

IPOPHL MEMORANDUM CIRCULAR NO. 2023-Q01
Series of 2023

Subject: RULES AND REGULATIONS ON TRADEMARKS, SERVICE MARKS, TRADE NAMES AND MARKED OR STAMPED CONTAINERS OF 2023 REPLACING THE REVISED TRADEMARK REGULATIONS OF 2017

WHEREAS, the State recognizes that an effective industrial property system is vital to the development of domestic creativity, facilitates transfer of technology, attracts foreign investments, and ensures market access for our products;

WHEREAS, it is the policy of the State to streamline administrative procedures in registering trademarks and enhance the enforcement of intellectual property rights in the Philippines.

WHEREAS, in recognition of the developments in trademark principles and practices and make the Rules responsive to these developments and the needs of stakeholders, there is a need to amend the 2017 Trademark Regulations and institutionalize the protection for non-traditional visual trademarks as provided under Republic Act No. 8293 (otherwise known as the "IP Code") and the protection of rightful owners against applications presumed to be filed in bad faith.

WHEREAS, to best serve public interest and to realign the existing Rules and Regulations with how work processes are done in view of the shift to a zero-contact policy and automating business-related transactions, the IPOPHL established online systems to facilitate and expedite the filing, transmission, and receipt of official communications and payment, and to formalize the relevant practices in view of the changing landscape; and

WHEREAS, under Sec. 7 (a) of the IP Code, the Director General shall manage and direct all functions and activities of the Office, including the promulgation of rules and regulations to implement the objectives, policies, plans, programs, and projects of the Office.

NOW, THEREFORE, pursuant to its authority under Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines, the following rules and regulations on trademarks, service marks, trade names, and marked or stamped containers is hereby promulgated.

PART 1
REGISTRATION OF TRADEMARKS AND SERVICE MARKS

RULE 100. *Title.* -These Regulations shall be known as the "Trademark Regulations of 2023".

RULE 101. *Definitions.* - Unless otherwise specified, the following terms shall have the meaning provided in this Rule:

- (a) "Actual Use" means use in the ordinary course of trade that demonstrates real commercial purpose targeting the public.

- (b) "Bureau or Office" means the Bureau of Trademarks of the Intellectual Property Office of the Philippines;
- (c) "Certification Mark" means any sign, used or intended for use in commerce with the owner's permission by someone other than its owner, to certify regional or other geographic origin, material, mode of manufacture, quality, accuracy, or other characteristics of someone's goods or services, or that the work or labor on goods or services was performed by members of a group or associations;
- (d) "Collective mark" means any visible sign designated as such in the application for registration and capable of distinguishing the origin or any other common characteristics, including the quality of goods or services of different enterprises which use the sign under the control of the registered owner of the collective mark;
- (e) "Communication" shall mean any response to an office action, petition, request, motion, or any submission in relation to maintenance requirement or document affecting title filed with the Office, except compliance with filing date requirements;
- (f) "Competent authority" for purposes of determining whether a mark is well-known, means the courts, the Director General and the Bureau of Legal Affairs;
- (g) "Director" means the Director of the Bureau of Trademarks;
- (h) "Director General" means the head of the Intellectual Property Office of the Philippines;
- (i) "Examiner" means the Trademark Examiner or any official or employee of the Bureau of Trademarks authorized to examine applications for registration or renewals thereof;
- (j) "IP Code" means Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines, as amended;
- (k) "IPOPHL eGazette" means the electronic publication of the Intellectual Property Office where all matters required to be published under the IP Code shall be published;
- (l) "Mailing Date" means the date it was initially sent through the e-correspondence system or sent to the designated registered e-mail of the applicant/registrant or its agent, as the case may be. In case an office action or issuance has been received both through e-correspondence and e-mail, the reckoning date will be the later date of receipt.
- (m) "Mark" means any visible sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise and shall include a stamped or marked container of goods;
- (n) "IPOPHL" means the Intellectual Property Office of the Philippines;
- (o) "Registered e-mail" is the email address of the applicant/registrant or its agent/representative as stated or entered in the online application system (eTMFile) or as may be subsequently communicated to the Bureau;
- (p) "Regulations" mean these rules and regulations and other subsequent issuances that may be formulated by the Director of Trademarks and approved by the Director General;
- (q) "Trade name" also known or referred to as business name, company name, or corporate name, means the name or designation identifying or distinguishing an enterprise or the name by which it operates or does business;
- (r) "Translation" means the equivalent meaning of a word in one language in another language such as expressing a French word into English; and
- (s) "Transliteration" means the converting the words, letters or characters from one language to the corresponding words, letters or characters of another language or alphabet by means of their close similarity in sound like expressing Chinese characters into the Roman or Latin alphabet.

RULE 102. *Registrability*. - A mark cannot be registered if it:

- (a) Consists of immoral, deceptive or scandalous matter, or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute;
- (b) Consists of the flag or coat of arms or other insignia of the Philippines or any of its political subdivisions, or of any foreign nation, or any simulation thereof;
- (c) Consists of a name, portrait or signature identifying a particular living individual except by the person's written consent; or the name, signature, or portrait of a deceased President of the Philippines, during the life of the surviving spouse, if any, except by the latter's written consent;
- (d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:
 - (i) The same goods or services, or
 - (ii) Closely related goods or services, or
 - (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;
- (e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: *Provided*, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;
- (f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: *Provided*, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: *Provided further*, That the interests of the owner of the registered mark are likely to be damaged by such use;
- (g) Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services.
- (h) Consists exclusively of signs that are generic for the goods or services that they seek to identify;
- (i) Consists exclusively of signs or of indications that have become customary or usual to designate the goods or services in everyday language or in bona fide and established trade practice;
- (j) Consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the goods or rendering of the services, or other characteristics of the goods or services;
- (k) Consists of shapes that may be necessitated by technical factors or by the nature of the goods themselves or factors that affect their intrinsic value;
- (l) Consists of color alone, unless defined by a given form; or
- (m) Is contrary to public order or morality.

As regards signs or devices mentioned in paragraphs (j), (k), and (l), nothing shall prevent the registration of any such sign or device which has become distinctive in relation to the goods and/or services for which registration is requested as a result of the use that has been made of it in

commerce in the Philippines. The Office may accept as prima facie evidence that the mark has become distinctive, as used in connection with the applicant's goods and/or services in commerce, proof of substantially exclusive and continuous use thereof by the applicant in commerce in the Philippines for five (5) years before the date on which the claim of distinctiveness is made.

The nature of the goods or services to which the mark is applied will not constitute an obstacle to registration.

RULE 104. *Trade Names or Business Names.* - A name or designation may not be used as a trade name if its nature or its use is contrary to public order or morals and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties. In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful.

The remedies provided for cancellation and infringement of marks in Sections 153 to 156 and Sections 166 and 167 of the IP Code shall apply to trade names *mutatis mutandis*.

Any change in the ownership of a trade name shall be made with the transfer of the enterprise or part thereof identified by that name. However, such transfer or assignment shall be null and void if it is likely to mislead the public, particularly as regards the nature, source, manufacturing process, characteristics, or suitability of purpose, of the goods and/or services to which the mark is applied.

