



OFFICE OF THE DIRECTOR GENERAL

DEBASISH MUKHOPADHYAY,
Applicant-Appellant,

-versus-

DIRECTOR OF THE BUREAU
PATENTS,
Respondent-Appellee.

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Appeal No. 01-2011-0001

Application No. 1-1999-00306
Date Filed: 17 February 1999

For: Method and Apparatus for High
Efficiency Reverse Osmosis
Operation

DECISION

Debasish Mukhopadhyay ("Appellant") appeals the decision of the Director of the Bureau of Patents ("Director") upholding the final rejection of the Appellant's Patent Application No. 1-1999-00306 for a method and apparatus for high efficiency reverse osmosis operation.

Records show that the Appellant filed the patent application on 17 February 1999. Subsequently, the Examiner-in-Charge ("Examiner") issued an official action stating the following:

"Claim for priority date under Section 31 of R. A. 8293 is denied for failure of the applicant to file the present application and the corresponding home application within the prescribed period.

Reference cited:

WO 98/06483 Debasish Mukhopadhyay 01/19/1998

Claims 1-121 are rejected for lacking novelty over WO 98/06483, the corresponding PCT application, which was published by the PCT before the date of filing of the present application in the Philippines. Since the cited reference is a corresponding foreign application of the present invention, present application already fails to achieve the degree of novelty required by the Rules since all the essential features of present invention are already disclosed in said published foreign application.

Claims 1-121 of the present invention are rejected for failure to attain the degree of novelty required in Rule 203 of the Implementing Rules and Regulations."¹

In response, the Appellant filed a letter dated 14 April 2004 stating that he did not intend to claim for priority date and that the claims of the patent

¹ Paper No. 10 received by the Appellant on 17 February 2004.

application are novel as the publication cited is a non-prejudicial disclosure under Sec. 25 of the Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"). The Appellant maintained that the cited publication is considered a disclosure by the inventor.

The Examiner issued another official action reiterating his rejection of the Appellant's claims on the patent application on the ground that the cited publication is considered prior art. The Appellant filed a letter dated 14 October 2005 maintaining that WO 98/06483 is a non-prejudicial disclosure which should not prejudice him considering that the publication was made during the twelve (12) months preceding the filing date of the patent application.

The Examiner issued Paper No. 14 which finally rejected the Appellant's patent application. The Appellant appealed to the Director who sustained the Examiner's final rejection. Hence, this appeal.

The Appellant maintains that the Director erred in holding that WO 98/06483 is a prejudicial disclosure. The Appellant claims that this cited publication is a non-prejudicial disclosure either by the inventor or a third party.

On 07 March 2011, this Office issued an Order giving the Director thirty (30) days from receipt of the Order to submit comment on the appeal. The Director did not file his comment and this case was deemed submitted for decision.

The main issue in this case is whether the Director was correct in rejecting the Appellant's patent application.

The Appellant's patent application was rejected on the ground of lack of novelty. The Appellant, however, maintains that the cited publication of the foreign application that corresponds to his patent application is a non-prejudicial disclosure that shall not affect the novelty of his invention.

The appeal is not meritorious.

Sec. 21 of the IP Code provides that patentable inventions refer to 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 foregoing. The law on patents, thus, requires that the invention must be new or novel.

An invention shall not be considered new if it forms part of a prior art.² Prior art shall consist of everything which has been made available to the

² Intellectual Property Code, s 23.

public anywhere in the world, before the filing date or the priority date³ of the application claiming the invention.⁴

The records show that the patent application was filed in the IPOPHL on 17 February 1999. However, prior to the filing of this application, the World Intellectual Property Organization (WIPO) published on 19 February 1998, a patent application filed by the Appellant pursuant to the provisions of the Patent Cooperation Treaty (PCT).⁵ This PCT application corresponds and has similar claims as the application filed by the Appellant in the IPOPHL. Accordingly, the WIPO publication forms part of a prior art which makes the Appellant's patent application not new, and therefore, not patentable.

The Appellant's contention that the publication in the WIPO falls under the provision on non-prejudicial disclosure under the IP Code is not tenable. Sec. 25 of the IP Code states that:

SEC. 25. Non-Prejudicial Disclosure.- 25.1. The disclosure of information contained in the application during the twelve (12) months preceding the filing date or the priority date of the application shall not prejudice the applicant on the ground of lack of novelty if such disclosure was made by:

- (a) The inventor;
- (b) A patent 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
- (c) A third party which obtained the information directly or indirectly from the inventor.

25.2. For the purposes of Subsection 25.1, "inventor" also means any person who, at the filing date of application, had the right to the patent.

