



IPOPHL MEMORANDUM CIRCULAR NO. 2019 024  
Series of 2019

**SUBJECT: Amendments to the Rules and Regulations on Inter Partes Proceedings**

**WHEREAS**, the Intellectual Property Office of the Philippines (“IPOPHL”) aims to provide speedy, quality and effective legal remedies to resolve IP disputes;

**WHEREAS**, to achieve the aforementioned goal, the Bureau of Legal Affairs (“BLA”) continuously reviews and streamlines its operations, systems, processes and procedures;

**WHEREAS**, the IPOPHL adopted a policy requiring all inter partes cases to be submitted to mediation;

**NOW, THEREFORE**, pursuant to the authority of the Director General under Sections 7.1 and 10.3 of RA 8293, also known as the Intellectual Property Code of the Philippines, as amended (“IP Code”), the rules on expedited proceeding for trademark opposition and cancellation cases are hereby promulgated, as follows:

SECTION 1. Rule 2, Section 5 is hereby amended, as follows:

Section 5. Modes of **FILING AND SERVICE**. –

(a) **FILING AND SERVICE OF PLEADINGS, MOTIONS, MANIFESTATIONS, SERVICE OF** interlocutory orders, notices, summons and other processes shall be **MADE personally, OR VIA COURIER, OR BY** registered mail, or other similar means as the Director General may deem appropriate. **THESE MODES OF FILING AND SERVICE APPLY ALSO TO DELIVERY OF COPIES OF DECISIONS AND FINAL ORDERS SUBJECT TO RULE 9.**

(b) **IF A PARTY, COUNSEL OF RECORD OR REPRESENTATIVE OF RECORD REFUSES TO RECEIVE A COPY OF THE NOTICE TO ANSWER AND OTHER INTERLOCUTORY ORDERS ISSUED BY THE BUREAU; OR HAS MOVED OUT OF THE ADDRESS WITHOUT INFORMING THE OFFICE OF THE NEW ADDRESS; OR THE ADDRESS PROVIDED IS INCOMPLETE, THE BUREAU SHALL POST THE NOTICE TO ANSWER AND OTHER INTERLOCUTORY ORDERS IN THE IPOPHL WEBSITE. THE CONCERNED PARTY SHALL HAVE THE PERIOD PRESCRIBED IN THE NOTICE TO ANSWER OR INTERLOCUTORY ORDER TO COMPLY WITH THE ORDER, RECKONED FROM THE DATE OF POSTING IN THE WEBSITE.**

SECTION 2 .Rule 2 Section 7 (a) is hereby amended, to read:

Section 7. Filing Requirements for Opposition and Petition. — xxx

- (a) The opposition or petition must be in writing, verified and accompanied by a certification of non- forum shopping, and in due form as prescribed by these Rules. The opposer or petitioner shall file only the original of the opposition or petition, with proof of service to the respondent or representative/agent on record. The periods to file the opposition or petition are provided in the succeeding rules.

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SECTION 3. Rule 2 Section 7 is hereby amended by including new subsections (d) and (e), to read:

**Section 7. Filing Requirements for Opposition and Petition. — x xx**

**(D) UNLESS OTHERWISE REQUIRED BY THE BUREAU OF LEGAL AFFAIRS (BLA) FOR OTHER FILINGS WITH IT OR EXEMPTED FROM THIS REQUIREMENT, PDF AS WELL AS WORD FILES OF ALL PLEADINGS, TOGETHER WITH THE PDF FILES OF ALL SUPPORTING DOCUMENTS STORED IN A FLASH DRIVE, SHALL ALSO BE FILED.**

**(E) FILINGS WHICH ARE NOT IN COMPLIANCE WITH THESE RULES, MAY BE REJECTED WITHIN FIFTEEN (15) DAYS AFTER FILING OR ACTUAL RECEIPT BY THE BUREAU. IF REJECTED, THE BUREAU SHALL ISSUE AN ORDER WITH AN INDICATION OF THE DEFICIENCIES THEREIN. THE PARTY CONCERNED WILL BE GIVEN A PERIOD OF FIVE (5) DAYS WITHIN WHICH TO COMPLY WITH THE ORDER TO COMPLY WITH SUCH DEFICIENCIES. REJECTION OF SUCH PLEADINGS AND DOCUMENTS IS NOT A BAR TO THE RE-SUBMISSION OF THE SAME WITH THE BUREAU PROVIDED THAT THE SAME IS FILED WITHIN THE PERIOD TO FILE THE OPPOSITION OR CANCELLATION CASE. ACCEPTANCE OF A PLEADING OR DOCUMENT FOR FILING IS NOT A DETERMINATION THAT THE PLEADING OR DOCUMENT COMPLIES WITH ALL THE REQUIREMENTS OF THE BUREAU AND IS NOT A WAIVER OF SUCH REQUIREMENTS.**

SECTION 4. Rule 2 Section 7 (b) is hereby amended, to read:

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- (a) The documentary or object evidence, which must be duly-marked starting from Exhibit "A", and other supporting documents mentioned in the notice of opposition or petition together with the translation in English, if not in the English language. The verification and certification of non-forum shopping as well as the documents showing the authority of the signatory or signatories thereto, affidavits and other supporting documents, if executed and notarized abroad, must have been authenticated by the appropriate Philippine diplomatic or consular office **OR APOSTILLIZED BY THE APPROPRIATE AUTHORITY OF THE**



**MEMBER COUNTRIES.** The execution and authentication **OR APOSTILLE** of these documents must have been done before the filing of the case. For purposes of filing an opposition, however, the authentication **OR APOSTILLE** may be secured after the filing of the case provided that the execution of the documents aforementioned are done prior to such filing and provided further, that the authentication **OR APOSTILLE** must be submitted before the issuance of the order of default or conduct of the preliminary conference under Section 14 of this Rule. [*as amended by Memorandum Circular No. 7 (2016)*]

SECTION 5. Rule 2, Section 8 (c) is hereby amended, as follows:

Section 8. x xx

(c) The opposer, including those who file a motion for extension of time to file notice of opposition, or the petitioner shall be given a period of five (5) days from receipt of the order to comply or to cure any of the following defects:

- (1) Non-payment in full or in part of the filing fees and other applicable fees;
- (2) Failure to attach any of the following documents:
  - (i) Verification;
  - (ii) Certification of non-forum shopping.
- (3) Special Power of Attorney of representative(s) who signed the pleadings, the verification and the certification of non-forum shopping; and the proof of the authority to issue or execute the Special Power of Attorney; and
- (4) **FAILURE TO ATTACH TO THE OPPOSITION OR PETITION THE ORIGINALS OF THE ABOVEMENTIONED DOCUMENTS.**

The 5 [~~10~~]day period to complete or cure the defects in the filing may be extended for another 5 days upon motion by the opposer or petitioner based on meritorious grounds which shall be explicitly stated in the motion, and upon payment of the applicable fees. A second 5-day extension may be granted based on the aforementioned condition.

No further extension shall be allowed.

Failure to complete or cure the defect shall cause the dismissal of the case. The Director or Assistant Director shall issue the final order of dismissal; **PROVIDED, THAT THE FINAL ORDER ISSUED BY THE ASSISTANT DIRECTOR IS APPEALABLE TO DIRECTOR IN ACCORDANCE WITH RULE 9.**

SECTION 6. Rule 2, Section 9 (a) is hereby amended, as follows:

(a) The respondent must file a verified answer within 30 days from receipt of a copy of the Notice to Answer, with proof of service thereof to the opposer or petitioner. The respondent shall attach to the answer the affidavits of witnesses

and other documentary or object evidence, which must be duly-marked starting from Exhibit "1". The verification and the documents showing the authority of the signatory thereto, the affidavits and other pertinent documents, if executed and notarized abroad, must **HAVE BEEN APOSTILLIZED BY THE APPROPRIATE AUTHORITY OF THE MEMBER COUNTRIES, OR** authenticated by the Philippine diplomatic or consular office **IN APPROPRIATE CASES**. The execution, authentication **AND APOSTILIZATION** of these documents must have been done before the filing of the answer. **FOR PURPOSES OF FILING THE ANSWER, HOWEVER, THE AUTHENTICATION OR APOSTILIZATION MAY BE SECURED AFTER THE FILING OF THE ANSWER PROVIDED THAT THE EXECUTION OF THE DOCUMENTS AFOREMENTIONED ARE DONE PRIOR TO SUCH FILING AND PROVIDED FURTHER, THAT THE AUTHENTICATION OR APOSTILIZATION MUST BE SUBMITTED BEFORE THE CONDUCT OF THE PRELIMINARY CONFERENCE UNDER SECTION 14 OF THIS RULE.**

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- (b) The respondent shall be given a period of five (5) days from receipt of the order to comply or to cure any of the following defects:
- (1) Non-payment in full or in part of the applicable fees, for motions for extension to file answer;
  - (2) Failure to attach any of the following documents:
    - (i) Verification;
    - (ii) Special Power of Attorney of representative(s) who signed the pleadings, the verification and the proof of the authority to issue or execute the Special Power of Attorney; and
  - (3) **FAILURE TO ATTACH TO THE ANSWER THE ORIGINALS OF THE ABOVEMENTIONED DOCUMENTS.**

The 5 day period to complete or cure the defects in the filing may be extended for another 5 days upon motion by the respondent based on meritorious grounds which shall be explicitly stated in the motion, and upon payment of the applicable fees. A second 5-day extension may be granted based on the aforementioned condition.

No further extension shall be allowed.

SECTION 7. Rule 2, Section 11 is hereby amended, as follows:

Section 11. **SUBMISSION** to Alternative Dispute Resolution. – If the Answer is filed on time and/or the defects are completed or cured, the case shall be **SUBMITTED** to the Alternative Dispute Resolution ("ADR") in accordance with the applicable IOPHL rules.