PART 2 RIGHT TO A MARK

RULE 200. *How Marks are Acquired.* -The rights in a mark shall be acquired through registration made validly in accordance with the law.

RULE 201. *International Conventions and Reciprocity.* - Any person who is a national or who is domiciled or has a real and effective industrial establishment in a country which is a party to any convention, treaty or agreement relating to intellectual property rights or the repression of unfair competition, to which the Philippines is also a party, or extends reciprocal rights to nationals of the Philippines by law, shall be entitled to the benefits to the extent necessary to give effect to any provision of such convention, treaty or reciprocal law, in addition to the rights to which any owner of an intellectual property right is otherwise entitled by the IP Code.

The registration of a mark of such person shall be independent of the registration in the country of origin and the duration, validity, or transfer in the Philippines of such registration shall be governed by the IP Code and these Regulations.

RULE 202. *Priority Right; Basis for Claiming Priority Right.* -An application for registration of a mark filed in the Philippines by a person referred to in Rule 201, and who previously duly filed an application for registration of the same mark in one of those countries, shall be considered as filed as of the day the application was first filed in the foreign country.

No registration of a mark in the Philippines by a person described in this Rule shall be granted until such mark has been registered in the country of origin of the applicant. However, the mark may be allowed for publication for the purpose of opposition, but such publication shall be withheld until it has been ascertained that the mark has been registered in the country of origin of the applicant. The country of origin of the applicant is the country in which the applicant is a national, domiciled, or has a bona fide and effective industrial or commercial establishment.

Nothing in this Rule shall entitle the owner of a registration granted under these Regulations to sue for acts committed prior to the date on which its mark was registered in the Philippines; *Provided*, That, notwithstanding the foregoing, the owner of a well-known mark, as defined in the IP Code and these Regulations, that is not registered in the Philippines, may, against an identical or confusingly similar mark, oppose its registration, or petition the cancellation of its registration or sue for unfair competition, without prejudice to availing itself of other remedies provided for under the law.

In like manner and subject to the same conditions and requirements, the priority right may be based upon a subsequent regularly filed application in the same foreign country: *Provided*, That any foreign application that was made the basis of the priority right and filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority and shall not thereafter serve as a basis for claiming a right of priority.

RULE 203. *Requirements for Applications Claiming Priority Right.* - An application with a claim of priority right must be filed within six (6) months from the date the earliest foreign application was filed, if the fact of filing and/or registration is verifiable from the official website of the foreign intellectual property office where the earliest application was filed, the applicant is not required to submit a certified copy of the foreign application or registration that serves as basis of the claim of priority right. Otherwise, the applicant shall be required to submit a copy of the foreign registration and an English translation, if necessary, within six (6) months from the mailing date of the office action of the Examiner requiring the same, subject to extension as provided under Rule 614.

Priority claims for motion marks wherein there are two varying representations, such that one filing is represented in a sequence of still images (*e.g.*, jpeg) and the other in a video file (*e.g.*, MP4), will only be accepted if all the elements of the video file and their complete movement are clearly identifiable in the sequence of still images. If the subsequent Philippine application is represented in a sequence of still images, a description can be required to ensure that the subject matter is identical with the mark which is the basis of convention priority.

If any of those elements are missing and the complete movement cannot be clearly identified, the marks are considered non-identical and the priority claim will be rejected.

Priority claims for hologram marks wherein there are two varying representations, such that one filing is a hologram represented in a series of graphic or photographic images (image files, *e.g.*

JPEG), and the other is represented in a video file (e.g. MP4), will only be accepted if all the elements of the video file and the different stages of the holographic effect are clearly identified in the series of graphic or photographic images.

If any of those elements and the different stages of the holographic effect cannot be clearly identified, the marks are considered non-identical and the priority claim will be rejected.

RULE 204. *Period to File Declaration of Actual Use.* - The Office will not require any proof of use in commerce upon filing of an application. All applicants or registrants shall file a Declaration of Actual Use (DAU) of the mark with evidence to that effect and upon payment of the prescribed fee on the following periods:

- (a) Within three (3) years from the filing date of the application;
- (b) Within one (1) year from the fifth anniversary of the registration;
- (c) Within one (1) year from date of renewal;
- (d) Within one (1) year from the fifth anniversary of each renewal;

otherwise, the application shall be refused registration, or the registered mark shall be removed from the Register by the Director.

RULE 205. *Extension of Period to File Third (3rd) Year DAU, When Allowed.* -For the DAU required to be filed within three (3) years from filing date of the application, a six (6)-month extension period may be granted upon request of the applicant or registrant, provided such request is made prior to the expiration of the three-year period and the required fee is paid. Actual use of the mark may commence within the extension period. The corresponding fee must be paid on the day of the filing of the DAU or the request for extension of time to file the document. The date of payment shall be considered as the date of filing of the DAU.

RULE 206. *Renewal DAU.* - The Renewal DAU may be filed within the six-month period before the expiration of the registration.

RULE 207. *Absence of Notice to File DAU, Not an Excuse.* -The Office may issue notices or reminders to applicants/registrants regarding the timely filing of the DAU and which may be sent through the Bureau's online correspondence system (e.g., eCorr), published in the IPOP HL Website or disseminated by other alternative modes, as may be appropriate. However, the absence of such notice or reminder shall in no case excuse the applicant or registrant from filing the DAU within the prescribed period. The Office shall remove the mark from the Register or refuse the registration of a pending application if the applicant or registrant fails to file the required DAU in a timely manner.

RULE 208. *Contents of the DAU.* -The declaration shall be under oath, and filed by the applicant or registrant (or the authorized officer in case of a juridical entity) or the attorney or authorized representative. The declaration must refer to only one application or registration and must contain the following:

- (a) name and address of the applicant or registrant;
- (b) declaration that the mark is in actual use in the Philippines;
- (c) the list of goods and/or services for which the mark is used; and
- (d) the name/s of the establishment's and address /es where the products are being sold or where the services are being rendered. If the goods or services are available only by online

purchase, the website must be indicated on the form in lieu of the name or address of the establishment or outlet.

The applicant or registrant may include other facts to show that the mark described in the application or registration is being actually used in the Philippines.

RULE 209. *Effect of Actual Use for Related Classes.* - Actual use for some of the goods and/or services in the same class shall constitute use for the entire class of goods and services. Actual use for one class shall be considered use for related classes. In the event that some classes are covered in the declaration, a subsequent declaration of actual use may be filed for the other classes of goods or services not included in the first declaration, provided that the subsequent declaration is filed within the period to file the DAU as provided in Rule 204 or the extension period, in case an extension of time to file the declaration was timely made under Rule 205. If no subsequent declaration of actual use for the other classes of goods and services is filed within the prescribed period, the classes shall be automatically dropped from the application or registration without need of notice to the applicant or registrant.

RULE 210. *Evidence of Actual Use.* -The following shall be accepted as proof of actual use of the mark:

- (a) downloaded pages from the website clearly showing that the goods are being sold or the services are being rendered or made available in the Philippines;
- (b) photographs (including digital photographs printed on ordinary paper) of the following:
 - (i) labels or packaging bearing the mark as actually used on the goods;
 - (ii) the stamped or marked container of goods; or
 - (iii) signages bearing the mark on the facade or any area in the establishment/s where the mark is displayed.
- (c) brochures or advertising materials showing the actual use of the mark on the goods being sold or services being rendered in the Philippines;
- (d) receipts or invoices of sale of the goods or services rendered or other similar evidence of use, showing that the goods are placed on the market or the services are available in the Philippines;
- (e) copies of contracts for services showing the use of the mark; or
- (f) such other evidence of similar nature that the Director may determine as acceptable.

