medicament intended for therapeutic application Z, characterised in that the substance X is used" or the substantive equivalents thereof. In cases where an applicant simultaneously discloses more than one "subsequent" therapeutic use, claims of the above type directed to these different uses are allowable in the one application, but only if they form a single general inventive concept

	(Sec.38). 4.3 It should be noted that Sec.22.3 excludes only methods of treatment by surgery or therapy and diagnostic methods. It follows that other methods of treatment of live human beings or animals (e.g. treatment of a sheep in order to promote growth, to improve the quality of mutton or to increase the yield of wool) or other methods of measuring or recording characteristics of the human or animal body are patentable provided that (as would probably be the case) such methods are of a technical, and not essentially biological character (see IV, 3.4 here above) and provided that the methods are industrially applicable. The latter proviso is particularly important in the case of human beings. For example an application with a claim for a method of contraception, which is to be applied in the private and personal sphere of a human being, may not be considered "industrial applicable". However, an application containing claims directed to the purely cosmetic treatment of a human by administration of a chemical product could be considered as "industrially applicable". A cosmetic treatment involving surgery or therapy would not however be patentable (see below). A treatment or diagnostic method, to be excluded, would generally have to be carried out on the living human or animal body. A treatment of or diagnostic method practised on a dead human or animal body would therefore not be excluded from patentability by virtue of Sec.. Treatment of body tissues or fluids after they have been removed from the human or animal body, or diagnostic methods applied thereon, are not excluded from patentability in so far as these tissues or fluids are not returned to the same body. Thus the treatment of blood for storage in a blood bank or diagnostic testing of blood samples is not excluded, whereas a treatment of blood by dialysis with the blood being returned to the same body would be excluded. Regarding methods which are carried out on, or in relation to, the living human or animal body, it should be borne in mind that the intention of Sec.22.3 is to free from restraint non-commercial and non-industrial medical and veterinary activities. Interpretation of the provision should avoid the exclusions from going beyond their proper limits. However, in contrast to the subject-matter referred to e.g. Sec.22.1 and Sec.22.2, which are in general only excluded from patentability if claimed as such, a claim is not allowable under Sec.22.3 if it includes at least one feature defining a physical activity or action that constitutes a method step for treatment of the human or animal body by surgery or therapy or a diagnostic method step to be exercised on the human or animal body. In that case, whether or not the claim includes or consists of features directed to a technical operation performed on a technical object is legally irrelevant.

	Taking the three exclusions in turn: **Surgery** defines the nature of the treatment rather than its purpose. Thus, e.g. a method of treatment by surgery for cosmetic purposes is excluded, as well as surgical treatment for therapeutic purposes. **Therapy** implies the curing of a disease or malfunction of the body and covers prophylactic treatment, e.g. immunisation against a certain disease or the removal of plaque. **Diagnostic methods** likewise do not cover all methods related to diagnosis. Methods for obtaining information only (data, physical quantities) from the living human or animal body may not necessarily excluded by Sec.22.3, if the information obtained merely provides intermediate results which on their own do not enable a decision to be made on the treatment necessary. Examples of such methods include X-ray investigations, NMR studies, and blood pressure measurements. 4.4 **Methods of testing** generally should be regarded as inventions susceptible of industrial application and therefore patentable if the test is applicable to the improvement or control of a product, apparatus or process which is itself susceptible of industrial application. In particular, the utilisation of test animals for test purposes in industry, e.g. for testing industrial products (for example for ascertaining the absence of pyrogenetic or allergic effects) or phenomena (for example for determining water or air pollution) would be patentable. 4.5 It should be noted that "susceptibility of industrial application" is not a requirement that overrides the restriction of Sec.22, e.g. an administrative method of stock control is not patentable, having regard to Sec.22.2 , even though it could be applied to the store of spare parts of a factory. On the other hand, although an invention must be industrially applicable and the description must indicate, where this is not obvious, the way in which the invention is so industrially applicable (see II, 4.12), the claims need not necessarily be restricted to the indicated industrial application(s). **5. Novelty; prior art**
Sec.21 Sec.23 Sec.24.1	5.1 Sec.21 requires an invention to be new in order to be patentable. Sec.23 gives a negative definition of novelty, i.e. that “an invention shall not be considered new if it forms part of a prior art”. The "prior art" is defined in Sec.24.1 as consisting of "everything which has been made available to the public anywhere in the world, before the filing date or the priority date of the Philippine application claiming the invention”.
R.204(a), 1st	The width of this definition should be noted. R.204(a), 1st sentence indicates that there are no restrictions whatever as to the geographical

sentence R.204(a), 2nd sentence	location where, or the language or manner (e.g. by means of a written or oral description, by use, or in any other way) in which the relevant information was made available to the public; also no age limit is stipulated for the documents or other sources of the information. There are however certain specific exclusions (see IV, 8 here below). A prior use in a foreign country must however by disclosed in printed documents or in a tangible form. However, since the "prior art" available to the examiner will mainly consist of the documents listed in the search report, the following section IV, 5.2 deals with the question of public availability only in relation to written description (either alone or in combination with an earlier oral description or use). Other kinds of prior art are discussed in section IV, 5.4 here below. 5.2 A written description, i.e. a document, should be regarded as made available to the public if, at the relevant date, it was possible for members of the public to gain knowledge of the content of the document and there was no bar of confidentiality restricting the use or dissemination of such knowledge. For instance, German utility models ("Gebrauchsmuster") are already publicly available as of their date of entry in the Register of utility models ("Eintragungstag"), which precedes the date of announcement in the Patent Bulletin ("Bekanntmachung im Patentblatt"). The search report also may cite documents in which doubts with regard to the fact of public availability and doubts concerning the precise date of publication of a document have not, or not fully, been removed. If the applicant contests the public availability or assumed date of publication of the document the examiner should consider whether to investigate the matter further. If the applicant shows sound reasons for doubting whether the document forms part of the "prior art" in relation to his application and any further investigation does not produce evidence sufficient to remove that doubt the examiner should not pursue the matter further. The only other problem likely to arise for the examiner is where: (i) a document reproduces an oral description (e.g. a public lecture) or gives an account of a prior use (e.g. display at a public exhibition); and (ii) only the oral description or lecture was publicly available before the "date of filing" of the European application, the document itself being published on or after this date. In such cases, the examiner should start with the assumption that the document gives a true account of the earlier lecture, display or other event and should therefore regard the earlier event as forming part of the "prior art". If, however, the applicant gives sound reasons for contesting the truth of the account given in the document then again the examiner should not pursue the matter further. 5.3 It should be noted that the relevant date for establishing whether a piece of prior art belongs to the state of the art is the date of filing, or where a priority date has been validly claimed, the priority date (Sec.24). If

	a priority date has not been validly claimed (subject-matter claimed not disclosed in priority document), the filing date will become the relevant date for this purpose. For details, see V. It should be remembered that different claims, or different alternatives claimed in one claim, may have different relevant dates, depending on the validity of the priority for the subject-matter concerned . The question of novelty must be considered against each claim (or part of a claim where a claim specifies a number of alternatives) and the prior art in relation to one claim or one part of a claim may include matter which cannot be cited against another claim or part of a claim because the latter has an earlier relevant date. Of course if all the matter in the prior art was made available to the public before the date of the earliest priority document, the examiner need not (and should not) concern himself with the allocation of priority dates. 5.4 In determining whether other kinds of prior art (which could be introduced into the proceedings e.g. by a third party under Sec.47) have been made available to the public, the following issues will need to be considered, depending on the circumstances and the type of prior art:
R.204(a), 2nd sentence	Prior use which is not present in the Philippines, even if widespread in a foreign country, cannot form part of the prior art if such prior use is not disclosed in printed documents or in any tangible form. 5.4a Prior art made available to the public by use or in any other way Types of use and instances of prior art made available in any other way: Use may be constituted by producing, offering, marketing or otherwise exploiting a product, or by offering or marketing a process or its application or by applying the process. Marketing may be effected, for example, by sale or exchange. The prior art may also be made available to the public in other ways, as for example by demonstrating an object or process in specialist training courses or on television. Availability to the public in any other way also includes all possibilities which technological progress may subsequently offer of making available the aspect of the prior art concerned. Matters to be determined as regards use: When dealing with an allegation that an object or process has been used in such a way that it is comprised in the prior art, the following details will need to be checked: Is the alleged use relevant at all? The date on which the alleged use occurred, i.e. whether there was any

	instance of use before the relevant date (prior use). What has been used, in order to determine the degree of similarity between the object used and the subject-matter claimed. All the circumstances relating to the use, in order to determine whether and to what extent it was made available to the public, as for example the place of use and the form of use. These factors are important in that, for example, the details of a demonstration of a manufacturing process in a factory or of the delivery and sale of a product may well provide information as regards the possibility of the subject-matter having become available to the public. 5.4b Ways in which subject-matter may be made available General principles Subject-matter should be regarded as made available to the public by use or in any other way if, at the relevant date, it was possible for members of the public to gain knowledge of the subject-matter and there was no bar of confidentiality restricting the use or dissemination of such knowledge (see also IV, 5.2 with reference to written descriptions). This may, for example, arise if an object is unconditionally sold to a member of the public, since the buyer thereby acquires unlimited possession of any knowledge which may be obtained from the object. Even where in such cases the specific features of the object may not be ascertained from an external examination, but only by further analysis, those features may nevertheless to be considered as having been made available to the public. If, on the other hand, an object could be seen in a given place (a factory, for example) to which members of the public not bound to secrecy, including persons with sufficient technical knowledge to ascertain the specific features of the object, had access, all knowledge which an expert was able to gain from a purely external examination is to be regarded as having been made available to the public. In such cases, however, all concealed features which could be ascertained only by dismantling or destroying the object will not be deemed to have been made available to the public. Agreement on secrecy The basic principle to be adopted is that subject-matter has not been made available to the public by use or in any other way if there is an express or tacit agreement on secrecy which has not been broken (concerning the particular case of a non-prejudicial disclosure arising from an evident abuse in relation to the applicant, see IV, 8 below), or if the circumstances of the case are such that such secrecy derives from a relationship of good faith or trust. Good faith or trust are factors which may occur in contractual or commercial relationships.

Use on non-public property

As a general rule, use on non-public property, for example in factories and barracks, is not considered as use made available to the public, because company employees and soldiers are usually bound to secrecy, save in cases where the objects or processes used are exhibited, explained or shown to the public in such places, or where specialists not bound to secrecy are able to recognise their essential features from the outside. Clearly the above-mentioned "non-public property" does not refer to the premises of a third party to whom the object in question was unconditionally sold or the place where the public could see the object in question or ascertain features of it.

Example of the accessibility of objects used

A press for producing light building (hard fibre) boards was installed in a factory shed. Although the door bore the notice "Unauthorised persons not admitted", customers (in particular dealers in building materials and clients who were interested in purchasing light building boards), were given the opportunity of seeing the press although no form of demonstration or explanation was given. An obligation to secrecy was not imposed as, according to witnesses, the company did not consider such visitors as a possible source of competition. These visitors were not genuine specialists, i.e. they did not manufacture such boards or presses, but were not entirely laymen either. In view of the simple construction of the press, the essential features of the invention concerned were bound to be evident to anyone observing it. There was therefore a possibility that these customers, and in particular the dealers in building materials, would recognise these essential features of the press and, as they were not bound to secrecy, they would be free to communicate this information to others.

Example of the inaccessibility of a process

The subject of the patent concerns a process for the manufacture of a product. As proof that this process had been made available to the public by use, a similar already known product was asserted to have been produced by the process claimed. However, it could not be clearly ascertained, even after an exhaustive examination, by which process it had been produced.

5.4c Prior art made available by means of oral description

Cases of oral description

The prior art is made available to the public by oral description when facts are unconditionally brought to the knowledge of members of the public in the course of a conversation, a lecture, a conference, or by means of radio, television or sound reproduction equipment (tapes and records).

	Non-prejudicial oral description The prior art will not be affected by oral descriptions under the circumstances referred to in Sec.25 and in IV, 8 here below. Matters to be determined in cases of oral description Once again, in such cases the following details will have to be determined: When the oral description took place, what was described orally, whether the oral description was made available to the public ; this will also depend on the type of oral description (conversation, lecture) and on the place at which the description was given (public meeting, factory hall. 5.4d Prior art made available to the public in writing or by any other means For this prior art, the details such as those referred to above might have to be determined, if they are not clear from the written or otherwise made available disclosure itself .
	6. Conflict with other Philippines applications
Sec.24.2	6.1 The prior art in addition comprises the whole content of other applications for a patent, utility model or industrial design published under Republic Act NO. 8293 (Sec.44 for patents), filed or effective in the Philippines, with a filing date or a validly claimed priority date that is earlier than the filing or priority date of the application under examination, even if the earlier patent, utility model or industrial design publication is published on or after the date of filing or the priority date of the application being examined. This does not apply when the applicant or the inventor identified in both applications is one and the same. Concerning this case, see however IV, 6.4 here below.
R.204(b), 2nd sentence	Hence, where two or more applications are independently filed with respect to the same invention, and the later applications are filed before the first application or earlier application is published, the whole contents of the first or earliest filed application published in accordance with Sec. 44 on or after the filing date or priority date of the later filed application shall be novelty destroying with respect to the later filed application. Whether a piece of prior art has to be taken into consideration or not may depend on whether the priority dates of the application under examination and of the earlier application have been validly claimed (see Chapter V).
R.206(b)	According to R.206(b) such earlier applications are part of the prior art only when considering novelty and not when considering inventive step. By the whole content of a Philippines application is meant the whole

	disclosure, i.e. the description, drawings and claims, including: (i) any matter explicitly disclaimed (with the exception of disclaimers for unworkable embodiments), (ii) any matter for which an allowable reference (see II, 4.18, penultimate paragraph) to other documents is made or (iii) prior art insofar as explicitly described. However, the "content" does not include any priority document (the purpose of such document being merely to determine to what extent the priority date is valid for the disclosure of the Philippines application (see V, 1.2)) nor, in view of Sec.37, last sentence, the abstract. 6.1a Whether a published Philippine application can be a conflicting application under Sec.24.2 is determined firstly by its filing date and the date of its publication, which have to be before, respectively on or after the filing date of the application under examination. If such an application validly claims priority (see first proviso in Sec.24.2) , the priority date replaces the filing date for that subject-matter in the application which corresponds to the priority application. If a priority claim was abandoned or otherwise lost with effect from a date prior to the publication, the filing date and not the priority date of such an application is relevant, irrespective of whether or not the priority claim might have conferred a valid priority right. Further it is required that the conflicting application was still pending at its publication date. If the application has been withdrawn or otherwise lost before the date of publication, but published because the Office could not stop its publication, the publication has no effect under Sec.24.2 pursuant to Sec.25(b)(a). 6.2 Earlier application(s) not yet published In cases where the application under examination is ready for grant before the search for conflicting applications could be finalised (e.g. because some of the potentially interferring applications have not yet been published), see C-VI, 8.4.
Sec.24.2 R.204(b) 2nd proviso	6.3 The second proviso in Sec.24.2 specifies that an application otherwise meeting the definitions given in Sec.24.2 does not belong to the prior art to be taken into consideration if in this application and in the application under examination one and the same. Further, the IP-code does not deal explicitly with the case of co-pending Philippines applications of the same effective date.
R.915	However, it is an accepted principle in most patent systems that two patents shall not be granted to the same applicant for one invention. This principle is e.g. reflected in R.915. It is permissible to allow an applicant to

