

Republic of the Philippines  
SUPREME COURT  
Manila

EN BANC

G.R. No. L-12426            February 16, 1959

PHILIPPINE LAWYER'S ASSOCIATION, petitioner,

vs.

CELEDONIO AGRAVA, in his capacity as Director of the Philippines Patent Office, respondent.

*Arturo A. Alafriz for petitioner.*

*Office of the Solicitor General Ambrosio Padilla and Solicitor Pacifico P. de Castro for respondent.*

MONTEMAYOR, J.:

This is the petition filed by the Philippine Lawyer's Association for prohibition and injunction against Celedonio Agrava, in his capacity as Director of the Philippines Patent Office.

On May 27, 1957, respondent Director issued a circular announcing that he had scheduled for June 27, 1957 an examination for the purpose of determining who are qualified to practice as patent attorneys before the Philippines Patent Office, the said examination to cover patent law and jurisprudence and the rules of practice before said office. According to the circular, members of the Philippine Bar, engineers and other persons with sufficient scientific and technical training are qualified to take the said examination. It would appear that heretofore, respondent Director has been holding similar examinations.

It is the contention of the petitioner Philippine Lawyer's Association that one who has passed the bar examinations and is licensed by the Supreme Court to practice law in the Philippines and who is in good standing, is duly qualified to practice before the Philippines Patent Office, and that consequently, the act of the respondent Director requiring members of the Philippine Bar in good standing to take and pass an examination given by the Patent Office as a condition precedent to their being allowed to practice before said office, such as representing applicants in the preparation and prosecution of applications for patent, is in excess of his jurisdiction and is in violation of the law.

In his answer, respondent Director, through the Solicitor General, maintains that the prosecution of patent cases "does not involve entirely or purely the practice of law but includes the application of scientific and technical knowledge and training, so much so that, as a matter of actual practice, the prosecution of patent cases may be handled not only by lawyers, but also engineers and other persons with sufficient scientific and technical training who pass the prescribed examinations as given by the Patent Office; . . . that the Rules of Court do not prohibit the Patent Office, or any other quasi-judicial body from requiring further condition or qualification from those who would wish to handle cases before the Patent Office which, as stated in the preceding paragraph, requires more of an application of scientific and technical knowledge than the mere application of provisions of law; . . . that the action taken by the respondent is in accordance with Republic Act No. 165, otherwise known as the Patent Law of the Philippines, which similar to the United States Patent Law, in accordance with which the United States Patent Office has also prescribed a similar examination as that prescribed by respondent. . . .

Respondent further contends that just as the patent law of the United States of America authorizes the Commissioner of Patents to prescribe examinations to determine as to who

practice before the United States Patent Office, the respondent, is similarly authorized to do so by our Patent Law, Republic Act No. 165.

Although as already stated, the Director of Patents, in the past, would appear to have been holding tests or examinations the passing of which was imposed as a required qualification to practice before the Patent Office, to our knowledge, this is the first time that the right of the Director of Patents to do so, specially as regards members of the bar, has been questioned formally, or otherwise put in issue. And we have given it careful thought and consideration.

The Supreme Court has the exclusive and constitutional power with respect to admission to the practice of law in the Philippines<sup>1</sup> and to any member of the Philippine Bar in good standing may practice law anywhere and before any entity, whether judicial or quasi-judicial or administrative, in the Philippines. Naturally, the question arises as to whether or not appearance before the patent Office and the preparation and the prosecution of patent applications, etc., constitutes or is included in the practice of law.

*“The practice of law is not limited to the conduct of cases or litigation in court; it embraces the preparation of pleadings and other papers incident to actions and social proceedings, the management of such actions and proceedings on behalf of clients before judges and courts, and in addition, conveying. In general, all advice to clients, and all action taken for them in matters connected with the law corporation services, assessment and condemnation services contemplating an appearance before a judicial body, the foreclosure of a mortgage, enforcement of a creditor's claim in bankruptcy and insolvency proceedings, and conducting proceedings in attachment, and in matters of estate and guardianship have been held to constitute law practice as do the preparation and drafting of legal instruments, where the work done involves the determination by the trained legal mind of the legal effect of facts and conditions. (5 Am. Jur. p. 262, 263). (Emphasis supplied).*

