

IPOPHL MEMORANDUM CIRCULAR NO. 2022-013

**SUBJECT: AMENDMENTS TO THE RULES AND REGULATIONS ON
INTER PARTES PROCEEDINGS**

WHEREAS, it has been the long-term vision of the Intellectual Property Office of the Philippines (“IPOPHL”) through the Bureau of Legal Affairs (“BLA”) to modernize the rules and procedures in the adjudication of Intellectual Property (“IP”) cases or disputes, through the use of relevant and available information and communication technology, which will not only benefit the office but more importantly the stakeholders, in terms of accessibility of services, resiliency, and cost efficiency;

WHEREAS, the aforementioned vision is in line with the Intellectual Property Office of the Philippines’ (“IPOPHL”) 6-Point Agenda for 2020-2025 (BRIGHT), particularly, “*Raising the Ante for Customer Service*” and “*Transforming IPOPHL into a Fully Digitalized Agency*”;

WHEREAS, Rep. Act No. 11032, also known as the “*Ease of Doing Business and Efficient Government Service Delivery Act of 2018*”, also requires the adoption of simplified procedures to expedite business and non-business related transactions in government;

WHEREAS, the Implementing Rules and Regulations of Rep. Act No. 11032 directs government agencies to initiate review for each of their government services or processes through automation or computerization of the processes/services;

WHEREAS, in response to the challenge posed by the Covid-19 pandemic, the IPOPHL through the BLA adopted and implemented measures to ensure the continuity of operations and the delivery of services, thus, fast-tracking the BLA’s modernization and digitization of its system, processes, and records;

NOW, THEREFORE, pursuant to the authority of the Director General under Sections 7.1 and 10.3 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines, as amended, the following amendments to the Rules and Regulations on Inter Partes Proceedings are hereby promulgated, as follows:

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

Section 5. Mode of Filing and Service. – (a) Filing and service of pleadings, motions, manifestations, service of interlocutory orders, notices, summons and other processes shall be made through electronic mail (“e-mail”). This mode of filing and service applies also to service or delivery of copies of decisions, final orders, and entries of judgment. For this purpose, all pleadings and submissions shall be filed through e-

mail using the e-mail address blareceiving@ipophil.gov.ph and/or other email addresses as may be provided or prescribed. Electronic service (“e-Service”) shall be made by sending a copy of the decisions, final orders, interlocutory orders, notices, summons and other processes via e-mail address blamailing@ipophil.gov.ph and/or other e-mail addresses as may be provided or prescribed, to the email address of the party’s counsel or representative, or of the party if no counsel or representative on record, as:

- (i) used in the filing of pleadings/documents with the Bureau;
 - (ii) provided by the counsel and/or the party directly to the Bureau as required; or
 - (iii) appearing in the records of this office, particularly, in the trademark, patent, utility model, industrial design applications/registrations, and submitted documents as found in the filewrapper.
- (b) Pleadings and submissions shall be deemed filed as of the date the Bureau received the e-mail. The party filing the pleading, motion and other submissions shall indicate the docket number and title of the case (if applicable), and the appropriate Intellectual Property Right application or registration number subject of the case. Evidence, if any, shall be attached to the e-mail. In case of large files, parties may use such tools as “compressed (zip) files” and “google drive”. The parties may send multiple e-mails containing the evidence provided that the Bureau receives the pleading and the evidence on the same date or within the period under Rule 2, Section 8, par. (b) and Rule 2, Section 9, par. (d).
- (c) The counsel/representative or party concerned has three (3) calendar days from the transmission via email of the decision, final order, entry of judgment, interlocutory orders, notices, summons or other processes within which to acknowledge the receipt thereof by sending a reply e-mail to the Bureau using the e-mail address blamailing@ipophil.gov.ph and/or other email addresses as may be provided or prescribed. The date of the acknowledgment shall be deemed the date of receipt thereof by the party. If no acknowledgement is received by the Bureau within the aforementioned 3-day period, the decision, final order, entry of judgment, interlocutory orders, notices, summons or other processes is considered received by the counsel/representative or party on the date of the transmission via e-mail. Service via e-mail to the e-mail addresses under Sec. 5 par. (a) (i)(ii) and (iii) shall be valid until the counsel/representative or the party concerned notifies the Bureau of the changes in the e-mail addresses.