	proceed with two applications having the same description where the claims are quite distinct in scope and directed to different inventions. However, in the rare case in which there are two or more Philippines applications of the type referred to here above, from the same applicant, and the claims of those applications relate to the same invention (the claims conflicting in the manner explained in VI, 9.6), the applicant should be told that he must either amend one or more of the applications in such a manner that they no longer claim the same invention, or choose which one of those applications he wishes to proceed to grant.
R.304, 2nd paragraph	6.4 Concerning applications of the same effective date and received from two different applicants, see R.304, 2nd paragraph
	7. Test for Novelty
	7.1 It should be noted that in considering novelty (as distinct from inventive step), it is not permissible to combine separate items of prior art together (see IV, 9.7). However, if a document (the "primary" document) refers explicitly to another document as providing more detailed information on certain features, the teaching of the latter may be regarded as incorporated into the document containing the reference, if the document referred to was available to the public on the publication date of the document containing the reference. For conflicting applications, see III, 6.1 here above and II, 4.18. The same principle applies to any matter explicitly disclaimed (except disclaimers which exclude unworkable embodiments) and to prior art insofar as explicitly described. It is further permissible to use a dictionary or similar document of reference in order to interpret a special term used in the primary document. The effective date for novelty purposes (see IV, 7.3 here below) is always the date of the primary document. 7.2 A document takes away the novelty of any claimed subject-matter derivable directly and unambiguously from that document including any features implicit to a person skilled in the art in what is expressly mentioned in the document, e.g. a disclosure of the use of rubber in circumstances where clearly its elastic properties are used even if this is not explicitly stated takes away the novelty of the use of an elastic material. The limitation to subject-matter "derivable directly and unambiguously" from the document is important. Thus, when considering novelty, it is not correct to interpret the teaching of a document as embracing well-known equivalents which are not disclosed in the documents; this is a matter of obviousness. 7.3 In determining novelty a prior document should be read as it would have been read by a person skilled in the art on the effective date of the document. By "effective" date is meant the publication date in the case of

	a previously published document and the date of filing (or priority date, where appropriate) in the case of a document according to Sec.24.2. However, it should be noted that a chemical compound, the name or formula of which was mentioned in a document, is not considered as known unless the information in the document, together, where appropriate, with knowledge generally available on the effective date of the document, enable it to be prepared and separated or, for instance in the case of a product of nature, only to be separated. 7.4 In considering novelty it should be borne in mind that a generic disclosure does not usually take away the novelty of any specific example falling within the terms of that disclosure, but that a specific disclosure does take away the novelty of a generic claim embracing that disclosure, e.g. a disclosure of copper takes away the novelty of metal as a generic concept, but not the novelty of any metal other than copper, and one of rivets takes away the novelty of fastening means as a generic concept, but not the novelty of any fastening other than rivets. 7.5 In the case of a prior document, the lack of novelty may be apparent from what is explicitly stated in the document itself. Alternatively, it may be implicit in the sense that, in carrying out the teaching of the prior document, the skilled person would inevitably arrive at a result falling within the terms of the claim. An objection of lack of novelty of this kind should be raised by the examiner only where there can be no reasonable doubt as to the practical effect of the prior teaching (for a second non-medical use, however, see IV, 7.6 here below). Situations of this kind may also occur when the claims define the invention, or a feature thereof, by parameters (see III, 4.7a). It may happen that in the relevant prior art a different parameter, or no parameter at all, is mentioned. If the known and the claimed products are identical in all other respects (which is to be expected if, for example, the starting products and the manufacturing processes are identical), then in the first place an objection of lack of novelty arises. If the applicant is able to show, e.g. by appropriate comparison tests, that differences do exist with respect to the parameters, it is questionable whether the application discloses all the features essential to manufacture products having the parameters specified in the claims (Sec.35.1). 7.6 In determining novelty of the subject-matter of claims the examiner should have regard to the guidance given in III, 4.4 to 4.13. He should remember that, particularly for claims directed to a physical entity, non-distinctive characteristics of a particular intended use, should be disregarded (see III, 4.8 to 4.9). For example, a claim to a substance X for use as a catalyst would not be considered to be novel over the same substance known as a dye, unless the use referred to implies a particular form of the substance (e.g. the presence of certain additives) which distinguishes it from the known form of the substance. That is to say, characteristics not explicitly stated, but implied by the particular use,

	should be taken into account (see the example of a "mold for molten steel" in III, 4.8). It should further be borne in mind that a claim to the use of a known compound for a particular purpose (second non-medical use), which is based on a technical effect, should be interpreted as including that technical effect as a functional technical feature, and is accordingly not open to objection under Sec.23 and 24.1, provided that such technical feature has not previously been made available to the public. For claims to a second or further medical use, see IV, 4.2, here above.
	8. Non-prejudicial disclosures
Sec.25.1	8.1 There are three specified instances in which a prior disclosure of the information contained in the application during the twelve months preceding the filing date or the priority date of the application shall not prejudice the applicant on the ground of lack of novelty, viz. if such disclosure was made by
Sec.25.1(a)	(a) The inventor;
Sec.25.1(b)	(b) A foreign patent office, the Bureau or the Office, and the information was contained (a) in another application filed by the inventor and should not have been disclosed by the office, or (b) in an application filed without the knowledge or consent of the inventor by a third party which obtained the information directly or indirectly from the inventor; or
Sec.25.1(c)	(c) A third party which obtained the information directly or indirectly from the inventor.
Sec.25.2 Sec.28	For the purposes of Sec.25.1, “inventor” also means any person who, at the filing date of application, had the right to the patent according to Sec.28. (i) an evident abuse in relation to the applicant or his legal predecessor - e.g. the invention was derived from the applicant and disclosed against his wish; or 8.2 An essential condition in all instances is that the disclosure in point must have taken place not earlier than twelve months preceding the filing date or the priority date of the application. 8.3 Regarding the cases addressed in Sec.25.1(a) and (c) , the disclosure might be made in a published document or at a conference or in any other way.

Sec.67	8.4 Regarding the cases addressed in Sec.25.1(b), they might occur - whenever a patent office publishes an application by mistake (e.g. after the application has been explicitly been withdrawn, or publication before the date foreseen by the law), or - for example, when a person B who has been told of A's invention in confidence, applies for a patent for this invention. If so, the disclosure resulting from the publication of B's application will not prejudice A's rights provided that A has already made an application, or applies within six months of such publication. In any event, having regard to Sec.67, B may not be entitled to proceed with his application (see VI, 9.7 to 9.11).
	9. Inventive step
Sec.26	9.1 "An invention involves an inventive step if, having regard to the prior art, it is not obvious to a person skilled in the art at the time of the filing date or priority date of the application claiming the invention". Novelty and inventive step are different criteria. Novelty exists if there is any difference between the claimed invention and the known art. The question - Is there inventive step? - only arises if there is novelty.
Sec.24 R.204(a)(b) R.206(b)	9.2 The "prior art" for the purposes of considering inventive step is as defined in Sec.24.1 (see IV, 5 here above)**;** it does not include later published Philippine patent, utility model or industrial design applications as referred to in Sec.24.2.
R.204(a), 2. Sentence	9.3 Thus the question to consider, in relation to any claim defining the invention, is whether at the priority date of that claim, having regard to the art known at the time, it would have been obvious to the person skilled in the art to arrive at something falling within the terms of the claim. If so, the claim is bad for lack of inventive step. The term "obvious" means that which does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art, i.e. something which does not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art. In considering inventive step, as distinct from novelty (see IV, 7.3 here above), it is fair to construe any published document in the light of subsequent knowledge and to have regard to all the knowledge generally available to the person skilled in the art at the filing or priority date of the claim. 9.3a The invention claimed must normally be considered as a whole. Thus it is not correct as a general rule, in the case of a combination claim, to argue that the separate features of the combination taken by themselves are known or obvious and that "therefore" the whole subject-matter claimed is obvious. The only exception to this rule is where there is no functional relationship between the features of the combination i.e.

where the claim is merely for a juxtaposition of features and not a true combination (see the example at 2.1 of the Annex 1 to this Chapter).

9.4 While the claim should in each case be directed to technical features (and not, for example, merely to an idea), in order to assess whether an inventive step is present it is important for the examiner to bear in mind that there are various ways in which the skilled person may arrive at an invention. An invention may, for example, be based on the following:

(i) The formulation of an idea or of a problem to be solved (the solution being obvious once the problem is clearly stated).

Example: the problem of indicating to the driver of a motor vehicle at night the line of the road ahead by using the light from the vehicle itself. As soon as the problem is stated in this form the technical solution, viz. the provision of reflective markings along the road surface, appears simple and obvious.

(ii) The devising of a solution to a known problem.

Example: the problem of permanently marking farm animals such as cows without causing pain to the animals or damage to the hide has existed since farming began. The solution ("freeze-branding") consists in applying the discovery that the hide can be permanently de-pigmented by freezing.

(iii) The arrival at an insight into the cause of an observed phenomenon (the practical use of this phenomenon then being obvious).

Example: the agreeable flavour of butter is found to be caused by minute quantities of a particular compound. As soon as this insight has been arrived at, the technical application comprising adding this compound to margarine is immediately obvious.

Many inventions are of course based on a combination of the above possibilities - e.g. the arrival at an insight and the technical application of that insight may both involve the use of the inventive faculty.

9.5 In identifying the contribution any particular invention makes to the art in order to determine whether there is an inventive step, account should be taken first of what the applicant himself acknowledges in his description and claims to be known. Any such acknowledgement of known art should be regarded by the examiner as being correct unless the applicant states he has made a mistake. However, the further prior art contained in the search report may put the invention in an entirely different perspective from that apparent from reading the applicant's specification by itself (and indeed this cited prior art may cause the applicant voluntarily

	to amend his claims to redefine his invention before his application comes up for examination). In order to reach a final conclusion as to whether the subject-matter of any claim includes an inventive step it is necessary to determine the difference between the subject-matter of that claim and the prior art and, in considering this matter, the examiner should not proceed solely from the point of view suggested by the form of claim (prior art plus characterising portion - see III, 2).
Sec.21, 1st sentence	Considering the definition of an invention as given in Sec.21, when assessing inventive step the examiner will normally apply the following "**problem and solution approach**": In the problem and solution approach there are three main stages: 1. determining the closest prior art, 2. establishing the technical problem to be solved, and 3. considering whether or not the claimed invention, starting from the closest prior art and the technical problem, would have been obvious to the skilled person. In the **first stage**, the closest prior art must be determined. The closest prior art is that combination of features derivable from one single reference that provides the best basis for considering the question of obviousness. The closest prior art may be, for example: (i) a known combination in the technical field concerned that discloses technical effects, purpose or intended use, most similar to the claimed invention or (ii) that combination which has the greatest number of technical features in common with the invention and capable of performing the function of the invention. In the **second stage**, one establishes in an objective way the technical problem to be solved. To do this, one studies the application (or the patent), the closest prior art and the difference in terms of technical features (either structural or functional) between the claimed invention and the closest prior art and then formulates the technical problem. In this context the technical problem means the aim and task of modifying or adapting the closest prior art to provide the technical effects that the invention provides over the closest prior art. The technical problem derived in this way may not be what the application presents as "the problem". The latter may require to be reformulated, since the objective technical problem is based on objectively established

	facts, in particular appearing in the prior art revealed in the course of the proceedings, which may be different from the prior art of which the applicant was actually aware at the time the application was filed. The extent to which such reformulation of the technical problem is possible has to be assessed on the merits of each particular case. For instance, any effect provided by the invention may be used as a basis for the reformulation of the technical problem, as long as said effect is derivable from the application as filed. It may also be possible to rely on new effects submitted subsequently during the proceedings by the applicant, provided that the skilled person would recognise these effects as implied by or related to the technical problem initially suggested. The expression “technical problem” should be interpreted broadly; it does not necessarily imply that the solution is a technical improvement over the prior art. Thus the problem could be simply to seek an alternative to a known device or process providing the same or similar effects or which is more cost-effective. Sometimes the technical features of a claim provide more than one technical effect, so one can speak of the technical problem as having more than one part or aspect, each corresponding to one of the technical effects. In such cases, each part or aspect generally has to be considered in turn. In the **third stage**, the question to be answered is whether there is any teaching in the prior art as a whole that would (not simply could, but would) prompt the skilled person, faced with the technical problem, to modify or adapt the closest prior art while taking account of that teaching, thus arriving at something falling within the terms of the claims, and thus achieving what the invention achieves (see IV, 9.3 here above). 9.5a If an independent claim is new and non-obvious, there is no need to investigate the obviousness or non-obviousness of any claims dependent thereon, except in situations where the priority claim for the subject-matter of the dependent claim has to be checked because of intermediate documents (see e.g. V, 2.6.3). Similarly, if a claim to a product is new and non-obvious there is no need to investigate the obviousness of any claims for a process which inevitably results in the manufacture of that product or any claims for a use of that product. In particular, analogy processes are patentable insofar as they provide a novel and inventive product.
R.207	9.6 The “person skilled in the art” should be presumed to be an ordinary practitioner aware of what was common general knowledge in the art at the relevant date. He should also be presumed to have had access to everything belonging to the "prior art", in particular the documents cited in the search report, and to have had at his disposal the normal means and capacity for routine work and experimentation.

If the problem prompts the person skilled in the art to seek its solution in another technical field, the specialist in that field is the person qualified to solve the problem. The assessment of whether the solution involves an inventive step should therefore be based on that specialist's knowledge and ability. There may be instances where it is more appropriate to think in terms of a group of persons, e.g. a research or production team, than a single person. This may apply e.g. in certain advanced technologies such as computers or telephone systems and in highly specialised processes such as the commercial production of integrated circuits or of complex chemical substances.

9.7 In considering whether there is inventive step (as distinct from novelty (see IV, 7 here above), it is permissible to combine together the disclosures of two or more documents or parts of documents, different parts of the same document or other pieces of prior art, but only where such combination would have been obvious to the person skilled in the art at the filing or priority date of the claim under examination. In determining whether it would be obvious to combine two or more distinct disclosures, the examiner should have regard to the following:

(i) Whether the content of the documents is such as to make it likely or unlikely that the person skilled in the art, when concerned with the problem solved by the invention, would combine them – for example, if two disclosures considered as a whole could not in practice be readily combined because of inherent incompatibility in disclosed features essential to the invention, the combining of these disclosures should not normally be regarded as obvious.

(ii) Whether the documents come from similar, neighbouring or remote technical fields.

(iii) The combining of two or more parts of the same document would be obvious if there is a reasonable basis for the skilled person to associate these parts with one another. It would normally be obvious to combine with a prior art document a well-known textbook or standard dictionary; this is only a special case of the general proposition that it is obvious to combine the teaching of one or more documents with the common general knowledge in the art. It would, generally speaking, also be obvious to combine two documents one of which contains a clear and unmistakable reference to the other (for references which are considered an integral part of the disclosure, see 6.1 and 7.1 here above. In determining whether it is permissible to combine a document with an item of prior art made public in some other way, e.g. by use, similar considerations apply.