RULE 211. *Declaration of Non-Use.* - In lieu of a DAU, an applicant or registrant, when warranted, shall file a Declaration of Non-Use (DNU) indicating the grounds and justification therefor. Non-use of a mark may be excused if caused by circumstances independently of the will of its owner but in no case shall lack of funds be an excuse for non-use of a mark.

Non-use of a mark may be excused in the following cases:

- (a) where the applicant or registrant is prohibited from using the mark in commerce because of a requirement imposed by another government agency prior to putting the goods in the market or rendering of services;
- (b) where a restraining order or injunction was issued by the Bureau of Legal Affairs, the courts, or quasi-judicial bodies prohibiting the use of the mark; or
- (c) where the mark is the subject of an opposition or cancellation case, or pending adjudication.

RULE 212. *Period to File DNU.* -The periods to file DNU are as follows:

- (a) Within three (3) years from filing date of the application. However, a six (6)-month extension period may be granted upon request of the applicant or registrant made prior to the expiration of the three-year period and the required fee is paid; or
- (b) Within the prescribed periods mentioned in Rule 204 when use of a registered mark or mark subject of an active application has been interrupted or discontinued by a pending litigation.

Except in cases falling under (b) of the immediately preceding paragraph, non-use of the mark shall not be allowed for a total of more than six (6) years. For this purpose, actual use must commence and the DAU must be filed within one (1) year from the 5th anniversary of the registration, otherwise, the Office shall remove the mark from the Register pursuant to Rule 207.

RULE 213. *Form and Contents of DNU.* -The DNU shall be under oath and shall clearly state the facts prohibiting the actual use of the mark in commerce. The corresponding fee for all the classes must also be paid upon filing of the declaration.

PART 3 WHO MAY APPLY FOR A MARK

RULE 300. *The Applicant.* -The applicant may be a natural or juridical person. All applications for a mark should be in the name of the applicant(s) who may sign the application. If there is more than one applicant, all of them should be named as applicants, but any applicant may sign the application for and on behalf of all the applicants.

RULE 301. *Assigned Marks.* - In case the whole interest in the mark is assigned, the application may be filed in the name of the assignee who may sign the application. In case the assignee is a juridical person, any officer thereof may sign the application on behalf of the said person. In case of an aliquot portion or undivided interest, each of the joint owners will sign the application, unless a common representative has been appointed to sign on their behalf.

RULE 302. *Representation; Address for Service.* - If the applicant is not domiciled or has no real and effective commercial presence in the Philippines, such applicant shall designate in writing a resident representative who shall be served with notices or processes in proceedings affecting the mark. The written designation, clearly indicating the name and the physical and e-mail address/es of the representative, shall be submitted within two (2) months from the mailing date of the office action requiring its submission.

If the written designation is not filed within the two-month period, the application may be abandoned.

Digital copies of notices and/or processes shall be served upon the authorized representative through the official e-mail address indicated in the last designation. The applicant may also opt to provide an alternate e-mail address where notices and other issuances may be sent.

Subsequent changes concerning the appointment of the authorized representative shall be submitted to the Office in writing together with the prescribed fee.

RULE 303. *Applicant may be Represented by Attorney.* - An owner of a mark may file and prosecute the application for registration without an attorney or representative, but the applicant may be represented by any attorney or other authorized representative, if so desired by the applicant/registrant or required under these Regulations such as when the applicant/registrant is not a resident of the Philippines under Rule 400(e).

RULE 304. *Power of Attorney or Authorization.* - At the time of filing of an application, no power of attorney or authorization is required. However, the Office may require any attorney or other recognized person or authorized representative to submit the same within two (2) months mailing date of the office action requiring its submission before the attorney or representative is allowed to take an initial or further action on any application or registration.

If the Power of Attorney or Authorization is not filed within the two (2)-month period, the application may be abandoned.

A substitute or associate attorney may be appointed by an attorney only upon the written authorization of the principal; but a third attorney appointed by the second will not be recognized.

RULE 305. *Death, Insanity, Incapacity of Applicant.* - When the applicant dies, becomes insane or is otherwise incapacitated, the legally appointed executor, administrator, guardian, conservator, or representative of the dead or insane or incapacitated applicant may prosecute the application on behalf of the applicant, the estate, heirs or successors-in-interest of the applicant.

RULE 306. *Signature and Other Means of Self-identification.* - Where a signature is required, the Office shall accept:

- (a) A hand-written signature;
- (b) The use of other forms of signature, such as a printed or stamped signature, or the use of a seal, instead of a hand-written signature: *Provided*, That where a seal is used, it should be accompanied by an indication in letters of the name of the signatory; or
- (c) Digital signature, subject to the provision the applicable laws and issuances.

No notarization, authentication, legalization, or other certification of any signature or other means of self-identification referred to in the preceding paragraph will be required, except when it concerns the surrender of a registration.

PART 4 TRADEMARK APPLICATION

RULE 400.1 *Application Requirements.* -All applications must be addressed to the Director and shall be in Filipino or English and shall contain the following:

- (a) a request for registration;
- (b) the name, address and other contact details of the applicant;
- (c) the name of a State of which the applicant is a national or has domicile; and the name of a State in which the applicant has a real and effective industrial or commercial establishment, if any;
- (d) where the applicant is a juridical entity, the law under which it is organized and existing;

- (e) if the applicant is not domiciled in the Philippines, the appointment of a resident agent or representative whose power of attorney may be required by the examiner if necessary;
- (f) where the applicant claims the priority of an earlier application, a declaration claiming the priority of that earlier application, indicating the following:
 - i. the name of the state of the national office where the earlier application was filed or if filed with an office other than a national office, the name of that office;
 - ii. the date on which the earlier application was filed; and
 - iii. where available, the application number of the earlier application
- (g) where the applicant wishes to claim color as a distinctive feature of the mark, a statement to that effect, as well as the name or names of the color or colors claimed and an indication, in respect of each color, of the principal parts of the mark which are in that color;
- (h) where the mark is a three-dimensional mark, a color mark, a motion mark, a position mark, a hologram mark, a statement to that effect;
- (i) reproduction of the mark as provided in these Regulations or subsequent issuances;
- (j) transliteration or translation of the mark or of some parts of the mark, as prescribed in these Regulations;
- (k) the names of the goods or services for which the registration is sought, grouped according to the classes of the Nice Classification, together with the number of the class of the said classification to which each group of goods or services belongs;
- (l) where the application is for a collective mark, a designation to that effect; and
- (m) a signature by, or other self-identification of, the applicant or authorized representative.

Rule 400.2 *Collective Marks and Certification Marks* - An application for registration of a collective or certification mark shall designate the mark as such and shall be accompanied by a copy of the agreement, if any, governing the use of the collective mark or the copy of the standards set by the certifier governing the use of the certification mark, as the case may be.