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

Section 7. Filing Requirements for Opposition and Petition –

- (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, and must indicate the following:
- (i) names and addresses including the e-mail addresses of the opposer or petitioner and the other parties if known to the opposer or petitioner;
 - (ii) the assigned application number and the filing date of the trademark application opposed; or of the registration number, the name of the registrant, and the date of the registration of the trademark, patent, utility model, industrial design or layout design sought to be cancelled; and
 - (iii) the ultimate facts constituting the opposer's or petitioner's cause or causes of action and the relief sought.
- (b) The opposer or petitioner shall attach to the opposition or petition the:
- (i) verification and certification of non-forum shopping;
 - (ii) affidavits of witnesses, documentary or object evidence, which must be duly-marked starting from exhibit "A";
 - (iii) other supporting documents mentioned in the notice of opposition or petition together with the translation in English, if not in the English language; and
 - (iv) the power of attorney or other proof of authority indicating the authority of the counsel or representative to sign the pleadings, verification, certification of non-forum shopping, to represent the party to the case, and such other delegations relevant to the adjudication of the opposition/petition, *provided*, that the power of attorney or authority may already include attendance to mediation conferences and negotiate and enter into compromise agreement on behalf of the party.
- (c) 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 apostilled by the appropriate authority of the concerned member country of the Apostille Convention. 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 authenticated or apostilled documents must be submitted during the period of inspection and comparison of documents and evidence under Section 14 of this rule.

- (d) A single pleading for opposition or petition involving more than one (1) application or registration is allowed, provided, that it involves the same parties and each application or registration or patent opposed or sought for cancellation shall constitute one and distinct case. The opposer or petitioner has to pay the applicable fees corresponding to each and every application or registration or patent opposed or sought to be cancelled. For this purpose, the opposer or petitioner may also submit a single power of attorney and/or proof of authority of the signatory including the verification and certification of non-forum shopping

SECTION 3. Rule 2, Section 8 is hereby amended, as follows:

Section 8. Action on the Notice of Opposition or Motion for Extension to File Notice of Opposition, and Petition. -

- (a) An inter partes case is deemed to have commenced upon the filing of a (i) notice of opposition or a motion for extension of time to file a notice of opposition, or (ii) a petition for cancellation or compulsory licensing in accordance with Section 5 of this rule.
- (b) Upon receipt of the opposition, or motion for extension to file opposition or petition, the Bureau shall send an acknowledgment of the receipt of the opposition or motion for extension to file opposition, or the petition. The opposer or petitioner has a period of five (5) days from receipt of the acknowledgment within which to submit any of the required documents which was not attached to the opposition or petition, if any.
- (c) The opposer or petitioner has a period of five (5) days from receipt of the electronic statement of account (“e-soa”) within which to pay the applicable fees through the IPOPHL online payment facilities. The proof of payment must be sent to the Bureau via e-mail within three (3) days from the date of the actual payment.
- (d) The opposition or petition shall be dismissed on the following grounds:
- (i) if the opposition or motion for extension to file opposition, or petition is filed out of time;
 - (ii) for lack of jurisdiction;
 - (iii) failure to state cause of action;
 - (iv) non-payment of fees within the prescribed period;
 - (v) non-compliance with Section 7, par. (b) of Section 8, and/or par. (b) of Section 14, of this rule;
 - (vi) failure to file the opposition or motion for extension to file opposition, or petition through the prescribed mode.

- (e) If the opposition or petition is determined to be compliant with the requirements, the Bureau shall immediately issue a notice to answer together with a copy of the opposition or petition to the counsel/representative on record or to the party. If no email address is provided on record, service of interlocutory orders, notices, and other processes shall be made via personal service and/or courier service, or by registered mail if personal service or courier services are not available or practicable due to the location of the physical address on record of the respondent, and similar circumstances. In case of failure of service either by personal service and/or courier service, or by registered mail, the notice to answer shall be published or posted in the IPOPHL website and shall be deemed as service to the respondent. In which case, the period to file the answer or the motion for extension to file answer shall be reckoned from the date of the publication of the notice to answer in the IPOPHL website. The respondent, however, must file the Answer and all pleadings, motions and other manifestations via email.