	9.8 Annex 1 to this chapter ("Guidance for the assessment of inventive step"), as well as Chapter VII (parts VII, 1 and VII, 5.4) give examples of circumstances where an invention should be regarded as obvious or where it involves an inventive step. It is to be stressed that these examples are only guides and that the applicable principle in each case is "was it obvious to a person skilled in the art?" Examiners should avoid attempts to fit a particular case into one of these examples where the latter is not clearly applicable. Also, the list is not exhaustive. 9.9 It should be remembered that an invention which at first sight appears obvious might in fact involve an inventive step. Once a new idea has been formulated it can often be shown theoretically how it might be arrived at, starting from something known, by a series of apparently easy steps. The examiner should be wary of “ex post facto” analysis of this kind. He should always bear in mind that the documents produced in the search have, of necessity, been obtained with foreknowledge of what matter constitutes the alleged invention. In all cases he should attempt to visualise the overall prior art confronting the skilled man before the applicant's contribution and he should seek to make a "real life" assessment of this and other relevant factors. He should take into account all that is known concerning the background of the invention and give fair weight to relevant arguments or evidence submitted by the applicant. If, for example, an invention is shown to be of considerable technical value, and particularly if it provides a technical advantage which is new and surprising, and this can convincingly be related to one or more of the features included in the claim defining the invention, the examiner should be hesitant in pursuing an objection that such a claim lacks inventive step. The same applies where the invention solves a technical problem which workers in the art have been attempting to solve for a long time, or otherwise fulfils a long-felt need. Commercial success alone is not to be regarded as indicative of inventive step, but evidence of immediate commercial success when coupled with evidence of a long-felt want is of relevance provided the examiner is satisfied that the success derives from the technical features of the invention and not from other influences (e.g. selling techniques or advertising). 9.10 The relevant arguments and evidence to be considered by the examiner for assessing inventive step may be taken either from the originally filed patent application, or be submitted by the applicant during the subsequent substantive examination proceedings (see IV-9.5 here above and VI, 5.7, 5.7a, 5.7c and 5.7d**.** Care must be taken, however, whenever new effects in support of inventive step are referred to. Such new effects may only be taken into account if they are implied by or at least related to the technical problem initially suggested in the originally filed application. Otherwise they have to be considered as corresponding to another invention that was not originally disclosed.

	Example of such a new effect: The invention as filed relates to a pharmaceutical composition having a specific activity. At first sight, having regard to the relevant prior art, it would appear that there is a lack of inventive step. Subsequently the applicant submits new evidence which shows that the claimed composition exhibits an unexpected advantage in terms of low toxicity. In this case it is allowable to reformulate the technical problem by including the aspect of toxicity, since pharmaceutical activity and toxicity are related in the sense that the skilled person would always contemplate the two aspects together. The reformulation of the technical problem may or may not give rise to an amendment, and subsequent insertion, of the statement of the technical problem in the description. Any such amendment is only allowable if it satisfies the conditions listed in VI, 5.7c. In the above example of a pharmaceutical composition, neither the reformulated problem nor the information on toxicity could be introduced into the description without infringing the proviso of Sec.49.

ANNEX 1 to CHAPTER IV, 9

Guidance for the assessment of inventive step

1. Application of known measures?

1.1 Inventions involving the application of known measures in an obvious way and in respect of which an inventive step is therefore to be ruled out:

(i) The teaching of a prior document is incomplete and at least one of the possible ways of "filling the gap" which would naturally or readily occur to the skilled person results in the invention.

Example: The invention relates to a building structure made from aluminium. A prior document discloses the same structure and says that it is of light-weight material but fails to mention the use of aluminium.

(ii) The invention differs from the known art merely in the use of well-known equivalents (mechanical, electrical or chemical).

Example: The invention relates to a pump which differs from a known pump solely in that its motive power is provided by a hydraulic motor instead of an electric motor.

(iii) The invention consists merely in a new use of a well-known material employing the known properties of that material.

Example: Washing composition containing as detergent a known compound having the known property of lowering the surface tension of water, this property being known to be an essential one for detergents.

(iv) The invention consists in the substitution in a known device of a recently developed material whose properties make it plainly suitable for that use ("analogous substitution").

Example: An electric cable comprises a polyethylene sheath bonded to a metallic shield by an adhesive. The invention lies in the use of a particularly newly developed adhesive known to be suitable for polymer-metal bonding.

(v) The invention consists merely in the use of a known technique in a closely analogous situation ("analogous use").

Example: The invention resides in the application of a pulse control technique to the electric motor driving the auxiliary mechanisms of an industrial truck, such as a fork-lift truck, the use of this technique to control the electric propulsion motor of the truck being already known.

1.2 Inventions involving the application of known measures in a non-obvious way and in respect of which an inventive step is therefore to be recognised:

(i) A known working method or means when used for a different purpose involves a new, surprising effect.

Example: It is known that high frequency power can be used in inductive butt-welding. It should therefore be obvious that high-frequency power could also be used in conductive butt welding with similar effect; an inventive step would exist in this case, however, if high-frequency power were used for the continuous conductive butt welding of coiled strip but without removing scale (such scale removal being on the face of it necessary in order to avoid arcing between the welding contact and the strip). The unexpected additional effect is that scale removal is found to be unnecessary because at high frequency the current is supplied in a predominantly capacitive manner via the scale which forms a dielectric.

(ii) A new use of a known device or material involves overcoming technical difficulties not resolvable by routine techniques.

Example: The invention relates to a device for supporting and controlling the rise and fall of gas holders, enabling the previously employed external guiding framework to be dispensed with. A similar device was known for supporting floating docks or pontoons but practical difficulties not encountered in the known applications needed to be overcome in applying the device to a gas holder.

2. Obvious combination of features?

2.1 Obvious and consequently non-inventive combination of features:

The invention consists merely in the juxtaposition or association of known devices or processes functioning in their normal way and not producing any non-obvious working inter-relationship.

Example: Machine for producing sausages consists of a known mincing machine and a known filling machine disposed side by side.

2.2 Not obvious and consequently inventive combination of features:

The combined features mutually support each other in their effects to such an extent that a new technical result is achieved. It is irrelevant whether each individual feature is fully or partly known by itself.

Example: A mixture of medicines consists of a painkiller (analgesic) and a tranquiliser (sedative). It was found that through the addition of the tranquiliser, which intrinsically appeared to have no pain-killing effect, the analgesic effect of the pain-killer was intensified in a way which could not have been predicted from the known properties of the active substances.

3. Obvious selection?

3.1 Obvious and consequently non-inventive selection among a number of known possibilities:

(i) The invention consists merely in choosing from a number of equally likely alternatives.

Example: The invention relates to a known chemical process in which it is known to supply heat electrically to the reaction mixture. There are a number of well-known alternative ways of so supplying the heat, and the invention resides merely in the choice of one alternative.

(ii) The invention resides in the choice of particular dimensions, temperature ranges or other parameters from a limited range of possibilities, and it is clear that these parameters could be arrived at by routine trial and error or by the application of normal design procedures.

Example: The invention relates to a process for carrying out a known reaction and is characterised by a specified rate of flow of an inert gas. The prescribed rates are merely those which would necessarily be arrived at by the skilled practitioner.

(iii) The invention can be arrived at merely by a simple extrapolation in a straightforward way from the known art.

Example: The invention is characterised by the use of a specified minimum content of a substance X in a preparation Y in order to improve its thermal stability, and this characterising feature can be derived merely by extrapolation on a straight line graph, obtainable from the known art, relating thermal stability to the content of substance X.

(iv) The invention consists merely in selecting particular chemical compounds or compositions (including alloys) from a broad field.

Example: The prior art includes disclosure of a chemical compound characterised by a specified structure including a substituent group designated "R". This substituent "R" is defined so as to embrace entire ranges of broadly-defined radical groups such as all alkyl or aryl radicals either unsubstituted or substituted by halogen and/or hydroxy, although for practical reasons only a very small number of specific examples are given. The invention consists in the selection of a particular radical or particular group of radicals from amongst those referred to, as the substituent "R" (the selected radical or group of radicals not being specifically disclosed in the prior art document since the question would then be one of lack of novelty rather than obviousness). The resulting compounds

(a) are not described as having, nor shown to possess, any advantageous properties not possessed by the prior art examples; or

(b) are described as possessing advantageous properties compared with the compounds specifically referred to in the prior art but these properties are ones which the person skilled in the art would expect such compounds to possess, so that he is likely to be led to make this selection.

3.2 Not obvious and consequently inventive selection among a number of known possibilities:

(i) The invention involves special selection in a process of particular operating conditions (e.g. temperature and pressure) within a known range, such selection producing unexpected effects in the operation of the process or the properties of the resulting product.

Example: In a process where substance A and substance B are transformed at high temperature into substance C, it was known that there is in general a constantly increased yield of substance C as the temperature increases in the range between 50 and 130 C. It is now found that in the temperature range from 63 to 65 C, which previously had not been explored, the yield of substance C was considerably higher than expected.

(ii) The invention consists in selecting particular chemical compounds or compositions (including alloys) from a broad field, such compounds or compositions having unexpected advantages.

Example: In the example of a substituted chemical compound given at (iv) under 3.2 above, the invention again resides in the selection of the substituent radical "R" from the total field of possibilities defined in the prior disclosure. In this case, however, not only does the selection embrace a particular area of the possible field, and result in compounds that can be shown to possess advantageous properties (see IV, 9.10 and VI, 5.7a) but there are no indications which would lead the person skilled in the art to this particular selection rather than any other in order to achieve the advantageous properties.

4. Overcoming a technical prejudice?

As a general rule, there is an inventive step if the prior art leads the person skilled in the art away from the procedure proposed by the invention. This applies in particular when the skilled person would not even consider carrying out experiments to determine whether these were alternatives to the known way of overcoming a real or imagined technical obstacle.

Example: Drinks containing carbon dioxide are, after being sterilised, bottled while hot in sterilised bottles. The general opinion is that immediately after withdrawal of the bottle from the filling device the bottled drink must be automatically shielded from the outside air so as to prevent the bottled drink from spurting out. A process involving the same steps but in which no precautions are taken to shield the drink

from the outside air (because none are in fact necessary) would therefore be inventive.

5. Further examples

Further examples concerning the assessment of inventive step can be found in Chapter VII, in particular parts VII, 1 (The problem and solution approach) and VII, 5.4 (Chemical problems, inventive step).

ANNEX 2 to CHAPTER IV, 9

(CONCERNING INVENTIVE STEP)

1. The Problem and Solution Approach

The biggest danger in assessing inventive step is the use of **subjectivity** and **hindsight** on the part of an examiner. The examiner doing the search and the substantive examiner, after reading a patent application, know the solution to a technical problem and, as everyone knows, once you know the answer, the problem doesn't seem that difficult after all. It is important, therefore, not to use hindsight (or **ex-post facto analysis**) in assessing an invention. It is equally important not to use criteria such as "brilliant", "simple", "revolutionary", etc. in evaluating an invention, since these are **subjective** criteria. These dangers can be avoided by the use of the **problem and solution approach**, whose use allows an **objective** analysis of an invention.

In the problem and solution approach we first take a step backwards from the invention to the closest prior art and then, on the basis of a comparison of this prior art with the invention, a so-called "**objective problem**" is formulated. Finally, the prior art is searched for indications as to whether a solution to this problem was available and would have been used.

This approach avoids the risk of hindsight. Moreover, it gives results that are consistent and transparent since it relies more on objective criteria than subjective judgement.

The basis for this approach is that every invention must be based on a technical problem and a technical solution. Before the method is explained some concepts are clarified.

Technical features: Structural (concrete) or functional (performance) elements necessary to produce the technical effects of the invention.

Examples: Structural elements could be: a transistor, a chemical compound, a vessel for liquids, the structure of a molecule. etc. Functional elements could be: a step in a procedure, elements identified as "amplifying means", "a solvent", "heat conducting means", etc.

Technical effects: Set of positive or negative results produced by technical features of an invention. Technical effects usually relate to the purpose or intended use of the invention.

Examples: Faster/slower performance, lighter, stronger, more acidic, more efficient, etc.

Technical problem: The task or aim of modifying or adapting the closest prior art to provide the technical effect that the invention provides.

The invention: By this we mean the combination of all the technical features as they are represented in a claim and their associated technical effects.

Prior art or State of the art: This means all the technical information that has already been made available to the public before the applicant applied for the patent.

Differences: By this we mean those technical features of a claim which are not found in a particular item of prior art.

Closest prior art: is that known combination of features that provides the strongest basis for an obviousness objection. In practice, this will generally be the item (usually a document) in the technical field concerned, disclosing technical effects, purpose or intended use, most similar to the invention. It should be noted that the closest prior art may well be different for considering the novelty and the inventive step of the same claim. The reason for this is that for novelty consideration the document having the most features of a claim (call this document D1) is most relevant, whereas for inventive step the technical effects of the features also have to be considered. D1 may not disclose the technical effects of the invention, in which case another document D2 would be the closest for inventive step purposes if it disclosed the technical effects.

Examples:

For a process invention, the closest prior art is usually a similar process.

For a method-of-use invention, the closest prior art is usually a disclosure of a similar use of the same product, or the same use of a structurally similar product.

For a product invention, the closest prior art is usually another product having the same intended use or purpose. This product will normally also have the greatest number of technical features in common with the invention.

For example: Suppose that the invention is concerned with an improvement to a table. The closest prior art will normally be another table having a comparable use. Most likely it will be the table having the greatest number of structural elements in common with the invention.

In chemical inventions, the purpose or intended use of a product is often less related to similarities in structure than is the case in other technical fields. This is because the structurally closest prior art might not provide similar effects; rather, an alteration of the chemical structure of a compound might change the possible use of the product entirely. Therefore, the closest prior art for a chemical product is usually the item providing effects close to or the same as the effects provided by the invention.

For example: A compound used as a herbicide, when altered, might no longer kill plants; rather, it might kill insects instead, so it could be used as an insecticide. The prior art selected as being the "closest" would thus be an insecticide. The herbicide, although structurally the closest, would not be considered as the closest prior art; in fact, it might not even be considered as relating to the same technical field at all.

Person skilled in the art or Skilled person: is a fictional person taken to have available all the prior art and to be able to understand it regardless of which language it is in, and all the common general knowledge of the art in question, but to have no

inventive ability. In some advanced fields it may be appropriate to consider what a team of workers would know. For example, in the field of rockets, a team consisting of ballistic experts, computer experts, rocket fuel experts, etc. would be "the skilled person". At the same time the skilled person has no imagination to be able to do inventive activity (see also 9.9 above).
Common general knowledge: what the normal skilled worker in that art would know, together with what would be found in standard textbooks.

By an **Indication** we mean here anything that would (not simply **could**, but **would**) prompt the skilled person to amend, adapt or modify a product or procedure, or combine the teaching of two items of prior art, with the expectation of a desired result. As noted earlier, the skilled person's general knowledge would sometimes provide the incentive to do something not described specifically in a prior art document.

Ex-post-facto analysis or **hindsight**: Once the solution to a problem is known the problem does not appear that difficult. Thus, looking back once the solution is known and creating a sequence of steps backward towards the prior art is not a recommended way of examining for inventive step. A proper way is to start from the prior art and to see which way the skilled person would go, if at all.

2. The four steps used in the problem and solution approach

Step 1: Determining the closest prior art

Study the application until you understand the technical features of the invention and their associated technical effects, and the overall effect, purpose or intended use of the invention.

Now consider each item of prior art individually.

For each item of prior art, identify the technical features and technical effects that are common to the invention.

Identify the differences between the invention and each item of prior art, and any technical effects that the differences achieve.

Decide which item represents the closest prior art.

After this sequence of steps you will have two documents, one (the application) setting out the invention, and the other the prior art that most closely resembles the invention. In the next stage of the procedure, you will compare the invention with the closest prior art and determine the technical problem in an objective manner.

If, occasionally, you find it difficult to decide which of two documents represents the closest prior art, you should carry out the following procedure for each of these documents.

Step 2: Evaluating the difference between the closest prior art and

The next step is to determine the difference between the claimed invention and the closest prior art. The difference will be that structural or functional feature or features or method steps that are in the claim but not in the closest prior art, and is called the distinguishing feature.

Step 3: Formulating the technical problem

Based on this difference, a problem is formulated. This in turn is based on the technical effect that the distinguishing feature(s) provides. Usually, the effect of this feature is given in the application itself, or it may be obvious from its description. For example, a heat conducting body adjacent an electronic component has the effect of conducting heat away from the component. The corresponding problem may be formulated as "cooling the electronic component".

In the description, the applicant often identifies the problem he faced when he made the invention or when he drafted the application. However, the applicant might not have had access to all the prior art, particularly the closest prior art, or it might not have been correctly appreciated. So the problem he faced might have been completely or partly solved already, unknown to him, and what he presents as the problem he solved might well have been solved already in the documents found in the search report. Hence there is the need to evaluate the actual technical problem solved by the applicant. As a matter of terminology, the problem originally identified by the applicant has sometimes been called "**the subjective problem**". After the analysis and, where necessary, the reformulation of the problem as set out above, the technical problem that emerges is sometimes called "**the objective problem**".