*Practice of law under modern conditions consists in no small part of work performed outside of any court and having no immediate relation to proceedings in court. It embraces conveyancing, the giving of legal advice on a large variety of subjects, and the preparation and execution of legal instruments covering an extensive field of business and trust relations and other affairs. Although these transactions may have no direct connection with court proceedings, they are always subject to become involved in litigation. They require in many aspects a high degree of legal skill, a wide experience with men and affairs, and great capacity for adaptation to difficult and complex situations. These customary functions of an attorney or counselor at law bear an intimate relation to the administration of justice by the courts. No valid distinction, so far as concerns the question set forth in the order, can be drawn between that part which involves advice and drafting of instruments in his office. It is of importance to the welfare of the public that these manifold customary functions be performed by persons possessed of adequate learning and skill, of sound moral character, and acting at all times under the heavy trust obligations to clients which rests upon all attorneys.” (Moran, Comments on the Rules of Court, Vol. 3 (1953 ed.), p. 665-666, citing In re Opinion of the Justices (Mass.), 194 N.E. 313, quoted in Rhode Is. Bar Assoc. vs. Automobile Service Assoc. (R. I. ) 179 A. 139, 144). (Emphasis ours).*

In our opinion, the practice of law includes such appearance before the Patent Office, the representation of applicants, oppositors, and other persons, and the prosecution of their applications for patent, their oppositions thereto, or the enforcement of their rights in patent cases. In the first place, although the transaction of business in the Patent Office involves the use and application of technical and scientific knowledge and training, still, all such business has to be rendered in accordance with the Patent Law, as well as other laws, including the Rules and Regulations promulgated by the Patent Office in accordance with law. Not only this, but practice before the Patent Office involves the interpretation and application of other laws and legal principles, as well as the existence of facts to be established in accordance with the law of

evidence and procedure. For instance: Section 8 of our Patent Law provides that an invention shall not be patentable if it is contrary to public order or morals, or to public health or welfare. Section 9 says that an invention shall not be considered new or patentable if it was known or used by others in the Philippines before the invention thereof by the inventor named in any printed publication in the Philippines or any foreign country more than one year before the application for a patent therefor, or if it had been in public use or on sale in the Philippines for more than one year before the application for the patent therefor. Section 10 provides that the right to patent belongs to the true and actual inventor, his heirs, legal representatives or assigns. Section 25 and 26 refer to connection of any mistake in a patent. Section 28 enumerates the grounds for cancellation of a patent; that although any person may apply for such cancellation, under Section 29, the Solicitor General is authorized to petition for the cancellation of a patent. Section 30 mentions the requirements of a petition for cancellation. Section 31 and 32 provide for a notice of hearing of the petition for cancellation of the patent by the Director of Patents in case the said cancellation is warranted. Under Section 34, at any time after the expiration of three years from the day the patent was granted, any person patent on several grounds, such as, if the patented invention is not being worked in the Philippines on a commercial scale, or if the demand for the patented article in the Philippines on a commercial scale, or if the demand for the patented article in the Philippines is not being met to an adequate extent and reasonable terms, or if by reason of the patentee's refusal to grant a license on reasonable terms or by reason of the condition attached by him to the license, purchase or use of the patented article or working of the patented process or machine of production, the establishment of a new trade or industry in the Philippines is prevented; or if the patent or invention relates to food or medicine or is necessary to public health or public safety. All these things involve the applications of laws, legal principles, practice and procedure. They call for legal knowledge, training and experience for which a member of the bar has been prepared.

In support of the proposition that much of the business and many of the act, orders and decisions of the Patent Director involve questions of law or a reasonable and correct evaluation of facts, the very Patent Law, Republic Act No. 165, Section 61, provides that:

“ . . . The applicant for a patent or for the registration of a design, any party to a proceeding to cancel a patent or to obtain a compulsory license, and any party to any other proceeding in the Office may appeal to the Supreme Court from any final order or decision of the director.”