SECTION 4. Rule 2, Section 9 is hereby amended, as follows:

Section 9. Answer. —

- (a) The respondent shall file a verified answer within thirty (30) days from receipt of a copy of the notice to answer. The respondent shall attach to the answer the following:
- (i) verification;
 - (ii) affidavits of witnesses, documentary or object evidence, which must be duly-marked starting from exhibit “1”; other supporting documents mentioned in the answer together with the translation in English, if not in the English language; and
 - (iii) the power of attorney or other proof of authority indicating the authority of the counsel or representative to sign the pleadings, verification, certification of non-forum shopping, to represent the party to the case, and such other delegations relevant to the adjudication of the opposition/petition; *provided*, that the power of attorney or authority may include attendance to mediation conferences, negotiate and to enter into compromise agreement on behalf of the party.
- (b) 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 apostilled by the appropriate authority of the concerned member country of the Apostille Convention. For purposes of filing the answer, however, the

authentication or apostille 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 authenticated or apostilled document must be submitted during the conduct of hearing set for the submission, inspection or comparison of the originals under Section 14 of this Rule.

- (c) A single pleading involving more than one (1) application or registration is allowed, provided, that it involves the same parties and each application or registration or patent opposed or sought for cancellation shall constitute one and distinct case. For this purpose, the respondent may also submit a single power of attorney and/or proof of authority of the signatory to execute the verification and certification of non-forum shopping.
- (d) Upon proper motion founded on meritorious grounds, and the payment of the applicable fees, the Bureau may grant only once an additional period of forty-five (45) days within which to file the answer, *provided*, that if the last day for the filing of the answer or motion for extension falls on a Saturday, Sunday, holiday, non-working day, or on a day when the office or the bureau is closed for business as may be declared by the Director General, the filing must be done the next succeeding working day, provided further, that any extension of period shall be reckoned from the original due date.
- (e) Upon receipt of the answer or motion for extension of time to file answer, the Bureau shall acknowledge the filing of the answer or motion. The respondent has a period of 5 days from receipt of the acknowledgement within which to submit any of the requirements which was not attached to the answer, if any.
- (f) The respondent shall be declared as in default in the following instances:
 - (i) failure to file answer or the motion for extension to file answer including the payment of fees thereof within the prescribed period;
 - (ii) non-compliance with paragraphs (a), (b), (c) and (e) above, and/or par. (b) of Section 14 of this rule; and
 - (iii) Failure to file the answer or motion through the prescribed mode.

SECTION 5. Rule 2, Section 14 is hereby amended, as follows:

Section 14. Assignment/Raffle of Cases; Presentation, Inspection or Comparison of Evidence. -

- (a) If the respondent is in default, the case shall be raffled or assigned to an adjudication officer. The adjudication officer shall, immediately after receiving

the records of the case, issue the order of default through and shall require in the said order the opposer or petitioner to submit within ten (10) days from receipt thereof, the originals and/or certified copies of the affidavits, documentary evidence and object evidence, if necessary. The case shall be decided on the basis of the petition or opposition, the affidavits of the witnesses and the documentary or object evidence submitted by the petitioner or opposer.

- (b) If the respondent is not in default and the case was referred to but was not resolved or dismissed through ADR, the case shall be raffled or assigned to an adjudication officer. The adjudication officer shall, immediately after receiving the records of the case, conduct hearings/conferences for the purposes of submission and/or presentation for inspection and comparison of the required documents attached to the opposition, petition or answer and other related matters. 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 adjudication officer.
- (c) The period of submission, presentation, inspection and comparison shall not exceed forty-five (45) days from the date the case was raffled to the adjudication officer.

Unless there are admissions or stipulations, the failure to submit or present during the period for inspection and/or comparison the originals and/or certified copies of the documentary evidence, and object evidence if any, shall render these inadmissible.

Each party has ten (10) days from the termination of the period to submit their respective position papers. The position papers shall take up only those matters and issues covered or alleged in the petition or opposition and the answer, the supporting evidence and those determined during the hearing for the inspection or comparison of the evidence. No new matters or issues shall be raised or included in the position papers.