The correct formulation of the technical problem lies at the heart of the problem/solution approach. If it is not correctly formulated, difficulties will arise in attempting to arrive at the correct evaluation of the inventive step. If the technical problem is formulated too specifically, it could include elements of the solution, and the invention might, unjustifiably, appear to be obvious. If, on the other hand, the technical problem is formulated too broadly, it could be that you will find a whole range of alternative solutions in the prior art. This might require extensive checking of each alternative.

Step 4: Is the invention obvious?

Given the objective technical problem and the prior art, the next step is to determine whether there are any **indications** in the prior art that would lead the skilled person to combine prior art documents to achieve the technical effect that the invention achieves, or to put it differently, to solve the same problem.

Example i): The statement "this numerical keypad could be used on any electronic equipment where a series of numbers are to be entered manually" would be an indication of the possibility of replacing the traditional telephone dialling ring by that numerical keypad.

Example ii): Readily recognisable (technical drawbacks) often indicate to the skilled person that certain technical effects require an improvement, e.g. "too slow, too heavy, too complicated, not stable", "inefficient", etc.

Example iii): For commercial reasons or due to technical drawbacks, the skilled person would, in some cases, be prompted to seek an alternative way of providing the same effects as the closest prior art provides.

If there are no indications in the prior art that would lead the skilled person, faced with the technical problem and the prior art, to consider combining the solution with the closest prior art to achieve what the invention achieves, then the invention is not obvious, because there is nothing that would lead the skilled person from the closest prior art to the invention.

If there are such indications, the invention does not involve an inventive step because the skilled person, faced with the technical problem and the prior art, **would** consider combining the solution with the closest prior art and arrive at the subject-matter of the claim.

Where the claim is for a combination of technical features which are functionally related to one another (which is usually the case), the obviousness of the whole combination must be established. Where however the claim is for a juxtaposition of functionally independent parts, it is legitimate to apply the problem-solution approach to each part separately; if each part is thereby shown to be obvious, the whole claim is obvious.

Note that the word "would" has been emphasised above. This is because it is clear that anything in the world **could** be combined with anything else, but it is unfair to the applicant to show that this is possible. Instead, it is necessary to demonstrate that, starting from the closest prior art, the skilled person inevitably **would** be led to combine it with another prior art, in order to build up a logical chain of reasoning to show lack of inventive step without using hindsight.

3. The sub-tests

Once the technical problem has been formulated using the problem and solution approach, you have to evaluate whether or not the invention as set out in the claim, is obvious. Deciding that involves answering the question: "What would a person skilled in the art do, when faced with that technical problem and having regard to the state of the art?".

It was also mentioned here above that you start from the closest prior art and then weigh up the rest of the prior art to determine whether or not there are any indications that would have led a skilled person from the closest prior art to the invention. In doing this factors are used that are referred to as secondary considerations or sub-tests. Sub-tests provide indicators or pointers (also called indicia) that help the evaluator to arrive at a decision.

Despite the usefulness of sub-tests, a technical evaluation of the invention remains of primary importance, particularly during the examination procedure. Answers to some sub-tests will seldom be available at such an early stage of the procedure; the marketing of products for example is unlikely to have started and the public response will be unknown.

Generally, it will be the "negative" sub-tests that will be quoted by the examiner; applicants may reply using "positive" sub-tests when arguing against the examiner's opinion. The examiner thus needs to have a thorough knowledge of the sub-tests, as well as their uses and limitations.

There are positive sub-tests, i.e. those that indicate the presence of inventive step, and negative sub-tests, which point to lack of inventive step.

3.1 Sub-tests that usually provide negative pointers

(a) Aggregation or collocation

The invention consists merely in the juxtaposition (bringing side-by-side) of known devices or processes, each functioning in its normal way without interacting with the other elements, and not producing any unexpected technical effect.

Example: Machine for producing sausages consists of a known mincing machine and a known filling machine disposed side by side.

(b) Simple and straightforward extrapolation from known facts

To extrapolate from already known measures to arrive at the invention is a sign for obviousness.
Example 1: The invention is characterised by the use of a specified minimum content of a substance X in a preparation Y in order to improve its thermal stability, and this characterising feature can be derived merely by extrapolation on a straight line graph, obtainable from the known art, relating thermal stability to the content of substance X.

Example 2: Care should be taken with extrapolation however, as this example shows. A synthetic material has been known to have very good static load-bearing properties. The invention consists of making railway sleepers of this material, which are subject to severe dynamic loading. It would be unfair to say that it would be obvious to replace known sleeper material by the new one since the dynamic load-bearing properties are surprising.

(c) A change of size, form or proportion

The choice of a particular dimension from a limited range of possibilities and resulting from routine trial and error or arrived at by the application of normal design procedure points towards obviousness.

Example: The invention relates to a process for carrying out a known reaction and is characterised by a specified rate of flow of an inert gas. The prescribed rates are merely those which would necessarily be arrived at by the skilled practitioner.

(d) An exchange of material

The substitution of a newly developed material for one that had been used in a known product, where the properties of the new material indicate that it is likely to be suitable, is a pointer towards obviousness.

Example 1: Washing composition containing as detergent a known compound having the known property of lowering the surface tension of water, this property being known to be an essential one for detergents.

Example 2: A new rubbery material which is very wear resistant comes onto the market and someone applies for a patent for a motor tyre made from this material. This use would be obvious considering the properties of the new material.

(e) Application of a technique known per se

In such a case it has to be established whether success could reasonably have been expected. This is usually the case when the known technique is applied in an analogous situation.

Example: The invention resides in the application of a pulse control technique to the electric motor driving the auxiliary mechanisms of an industrial truck, such as a fork-lift truck, the use of this technique to control the electric propulsion motor of the truck being already known.

(f) The use of well-known technical equivalents

One should consider whether the use of an equivalent involved particular technical difficulties. If this is not the case, then the test points towards obviousness.

Example: The invention relates to a pump which differs from a known pump solely in that its motive power is provided by a hydraulic motor instead of an electric motor.

(g) Filling a gap in the state of the art

When the teaching of the prior art is obviously incomplete, and completion thereof would naturally or readily occur to the skilled person, an inventive step has to be ruled out.

Example: The invention relates to a building structure made from aluminium. A prior document discloses the same structure and says that it is of light-weight material but fails to mention the use of aluminium.

(h) Selection from a number of known possibilities without any unexpected technical effect

This comes down to merely choosing from a number of equally likely alternatives.

Example: The invention relates to a known chemical process in which it is known to supply heat electrically to the reaction mixture. There are a number of well-known

alternative ways of so supplying the heat, and the invention resides merely in the choice of one alternative.

3.2 Sub-tests that might provide positive pointers

Technical considerations

(i) Overcoming a technical prejudice

This is normally a persuasive pointer towards "non-obviousness". If there has been disbelief or scepticism by experts towards a particular line of development and the prior art points away from the proposed invention, that is taken as strong support for the existence of an inventive step. However, the applicant must provide evidence to demonstrate the existence of such a prejudice at the priority date of the application. A mere allegation that technical prejudice was present is not sufficient. It must also be shown by the applicant that the technical prejudice was generally known to the world and not just perceived by him only.

Example: Drinks containing carbon dioxide are, after being sterilised, bottled while hot in sterilised bottles. The general opinion is that immediately after withdrawal of the bottle from the filling device the bottled drink must be automatically shielded from the outside air so as to prevent the bottled drink from spurting out. A process involving the same steps but in which no precautions are taken to shield the drink from the outside air (because none are in fact necessary) would therefore be inventive.

(j) The invention overcomes difficulties by means of a new use of a known process, of a known device or known material

This point is taken as a sign of non-obviousness if the difficulties are not resolvable by routine techniques.

Example: The invention relates to a device for supporting and controlling the rise and fall of gas holders, enabling the previously employed external guiding framework to be dispensed with. A similar device was known for supporting floating docks or pontoons but practical difficulties not encountered in the known applications needed to be overcome in applying the device to a gas holder.

(k) Unexpected technical progress or technical advance

This point deals with improvements over the prior art which, although a permanent aim in industry, are not a requirement for patentability, in particular for inventive step. However, this test may be relevant if a long period of research or of attempts to make an improvement have failed to find a better solution. The unexpected technical progress has to be demonstrated in comparison with the closest prior art. Therefore it is sometimes necessary for the applicant to support this pointer with comparative tests. Examples of this pointer are such things as: increase in performance, greater productivity, cheaper and more economical production, the simplification of machines or construction and manufacturing methods.

Example: The invention involves a special selection in a process of particular operating conditions (e.g. temperature and pressure) within a known range, such selection producing unexpected effects in the operation of the process or the properties of the resulting product.

(l) Surprising technical effect

An example of such an effect would be when the various elements of the invention are known individually from different sources in the prior art, but when combined in the particular way of the invention, produce a technical effect that goes beyond what would have been expected from a mere juxtaposition of these known measures (This is sometimes called synergy). This pointer is generally known as "the combination effect". It occurs quite frequently in chemical inventions.

Example: A mixture of medicines consists of a painkiller (analgesic) and a tranquilliser (sedative). It was found that through the addition of the tranquilliser, which intrinsically appeared to have no pain-killing effect, the analgesic effect of the pain-killer was intensified in a way which could not have been predicted from the known properties of the active substances.

Another occasion where we might speak of a surprising effect would be when a known method or means is successfully used for an entirely different purpose.

It is known that high frequency power can be used in inductive butt welding. It should therefore be obvious that high-frequency power could also be used in conductive butt welding with similar effect; an inventive step would exist in this case. This would also be the case if high-frequency power were used for the continuous conductive butt welding of coiled strip but without removing scale (such scale removal being on the face of it necessary in order to avoid arcing between the welding contact and the strip). The unexpected additional effect is that scale removal is found to be unnecessary because at high frequency the current is supplied in a predominantly capacitive manner via the scale which forms a dielectric.

Care must be taken to ensure that all technical effects are indeed caused by the features of a claim. Often an applicant argues that his invention provides some effect, but it turns out that the effect is not provided by the features of the claim, but by some other feature. For his arguments to be relevant, this other feature must be included in the claim.

It might be argued that unexpected or surprising effects are subjective tests since different people react differently to a given result. However, insofar as the effect can be measured objectively (e.g. a greater efficiency or yield is produced) and shown to be different from what one would expect from the prior art, it is not subjective.

(m) Professional recognition or technical esteem

The opinion of experts and their admiration of the invention are pointers towards non-obviousness of the invention. Of course, if those experts are employed by or are related commercially to the applicant, one should be careful about their opinions.

Commercial considerations

(n) Commercial or economic success

This pointer is not necessarily based on technical differences between the invention and the state of the art; it should therefore be treated with caution. Commercial success can only occur after the invention has been on the market for a while (usually after the examination of the application has finished). Thus it cannot have influenced the design of the invention before the filing date and so cannot normally be used as an argument for inventive step. Commercial success might be derived from a number of factors, e.g. first to the market, skilful positioning, good selling techniques, effective advertising, not to mention occasional good luck. However, if it can be proved that commercial success is coupled with another pointer such as the satisfaction of a long-felt want and stems from technical features of the invention, it should be accepted as being relevant.

(o) Licence acquired from the inventor

This pointer relates to the concept of commercial success. It suggests an existing need for the invention and the related commercial interest. If the rights were acquired by competitors of the inventor, they will have carefully examined the value of the invention before entering into any agreement. Usually they will not be distracted by selling techniques or good advertising. It could be a sign that the competitors are convinced that they could not win an opposition or an infringement suit, thus pointing at non-obviousness.

However, it might also be the cheapest and most convenient way for a competitor to make money while avoiding trouble, since the cost of defending an infringement case in court, even against a patent thought to be invalid, could be greater than the cost of a licence. In other instances, licences could also be exchanged between competitors.

(p) Copying or infringement of the invention by competitors

This pointer also relates to the concept of commercial success. The fact that someone copies an invention, regardless of the risk of an infringement suit and the possible payment of damages is not convincing one way or the other. While one could argue that it supports the value of the invention to a certain extent, one could also argue that it indicates that the copier is convinced that the patent is not valid, i.e. there is no inventive step.

(q) Circumvention

This concept can also be related to commercial success. The fact that competitors try to produce a substitute for an invention (i.e. trying to use the inventive idea in a legal manner) can be taken as acknowledgement of the attractiveness of the invention and at the same time recognition of the commercial value of the invention.

(r) Parallel applications abroad

Applicants sometimes say that a patent has been granted for the invention in the US, Europe, or some other country, and imply that it should similarly be granted in other

countries. This argument should be given some weight and, indeed, it is recommended that "young" patent offices make use of results from experienced patent offices.

Other considerations

(s) Long-existing prior art

This concept implies the question "If the invention is obvious, why was it not done a long time ago?". If the elements of the invention have been available for a long time and the particular combination that would result in the invention has not been made, although the result obtained by the invention is useful, this can be taken as a sign of non-obviousness. However, this pointer is usually given only limited weight because there may have been no particular need or desire to solve that problem during that period of time.

(t) Overcoming technical difficulties or solving a technical problem which others have been working on without success

This pointer covers a series of different aspects. We are not talking here simply about difficulties or problems the inventor himself had to overcome to achieve his result. The difficulties or problems must have existed in the technical field concerned and were such that the experts in this field were not able to overcome them. The length of time during which the difficulties or problems were known and the efforts made to remove them are important factors in this context.

(u) Satisfaction of a long-felt want (the time factor)

If a need for a solution to a technical problem existed for a long time, and the invention immediately satisfies that need, e.g. as evidenced by immediate commercial success, that suggests that the solution represented by the invention was not obvious.

(v) Failures and unsuccessful attempts

This means that others have tried to solve a technical problem and failed. There is a strong relation with the "long-felt want" here in so far as attempts are usually undertaken only if a need exists. One needs to consider the nature of the attempts, the number of attempts, the time span over which they were performed and the skills of those who failed.

(w) Pioneer inventions

A pioneer invention can change the production methods of a whole industry or create a totally new industry or branch of industry which did not exist before. In the latter case, there cannot be any doubt about non-obviousness, since there would not be any close prior art available to compare it with. However, it is often difficult to recognise the extent of the value of such inventions at the examination stage. Examples that could be quoted would be: the ball-point pen, the laser (actually the maser came first), xerography.

(x) A (large) number of (sequential) steps have to be taken to move from the closest prior art to the invention

This is considered to be a significant indicator of the presence of inventiveness; the larger the number of steps, the less likely it is to be obvious. Also, the larger the number of disclosures that need to be combined to assemble all the technical features of the claim, the less likely it is to be obvious to do so. Note that this is a different criteria to that in (a) above.

(y) Special choice among a multitude of possible solutions (selection inventions)

This pointer is effectively a "lucky invention" which expresses quite clearly the extent of this concept. If an inventor found the one, or a few, working solutions amongst a theoretically unlimited number of unsuccessful ones, this is an indication for non-obviousness. This test for inventive step is similar to the unexpected effect test in (k) above.

(z) Unexpected additional (bonus) effects

It sometimes happens that, in addition to expected effects, additional, unexpected effects or advantages occur. The question then arises: can the presence of these unexpected effects be taken as evidence of non-obviousness in cases where the expected effects are due to routine development and, for this reason, the invention would normally be regarded as obvious? In such cases the number of options available to the skilled person is to be considered. Where the choice is restricted, the lack of alternatives may create a so-called "**one-way-street**" situation, where normal development will lead almost inevitably to the invention; the invention will then be taken to be obvious in spite of an unexpected **"bonus effect"**. This situation should be contrasted with the multiple-choice situation such as commonly arises e.g. in selection. A fanciful example of a one-way-street situation is the following: A man at a junction of several roads is looking for a bar and sees a bar along only one of the roads. He goes down this road and into the bar, and finds a beautiful woman there. In this case the woman is a bonus effect since the man did not have a choice, he was forced to go down one road only.