Sec. 25 of the IP Code allows instances where the disclosure of information during the twelve (12) months preceding the filing date of the

³ The Paris Convention for the Protection of Industrial Property provides that an applicant who filed an application in one country party to the Convention is entitled to claim priority for a period of twelve months and the filing date of that first application is considered the "priority date." (Article 4). Therefore, when that applicant applies for protection in other member countries (of the Paris Convention) during those twelve months, the filing date of the first application is considered to have "priority" over other applications filed after that date. In such a case, the applicant will still succeed in being the first-to-file in other member countries, even if there are other applications filed before the filing date of the application in those countries. The Philippines and the United States are both signatories to the Paris Convention.

⁴ Intellectual Property Code, s 24.

⁵ The PCT makes it possible to seek patent protection for an invention simultaneously in each of a large number of countries by filing an international patent application. Such an application may be filed by anyone who is a national or resident of a PCT contracting State. It may generally be filed with the national patent office of the contracting State of which the applicant is a national or resident or, at the applicant's option, with the International Bureau of WIPO in Geneva.

patent application shall not prejudice the applicant. Under this provision, the following disclosures during the twelve (12) months preceding the filing date or priority date of a patent application are not novelty destroying if made by:

1. the inventor;
2. a patent office and the information should not have been disclosed by the patent office; and
3. a third party which obtained the information directly or indirectly from the inventor.

Sec. 25 is an exemption to the general rule on novelty and prior art provided under Sections 23 and 24 of the IP Code. Therefore, Sec. 25 of the IP Code must be strictly construed. Under the rules of statutory construction, exceptions, as a general rule, should be strictly, but reasonably construed, should be extended only so far as their language fairly warrants, and all doubts should be resolved in favor of the general provisions rather than the exception.⁶

In this case, the publication by the WIPO of the Appellant's PCT application is not among the enumeration in Sec. 25 which can be considered a non-prejudicial disclosure or a disclosure that will not prejudice the Appellant's patent application. The general rule on determining the novelty of a patent application must, therefore, be applied. In other words, the WIPO publication of the Appellant's PCT application forms part of the prior art that makes the Appellant's invention not patentable for lack of novelty.

As correctly discussed by the Director:

"In the case before us, the earliest foreign application was filed on 12 August 1997 in the US. Applicant has twelve (12) months or until 12 August 1997 (sic) to file his application in a country which recognizes the Paris Convention and where applicant wants to protect his invention. However, applicant belatedly filed his Philippine application on 17 February 1999, thus, forfeiting, his right to the priority date of the US application. Consequently, the filing date of this Philippine patent application is 17 February 1999. However, on this date, an earlier patent application pertaining to the same invention has already been published by the WIPO (publication date: 19 February 1998, WO 98/06483). This publication by the WIPO is prejudicial to applicant's Philippine application and rightfully considered by the Examiner as "prior art" pursuant to Section 24 of the IP Code which provides:

"SECTION 24. Prior Art.- Prior art shall consist of:

24.1. Everything which has been made available to the public anywhere in the world, before the filing date or the priority date of the application claiming the invention;

xxx" (emphasis supplied)⁷

⁶ Rufus B. Rodriguez, *Statutory Construction*, page 309 (1994, 1999).

⁷ Decision dated 18 January 2011, pp. 4-5.

Moreover, the exclusion of the publications by the WIPO of PCT applications from the enumeration of non-prejudicial disclosures under Sec. 25 was expressly provided in a Memorandum Circular issued by the IPOPHL which states in part that:

1. The term "third party" as used in the phrase "third party which obtained information directly or indirectly from the inventor" appearing in Section 25.1, item (c) of the IP Code, excludes all patent offices as well as the WIPO which publishes patent applications filed through the PCT.⁸

In addition, prior art shall consist of the whole contents of corresponding foreign applications disclosing substantially the same invention, or a description thereof, published before the filing date of the application. Inventions are considered substantially the same if the composition of all important particulars, excluding mere formal, unimportant or obvious variations, define the invention.⁹ In this instance, there is no dispute that the claims in the Appellant's patent application are substantially the same as the claims of the invention in the WIPO publication cited by the Examiner.

The granting of patent protection is a privilege allowing a temporary monopoly as a reward for the innovation made. The protection is given in exchange for the disclosure of the invention resulting from the innovation. If a disclosure of the invention has already been made, then the system of patent protection is not anymore necessary.

WHEREFORE, premises considered, the instant appeal is hereby DISMISSED. Let a copy of this Decision be furnished to the Director of the Bureau of Patents and the library of the Documentation, Information and Technology Transfer Bureau for information, guidance, and records purposes.

SO ORDERED.

SEP 02 2013 Taguig City.


RICARDO R. BLANCAFLOR
Director General

⁸ Memorandum Circular No. 4, Series of 2002.

⁹ The Revised Implementing Rules and Regulations for Patents, Utility Models, and Industrial Designs, Rule 204 (c).