RULE 401. *Office Application Form*. - While the filing of an application will be done online as required under Rule 503, the Office shall still make available a standard application form which shall be made available in electronic format or in printed form. The form may be used and submitted only in exceptional circumstances as provided in Rule 503.

RULE 402. *Reproduction of the Mark*. - One (1) reproduction of the mark shall be submitted upon filing of the application which shall substantially represent the mark as actually used or intended to be used on or in connection with the goods and/or services of the applicant. The reproduction must be clear and legible, rendered in black ink or in color, if colors are claimed, and must be capable of being clearly reproduced when published in the IPOPHL eGazette. An electronic copy of the reproduction must be submitted through the online filing system. The electronic reproduction should be in .jpg format, must not exceed 8cm x 8cm, and must not be more than two (2) megabytes.

In the case of word marks or if no special characteristics have to be shown, such as design, style of lettering, color, diacritical marks, or unusual forms of punctuation, the mark must be represented in standard characters. The specification and/or description of the mark to be reproduced will be indicated in the application form and/or published on the website.

In the case of three-dimensional marks, one drawing of the mark in a single perspective view may be filed if it sufficiently depicts all its features. When one drawing is inadequate to represent the mark's over-all shape or design or it would be difficult to ascertain these in one view, multiple perspectives may be submitted, in which case, the submissions should not exceed six (6) perspectives that are properly labeled - e.g., front view, side view, etc. - and submitted in one single .jpeg file.

In the case of color marks not defined by a given form but has acquired secondary meaning as defined under the law and issuances, a reproduction of the sample color must be filed together with a description of the shade of color to be claimed in ordinary language. In case of an application with a combination of multiple colors, a description detailing the systematic arrangement of the colors is required. Where the description is complex, the applicant may submit a pictorial representation showing the color/s claimed as applied on the goods, packaging, or service. The pictorial representation, however, should appear in broken or dotted lines to show that the shape of the goods or packaging is not claimed as part of the mark. The applicant may also include a designation from an internationally recognized color matching or identification system to describe the colors claimed. However, failure to indicate such international designation will not result in the denial of the application.

In the case of position marks, a drawing or reproduction of the mark that shows the placement of the mark and its size or proportion relative to the relevant goods or packaging is required. The applicant may also provide a description of the positioning of the mark.

In the case of motion marks, a clear and correct sequence of still images that corresponds to the movement depicted must be submitted. There is no limit as to the number of images, however, they must be submitted as a single jpeg file. The applicant is also required to provide a clear and detailed description explaining the movement in sequential order. The applicant may also submit a video clip in .mp4 format or a series of still images in graphic interchange format (gif) for clarity.

In the case of hologram marks, each of the various views which show all the material features of the mark must be depicted in the reproduction and must be filed in a single .jpeg file. The multiple views submitted must have only one commercial impression. For simple holograms, multiple views may not be necessary, and a single representation may be acceptable.

For three-dimensional marks, position marks, and color marks, in addition to the above requirements, the necessary broken or dotted lines must be sufficiently depicted in the representation to show the necessary disclaimers pursuant to Rule 604. The application must also provide a clear and accurate description as to the elements which are claimed and the unclaimed portions in the mark. In case the mark also contains any word, design, or symbol, the description shall also state these elements.

The provisions of this Rule shall, however, be construed liberally in determining whether the application shall be considered complete for purposes of granting a filing date.

RULE 403. *Submission of Label.* - For illustration, the applicant may submit the label as actually used or intended to be used on the goods or a computer printout of the label.

The mark intended to be protected, must, as far as practicable, be bigger and more dominant than the generic term of the goods, except in the case of pharmaceutical preparations or products, as required by law.

RULE 404. *Translation or Transliteration.* - A translation or transliteration of the mark or of some parts of the mark must accompany the application if the mark or of some parts of the mark is/are in foreign word(s), letter(s) and character(s), or foreign sounding.

RULE 405. *Classification of Goods and Services.* -The applicant must indicate the goods and/or services for which the registration is sought, grouped according to the classes of the Nice Classification, together with the number of the class to which each group of goods or services belongs. The Nice Classification shall pertain to the latest edition published by the World Intellectual Property Organization (WIPO).

The goods and/or services of registered marks which were classified under previous editions of the Nice Classification shall, upon renewal of registration, be reclassified by the Examiner consistent with the latest edition thereof, subject to payment of the required fees if the reclassification resulted in additional classes. Such reclassification may also be requested by the registrant prior to the renewal of the registration and allowed by the Office after examination of the request and payment of the appropriate fees.

The Office may declare the acceptance of other terms for as long as these may be classified under any of the classes of the Nice Classification.

RULE 406. *Broad Terms.* - In any application, the use of broad terms in identifying the goods, business or services shall be unacceptable. However, an applicant whose application is based on foreign registration/s shall be required to specify the goods covered by such foreign registration/s in all cases where the foreign registration/s used broad terms in identifying the goods and/or services. Class headings may be accepted, but they shall only cover the goods and/or services as stated and not all the goods and/or services under such class, and provided they do not mislead as to the nature of the goods and/or services.

RULE 407. *Single Registration for Goods and/or Services.* - One (1) application may relate to several goods and/or services, whether they belong to one (1) class or to several classes of the Nice Classification. Where goods and/or services belonging to several classes of the Nice Classification have been included in one (1) application, such application shall result in one registration.

RULE 408. *Division or Merger of Application/s.* - Any application referring to several classes of goods and/or services referred to as the "initial application" may be divided by the applicant into two (2) or more applications referred to as "divisional applications" by distributing among the latter the classes referred to in the initial application. A single class may be subdivided into two (2) or more separate applications upon payment of the prescribed fees.

The request to divide an application must be submitted at any time prior its registration.

Upon receipt of such a request together with the corresponding payment, the Office shall accordingly assign application numbers to the divisional applications, but the filing date shall be the same as the filing date of the initial application.

Upon request by the applicant and payment of the corresponding fee, a locally filed multi-class application partly based on a foreign application/registration and covering class/classes of goods and/or services not included in the foreign application or registration shall be divided into the following:

- (a) application with class/classes of goods/services covered by convention priority; and
- (b) application with class/classes of goods/services not covered by convention priority.

Only the divisional application/s covering class/classes of goods/services included in the foreign application/registration shall preserve the benefit of the right of convention priority. The divisional application/s covering class/classes of goods/ services not included in the foreign application/registration shall bear the filing date of the initial application.

A request to merge separate applications belonging to the same applicant may be filed at any time before publication of the mark for opposition. A written request for merger shall be submitted by the applicant and the required fees paid.

PART 5 THE FILING DATE

RULE 500. *Filing Date.* - Subject to the provisions on priority right, the filing date of an application is the date when the Office receives the payment for the correct filing fee and the following information in English or Filipino:

- (a) An application for the registration of a mark;
- (b) The legal identity of the applicant;
- (c) The physical and official email address of the applicant, as well as the representative, if any;
- (d) Clear and sufficient reproduction/s of the mark applied; and
- (e) The list of the claimed goods and/or services.

Communications in general are deemed filed/received on the date it is sent online except when payment of fee/s is required, in which case, the date of receipt is when the communication together with the full payment is transmitted.