Example 1

Suppose it is known from the prior art that, when one reaches a particular compound in a series of known chemical compounds, expressed in terms of the number of carbon atoms, there is a consistently increasing insecticidal effect as one moves up the series. The next
higher member of the series, if it was not previously known, then lies in a "one-way street". If this member of the series, in addition to exhibiting the expected enhanced insecticidal effect, proves also to have the unexpected effect of being selective, i.e. of killing some insects but not others, it nevertheless remains obvious.

Example 2

A further general case of a one-way street could be the replacement of mechanical automatic control by electronic automatic control. Suppose the mechanical control system in an automatic gear box for a motor car is replaced by a microprocessor-controlled system, the microprocessor being able to take account of all factors, i.e. accelerator pedal position, engine revolutions etc., to select the most appropriate gear. When the microprocessor system is used it is unexpectedly found

that the tyres of the car exhibit a significantly reduced wear and therefore a longer life. This effect is a bonus effect, and the invention remains obvious.

CHAPTER V – PRIORITY

Art.4, 4bis Paris Convention	The Philippines being a signatory state of the Paris Convention, Art.4 and Art.4bis thereof do also apply in the Philippines
	1. The right to priority
Sec.40	1.1 A Philippine patent application is accorded as its date of filing the date on which it satisfies the requirements of Sec.40 and Rule 600. This date remains unchanged except in the special circumstances referred to in Sec.41 and Rules 600.1 to 602.
Sec.29	The date of filing may be the only effective date of the application. It will be of importance for fixing the expiry of certain time limits, for determining the state of the art relevant to the novelty or obviousness of the subject-matter of the application, and for determining, in accordance with Sec.29 and R.304, which of two or more Philippine applications from independent persons for the same invention is to proceed to grant.
Sec.31 R.305	1.2 However, in many cases, a Philippine application will claim the right of priority of the date of filing of an earlier application. In such cases, it is the priority date (i.e. the date of filing of the earlier application) which becomes the effective date for the purposes mentioned in the preceding paragraph, except for the fixing of certain time limits.
Sec.31 R.305	1.3 For a valid claim to priority, the earlier application whose priority has been claimed must have been made by the applicant, it must have been made in (or for) another country which by treaty, convention or law affords similar privileges to Filipino citizens (e.g. a signatory state of the Paris Convention), and the following conditions must also be satisfied: (a) the local application must expressly claim priority, (b) it must be filed within twelve (12) months from the date the earliest foreign application was filed, and (c) a certified copy of the foreign application together with an English translation must be filed within six (6) months from the date of filing in the Philippines. Pursuant to Rule 305, the six months period may be extended by the Director for a maximum of six months upon showing of good cause or in compliance with treaties to which the Philippines are or may become a member. The words "in (or for) another country which…“ mean that priority may be

	claimed of an earlier national regional or international application. The earlier application may be for a patent or for the registration of a utility model or for a utility certificate or for an inventor's certificate. As long as the contents of the earlier application were sufficient to establish a regular filing date, it can be used to create a priority date, no matter what the outcome of the application may later be; for example, it may subsequently be abandoned or refused.
Art.4C(2) Paris Convention	1.4 Normally (except as explained in V, 1.4a here below) the filing date of the "first application" must be claimed as a priority, i.e. the application disclosing for the first time any or all of the subject-matter of the Philippines application. If it is found that the application to which the priority claim is directed is in fact not the first application in the above sense, but some or all of the subject-matter was disclosed in a still earlier application in or for the same country and originating from the same inventor, the priority claim is invalid as far as the subject-matter was already disclosed in the still earlier application.
Sec.24.1 Sec.24.2	To the extent the priority claim is invalid, the effective filing date of the local application under examination is the date of its filing in the Philippines. The previously disclosed subject-matter of the local application is not novel, if the still earlier application referred to above was published prior to the effective filing date of the local application (Sec.24.1) or if the still earlier application is also a Philippines application which was published on or after the effective filing date of the local application in question (Sec.24.2), provided the inventor or applicant identified in both the applications are not one and the same.
Art.4C(4) Paris Convention	1.4a A subsequent application for the same subject-matter and filed in or for the same state shall be considered as the first application for priority purposes if, at the date this subsequent application was filed, the first application had been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and had not served as a basis for claiming priority. The Office will not consider this question unless there is evidence of the existence of an earlier application as, for example, in the case of a United States continuation-in-part application. Where it is clear that an earlier application for the same subject-matter exists, and where the priority right is important because of intervening prior art (see V, 2.1 here below), the applicant should be required to establish by evidence from an appropriate authority (normally a national patent office) that there were no rights outstanding of the in the earlier application in respect of the subject-matter of the application being examined. If the earlier application has been published, or it has been used for priority purposes in another application, there are clearly rights outstanding.
R.306.1 R.306.2	1.5 Multiple priorities from different countries may be claimed - i.e. a Philippines application may claim rights of priority based on more than one earlier application. The earlier application may have been filed in or for the

	same or different states, but in all cases the earliest application must have been filed not more than 12 months before the date of filing of the Philippines application. If more than one priority is claimed, time limits will be computed from the priority date will be based on the earliest priority date.
R.306.3	An element of a Philippines application will be accorded the priority date of the earliest priority application which discloses it. If, for instance, the Philippines application describes and claims two embodiments (A and B) of an invention, A being disclosed in a French application and B in a German application, both filed within the preceding 12 months, the priority dates of both the French and German applications may be claimed for the appropriate parts of the Philippines application; embodiment A will have the French priority date, and embodiment B the German priority date, as effective filing dates. If embodiments A and B are claimed as alternatives in one claim, these alternatives will likewise have the different priority dates as effective dates. If, on the other hand, a Philippines application is based on one earlier application disclosing a feature C and a second earlier application disclosing a feature D, neither disclosing the combination of C and D, a claim to that combination will be entitled only to the date of filing of the Philippine application under examination itself. In other words, it is not permitted to mosaic priority documents. An exception might arise where one priority document contains a reference to the other and explicitly states that features from the two documents can be combined in a particular manner. **2. Determining priority dates** 2.1 As a general rule, the examiner should not make any investigation as to the validity of a right to priority. However, the priority right assumes importance if prior art has to be taken into account, which has been made available to the public within the meaning of Sec.24.1, on or after the priority date claimed and before the date of the local filing **(**e.g. an intermediate document, see IV, 5.3, or if the content of the Philippine patent application is totally or partially identical with the content of another Philippine application from a different applicant or inventor within the meaning of Sec.24.2, such other application claiming a priority date within that period. In such cases, (i.e. cases where the art in question would be relevant if of earlier date) the examiner must investigate whether the priority date(s) claimed may be accorded to the appropriate parts of the application he is examining and should inform the applicant of the outcome and whether, in consequence, the particular prior art under consideration, e.g. the intermediate document, or the other Philippine application forms part of the state of the art within the meaning of Sec.24. Also, in the case of possible conflict with another Philippine application under Sec.24.2, it may be necessary in addition to allocate priority dates to the appropriate parts of that other application and to communicate this to

	the applicant analogously. In the case of conflicting local applications, the examiner can only take action once the earlier local application has been published.
R.306.3	2.2 When the examiner needs to consider the question of priority date, he should bear in mind all the matters which are mentioned in V, 1.3 to 1.5 above. He should also remember that, to establish a priority date, it is not necessary that the elements of the invention for which priority is claimed should be found among any claims in the previous application. It is sufficient that the documents of the previous application taken as a whole "specifically disclose" such elements. The description and any claims or drawings of the previous application should, therefore, be considered as a whole in deciding this question, except that account should not be taken of subject-matter found solely in that part of the description referring to prior art, or in an explicit disclaimer. 2.3 The requirement that the disclosure must be specific means that it is not sufficient if the elements in question are merely referred to in broad and general terms. A claim to a detailed embodiment of a certain feature would not be entitled to priority on the basis of a mere general reference to that feature in a priority document. Exact correspondence is not required, however. It is enough that, on a reasonable assessment, there is in substance a disclosure of all the elements of the claim. 2.4 The basic test to determine whether a claim is entitled to the date of a priority document is the same as the test of whether an amendment to an application satisfies the requirement of the proviso in Sec.49 (see also VI, 5.4). That is to say for the priority date to be allowed, the subject-matter of the claim must be derivable directly and unambiguously from the disclosure of the invention in the priority document, when account is taken of any features implicit to a person skilled in the art in what is expressly mentioned in the document. As an example of an implicit disclosure, a claim to apparatus including "releasable fastening means" would be entitled to the priority date of a disclosure of that apparatus in which the relevant fastening element was, say, a nut and bolt, or a spring catch or a toggle-operated latch, provided the general concept of "releasable" is implicit in the disclosure of such element. 2.5 If the tests set out in V, 2.2 to 2.4 here above are not satisfied in relation to a particular earlier application, then the effective date of the claim (or one of the embodiments claimed) will either be the filing date of the earliest application which does provide the required disclosure and of which the priority is validly claimed or, in the absence of such, will be the date of filing of the Philippine application itself (or the new date of filing if the application has been re-dated under Sec.41).

2.6 Some examples of determining priority dates

Note: the dates used are merely illustrative; they do not take account of the fact that filing may not be possible on weekends and public holidays.

2.6.1 Intermediate publication of the contents of the priority application:

P is the application from which priority is claimed by the PH application, D is the disclosure of the subject-matter of P.

01.01.90	*01.05.90*	01.06.90
filing	*publication*	filing
P	*D*	PH

D is state of the art under Sec.24.1 when the priority claim of P is not valid.

2.6.2 Intermediate publication of another Philippine application:

P1 is the application from which priority is claimed by PH1, P2 the one from which PH2 claims priority. PH1 and PH2 are filed by different applicants.

01.02.89	*01.01.90*	01.02.90	01.08.90	*01.01.91*
filing	*filing*	filing	publication	*filing*
P1	*P2*	PH1	PH1	*PH2*
A + B	*A + B*	A + B	A + B	*A + B*

PH1 is state of the art for PH2 under Sec.24.2 when the respective priority claims of P1 and P2 are valid. This does not change if the publication of PH1 takes place after the filing date of PH2.

The publication of PH1 is state of the art under Sec.24.1 if the priority claim of P2 is not valid.

2.6.3 Multiple priorities claimed for different inventions in the application, with an intermediate publication of one of the inventions.

PH claims priority of P1 and P2, D is the disclosure of A+B.

01.01.90	*01.2.90*	01.03.90	01.06.90
filing	*publication*	filing	filing
P1	*D*	P2	PH
A + B	*A + B*	A + B + C	Claim 1: A + B Claim 2: A + B + C

Claim 1 has a valid priority of P1 for its subject-matter, thus publication D is not state of the art under Sec.24.1 against this claim. Claim 2 cannot benefit from the priority of P1, as it does not concern the same subject-

matter. Thus publication D is state of the art under Sec.24.1 for this claim. It is immaterial whether claim 2 is in the form of a dependent or an independent claim.

2.6.4 A situation in which it has to be checked whether the application from which priority is actually claimed is the "first application" in the sense of Art.4 C. (1) and (4) of the Paris Convention:

P1 is the earliest application of the same applicant containing the invention. PH claims the priority of the later US-application P2, which is a “continuation-in-part" of P1. D is a public disclosure of A+B.

01.07.89	01.01.90	*01.06.90*	01.12.90
filing	filing	*publication*	filing
P1	P2 (cip)	*D*	PH
A + B	A + B	*A + B*	claim 1: A + B
	A + B + C		claim 2: A + B + C

The priority claim of P2 for claim 1 is not valid as P2 is not the "first application" for this subject-matter in the sense of Art.4 C. (1) and (4) of the Paris Convention, but P1, which has "left rights outstanding" in that P2 is a "continuation-in-part" thereof. Therefore Art.4 C. (4) of the Paris Convention does not apply and this is not altered by an abandonment, withdrawal, refusal or non-publication of P1.

D is prior art pursuant to Sec.24.1 against claim 1, but not against claim 2, as the latter claim has the earlier priority of P2.

3. Claiming priority

Sec.31
R.305
R.307

3.1 An applicant who wishes to claim priority must file a declaration of priority giving particulars of the previous filing, as specified in Sec.31 and Rules 305 and 307, together with a certified copy of the previous application, and if necessary a translation of it into English

Sec.31
R.305
R.603(b)

3.2 At least the date and state of any filing from which priority is claimed must be stated at the time of filing the local application and the file number of the priority application must be indicated during formality examination. The certified copy of the priority document, together with a translation into English, if necessary, must be filed within 6 months of the priority date, which period may be extended for a maximum of 6 months under special circumstances.
Where the earlier application is an international application, the name of the state(s) for which it was filed must be stated.

3.3 If the required translation or declaration is not filed within the time limit, the right of priority is lost for the Philippine patent application.

CHAPTER VI – SUBSTANTIVE EXAMINATION PROCEDURE

	This chapter sets out the general procedure for substantive examination, together with guidance on particular matters where necessary. It does not provide detailed instructions on matters of internal administration.
	1. The start of the substantive examination
Sec.48.1 Sec.44, R.803	1.1 In order that substantive examination of a patent application can begin, the applicant is required to file a written request for examination according to Sec.48.1 within six months from the publication of the application (Sec.44) and to pay the required fees. If the request is not filed and/or the fees are not paid within the six months following publication, the application is deemed withdrawn.
Sec.48.2, R.803.1	1.2 A withdrawal of the request for examination is irrevocable. Although the examination will be not be carried out any further, the fees will not be refunded.
Sec.42 Sec.43	1.3 Formality examination (Sec.42), classification and search (Sec.43) and substantive examination will not always be carried out by the same examiner. After the request for substantive examination has been received, the file relating to the application is passed to the examining division competent for the substantive examination of the application.
R.906	1.4 The file will normally be assigned to the examiner responsible for the examination of applications in the technical field in which the particular application has been classified (R.906). Irrespective of the classification, it may sometimes be more efficient to assign applications having different classifications to the same examiner. For instance, closely related applications, or parent and divisional applications could be allocated to the same examiner. The applications will be taken up for examination in the order in which they have been filed, or in which the applicant's responses have been filed.
	1.5 The substantive examiner is entrusted to carry out all the work up to the point of a decision to grant a patent or refuse the application, under the supervision of his superior. This means that this examiner is entrusted to act on behalf of the Office in all communications with the applicant up to that point, but he will in general confer informally with his supervisors at any time if a special point of doubt or difficulty arises (see VI, 7.1 here below). Where reference is made in this part of the guidelines to the "examiner", this normally means the examiner entrusted with the work in this way, and it should be understood that this examiner is always acting in the name of the Office.

