

IPOPHL Establishes Temporary Guidelines on Payment of Filing Fees for Patent Applications

Authors: *Mark Leo P. Bejemino | Edward King L. Chua*

Last year, the Philippine Intellectual Property Office (“IPOPHL”) issued the Revised Implementing Rules and Regulations for Invention, Utility Models, and Industrial Designs (“Revised IRR”), which introduced several amendments, one of which is the removal of the one (1) month grace period to pay the filing fees. Under the Revised IRR, payment of the filing fee, excess claims fee, priority claim fee, and the first publication fee (collectively, the “required fees”) must be made at the time of filing of the application. Otherwise, the application shall not be considered as a *bona fide* application and shall be deemed a failed application.

However, IPOPHL’s external payment gateway partners have not adapted their payment facilities to implement this requirement and continued to accept payment of the required fees up until one (1) week from filing. This results in the assignment of application numbers even though the application is already a failed application.

To address this discrepancy, the IPOPHL issued on 29 May 2023 IPOPHL Memorandum Circular No. 2023-014 which provides the following guidelines regarding the payment of the required fees:

1. Full payment of the required fees shall still be mandatory in filing the application and to be accorded a filing date.
2. If the application does not include the required fees, the filing date will be the date when the required fees are actually paid which must be within one (1) week from the date on which the application was initially submitted to the IPOPHL. Otherwise, the application shall be considered to have failed and a Notice of Failed Application shall be issued.
3. If the application is submitted on the last day to claim priority but the required fees are paid afterwards even within the one-week period, a later filing date shall be accorded and the claim of priority shall be lost.
4. If the required fees are not paid within the one-week period, the application shall be considered to have failed and a Notice of Failed Application shall be issued.
5. A strict implementation of the rule requiring payment of the required fees at the time of or within 24 hours from filing the application shall be temporarily suspended until the external online payment gateway systems are aligned with the Revised IRR.

The foregoing guidelines shall take effect prospectively beginning 01 July 2023.

It is not clear from IPOPHL Memorandum Circular No. 2023-014 if the temporary guidelines shall also apply to applications filed through the Patent Cooperation Treaty (“PCT”). Last year, the Bureau of Patents issued BOP Memorandum Circular 2022-004 which amended the Philippine Rules on PCT Applications to align it with the Revised IRR. Under the amended Philippine Rules on PCT Applications, the filing fees must be paid on the date of entry into the national phase of a PCT application. Otherwise, the application shall be considered a failed application.