In case of non-payment or insufficient payment of filing fees, the applicant is allowed three (3) calendar days to complete the filing fees to be accorded the original filing date. Thereafter, neither partial payment nor refund of the filing fees is allowed.

In all cases, the document/s submitted must be complete and compliant with the existing requirements. Otherwise, it shall be considered as not submitted and shall not stop the running of the prescribed period, if any.

The filing of applications for registration, communications and supporting documents shall be in accord with Rule 502 hereof.

RULE 501. *Filing Fee; Other Fees* - The Filing Fee, for purposes of according filing date, shall include the following fees:

- (a) Basic fee;
- (b) Color claim fee (if applicable); and
- (c) Publication for opposition fee.

The Filing Fee also includes the following, as may be applicable, and may be paid in advance:

- (a) convention priority claim fee;
- (b) priority examination fee and;
- (c) issuance and second publication fee.

The Filing Fee shall be deemed forfeited in favor of the government without obligation on the part of IPOPHL to reimburse should the application not proceed to registration for whatever cause.

RULE 502. *Application Number and Filing Date.* - Before the formal and substantive examination of the mark, the Examiner or such other personnel as the Director may authorize, shall examine whether the application satisfies the requirements for the grant of a filing date as provided in these Regulations. If the application does not satisfy the filing date requirements, the Office shall notify the applicant who shall, within a period of two (2) months from mailing date of the notice, complete or correct the application as required; otherwise, the application shall be deemed as not filed.

If the application did not satisfy the requirements for the grant of a filing date at the time that the filing fee and other indications were received by the Office, the filing date that was given shall be cancelled and a new filing date shall be entered in the records of the Office. The new filing date shall be the date on which the Office received the completed or corrected application as specified in the notice to the applicant.

RULE 503. *Mode of Filing; Transmitting Office Communications* - The filing of applications or such related communication shall be submitted only through the online submission system, i.e., eTMFile, of the Office. The use of eTMFile shall be governed by existing Guidelines and other issuances that the Office may issue in the future.

Any other communication to the Office can be submitted online using the Office's online submission system, i.e., eDocFile.

Under exceptional circumstances (e.g., natural calamities, prolonged system downtime), communication to the Office may be filed by electronic means (e.g, e-mail: bot@ipophil.gov.ph), by personal delivery, by courier services, or by registered mail, as may be ordered by the Director General or the Director of Trademarks.

RULE 504. *Mailing Dates.* A document transmitted is deemed received on the mailing date as defined under these Rules except if non-receipt is clearly attributable to the Office. The burden of proof that such transmittal was not received due to the fault of the Office lies with the applicant/registrant.

PART 6 PROCEEDINGS IN THE EXAMINATION OF AN APPLICATION FOR REGISTRATION

RULE 601. *Order of Examination; Priority of Action.* - Applications shall be examined for registrability in the order in which the complete requirements for grant of a filing date are received by the Office. Ordinarily, the order of the application number assigned to them by the Office will be followed and no application bearing a higher application number shall be assigned for examination ahead of the applications with lower application numbers, unless the filing date of the application bearing the higher number is earlier than those bearing a lower number.

Priority of action and/or examination may be granted upon petition under oath with payment of fees and upon approval by the Examiner to trademark applications falling under any of the following:

- (a) Re-filing by the same registrant or assignee of a mark previously registered but:
 - (i) removed from the Register for failure to file the 3rd year DAU or DNU or meet the maintenance requirement; or
 - (ii) has expired due to non-filing or late filing of the renewal;
- (b) Re-filing by the same applicant of a mark previously filed but:
 - (i) abandoned and can no longer be revived; or
 - (ii) refused for failure to file the 3rd year DAU or DNU;
- (c) An application for registration of a mark, names or abbreviation of names, logos of any nation, intergovernmental or international organizations;
- (d) An application for registration of a mark, names, abbreviation of names, logos of any sports competition conducted within a short period of time or when periodically conducted, the registration of the mark is necessary to promote goodwill or image before the commencement of the sports activity;
- (e) An application for registration of a mark, names, abbreviation of names, logos of product and services of applicants introduced and/or participating in a trade mission and/or exposition local or abroad and will be conducted within a short period of time;
- (f) An application for registration of a mark, names, abbreviations of names, logos of a religious, social or charitable, educational activity the early registration of which is necessary to achieve its purpose or objective;
- (g) Domain names (as service mark); and
- (h) Trademarks, service marks, and trade names used or to be used in Information and Communications Technology (ICT) infrastructure; or
- (i) Applications for marks used or to be used on goods or services directly related to preparing or responding to pandemics, or to addressing public health emergencies, including pharmaceutical preparations or vaccines; personal protective equipment (PPE) such as face masks, face shields, gloves and laboratory gowns; medical and laboratory apparatus and equipment; sanitizers and disinfectants; scientific and laboratory services; and medical services.

RULE 602. *Jurisdiction of the Examiner.* -The Examiners shall have original jurisdiction over the examination of all applications for registration and over their allowance for publication in the IPOPHL eGazette for purposes of opposition. Their decision, when final, shall be subject to petition and appeal to the Director. Applicants, their attorneys or agents shall take up the issue arising from their pending applications only with the respective Examiners in charge or their supervisors and with no other person in the Office.

RULE 603. *Examination of the Application; Action by the Examiner.* If, after the examination, the application is found not to be registrable for any reason, the applicant will be advised of the reason/s therefor and will be given such information and references as may be helpful in the further prosecution of the application.

If during the examination of the application, the Office finds factual basis to reasonably doubt the veracity of any indication or element in the application, the Examiner may require the applicant to submit sufficient evidence to remove the doubt. This evidence may be in the form of a sworn statement of ownership and/or affidavit of good faith, among others.

All Examiners are required to include all grounds of objection existing at the time of the issuance of the first office action. Piecemeal actions shall be prohibited.

Rule 604. Disclaimers. -The basic purpose of disclaimers is to make of record, that a significant element of a composite mark is not being exclusively appropriated apart from the composite. The following portions of a mark, when forming part of the composite mark, must be disclaimed to permit registration, namely:

- (a) a generic term;
- (b) a descriptive matter including a pictorial representation descriptive of the matter in the composite mark;
- (c) a customary term, sign or indication;
- (d) a matter which does not function as a trademark, or service mark or a trade name; or
- (e) a functional portion of a trademark.

In the case of three-dimensional marks, where the subject matter of the application consists of only part of a shape or the essential elements of a shape attached to a three-dimensional object, such as a container, the parts of the configuration claimed as part of the trademark should be shown in solid lines, while the unclaimed parts, if any, should be shown in broken lines. The elements that are incapable of being registered as a trademark such as a matter that is of functional or non-distinctive, must also be presented in broken lines to indicate that these elements are not claimed as part of the mark.

In the case of position marks and color marks, as appropriate, the applicant should use broken lines to identify the disclaimer of those elements which are not intended to form part of the application.

Where it is impractical to depict certain elements of a mark in broken lines or if broken lines would result in an unclear reproduction of the mark, the applicant may use solid lines. However, the applicant must identify these elements and state in the description that these elements are not part of the mark.

If the unclaimed portion of the mark is not depicted in broken lines but the description in the application makes it clear that some elements in the representation submitted are not claimed, the Office will still accept the disclaimer.