	2. Examination procedure in general
	2.1 The purpose of the examination is to ensure that the application and the invention to which it relates, meet the requirements set out in the relevant Sections of the IP-Code and in the IRR so that a patent can be granted. The prime task of the examiner is to deal with the substantive requirements; the criteria by which an examiner shall judge whether they have been met, are dealt with in detail, in so far as appears necessary, in the other chapters of this part of the guidelines. Some of the formal requirements may be dealt with by administrative staff, such as recording, monitoring time limits and payment of fees etc.
R.907(a)	2.2 The examiner's first step is to study the description, drawings (if any) and the claims of the application. In carrying out his task, the examiner will have in the file the documents making up the application and a history of the proceedings up to the start of the substantive examination. In particular, this examination file will include the request for examination, description, drawings (if any) and the claims as originally filed; any amendments proposed to date; the search report with the applicant's comments (if any), and references to or copies of any cited documents; formality examination reports, priority documents together with any translations etc. It is usually a good practice to read the claims first, since unclear passages stand out more clearly if the claims are read without first reading the description. The next step is to understand the invention by studying the description, the drawings (if any) and the claims (at least once again) of the application. While reading the application, the examiner should identify unclear, inconsistent, and wrong statements. Then the claims should be read again to check that they are consistent with the description and not too broad in scope (i.e. properly supported by the description). After that the prior art should be read and the claims examined for patentability.
Sec.24.2	2.3 When the examiner has studied and understood the claims (including any amended claims), he should also make a search for any additional conflicting Philippine applications falling within the area defined by Sec.24.2 (see VI, 8.4 here below).
R.910	Applications cited as prior art under Sec.24.1 must have been published. Unpublished, withdrawn or forfeited applications may not be cited.
Sec.39 R.612	2.3a In the case of foreign applications, the applicant will be requested, as often as appropriate, to provide information on the status of any foreign application relating to the same invention within a specified period. Copies of the documents cited in foreign search reports may be requested. In the case of relevant citations in other languages than English, the examiner may request the submission of a corresponding patent (family member) in English.

R.612.2	Non-compliance with such requests has the effect that the application will be considered withdrawn.
R.907(b) R.908 R.909 R.912	2.4 Taking into account the documents (if any) cited in the search report and any further documents found as the result of the search referred to in VI, 2.3 here above, and taking account also of any amendments that may have been proposed, or comments made, by the applicant, the examiner should identify any requirements of the IP code and IRR which, in his opinion, the application does not satisfy. He will then write to the applicant giving reasons for any objections he raises and inviting the applicant within a specified period to file his observations or submit amendments. When the applicant has replied with or without amendment, the examiner will re-examine the application. 2.4a The examiner may base his objections on documents cited in the foreign search reports and on the contents in foreign examination reports or decisions. If such foreign examination reports or decisions are negative and also apply to the claims as filed in the Philippines, the examiner may raise prima facie objection referring to these reports/decisions. Provided certain claims (in English) have been granted after substantive examination in a foreign country, the examiner can save time by checking these for their compliance with the IP-code and the IRR, and – if positive – suggest to the applicant to amend his Philippine patent application accordingly.
Sec.51 R.912 R.913(a) R.913(b)	2.5 At the re-examination stage, the examiner should be guided by the over-riding principle that a final position (grant or refusal) should be reached in as few actions as possible, and he should control the procedure with this always in mind. The process of communicating with the applicant described in VI, 2.4 here above shall be repeated as often as necessary. Nevertheless, if it is clear that the applicant is not making any real effort to deal with the examiner's objections, either by amendments or by counter-arguments, then even at the re-examination stage the examiner should bring the application before his supervisor, who may approve the refusal of the application. In any event, at some stage, the examiner will make a short written recommendation to his supervisor either that the application should be refused or that a patent should be granted thereon. If the application is to be refused (final rejection, Sec.51), a written reasoned decision will be prepared by the examiner entrusted with the examination of the application. In preparing the decision, the examiner must take care to abide by the general principle that the decision must be based on grounds or evidence on which the applicant has had the opportunity to comment (R.913(b)).
R.909 R.913 R.1302 R.917 R.1305	However, according to R.909, R.913, R.1302, a second adverse action by the examiner on the same grounds may already be considered as final by the applicant for the purpose of appeal. The applicant may appeal against a final rejection or decision of refusal. If

	the examiner considers in the light of the applicant's statement, that the appeal is admissible and well-founded, or if the rejected claims have been cancelled (R.913)**,** or if any other objected deficiencies have been removed (R.917), he should rectify its decision accordingly after receipt of the restricted claims or the appellant's brief according to R.1305.
R.1307 - R.1311	Otherwise, the appeal will be considered by the Director of patents and possibly higher instances as foreseen in R.1307 to 1311. If a decision to refuse a patent is reversed on appeal, the application may be referred back to the examiner for further examination. In such a case, the further examination will normally be entrusted to the examiner who performed the original examination. The examiner is bound by the decision of the Director or any higher instance. 2.6 If the examiner considers that a patent should be granted, he will first inform the applicant, by the means of a Notice of Allowability, of the claims which are allowed. Prosecution on the merits is closed with the issuance of this Notice. Further fees (inter alia the publication fee) will have to be paid by the applicant within a specified time period. Once the requirements referred to in this Notice are fulfilled, a Philippine patent is granted. For further details of the granting procedure, see VI, 15 here below. 2.7 Reference is made to the Part 9 of the IRR, where the rules relating to substantive examination are set out. The stages of this procedure are considered in more detail in the following sections. **3. The first stage of examination** 3.1 Following the publication of the application and prior to the substantive examiner's first communication with the applicant, the latter may file comments on the search report and amendments to the description, claims or drawings. These amendments may be submitted to avoid possible objections of lack of novelty or lack of inventive step in view of the citations listed in the search report; or to meet any objections that might have lead to a partial or incomplete search report (i.e. at least some claims did not permit of a meaningful search), or they may be suggested for some other reason, e.g. to remedy some obscurity which the applicant himself has noted in the original documents. These amendments will of course only be considered provided a request for substantive examination has been filed according to Sec.48.1. 3.2 Such amendments being voluntarily made by the applicant, the applicant is not restricted to amendment necessary to remedy a defect in his application. It does not, however, mean that the applicant is free to amend in any way he chooses. Any amendment must satisfy the following conditions:

	(i) It must not add subject-matter to the content of the application as filed (see VI, 5.3 to 5.8b here below); and (ii) it must not itself cause the application as amended to be objectionable under the IP-code, e.g. the amendment must not introduce obscurity (Sec.36.1). If the amendments do not meet these conditions, the applicant should be told that the amended application cannot be allowed. Apart from the amendments referred to above, which are allowed under Sec.49, the applicant may correct obvious errors (see VI, 5.9 here below).
R.907 R.908	3.3 The examiner's first substantive examination action should, as a general rule, cover all objections to the application (but see VI, 3.6 here below). These objections may relate to formal matters (e.g. failure to comply with one or more of the requirements specified in R.407, 415 or 416), to substantive matters (e.g. the subject-matter of the application is not patentable), or to both. Substantive matters should normally be set out first. The letter should be drafted in such a manner as to facilitate re-examination of the amended application and, in particular, to avoid the need for extensive re-reading (see VI, 4.2 here below). The question of unity of invention (Sec.38) should be addressed as early as possible. Concerning the assessment of unity and the procedure to follow in case of lacking unity, reference is made to Sec.38.2, to R.604 to R.611 and to III, 7.
R.909(b)	3.4 For each objection the letter should indicate the part of the application which is deficient and the requirement of the IP code or the IRR which is not met, either by referring to specific Sections or Rules, or by other clear indication; it should also give the reason for any objection where this is not immediately apparent. For example, where prior art is cited and only part of a cited document is relevant, the particular passage relied upon should be identified. If the cited prior art is such as to demonstrate lack of novelty or inventive step in the independent claim or claims, and if consequently there is lack of unity between dependent claims, the applicant should be warned of this situation (see VI, 5.2(i) here below).
R.907(b) R911 R.929	3.5 The letter should include an invitation to the applicant to file his observations, to correct any deficiencies and, if necessary, to submit amendments to the description, claims and drawings. It must also state the period within which the applicant must reply. Failure to reply in due time will cause the application to be deemed withdrawn. 3.6 It is emphasised that the first sentence of VI, 3.3 here above only sets out the general rule. There may be cases in which the application is generally deficient. In these cases the examiner should not carry out a

	detailed examination (R.908), but should send a letter to the applicant informing him of this fact, mentioning the major deficiencies and saying that further examination is deferred until these have been removed by amendment; the letter should specify a period within which the deficiencies must be removed. There may be other cases in which, although a meaningful examination is possible, a fundamental objection arises, e.g. it is clear that certain claims lack novelty and that the statement of claim will have to be drastically recast, or there are substantial amendments which are not allowable for one of the reasons stated in VI, 3.2 here above. In such cases it may be more appropriate to deal with this objection before making a detailed examination; if, e.g. the claims need re-casting, it may be pointless to raise objections to the clarity of some dependent claims as a consequence. However, if there are other major objections these should be dealt with. Generally the examiner should at the first examination stage seek to make the maximum impact with the broad aim of bringing matters to a conclusion (grant or refusal, as the case may be), without any undue delay (R.908). 3.7 When making the full examination, the examiner should concentrate on trying to understand what contribution the invention as defined in the claims adds to the known art. This should normally be sufficiently clear from the application as filed (R.407(1)c)). If it is not, the applicant should be required to elucidate the matter (see II, 4.5); but the examiner should not raise an objection of this kind unless he is convinced it is necessary, since to do so might result in the applicant introducing additional subject-matter and thus offending against the proviso of Sec.49 (see VI, 5.3 to 5.8b here below). 3.8 Although the examiner must bear in mind all the requirements of the IP-code and the IRR, the requirements which are most likely to require attention in the majority of cases are sufficiency of disclosure (see II, 4); clarity, especially of the independent claims (see III, 4); novelty (see IV, 5); and inventive step (see IV, 9). 3.9 The examiner should not require or suggest amendments merely because he thinks they will improve the wording of the claims. A pedantic approach is undesirable; what is important is that the meaning of the claims should be clear. 3.10 It must be emphasised that it is not part of the duty of an examiner to require the applicant to amend the application in a particular way to meet an objection, since the drafting of the application is the applicant's responsibility and he should be free to amend in any way he chooses provided that the amendment removes the deficiency and otherwise satisfies the requirements of the IP-code and the IRR. However, it may sometimes be useful if the examiner suggests at least in general terms an acceptable form of amendment, but if he does so he should make it clear that the suggestion is merely for the assistance of the applicant and that other forms of amendment will be considered.

R.911	3.11 After the action of the examiner, if the same be adverse in any respect, the applicant, if he persists in his application for a patent, must reply thereto and may request re-examination or reconsideration, with or without amendment. In order to be entitled to re-examination or reconsideration, the applicant must make a request therefore in writing, and he must distinctly and specifically point out the supposed errors in the examiner's action. The applicant must respond to every ground of objection and rejection in the prior examiner's action (except that request may be made that objections or requirements as to form, not necessary to further consideration of the claims, be held in abeyance until a claim is allowed), and the applicant's action must appear throughout to be a *bona fide* attempt to advance the case to grant. The mere allegation that the examiner has erred will not be received as a proper reason for such re-examination or reconsideration. In amending an application in response to a rejection, the applicant must clearly point out the patentable inventiveness and novelty which he thinks the claims present, in view of the state of the art disclosed by the references cited or the objections made. He must also show how the amendments avoid such references or objections. To avoid objections under the proviso of Sec.49**,** he should indicate and upon which passages of the application as filed the amendments are based. **4. Further stages of examination** **General procedure**
R.912	4.1 Following the examiner's first letter and the applicant's reply, the examiner re-examines the application taking into account observations or amendments made by the applicant. 4.2 The examiner should apply the same standard of examination in relation to matters of substance at all stages in the processing of an application. However, after the first examination stage, he will not normally need to completely re-read the amended application if he has drafted his first letter in a comprehensive way (see VI, 3.4 here above), but should concentrate on the amendments themselves and any related passages, and on the deficiencies noted in the letter. 4.3 In most cases, the applicant will have made a bona fide attempt (see R.911(b)) to deal with the examiner's objections. There are then two possibilities to consider. The first is that the examiner, having taken account of the observations of the applicant, considers that there is little prospect of progress towards grant and that the application should be refused (Sec.51). In such a case, the examiner should not as a rule refuse immediately but should warn the applicant, e.g. by a short further written action, that the application will be refused unless he can produce further more convincing arguments or makes appropriate amendments within a

	specified time limit. The second and more usual possibility, however, is that the re-examination shows that there is good prospect of bringing the procedure to a positive conclusion in the form of a grant. In these latter cases, if there are still objections that require to be met, the examiner will issue a further written action pointing out the remaining deficiencies of the application. If this re-examination, however, shows that the applicant has not made any real effort to deal with these objections, the examiner should consider recommending the application be refused immediately. However, this would be an exceptional case. 4.4 If the matters are such that the applicant is likely to require time to consider them, it will probably be preferable to deal with them by means of a written action. If, however, there seems to be confusion about points in dispute, e.g. if the applicant seems to have misunderstood the examiner's argument, or if the applicant's own argument is not clear, then it may expedite matters if the examiner proposes an interview (to be requested by the applicant, see VI, 6 here below). On the other hand, if the matters to be resolved are minor, or can quickly and easily be explained and dealt with, then they might be settled more expeditiously by a short written action. Discussion with the applicant or his representative at an interview is more fully considered in VI, 6. 4.5 Similar considerations apply to later stages of re-examination except that, having regard to the principle stated in VI, 2.5 here above, the greater the number of actions which have already taken place, the greater is the likelihood that the most appropriate action is a final rejection or refusal under Sec.51. 4.5a Where the final decision is to refuse the application, care should be taken that the decision does not offend against R.913(b), 2nd sentence. **Examination of amendments** 4.6 Any amendment must satisfy the conditions listed in VI, 3.2 here above. When it was effected must also be established. After publication of the search report and before receipt of the first communication from the substantive examiner, the applicant may, of his own volition, amend the description, claims and drawings, provided a valid request for substantive examination has already been made.
R.911(c)	4.7 After receipt of the first communication from the examiner, the applicant may amend the description, claims and drawings provided that the amendment is filed at the same time as his reply.
R.912(b)	With his reply to the second communication from the substantive examiner

	the applicant may amend again, but any amendment will ordinarily need to be restricted to overcoming the objections raised by the examiner. Other types of amendments will require the consent of the examiner. Giving the examiner this discretion is intended to ensure that the examination procedure is brought to a conclusion in as few actions as possible (see VI, 2.5 here above). If an amendment is allowed, subsequent proceedings are based on the Description, claims and drawings as amended. Consent to an amendment does not necessarily imply that the application as amended is free from any objection under the IP-code and/or IRR. Distinctions should be drawn between different types of amendments: Amendments remedying a deficiency in response to the preceding communication must always be allowed, provided they do not give rise to some new deficiency. Amendments limiting a claim already considered allowable should normally be allowed, as too should those improving the clarity of the description or claims in a manner clearly desirable. A further factor is the amount of alteration to the application documents involved. Extensive reworking of the description or claims may be a proper response to highly relevant further prior art of which the applicant has only just become aware (e.g. either through further citation by the examiner or through knowledge obtained from another source). Regarding less extensive amendments, the examiner should adopt a reasonable approach, trying to balance fairness to the applicant against the need to avoid unnecessary delay and excessive and unjustified additional work for the Office. Any subsequent request to withdraw an amendment is itself a request for further amendment; thus, if this subsequent request occurs after the second communication from the examiner, it will be allowed only if the examiner consents. In exercising his discretion, the examiner should bear in mind the length of the proceedings to date and whether the applicant has already had sufficient opportunity for amendments. He should refuse in particular amendments reintroducing deficiencies previously pointed out to and removed by the applicant. In deleting subject-matter from an application the applicant should avoid any statement which could be interpreted as abandonment of that subject-matter. Otherwise this subject-matter cannot be reinstated. 4.8 Any request by an applicant to replace the text of the application on whose basis a patent could be granted, with one that has been extensively revised should be refused, unless the applicant gives good reasons for proposing the changes only at this stage in the proceedings. This applies particularly in cases where the examiner has indicated that a version of the claims proposed by the applicant is grantable and that the applicant has only to bring the description into line with that version.