In other words, the appeal is taken to this Tribunal. If the transaction of business in the Patent Office and the acts, orders and decisions of the Patent Director involved exclusively or mostly technical and scientific knowledge and training, then logically, the appeal should be taken not to a court or judicial body, but rather to a board of scientists, engineers or technical men, which is not the case.

Another aspect of the question involves the consideration of the nature of the functions and acts of the Head of the Patent Office.

“ . . . The Commissioner, in issuing or withholding patents, in reissues, interferences, and extensions, exercises quasi-judicial functions. Patents are public records, and it is the duty of the Commissioner to give authenticated copies to any person, on payment of the legal fees. (40 Am. Jur. 537). (Emphasis supplied).

. . . . The Commissioner has the only original initiatory jurisdiction that exists up to the granting and delivering of a patent, and it is his duty to decide whether the patent is new and whether it is the proper subject of a patent; and his action in awarding or refusing a patent is a *judicial function*. In passing on an application the commissioner should decide not only questions of law, but also *questions of fact*, as whether there has been a prior public use or sale of the article invented. . . .” (60 C.J.S. 460) (Emphasis supplied).

The Director of Patents, exercising as he does judicial or quasi-judicial functions, it is reasonable to hold that a member of the bar, because of his legal knowledge and training, should be allowed to practice before the Patent Office, without further examination or other qualification. Of course, the Director of Patents, if he deems it advisable or necessary, may require that members of the bar practicing before him enlist the assistance of technical men and scientist in the preparation of papers and documents, such as, the drawing or technical description of an invention or machine sought to be patented, in the same way that a lawyer filing an application for the registration of a parcel of land on behalf of his clients, is required to submit a plan and technical description of said land, prepared by a licensed surveyor.

But respondent Director claims that he is expressly authorized by the law to require persons desiring to practice or to do business before him to submit an examination, even if they are already members of the bar. He contends that our Patent Law, Republic Act No. 165, is patterned after the United States Patent Law; and of the United States Patent Office in Patent Cases prescribes an examination similar to that which he (respondent) has prescribed and scheduled. He invites our attention to the following provisions of said Rules of Practice:

*“Registration of attorneys and agents.* — A register of an attorneys and a register agents are kept in the Patent Office on which are entered the names of all persons recognized as entitled to represent applicants before the Patent Office in the preparation and prosecution of applicants for patent. Registration in the Patent Office under the provisions of these rules shall only entitle the person registered to practice before the Patent Office.

(a) *Attorney at law.* — Any attorney at law in good standing admitted to practice before any United States Court or the highest court of any State or Territory of the United States who fulfills the requirements and complied with the provisions of these rules may be admitted to practice before the Patent Office and have his name entered on the register of attorneys.

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(c) *Requirement for registration.* — No person will be admitted to practice and register unless he shall apply to the Commissioner of Patents in writing on a prescribed form supplied by the Commissioner and furnish all requested information and material; and shall establish to the satisfaction of the Commissioner that he is of good moral character and of good repute and possessed of the legal and scientific and technical qualifications necessary to enable him to render applicants for patent valuable service, and is otherwise competent to advise and assist him in the presentation and prosecution of their application before the Patent Office. In order that the Commissioner may determine whether a person seeking to have his name placed upon either of the registers has the qualifications specified, satisfactory proof of good moral character and repute, and of sufficient basic training in scientific and technical matters must be submitted and an examination which is held from time to time must be taken and passed. The taking of an examination may be waived in the case of any person who has served for three years in the examining corps of the Patent Office.”

Respondent states that the promulgation of the Rules of Practice of the United States Patent Office in Patent Cases is authorized by the United States Patent Law itself, which reads as follows:

*“The Commissioner of Patents, subject to the approval of the Secretary of Commerce may prescribe rules and regulations governing the recognition of agents, attorneys, or other persons representing applicants or other parties before his office, and may require of such persons, agents, or attorneys, before being recognized as representatives of applicants or other persons, that they shall show they are of good moral character and in good repute, are possessed of the necessary qualifications to enable them to render to applicants or other persons valuable service, and are likewise to*