Such disclaimer shall not prejudice or affect the applicant's rights then existing under some other law or thereafter arising in the disclaimed matter, nor shall such disclaimer prejudice or affect the applicant's rights to registration on another application of later date, where the disclaimed matter has become distinctive of the applicant's goods, business or services.

Where the Examiner has determined that any portion of a mark contains unregistrable matter which must be disclaimed, the Examiner shall communicate the findings to the applicant in the office action. If the applicant fails to comply with the Examiner's requirement for a disclaimer, the Examiner must make the requirement final if the application is in condition for a final action.

Partial disclaimer may be allowed with respect to some classes or some goods and/or services.

Rule 605. Submission of Additional Representations and/or Drawings; Action by Examiner. - The Examiner may require the submission of additional representations should they determine that

the reproduction/s filed pursuant to Rule 402 do not sufficiently depict the mark; *Provided*, that the additional representations must not substantially alter the mark or the nature of the mark.

RULE 606. *Period for Response, Action by Applicant.* -The applicant has two (2) months from the mailing date of any action of the Examiner to respond thereto. Such response must be complete, and shall address all the issues raised by the Examiner, and may be made with or without amendment or submission of additional representation/s. The period to respond may be extended upon written request by the applicant and payment of the required fee for an additional period of two (2) months. In no case shall the total period to respond exceed four (4) months from the mailing date of the Examiner's action requiring the response as defined under Rule 504 of these Regulations.

RULE 607. *Communications; Original Copy, when Required.* - The Office shall accept communications that are only sent through the online submission system referred to in Rule 503.

Scanned copies of the printed or hard copies of communications and supporting documents, including those with wet signature and proper notarization shall be filed in Portable Document Format (pdf). However, the Office, at its discretion and for reasonable cause, may require the submission of the original or certified true copies of the document/s including but not limited to deed/s affecting the title of a mark, licensing agreement/s and voluntary cancellation/s. The required document/s shall be submitted within two (2) months from receipt of the notice, otherwise the copy filed online shall be deemed withdrawn and expunged from the records. In all cases, the burden of proof that such documents have been received by the Office lies on the applicant.

Communications that are not responsive to the office action, including irrelevant attachments, shall not be considered as filed and shall be stricken from the record.

RULE 608. *Re-examination.* - After response by the applicant, the application will be re-examined or reconsidered by the Examiner, and if the registration is again refused or formal requirements insisted upon, but not stated to be final, the applicant may respond again.

RULE 609. *Final Action.* - On any subsequent re-examination or reconsideration, the Examiner may state that the refusal of the registration or the submission of or compliance with any requirement/s is final. Thus, the applicant's recourse is limited to an appeal to the Director or to compliance with the requirement/s made by the Examiner.

RULE 610. *Abandonment; Incomplete Response.* - If an applicant fails to respond or submit a complete response within the period given, counted from the mailing date of an action of the Examiner, the application shall be deemed abandoned on the day immediately following the last day of the aforesaid period. The applicant shall be notified accordingly.

RULE 611. *Revival of Abandoned Application.* - An abandoned application may be revived within three (3) months from mailing date of the Notice if it is shown to the satisfaction of the Examiner that the delay was due to fraud, accident, mistake or excusable negligence, and upon payment of the required fee; *Provided*, That there shall be no revival of an abandoned application that had been revived once before on the same issue.

A request to revive an abandoned application must be accompanied by a statement of the causes of the delay in submitting the complete response and by the proposed response, unless the same had been previously filed. Any application not revived within the specified time will be deemed

abandoned with finality upon the expiration of the three-month period to revive. The applicant or the authorized representative shall be notified accordingly.

RULE 612. *Time Less than Four (4) Months; When Request for Extension Should be Made.* - The applicant may be required to prosecute the application in a time shorter than four (4) months. Unless the applicant is notified in writing that the response is required in less than four (4) months, a maximum period of four (4) months, including any extension, is allowed.

The time to reply, when a time less than four (4) months has been set, will be extended only for good and sufficient cause, and for a reasonable time specified. Any request for such extension must be filed on or before the day on which the response of the applicant is due. In all cases, the maximum time within which to submit a response to an action shall not exceed four (4) months from the mailing date of the action.

RULE 613. *Suspension of Action by the Examiner.* - Action by the Office may be suspended upon written request of the applicant for good and sufficient cause, for a reasonable time specified, and upon payment of the required fee. The Examiner may grant only one suspension, and any further suspension shall be subject to the approval of the Director.

RULE 614. *Allowance of Applications with a Claim of Priority Right.* If the only issue remaining in an application with a priority right claim based on a foreign application is the registration of such foreign application, the Examiner shall allow the application.

The Examiner shall verify whether the mark has been registered from the online trademarks database of the foreign intellectual property office where the application was filed. If the foreign application has been registered, the allowed mark shall be published for opposition.

If the foreign application has not been registered at the time of allowance or if the foreign intellectual property office does not have an online trademarks database, the Examiner shall, in the Notice of Allowance and Deferment, require the applicant to submit a photocopy of the foreign registration within one (1) year from mailing date of such notice. Upon request of the applicant and subject to the payment of the required fee, the period to submit a copy of the foreign registration may be extended for a period of one (1) year, counted from the expiry of the initial period of one (1) year. If the applicant does not request an extension or is unable to submit a copy of the foreign registration within the extension period, the claim to the right of priority shall be deemed waived. The application will thereafter be published for opposition upon payment of the required fees.

RULE 615. *Express Abandonment.* - An application may be expressly abandoned by filing with the Office a written declaration of abandonment signed by the applicant or by the authorized representative or agent and payment of the prescribed fee.

RULE 616. *Amendments to the Application.* -The application may be amended to correct formalities to overcome objections made by the Examiner, or for other reasons arising in the course of examination.

RULE 617. *Amendments to Reproduction of Mark or Goods and/or Services.* -Amendment/s requested during examination pertaining to the reproduction of the mark may be permitted only if warranted, but may not be made if the mark or the nature of the mark is substantially altered.

Amendment by addition of goods and/or services related to those originally filed and which fall under the same class may be allowed. Amendment by deletion is likewise allowed.

RULE 618. Manner of Making the Amendment. - In every amendment, the exact word or words to be stricken out or inserted must be specified and the precise point indicated where the erasure or insertion is to be made.

In amending the representation, the rule on applying solid lines and broken lines to depict the claimed and unclaimed portion of the marks shall be followed. A brief description of the amendment must also be submitted.

RULE 619. Prohibition Against Marking of Papers or Records of the Office by Applicants. - The applicant or the representative or agent shall not make any erasure, addition, insertion, or mutilations of any papers or records of the Office.

PART 7 PUBLICATION, ALLOWANCE AND ISSUANCE OF CERTIFICATE OF REGISTRATION

RULE 700. Publication in the IPOP HL eGazette; End of Jurisdiction of the Examiner. - An application for registration is subject to opposition proceeding before issuance of the Certificate of Registration. Thus, if after examination or re-examination of an application for registration, it should appear to the Examiner-in-charge that the mark is registrable, it shall be published for opposition in the IPOP HL eGazette. The applicant shall be notified of such action accordingly.