	4.9 The Notice of Allowability closes the prosecution on the merits and does not constitute an opportunity for the applicant to call into question the outcome of the earlier procedure (see VI, 15 here below for procedure upon grant). At this stage of the proceedings the substantive examination has already been completed and the applicant has had the opportunity to amend the application and therefore normally only minor amendments which do not appreciably delay the preparations for grant of the patent will be allowed. 4.10 Once the decision to grant has been taken, further amendments or corrections to the granted patent, can only be requested on the basis of Sec.57, 58 or 59. 4.11 Paragraph 4.9 above do not prevent the examiner from resuming the proceedings of his own motion where he becomes aware of circumstances which are such as to render non-patentable the subject-matter claimed. Such circumstances may be brought to the examiner's attention by the applicant or following observations by third parties under Sec.47 and can be considered up to the moment the final decision to grant is taken. In the resumed proceedings, substantive amendments to resolve this problem are possible.
R.912(b) R.927	4.12 If a request for amendment is to be refused under R.912(b), the applicant must first be sent a communication giving the reasons for refusing the amendment. The applicant may then make a petition according to R.927. In the case of a situation as described in e.g. VI, 4.9, the applicant should be invited at the same time to request grant of the patent on the basis of the preceding acceptable version of the documents. If the applicant maintains his request for the amendment, the application must be refused under Sec.51 since, in these circumstances, there is no text of the application which has been agreed by the applicant and allowed by the examiner. 4.13 Reference is made to the IRR, R.911,912,916-927 concerning the provisions relating to amendments of the application documents.
	5. Amendments **Making the amendments**
Sec.49, Proviso R.916, R.919 R.918	5.1 An applicant may amend the patent application during examination, provided that such an amendment does not include new matter outside of the scope of the disclosure contained in the application as filed. The description, claims and drawings must be amended and revised when required, to correct inaccuracies of description and definition or unnecessary prolixity, and to secure correspondence between the claims, the description and the drawings.

R.920 to R.926	The formal considerations relating to the technique of making amendments are set out in R.920 to 926. **Allowability of amendments** 5.2 Amendments can consist of addition, replacement or deletion of features originally present in the claims, the drawings or the description. Legally, the question of allowability of amendments is a question of whether the application as so amended is allowable. An amended application must of course satisfy all the requirements of the IP Code and the IRR including, in particular, inventive step and the other matters listed in VI, 3.8 here above (see also VI, 3.2 here above). Also, however, especially when the claims have been substantially limited, the examiner should bear in mind that the following questions may require special consideration at the amendment stage: (i) **Unity of invention**: Do the amended claims still satisfy the requirements of Sec.38.1? If the documents cited in the search report seem to reveal lack of novelty or inventive step in the concept common to all the claims as filed, but the amended claims do not necessitate further search, the examiner should consider carefully whether objection to lack of unity is justified at this stage of the proceedings (see III, 7). If, however, the amended claims lack a common inventive concept and a further search is necessary, objection should be raised. (ii) **Changing to unsearched subject-matter**: If amended claims are directed to subject-matter which has not been searched (e.g. because it only appeared in the description and the examiner did not find it appropriate to extend the main search to this subject-matter), and which does not combine with the originally claimed and searched invention or group of inventions to form a single general inventive concept, such amendments are not admissible. This applies particularly when this unsearched subject-matter alone is now claimed. Applicants should bear in mind that the examining procedure should be brought to a conclusion in as few actions as possible, thus the examiner may not allow further amendments (R.912, 2nd sentence, R.927). See also VI, 4.7 here above). It is important also to ensure that no amendment adds to the content of the application as filed and thus offends against the proviso in Sec.49 as explained in the following paragraphs.

	Additional subject-matter
Sec.49, proviso R.916 R.919	5.3 There is normally no objection to an applicant introducing, by amendment, further information regarding prior art which is relevant; indeed this may be required by the examiner (see II, 4.4 and 4.18). Nor will the straight-forward clarification of an obscurity, or the resolution of an inconsistency, be objected to (e.g. under Sec.36.1, clarity or under R.918). When, however, the applicant seeks to amend the description (other than references to the prior art), the drawings, or the claims in such a way that subject-matter which extends beyond the content of the application as filed is thereby introduced, the application as so amended cannot be allowed. 5.4 An amendment should be regarded as introducing subject-matter which extends beyond the content of the application as filed, and therefore unallowable, if the overall change in the content of the application (whether by way of addition, alteration or excision) results in the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the application, even when account is taken of matter which is implicit to a person skilled in the art. At least where the amendment is by way of addition, the test corresponds to the test for novelty given in IV, 7.2. Under Sec.49 and R.919 it does not appear to be permissible to add to an application matter present only in the priority document for that application. For correction of errors see VI, 5.9 here below. 5.5 For example, if an application related to a rubber composition comprising several ingredients and the applicant seeks to introduce the information that a further ingredient might be added, then this amendment should normally be objected to as offending against the proviso in Sec.49. Likewise, in an application which described and claimed apparatus "mounted on resilient supports", without disclosing any particular kind of resilient support, objection should be raised if the applicant seeks to add the specific information that the supports are, or could be, e.g. helical springs (see, however, VI, 5.6 here below). 5.6 If, however, the applicant can show convincingly that the subject-matter in question would, in the context of the invention, be so well-known to the person skilled in the art that its introduction could be regarded as an obvious clarification, the amendment may be permitted. For example, in the matter of the rubber composition referred to in VI, 5.5 here above, if the applicant were able to show that the further ingredient which he sought to introduce was, say, a well-known additive normally used in rubber compositions of that kind as an aid to mixing and that its omission would generally be questioned, then its mention would be allowable on the grounds that it merely clarified the description and introduced nothing not already known to the skilled person; however, if the introduction of this additive brought about some special effects not originally disclosed, an amendment mentioning this should not be allowed. Similarly in the above-

	mentioned case of the resilient supports, if the applicant were able to demonstrate that the drawings, as interpreted by the skilled person, showed helical springs, or that the skilled person would only consider helical springs for the mounting in question, the specific mention of helical springs would be allowable. 5.6a Where a technical feature was clearly disclosed in the original application but its effect was not mentioned or not mentioned fully, yet it can be deduced without difficulty by a person skilled in the art from the application as filed, subsequent clarification of that effect in the description does not contravene the proviso of Sec.49. 5.7 Amendment by the introduction of further examples should always be looked at very carefully in the light of the general considerations outlined in paragraphs VI, 5.3 to 5.6a here above, and will not, in general, be admissible. The same applies to the introduction of statements of new (i.e. previously not mentioned) effects of the invention such as new technical advantages: for example, if the invention as originally presented related to a process for cleaning woollen clothing consisting of treating the clothing with a particular fluid, the applicant should not be allowed to introduce later into the description a statement that the process also has the advantage of protecting the clothing against moth damage. 5.7a Under certain circumstances, however, later filed examples or new effects, even if not allowed into the application, may nevertheless be taken into account by the examiner as evidence in support of the patentability of the claimed invention. For instance, an additional example may be accepted as evidence that the invention can be readily applied, on the basis of the information given in the originally filed application, over the whole field claimed (see III, 6.4). Similarly a new effect (e.g. the one mentioned in VI, 5.7 here above) may be considered as evidence in support of inventive step, provided that this new effect is implied by or at least related to an effect disclosed in the originally filed application (see IV, 9.10). 5.7b Any supplementary technical information submitted after the filing date of the application which cannot be incorporated in the application documents as such will be added to the part of the file which is open to public inspection under Sec.44.2. From the date at which the information is added to the open part of the file, it forms part of the state of the art within the meaning of Sec.24.1. 5.7c Care must also be taken to ensure that any amendment to, or subsequent insertion of, a statement of the technical problem solved by the invention meets the proviso of Sec.49. For example it may happen that following restriction of the claims to meet an objection of lack of inventive step, it is desired to revise the stated problem (R.407(c)) mentioned in the description to emphasise an effect attainable by the thus restricted invention but not by the prior art. It must be remembered that such revision

	is only permissible if the effect emphasised is one deducible by a person skilled in the art without difficulty from the application as filed (see VI, 5.6a and 5.7 here above). 5.7d Features which are not disclosed in the description of the invention as originally filed but which are only described in a cross-referenced document which is identified in such description are prima facie not within the content of the application as filed for the purpose of the proviso of Sec.49. It is only under particular conditions that such features can be introduced by way of amendment into the claims of an application. For, example such an amendment would not contravene Sec.49 if the description of the invention as filed leaves no doubt to a skilled reader that protection is or may be sought for such features, that such features contribute to solving the technical problem underlying the invention, that such features at least implicitly clearly belong to the description of the invention contained in the application as filed and thus to the content of the application as filed, and that such features are precisely defined and identifiable within the disclosure of the reference document. 5.8 Alteration or excision of the text, as well as the addition of further text, may introduce fresh subject-matter. For instance, suppose an invention related to a multi-layer laminated panel, and the description included several examples of different layered arrangements, one of these having an outer layer of polyethylene; amendment of this example either to alter the outer layer to polypropylene, or to omit this layer altogether would not normally be allowable. In each case the specific panel disclosed by the amendment example would be quite different from that originally disclosed and hence the amendment would introduce fresh subject-matter and therefore be unallowable. 5.8a The replacement or removal of a feature from a claim may, for example, not contravene the proviso of Sec.49 provided the skilled person would directly and unambiguously recognise that the feature was not explained as essential in the disclosure, it is not, as such, indispensable for the function of the invention in the light of the technical problem it serves to solve, and the replacement or removal requires no real modification of other features to compensate for the change. In case of replacement by another feature: the replacing feature must of course find support in the original application documents, so as not to contravene the proviso of Sec.49. 5.8b However, when the extent of a claim is to be limited because of a coincidental overlap between the prior art and the claimed subject-matter, and the claim's remaining subject-matter cannot be defined more clearly and concisely by positive features, this specific prior art may be excluded by means of a disclaimer.

Correction of errors

5.9 Correction of errors in the application documents is a special case involving an amendment, therefore the requirements of the proviso of Sec.49 apply likewise.

Where the mistake is in the description, claims or drawings, the correction must be obvious in the sense that it is immediately evident (at least once attention is directed to the matter):

(i) that an error has occurred; and

(ii) what the correction should be.

Regarding (i), the incorrect information must be objectively recognisable for a skilled person using common general knowledge from the originally filed application documents (description, claims and drawings) taken by themselves.

Regarding (ii), the correction should be within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the originally filed application documents. Evidence of what was common general knowledge on the date of filing may be furnished in any suitable form.

Such a correction is of a strictly declaratory nature and establishes what a skilled person, using common general knowledge, would already derive on the date of filing from the parts of a patent application, seen as a whole, relating to the disclosure.

Requests for correction can only be considered until the decision to grant a patent or to refuse the application has been taken. Concerning correction of errors in a granted patent, reference is made to Sec.57 and Sec.58.

6. Discussion with the applicant

6.1 In this section the term "applicant" is intended to mean "representative" where he has appointed one. Where the applicant has appointed a representative, the communication should be with that representative.

6.2 According to the IRR, Final Provisions, Sections 1(a)(b), all business with the Office shall be transacted in writing. Actions will be based exclusively on the written record, and no attention will be paid to any alleged oral promise, stipulation or understanding.
Unless otherwise provided, the personal attendance of applicants and

	other persons at the Office is unnecessary. Their business can be transacted by correspondence.
R.905 R.928	6.3 As regards information on any specific technical or scientific matter pending final action by the Bureau, the applicant may, upon request and upon the payment of a fee, request in writing a conference with the examiner, specifying the query he would want to propound to the examiner. The examiner has the discretion to grant the request or to choose to reply to the query in writing. Interviews for the discussion of pending applications shall not be held prior to the first written official action thereon.
	6.4 The circumstances in which it may be appropriate for the examiner accept the request for an interview rather than send a further written action are considered in VI, 4.4 here above. If the applicant requests an interview the request should be granted unless the examiner believes that no useful purpose would be served by such a discussion.
R.928	6.5 When an interview is requested, the matters for discussion should be clearly stated. When granting the request and making the necessary arrangements, the examiner should record the particulars and briefly indicate the matters to be discussed. The interview shall take place within the premises of the Bureau during regular working hours as specified by the examiner.
	6.6 Solely the examiner dealing with the application will normally conduct the interview. It should always be made clear to the applicant that any agreement reached must ultimately be subject to the approval of the examiner's superior.
R.928	6.7 The interview is not a procedure as formal as a hearing before the legal division; it shall nevertheless always be reduced to writing and signed by both the examiner and the applicant immediately after the interview. Such writing shall form part of the records of the Bureau.
	6.8 The recording of the interview depends upon the nature of the matters under discussion. Where the interview is concerned with the clarification of obscurities, the resolution of uncertainties, or putting the application in order by clearing up a number of minor points it will usually be sufficient if the examiner makes a note on the file of the matters discussed and the conclusions reached, or amendments agreed. If, however, the interview is concerned with resolving weightier matters, such as questions of novelty, inventive step, or whether the amendment introduces fresh subject-matter, then a fuller note of the matters discussed should be made in the file.
	6.9 The records of interviews should always indicate whether the next action is due to come from the applicant or the examiner. Pending time limits may be extended.

6.10 If a fresh objection of substance is raised at an interview and no amendment to meet it is agreed at the time, the objection must be confirmed by a letter giving the applicant a fresh period within which he may reply if he so wishes. Otherwise time limits may not be altered as a result of an interview.

7. Work within the examining divisions

7.1 As stated in VI, 1.4 here above, the examiner may seek the advice of other members of the examining division, such as his assistant division chief or division chief, if necessary, at any stage in the examination. Any action processed by the examiner will be checked by his superior(s). With ongoing examination, a point will be reached when it becomes appropriate for the examiner to refer the case formally to his superior. This will arise if he considers that a final action is appropriate, i.e. if it the application is in order to proceed to grant; or, at the other extreme, if there seems no possibility of amendment which would overcome his objections, or if the applicant has made no serious attempt to meet these objections and it therefore appears that the application must be refused. Between these extremes there are other circumstances in which reference to the superiors is appropriate, e.g. an interview may be requested by the applicant because an impasse has been reached.

7.2 If the examiner considers that the application satisfies the requirements of the IP code and the IRR, and is thus in order to proceed to grant he should usually make a brief written report. As a general rule, it will be appropriate in this report for the examiner to give the reasons why, in his opinion, the subject-matter as claimed in the application is not obvious having regard to the state of the art. He should normally comment on the document reflecting the nearest prior art and the features of the claimed invention which make it patentable, although there may be exceptional circumstances where this is not necessary, e.g. where patentability is based on a surprising effect. He should also indicate how any apparently obscure but important points have ultimately been clarified, and if there are any borderline questions which the examiner has resolved in favour of the applicant, he should draw attention specifically to these. The report may be made very brief by including references pointing to the relevant file contents, e.g. applicant's reply etc.

7.3 When referring to his superior an application which is not in order for grant of a patent, the examiner should make a written report which sets out the points at issue, summarises the case history to the extent necessary to enable his superior to obtain a quick grasp of the essential facts, and recommends the action to be taken, e.g. refusal, or grant conditional upon certain further amendments. As the superiors will require to study such cases themselves, there is no need for a detailed exposition. It will be useful however to draw attention to any unusual features or to points not readily apparent from the documents themselves. If the report

	recommends refusal and the issue seems clear cut, the examiner may include with his report a draft reasoned decision for issue by the Office (see VI, 2.5 here above); if the issue is not clear cut, the drafting of the reasoned decision should be deferred until the superior has studied the case. 7.4 When an application is referred to the superior, he will first consider the case and will indicate his opinion on the course of action to be taken. When further action is needed, the substantive examiner will be entrusted with the work. 7.5 The superior should bear in mind that his function generally is not to make a complete re-examination of the application. If, following a discussion, the conclusions of the examiner entrusted with the examination are generally considered to be reasonable, they should be accepted. 7.6 If, in the opinion of the superior, the possibility exists of amending the application to bring it into a form which meets the requirements of the IP code and the IRR, then the examiner should be entrusted with the task of communicating to the applicant that the application should be refused on certain grounds unless satisfactory amendments are submitted within a stated period. If, within the time limit, satisfactory amendments are made, the examiner will then report back to his superior recommending that the application should proceed to grant. If not, he should report back recommending refusal.
Sec.51.2 R.913 IRR Part 13	7.7 If, on the other hand, the examiner and his division chief are satisfied that the applicant has had sufficient opportunity to amend and that all the requirements are still not met, the examiner should issue a final rejection or a decision to refuse the application under Sec.51.1; this decision will normally be drafted by the examiner. The grounds of refusal must be stated and full reasons must be given; refusal may be based only on grounds on which the applicant has had an opportunity to put forward comments. In addition, the applicant's attention must be directed to the provisions for appeal laid down in Sec.51.2, R.913(a)(b), and in Part 13 of the IRR. 7.8 Any decision is issued by the examining division is signed by the examiner and his superior(s).
	8. Searching and the search report **The search report**
Sec.44.1 R.800, R.701.1	8.1 The search report is prepared before the publication of the application and published together with the application. The search report normally is in the form prescribed by R.701.1.