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SECTION 8. Rule 2, Section 14 is hereby amended, as follows:

Section 14. **ASSIGNMENT**/Raffle of Cases; Preliminary Conference.-

- (a) If the respondent is in default, or if the case is not resolved or dismissed through ADR, the Director, **OR IN HIS ABSENCE THE** Assistant Director shall **ASSIGN OR** raffle the case to the Hearing Officer/Adjudication Officers.

Section 9. Section 14, Rule 2 is hereby amended by including a new subsection (d), to read:

**Section 14. Raffle of Cases; Preliminary Conference. — xxx**

(c) If the case was referred to but was not resolved or dismissed through ADR, the Hearing/Adjudication Officer shall, immediately after receiving the records of the case, issue an order setting the conduct of the preliminary conference for the purpose of facilitating the resolution of the case through stipulations, clarifications and simplification of issues, and the submission and/or presentation of the original or certified true copies of affidavits, documents, ~~and other evidence~~ if necessary.

**(D) THE FOREGOING NOTWITHSTANDING, IN THE INTEREST OF JUSTICE OR THE EXIGENCY OF THE SERVICE OR EFFICIENCY, CASES MAY ALSO BE REASSIGNED OR RAFFLED TO ANOTHER HEARING/ADJUDICATION OFFICER.**

SECTION 6. Rule 9, Sections 1 and 2 are hereby amended, as follows:

Section 1. Decisions and Final Orders.- A decision or final order shall be duly signed by the appropriate authority, in writing, stating clearly and distinctly the facts, evidence, records, the provisions of law, rules and regulations as well as principles and doctrines if applicable, on which it is based. The approval of a compromise agreement shall be deemed decision on the merits and shall be treated and enforced accordingly. **NO MOTION FOR RECONSIDERATION OF THE DECISION OR FINAL ORDER OF THE HEARING/ADJUDICATION OFFICER OR THE ASSISTANT DIRECTOR SHALL BE ALLOWED.**

Section 2. Appeal to the Director.-

- (a) Within ten (10) days after receipt of the decision or final order **OF THE HEARING/ADJUDICATION OFFICER OR THE ASSISTANT DIRECTOR**, a Party may file **A MEMORANDUM OF APPEAL** to the Director together with the payment of the applicable fees. The appeal shall be immediately denied if it is filed out of time and/or is not accompanied by the payment of the applicable fee. **THE PERIOD TO FILE APPEAL, HOWEVER, MAY BE EXTENDED UPON MOTION OF THE PARTY CONCERNED WHICH MUST STATE MERITORIOUS GROUND; PROVIDED, THAT THE MOTION IS FILED WITHIN THE PERIOD TO FILE THE APPEAL AND IS ACCOMPANIED BY THE PAYMENT OF THE APPEAL FEE AND OTHER APPLICABLE FEES.**

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After receipt of the appeal, the Director shall issue an order for the adverse party to file comment within a period of ten (10) days from receipt of the order. **THE PERIOD TO FILE COMMENT, HOWEVER, MAY BE EXTENDED UPON MOTION OF THE APPELLEE WHICH MUST STATE MERITORIOUS GROUND; PROVIDED, THAT THE MOTION IS FILED WITHIN THE PERIOD TO FILE COMMENT AND IS ACCOMPANIED BY THE PAYMENT OF THE APPLICABLE FEES.** The Director shall **ENDEAVOR TO** decide on the appeal within thirty (30) days from the lapse of the period for the filing of a comment. Within thirty (30) days after receipt of the decision by the Director, a party may file an appeal to the Director General; **PROVIDED THAT NO MOTION FOR RECONSIDERATION OF THE DECISION OF THE DIRECTOR SHALL BE ALLOWED.**

- (b) If a party, counsel of record or representative of record refuses to receive a copy of the decision, final order or resolution promulgated by the Hearing/Adjudication Officer, or Assistant Director, or Director; or has moved out of the address, said party, counsel of record or representative of record indicated in the pleadings of other records in the Bureau and/or IPOPHL, the Bureau shall post the decision, final order or resolution in the IPOPHL website. Within ten (10) days after posting the decision or final order in the IPOPHL website, the party concerned may file together with the payment of the applicable fees, the appropriate appeal.

SECTION 7. Separability Clause. - Any portion or provision of this Memorandum Circular that may be declared invalid shall not have the effect of nullifying other portions or provisions hereof as long as such remaining portion or provision can still subsist and be given effect in their entirety.

SECTION 8. Repealing Clause. - All rules and regulations or parts thereof inconsistent herewith are hereby repealed or modified accordingly.

SECTION 9. Filing of Certified Copies. - Certified copies of this Memorandum Circular shall be filed with the University of the Philippines Law Center, Department of Trade and Industry, the Senate of the Philippines, the House of Representatives, the Supreme Court of the Philippines and The National Library.

SECTION 10. Effectivity. - These amendments shall become effective fifteen (15) days after publication in a newspaper of general circulation

SIGNED this 20 th of December 2019, at Taguig City, Philippines

  
ATTY. JOSEPHINE R. SANTIAGO, LL.M.  
Director General 