The jurisdiction of an Examiner over an application ceases after the Director has ordered the mark to be published for opposition.

RULE 701. Examiners may Request the Remand of Allowed Application to their Jurisdiction. - After allowance or within one (1) month from publication of the allowed application but before registration, the Examiner may again exercise jurisdiction over the application upon written request by such Examiner, and approval by the Director on the ground of newly discovered objections to the registration of the mark.

After remand of an application, the amendment(s) recommended by the Examiner, if any, may be approved by the Director and may be made without withdrawing the allowance. The Examiner may likewise issue a subsequent action on the basis of the newly discovered objection/s

RULE 702. Publication for Opposition; Applications Confidential Prior to Publication. - The Bureau shall take charge of all matters relating to the publication for opposition of all marks and trade names as provided in these Regulations.

Access to files of pending applications will not be given to anyone without the written authority of the applicant prior to publication for opposition of the mark, trade name, or other mark of ownership. Once the application has been published, access to files including DAU and submitted proofs of use may be made available to the public upon request and payment of the prescribed fees. Information on the name and address of the applicant, name and address of the agent or authorized representative, if any, the mark, the description of the mark, trade name or other mark of ownership, the goods and/or services listed in the application and the corresponding class

number/s, the application number and filing date of the application shall be made available on the website of the Office.

RULE 703. Allowance of Application and Issuance of Certificate of Registration. -When no opposition is filed within thirty (30) days after the publication for opposition, the mark is deemed registered on the next calendar day following the expiration of the opposition period. In cases where a motion for extension for the period to file an opposition is granted by the Bureau of Legal Affairs, the mark is deemed registered the day following the expiration of the extension period.

When an opposition is filed, a mark shall be considered registered on the date the decision or final order giving due course to the application becomes final and executory.

If the payment for the issuance of the Certificate of Registration has not been paid, the Examiner shall send a notice thereof to the applicant. The applicant shall pay the corresponding fee for the issuance of the Certificate of Registration within two (2) months from mailing date of the notice; otherwise, the registered mark shall be declared abandoned. The abandoned registration, however, may be revived subject to the requirements of this TM Regulations.

The issuance of the Certificate of Registration shall be published in the IPOPHL eGazette and shall be entered in the records of this Office.

RULE 704. Republication in cases of Settlement. In instances when the mark is subject of a settlement and/or compromise agreement, and there was an amendment to the mark, its description, and/or specification, the amended mark may be republished for the public's information.

PART 8 EFFECT AND NOTICE OF REGISTRATION

RULE 800. Rights Conferred. - The owner of a registered mark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs or containers for goods or services which are identical or similar to those in respect of which the mark is registered, where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

The exclusive right of the owner of a well-known mark which is registered in the Philippines, shall extend to goods and services which are not similar to those in respect of which the mark is registered: *Provided*, That use of the mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered mark: *Provided further*, That the interests of the owner of the registered mark are likely to be damaged by such use.

RULE 801. Duration. - The registration shall remain in force for ten (10) years, renewable for periods of ten (10) years: *Provided*, That the requisite DAU as provided for under these Regulations has been filed.

RULE 802. Certificate of Registration. - A certificate of registration of a mark shall be *prima facie* evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those

that are related thereto as specified in the certificate. For this purpose, a digitally signed certificate of registration shall have the same legal effect as a traditionally signed certificate.

After a mark, trade name, or other mark of ownership has been registered, all documents relating to the case are subject to general inspection, and copies will be furnished upon written request of the interested party and payment of the required fees.

RULE 803. *Contents of Certificate of Registration.* - The certificate of registration of a mark shall include the following:

- (a) reproduction of the mark;
- (b) nature of the mark;
- (c) registration number;
- (d) the name of the registered owner;
- (e) address of the registered owner, and if the registered owner's address is outside the country, its address for service within the country;
- (f) the date of application;
- (g) the date of registration;
- (h) if priority is claimed, an indication of this fact, and the number, date and country/office of the application, basis of the priority claim;
- (i) the list of goods and/or services in respect of which registration has been granted, with the indication of the corresponding class or classes; and
- (j) disclaimer, color/ s claimed, description of the mark, if any, translation/transliteration of the mark, if any, and such other data as the Regulations may prescribe from time to time.

The certificate of registration or renewal registration, as far as practicable, shall contain information on the periods for filing the DAU as prescribed in these Regulations.

PART 9 USE OF MARK

RULE 900. *Use of a Mark in a Different Form.* - The use of the mark in a form different from the form in which it is registered, but which does not alter its distinctive character, shall not be a ground for cancellation or removal of the mark and shall not diminish the protection granted to the mark.

RULE 901. *Use of a Mark for Goods Belonging to the Class Registered.* - The use of a mark in connection with one or more of the goods or services belonging to the class in respect of which the mark is registered shall prevent its cancellation or removal in respect of all other goods or services belonging to the same class.

RULE 902. *Use of a Mark by Related Company.* - The use of a mark by a company related to the registrant or applicant shall inure to the latter's benefit, and such use shall not affect the validity of the mark or of its registration: *Provided, That* such mark is not used in such manner as to deceive the public. If use of a mark by a person is controlled by the registrant or applicant with respect to the nature and quality of the goods and/or services, such use shall inure to the benefit of the registrant or applicant.

RULE 903. *Use of Indications by Third Parties for Purposes Other Than Those for Which the Mark is Used.* - Registration of the mark shall not confer on the registered owner the right to preclude third parties from using bona fide their names, addresses, pseudonyms, a geographical name, or exact indications concerning the kind, quality, quantity, destination, value, place of origin, or time of production or of supply, of their goods or services: *Provided, That* such use is confined to the purposes of mere identification or information and cannot mislead the public as to the source of the goods or services.

PART 10
VOLUNTARY SURRENDER OR CANCELLATION, AMENDMENT,
DISCLAIMER BY THE REGISTRANT OR BY ASSIGNEE OF RECORD,
CORRECTION OF MISTAKES; USE OF PRESCRIBED FORMS

RULE 1000. *Jurisdiction of the Examiner.* - The Examiners shall have original jurisdiction over all matters relating to voluntary surrender, voluntary cancellation, voluntary amendment, and voluntary disclaimer of registration, and their decisions, when final, shall be subject to appeal to the Director in the same manner that final decisions of the Examiners in respect of applications for registration may be appealed to the Director. In all such matters, registrants or assignees, their attorneys or agents will deal with the Examiners exclusively, or with such other officials and employees who may be designated by the Director.

RULE 1001. *Cancellation upon Petition by Registrant.* - Upon petition by the registrant or the registrant's authorized representative or agent, the Office may permit any registration to be surrendered for cancellation, and forthwith the appropriate entries shall be made in the records of the Office. The petition for cancellation of registration shall be under oath. Prior to the actual cancellation of the registration, the fact of voluntary cancellation of the mark shall be published in the eGazette for fifteen (15) days for the public's information. However, the date of the cancellation shall be the date when the request was approved by the Office.

RULE 1002. *Amendment or Disclaimer of Registration.* - Upon request of the registrant or the registrant's authorized representative or agent, and payment of the prescribed fee, the Office, for good cause, may permit any registration to be amended or to be disclaimed in part: *Provided, That* the amendment or disclaimer does not alter materially the character of the mark. The appropriate entry shall be made in the records of the Office and a replacement certificate may be issued upon request of the registrant and payment of the prescribed fee. The replacement certificate shall expressly state the fact that it is a replacement and shall reflect the amendment or disclaimer made.