SECTION 6. Rule 2, Section 16 is hereby amended, as follows:

Section 16. Submission for decision. –After the lapse of the reglementary period within which to file the position paper, and with or without the parties having submitted the same, the adjudication officer shall immediately declare that the case is submitted for decision. The adjudication officers shall issue the decisions or final orders within 20 calendar days from date the case is deemed submitted for decision, which period may be extended for another twenty (20) calendar days for justifiable reasons.

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

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Section 2. Period to File Opposition. – The verified notice of opposition must be filed within thirty (30) days from the date of the publication of the trademark application for opposition purposes. Upon proper motion anchored on meritorious grounds which must be expressly indicated in the motion, and the payment of the filing fee for opposition and other applicable fees, the Bureau may grant only once an additional period of forty-five (45) days within which to file the opposition, *Provided*, that if the last day for filing of the verified opposition or motion for extension falls on a Saturday, Sunday, holiday, non-working day or on a day when the office or the bureau is closed for business as may be declared by the director general, the filing must be done the next succeeding working day; *provided* further that any extension of period shall be reckoned from the original due date.

SECTION 8. Rule 9, Sections 1, 2 and 3 are hereby amended, as follows:

Section 1. Decisions and Final Orders. –

- (a) 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 is allowed.
- (b) In respect of a party who has not filed any pleading via email nor provided the Bureau with an email address up to the time of the issuance of the decision or final order, a copy of the decision or final order shall be made via personal service and/or courier service, or by registered mail if personal service or courier services are not available or practicable due to the location of the physical address on record of the respondent, and similar circumstances. In case of failure of service either by personal service and/or courier service, or by registered mail, the decision or final order shall be published or posted in the IPOPHL website and shall be deemed as service to the concerned party. In which case, the period to file the appeal shall be reckoned from the date of the publication of the decision, final order, or resolution in the IPOPHL website.

Section 2. Appeal to the Director.-

- (a) Within fifteen (15) days from receipt of the decision or final order, a party may file a memorandum of appeal to the Director. The period to file appeal may be extended only once for another fifteen (15) days upon motion of the party concerned which must state meritorious grounds, provided, that the motion is filed within the period to file the appeal and the applicable fees are paid.

- (b) The appellant has a period of five (5) days from receipt of the electronic statement of account (“e-soa”) within which to pay the applicable fees through the IPOPHL online payment facilities. The proof of payment must be sent to the Bureau via e-mail within three (3) days from the date of the actual payment.
- (c) The appeal shall be dismissed outright if filed out of time and/or for non-payment of fees.
- (d) If the appeal is timely and the fees are paid, the Director shall issue an order for the appellee to file comment within a period of fifteen (15) days from receipt thereof. The period to file a comment, however, may be extended for another fifteen (15) days upon motion of the appellee which must state meritorious grounds; provided, that the motion is filed within the period to file comment and the fees are paid. The Director shall resolve or dispose the appeal within twenty (20) calendar days, which may be extended to another twenty (20) calendar days for justifiable reasons, from the date the appeal is submitted for resolution or disposal. No motion for reconsideration of the decision of the Director is allowed. The decision or final order of the Director may be appealed to the Director General within the period and through the mode prescribed in the rules on appeal to the Director General.
- (e) In respect of a party who has not filed any pleading via email nor provided the Bureau with an email address up to the time of the issuance of the interlocutory order, decision or final order of the Director, the copy of the interlocutory order, decision, or final order shall be made via personal service and/or courier service, or by registered mail if personal service or courier services are not available or practicable due to the location of the physical address on record of the respondent, and similar circumstances. In case of failure of service either by personal service and/or courier service, or by registered mail, the interlocutory order, decision or final order shall be published or posted in the IPOPHL website and shall be deemed as service to the concerned party as of the date of the said publication.

SECTION 9. 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 10. Repealing Clause. All rules and regulations or parts thereof inconsistent herewith are hereby repealed or modified accordingly.

SECTION 11. 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 12. Publication. – This memorandum circular shall be published in a newspaper of general circulation and shall be posted in the IPOPHL website.

SECTION 13. Effectivity. These amendments to the Rules and Regulations on Inter Partes Proceedings shall take effect on 30 June 2022. Accordingly, the amendments shall apply to all Inter Partes cases, including appeals to the Director, filed starting 30 June 2022.

Signed this 27th of May 2022, at Taguig City, Philippines



ATTY. ROWEL S. BARBA
Director General ^{REP}

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