	In cases where the application lacks unity, the search report may relate to more than one invention. In some exceptional cases provided only a incomplete search report will be available. Due to obscurities in the application as filed. 8.2 Assuming that a search has been made and documents cited, there are two special problems that may arise occasionally in respect of such documents. The first is the date of publication of the material in the document; this is dealt with in IV, 5.2 the other problem concerns documents in a foreign language (e.g. Japanese, German or French) . 8.3 The search examiner will cite a document in a foreign language only if he knows or has strong evidence leading him to suspect (e.g. from drawings, from an abstract, or a corresponding patent in English or Filipino), or from a translation produced by himself or some other person familiar with the language of the document) that the document is relevant. The substantive examiner, in his first action, may cite the document on the basis of similar evidence; an abstract or corresponding document in English, if supplied by the search examiner, will also be cited. If, however, the applicant disputes the relevance of the document and gives specific reasons, the examiner should consider whether, in the light of these reasons and of the other prior art available to him, he is justified in pursuing the matter. If so, he may try to obtain from the applicant a translation of the document (or merely the relevant part of it, if that can be easily identified), or at least statements concerning specific questions relating to the disclosure comprised in the document. **Search for conflicting Philippine applications**
Sec.24.2	8.4 As stated in VI, 2.3 here above**,** the examiner will need to make a so-called "topping-up" search for conflicting Philippine applications falling within the area defined by Sec.24.2. This is because the searchable collection of the Philippine applications may not be complete in respect of such material at the time the main search is made. Since priority dates claimed (if any) may not be accorded to all or part of the application but may be accorded to the appropriate part of a conflicting application (see V, 2.1), this search should be extended so as to cover all published Philippine applications filed up to one year or more after the filing of the application under consideration. If the examiner is unable to complete this "topping-up" search at the first examination stage he should ensure that such search is completed before the application is reported to be in order for the grant of a patent. In the cases in which an application is found to be in order before this search can be completed (because of publication delays concerning older, potentially conflicting Philippine applications), the grant of a patent should not be substantially delayed for this reason unless the examiner has knowledge of such a conflicting application which would have to be cited

	against novelty. In this case, publication of the relevant application, should, if possible, be accelerated and the granting of the application in question should be delayed.
	Other additional searches during examination
	8.5 An additional search will sometimes be required either at the first stage of amendment or subsequently. This may arise for a number of reasons. First, an additional search may be necessary where only an incomplete search report (e.g. because of obscure claims) has been issued after the main search, and subsequently the deficiencies which rendered a meaningful or complete search impossible have been corrected by amendment, or successfully refuted by the applicant. An additional search may also be necessary where the claims have been so amended that their scope is no longer covered by the original search. Exceptionally, an additional search may be required if the applicant refuses an acknowledgement of prior art (see IV, 9.5), or if the examiner believes that material relevant to obviousness might be found in technical fields not taken into account during the main search.
	8.6 The substantive examiner is not barred from looking for a relevant document whose existence he knows of or has reason to suspect, if he can retrieve that document in a short time from material available at the Office.
Sec.39 R.612 R.612.1	8.7 In the case of foreign applications, pursuant to Sec.39 and R.612 and 612.1, the applicant will generally be requested to provide copies of relevant documents relating to that foreign application, e.g. search reports, examination reports, and citations. Such requests may be issued during the whole procedure up to grant, depending on the circumstances of the case. See also VI, 2.3a and 2.4a here above.
R.805	8.9 Concerning the formats to be used in citing relevant documents, reference is made to R.805. The references cited should be clearly identified, the relevant passages thereof should be identified as precisely as possible.
	9. Special applications
	Divisional applications
Paris Convention Art.4 G	The Philippines are a signatory state of the Paris Convention. Art.4 G of the Paris Convention reads: *"G. – (1) If the examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.*

	(2) The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized."
Sec.38.2 R.604(b) R.606- R.610 R.611	Sec.38.2 and R.604(b), R.606 to R.610 relate to the first case (requirement for restriction, following a lack of unity objection) and R.611 to the second case (division on own initiative). 9.1 Subsequent to the filing of a patent application, a divisional application may be filed. The divisional application is accorded the same filing date as the parent application, and has the benefit of any right of priority of the parent application in respect of the subject-matter contained in the divisional application. A Philippine application may give rise to more than one divisional application. A divisional application may itself give rise to one or more divisional applications. 9.2 The applicant may file a divisional application of his own volition (voluntary division). The most common reason, however, for filing a divisional application is to meet an objection under Sec.38.1 of lack of unity of invention (mandatory restriction). If the examiner objects to lack of unity, the applicant is allowed a period in which to limit his application to a single invention. Concerning details of the procedure in case of lack of unity objection, reference is made to the provisions of Sec.38.2 and R.604 to 610 and to III, 7. 9.3 Divisional applications may be filed on a pending application before the parent application is withdrawn, abandoned or patented. This means that the mere deletion of subject-matter in an application is not prejudicial to the later filing of a divisional application up to the events mentioned above. When deleting subject-matter the applicant should, however, avoid any statements which could be interpreted as abandonment. The applicant may thus file a divisional application for the subject-matter deleted in the parent application if he wishes to obtain protection for this subject-matter. 9.4 The substantive examination of a divisional application should in principle be carried out as for any other application but the following special points need to be considered. The examination of a divisional examination should normally be carried out as soon as possible by the examiner of the parent application. The claims of a divisional application need not be limited to subject-matter already claimed in claims of the parent application; however the subject-matter may not extend beyond the content of the parent application as filed (see proviso in Sec.38.2). If a divisional application contains subject-matter additional to that contained in the parent application as filed and the applicant is unwilling to remedy this defect by removal of that additional subject-matter, the divisional application must be refused. It cannot be

	converted into an independent application taking its own filing date. Moreover a further divisional application for this additional subject-matter will also be refused. If the divisional application's subject-matter is restricted to only a part of the subject-matter as claimed in the parent application, this subject-matter must be directly and unambiguously derivable as such a separate entity, which could be used outside the context of the invention of the parent application. 9.5 The description and drawings of the parent application and the or each divisional application should in principle be confined to matter which is relevant to the invention claimed in that application. However, the repetition in the description of a divisional application of matter in the parent application need not be objected to unless it is clearly unrelated to or inconsistent with the invention claimed in the divisional application.
Sec.111 R.915	9.6 The parent and divisional applications may not claim the same subject-matter (see IV, 6.4 and e.g. Sec.111 and R.915**)**. This means not only that they must not contain claims of substantially identical scope, but also that one application must not claim the subject-matter claimed in the other, even in different words. The difference between the claimed subject-matter of the two applications must be clearly distinguishable. As a general rule, however, one application may claim its own subject-matter in combination with that of the other application. In other words, if the parent and divisional applications claim separate and distinct elements A and B respectively which function in combination, one of the two applications may also include a claim for A plus B. In such a case, both applications should contain appropriate cross-references which clearly set out the position. **Applications resulting from a court order or decision under Sec.67**
Sec.67	9.7 In certain circumstances, before a patent has been granted on a particular application, it may be adjudged as a result of a final court order or decision that a person other than the applicant is entitled to the grant of a patent thereon. In this event this person may either (**Sec.67.1**): (a) prosecute the application as his own application in place of the applicant, (b) file a new patent application in respect of the same invention, or (c) request that the application be refused. (See also IV, 8).

	9.8 If the other person adopts the first of these alternatives he becomes the applicant in place of the former applicant and the prosecution of the application is continued from the position at which it was interrupted. 9.9 If however the other person files a new application under Sec.67.1(b), the provisions of Sec.38.2 apply to this new application mutatis mutandis. This means that the new application is treated as though it were a divisional application i.e. it takes the date of filing and the benefit of any priority right of the original application. The examiner must therefore ensure that the subject-matter content of the new application does not extend beyond the content of the original application as filed. 9.10 The IP code and the IRR are silent about cases where the original application has been withdrawn or refused or was deemed to be withdrawn and is thus no longer pending. Sec.67.1(b) does not appear to exclude the filing of a new patent application in respect of the same invention in such a case. 9.11 The IP code and the IRR are silent about cases where, by a final court order or decision, it is adjudged that a third party is entitled to the grant of a patent in respect of only part of the matter disclosed in the patent application. It would appear that in such a case, the foregoing considerations apply only to such part of the matter and that - the option of Sec.67.1(a) is not open to the third party and, - regarding the option of Sec.67.1(b), the new application must be confined to that part of the original subject-matter to which he has become entitled; similarly the original application must be confined to the subject-matter to which the original applicant remains entitled. The new application and the amended original application will stand in a relationship to each other similar to that appertaining between two divisional applications, and they will each stand in a relationship to the original application similar to that in which divisional applications stand in relation to the application from which they are divided. The guidance set out in VI, 9.4, 9.5 and 9.6 here above therefore applicable to this situation. **10. Time limits for response to communications from the examiner, requirements on reply**
R.929 R.930	10.1 The general considerations relating to such time limits are set out in R.929 and R.930. The time limit for response to a letter from the examiner should in general be between two months.
R.929(a)	If an applicant fails to prosecute his application within the required time as provided in the IRR, the application shall be deemed withdrawn (R.929(a)).

R.929(b)	10.2 The time limit for reply may be extended only for good and sufficient cause, and for a reasonable time specified. Any such request must be filed on or before the day on which the action by the applicant is due. The examiner may grant a maximum of two extensions, provided that the aggregate period granted including the initial period allowed to file the response, shall not exceed six months from the mailing date of the official action requiring such response (R.929(b)). An extension of the time limit may e.g. be appropriate, for instance, if the applicant resides a long way from his representative and the language of the proceedings (i.e. English, Filipino) is not one to which the applicant is accustomed; or if the subject-matter of the application or the objections raised are exceptionally complicated.
R.929(c)	10.3 Prosecution of an application to save it from the deemed withdrawal must include such complete and proper action as the condition of the case may require. Any reply not responsive to the last official action shall not save the application from being deemed withdrawn (R.929(c)).
R.929(d) R.911(b)	10.4 Such a reply must be a bona fide attempt to deal with all the objections raised by the examiner. When the reply is a bona fide attempt to advance the case, and is a substantially complete response to the examiner's action, but consideration of some matter or compliance with some requirements has been inadvertently been omitted, opportunity to explain and supply the omission may be given. However, if a serious objection raised in the examiner's action has not been dealt with at all and is still applying , the examiner may refuse the application under Sec.51.1 and R.913.
	11. Examination of observations by third parties
Sec.47 R.802	Following the publication of the patent application, any person may present observations concerning the patentability of the invention. Such observations must be filed in writing and must include a statement of the grounds on which they are based. That person shall not be a party to the proceedings before the Bureau of Patents. The statement of grounds must be presented in English or Filipino language. In the context of substantive examination, such observations are only taken into account if a request for examination has been filed. The observations are communicated to the applicant who may comment on them. The Office will acknowledge the receipt of such observation to the third party. The Office will not inform the third party of any further action taken by the Office in response to his observations.

	If, in whole or in part, they call into question the patentability of the invention, they must be taken into account by the examiner until the end of the examination proceedings. If the observations relate to alleged prior art available other than from a document, e.g. from use, this should be taken into account only if the alleged facts are either not disputed by the applicant or proprietor or established beyond reasonable doubt. Observations by third parties received after the conclusion of proceedings will not be taken into account and will simply be added to the file. Since opposition proceedings before the Bureau of Patens are not foreseen by the Code, observations by third parties may be considered as an low-cost way of attacking a potential patent. Petitions to cancel a patent (post grant) are handled by the Bureau of Legal Affairs, Sec.61-66. **12. Oral proceedings** Formal oral hearings before the examiner are not foreseen in the IP code or IRR. Informal interviews/conferences with the examiner are addressed in VI,6 here above. **13. Taking of evidence** 13.1 This section deals only with the kind of evidence most likely to arise in pre-grant proceedings, i.e. written evidence. 13.2 An examiner would not, as a general rule, require evidence to be produced. The primary function of the examiner in proceedings before grant is to point to the applicant any ways in which the application does not meet the requirements of the IP-Code. If the applicant does not accept the view of the examiner, then it is for the applicant to decide whether he wishes to produce evidence in support of his case and, if so, what form that evidence should take. The examiner should afford the applicant a reasonable opportunity of producing any evidence which is likely to be relevant. However, this opportunity would not be given where the examiner is convinced that no useful purpose would be served by it, or that undue delay would result. 13.3 Written evidence could include the supply of information, or the production of a document or of a sworn statement. To take some examples: To rebut an allegation by the examiner of lack of inventive step, the applicant might, in support of his case, supply information as to the technical advantages of the invention. Again he might produce a sworn
R.905 R.928	

	statement, either from himself or from an independent witness, purporting to show that workers in the art have been trying for a long time unsuccessfully to solve the problem with which the invention is concerned, or that the invention is a completely new departure in the relevant art.
R.419 to R.419.4	13.4 Concerning models, reference Is made to the provisions of R.419 to 419.4.
	14. Grant and publication of patent
Sec.50 R.1000	14.1 If the application meets the requirements of the IP code and the IRR, the Office shall grant the patent.
Sec.51.1	14.2 If the examiner considers that the application satisfies the requirements of the IP code and the IRR and is thus in order to proceed to grant he should make a brief written internal report recommending grant. This report may be called a votum. As a general rule, it will be appropriate in this report for the examiner to give the reasons why, in his opinion, the subject-matter as claimed in the application is not obvious having regard to the state of the art. He should normally comment on the document reflecting the nearest prior art, the technical problem solved, and the features of the claimed invention which solve the problem and thus make it patentable. He should also indicate how any major objections have been met, or if they have been withdrawn the reason for this, for example the applicant provided good counter arguments to show that the objection was wrong. If there are any borderline questions which the examiner has resolved in favour of the applicant, he should draw attention to these. The internal report may be made very brief by including references pointing to the relevant file contents, e.g. applicant's reply et
Sec.50.1 Rule 1000	14.3 When an application which is not in order for grant of a patent, despite one or more letters to the applicant and failure by him to meet the objections raised, the application should be refused. The examiner should make a written report which sets out the points at issue, summarises the case history to the extent necessary to enable someone else to obtain a quick grasp of the essential facts, and recommends refusal. It will be useful to draw attention to any unusual features or to points not readily apparent from the documents themselves.
Sec.52.1 R.1002	14.4 An application may only proceed to grant provided that all fees are paid on time. If the required fees for grant and printing are not paid in due time, the application shall be deemed withdrawn.
Sec.52.2 Rule 1003	14.5 The grant of the patent together with other information shall be published in the IPO Gazette within six (6) months.

	14.6 Any interested party may then inspect the complete description, claims and drawings of the patent on file with the Office.