*competent to advise and assist applicants or other persons in the presentation or prosecution* of their applications or other business before the Office. The Commissioner of Patents may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case from further practice before his office any person, agent or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who refuses to comply with the said rules and regulations, or who shall, with intent to defraud in any matter, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the office, by word, circular, letter, or by advertising. The reasons for any such suspension or exclusion shall be duly recorded. The action of the Commissioner may be reviewed upon the petition of the person so refused recognition or so suspended by the district court of the United States for the District of Columbia under such conditions and upon such proceedings as the said court may by its rules determine.” (Emphasis supplied)

Respondent Director concludes that Section 78 of Republic Act No. 165 being similar to the provisions of law just reproduced, then he is authorized to prescribe the rules and regulations requiring that persons desiring to practice before him should submit to and pass an examination. We reproduce said Section 78, Republic Act No. 165, for purposes of comparison:

“SEC. 78. *Rules and regulations.* — The Director subject to the approval of the Secretary of Justice, shall promulgate the necessary rules and regulations, not inconsistent with law, for the conduct of all business in the Patent Office.”

The above provisions of Section 78 certainly and by far, are different from the provisions of the United States Patent Law as regards authority to hold examinations to determine the qualifications of those allowed to practice before the Patent Office. While the U.S. Patent Law authorizes the Commissioner of Patents to require attorneys to show that they possess the necessary qualifications and competence to render valuable service to and advise and assist their clients in patent cases, which showing may take the form of a test or examination to be held by the Commissioner, our Patent Law, Section 78, is silent on this important point. Our attention has not been called to any express provision of our Patent Law, giving such authority to determine the qualifications of persons allowed to practice before the Patent Office.

Section 551 of the Revised Administrative Code authorizes every chief of bureau to prescribe forms and make regulations or general orders not inconsistent with law, to secure the harmonious and efficient administration of his branch of the service and to carry into full effect the laws relating to matters within the jurisdiction of his bureau. Section 608 of Republic Act 1937, known as the Tariff and Customs Code of the Philippines, provides that the Commissioner of Customs shall, subject to the approval of the Department Head, make all rules and regulations necessary to enforce the provisions of said code. Section 338 of the National Internal Revenue Code, Commonwealth Act No. 466 as amended, states that the Secretary of Finance, upon recommendation of the Collector of Internal Revenue, shall promulgate all needful rules and regulations for the effective enforcement of the provisions of the code. We understand that rules and regulations have been promulgated not only for the Bureau of Customs and Internal Revenue, but also for other bureaus of the Government, to govern the transaction of business in and to enforce the law for said bureaus.

Were we to allow the Patent Office, in the absence of an express and clear provision of law giving the necessary sanction, to require lawyers to submit to and pass on examination prescribed by it before they are allowed to practice before said Patent Office, then there would be no reason why other bureaus specially the Bureau of Internal Revenue and Customs, where the business in the same area are more or less complicated, such as the presentation of books of accounts, balance sheets, etc., assessments exemptions, depreciation, these as regards the Bureau of Internal Revenue, and the classification of goods, imposition of customs duties, seizures, confiscation, etc., as regards the Bureau of Customs, may not also require that any

lawyer practicing before them or otherwise transacting business with them on behalf of clients, shall first pass an examination to qualify.

In conclusion, we hold that under the present law, members of the Philippine Bar authorized by this Tribunal to practice law, and in good standing, may practice their profession before the Patent Office, for the reason that much of the business in said office involves the interpretation and determination of the scope and application of the Patent Law and other laws applicable, as well as the presentation of evidence to establish facts involved; that part of the functions of the Patent director are judicial or quasi-judicial, so much so that appeals from his orders and decisions are, under the law, taken to the Supreme Court.

For the foregoing reasons, the petition for prohibition is granted and the respondent Director is hereby prohibited from requiring members of the Philippine Bar to submit to an examination or tests and pass the same before being permitted to appear and practice before the Patent Office. No costs.

*Paras, C.J., Bengzon, Padilla, Reyes, A., Bautista Angelo, Labrador, Concepcion, Reyes, J.B.L. and Endencia, JJ., concur.*

**Footnotes:**

<sup>1</sup> In re: Albino Cunanan, 50 Off. Gaz. m, 1617, prom. March 18, 1954.