RULE 1003. *Correction of Mistakes Made by the Office.* - Whenever a material mistake in a registration through the fault of the Office is clearly disclosed by the records of the Office, a new certificate of registration may be issued in accordance with these Regulations and without charge. The registration will be published without charge.

RULE 1004. *Corrections of Mistakes Made by Applicant.* - Whenever a mistake is made in a registration and such mistake occurred in good faith through the fault of the applicant, the Office may issue a certificate upon the payment of the prescribed fee: *Provided, That* the correction does not involve any change in the registration that requires republication of the mark. In case of

mistake in the application, the correction shall be entered accordingly upon payment of the prescribed fee.

The petition for correction must be under oath and must specify the mistake for which correction is sought, the manner in which it arose and must state that it occurred in good faith.

RULE 1005. Surrender, Cancellation, or, Amendment, or Removal from the Register, Disclaimer, and Correction to be Given Publicity. - Notice of the surrender, cancellation, or removal from the register, amendment, disclaimer, and correction shall be published in the IPOP HL eGazette. The cost of publication shall be for the account of the registrant or assignee of record in cases of amendment, disclaimer and correction, except when the notice of correction refers to a mistake of the Office.

RULE 1006. Use of Prescribed Forms - The applicant and/or registrant is required to use the IPOP HL-prescribed form/s when making submissions before this Office. In the event that the applicant and/or registrant fails to submit using the prescribed form, the submission will be considered as not having been filed; *However*, the Office may allow the applicant and/or registrant to comply with this requirement and adopt the prescribed form within thirty (30) days from the mailing date of the Office Action requiring its submission. Failure to file the prescribed form within this period will result in the abandonment and/or removal of the mark from the Register.

PART 11
RECORDING OF ASSIGNMENTS OF REGISTRATION, OR ANY OTHER
INSTRUMENT AFFECTING THE TITLE TO ANY REGISTERED MARK,
INCLUDING LICENSES; DIVISION OF REGISTRATION

RULE 1101. Form of Assignment or Transfer. - The assignment of the application for registration of a mark, or of its registration, shall be notarized and require the signature of the applicant, registrant, or the assignee of record in case of subsequent assignment. Transfers by mergers or other forms of succession may be evidenced by the deed of merger or by any document supporting such transfer. If executed and notarized abroad, the document must be authenticated or apostilled, as appropriate.

RULE 1102. Recordal of Assignment or Transfer. - Assignments and transfers shall have no effect against third parties until they are recorded at the Office. Assignments and transfers of registrations and applications for registration shall be recorded upon payment of the required fee.

RULE 1103. Assignment, Other Instruments Affecting the Registration, or License, and Translation, to be Submitted in Original Copy. - Subject to the requirements under Rule 607 of these Regulations, the original or certified true copy of the document of assignment, other instrument or license and its verified translation under oath, if necessary, is required to be submitted to and shall be retained by the Office. If executed and notarized abroad, the document must be authenticated or apostilled, as appropriate

A notice of recordal shall accordingly be issued to the party filing the instrument.

RULE 1104. Date of Recordal of Documents - The date of recordal of an assignment, license or other document is the date of receipt of the instrument in the proper form and the payment of the prescribed fees.

RULE 1105. *A New Certificate of Registration Must be Issued to Assignee.* - Upon written request of an assignee of record, and upon payment of the required fee, a new certificate of registration for the unexpired period of the registration shall be issued to the assignee.

RULE 1106. *Action may be Taken by Assignee of Record in Any Proceeding in the Office.* - Any action in any proceeding in the Office which may or must be taken by a registrant or applicant may be taken by the assignee to the exclusion of the original owner, registrant, applicant, or earlier assignee, provided the assignment has been recorded. Unless such assignment has been recorded, no assignee will be recognized to act on the application or registration.

RULE 1107. *Clearance of Trademark License Agreement Prior to Recordal.* - A trademark license agreement shall provide for effective control by the licensor of the quality of the goods or services of the licensee in connection with which the mark is used. If the license contract does not provide for such quality control, or if such quality control is not effectively carried out, the license contract shall not be valid.

A license contract shall be submitted to this Office, the contents of which shall be kept confidential but shall record it and publish a reference thereto.

No trademark license agreement shall be recorded with this Office unless it has complied with the above-mentioned provision. A license contract shall have no effect against third parties until such recording is effected.

RULE 1108. *Division or Merger of Registration/s.* - At any time during the life of a registration, and upon payment of the required fee, the owner of the registered mark may request in writing and under oath that the registration be divided. The request must state the following:

- (a) name and address of the owner of record and the authorized representative or agent of record;
- (b) the mark;
- (c) the number and the date of issuance of the certificate to be divided; and
- (d) the goods and/or services into which the registration is to be divided, specifying the number of the class of said goods and/or services according to the Nice Classification.

The Office may grant the request to divide the registration, provided that the division shall not involve any change in the registration that requires republication of the mark and provided that a single class shall not be subdivided.

Separated registrations resulting from the division of registration under this Rule may be merged upon written request under oath and payment of the required fee.

RULE 1109. *Cancellation of Original Certificate and Issuance of Transfer Certificates of Registration.* - Upon approval of the request to divide a registration and payment of the required fee, the Director shall order that the original certificate be cancelled and new certificates of registration be issued for the remainder of the term covered by the original certificate.

RULE 1110. *Contents of Transfer Certificates of Registration.* - The transfer certificates of registration shall include the following:

- (a) a reproduction of the mark;
- (b) the nature of the mark;

- (c) transfer certificate registration numbers;
- (d) the name of the registered owner;
- (e) the address of the registered owner, and if such address is outside the country, the address for service within the country;
- (f) the name of the registered owner of the original certificate in case the owner of the transfer certificates is a different person;
- (g) the date of request for division of the original registration;
- (h) the date of the issuance of the transfer certificate of registration;
- (i) the date of filing of the application and registration of the original registration;
- (j) if priority is claimed, an indication of this fact, and the number, date and country/office of the application which is the basis of the priority claim;
- (k) the list of goods or services covered by the transfer certificate of registration with the indication of the corresponding class or classes; and
- (l) such other data included in the original certificate of registration and such other information as the Regulations may prescribe from time to time.

PART 12 RENEWAL OF REGISTRATION

RULE 1200. *Request for Renewal.* - A registration may be renewed for periods often (10) years at its expiration upon filing of a request and payment of the prescribed fee. The request shall contain the following indications and/or supporting documents:

- (a) An indication that renewal is sought;
- (b) The name, address and other contact details of the registrant or successor-in-interest, hereafter referred to as the "right holder";
- (c) The registration number;
- (d) The filing date of the application which resulted in the registration to be renewed;
- (e) Where the right holder has an authorized representative or agent, the name and address of that representative or agent;
- (f) The recorded goods or services for which the renewal is requested, grouped according to the classes of the latest version of the Nice Classification; and
- (g) A signature by the right holder or the right holder's authorized representative or agent.

In case of material variations of the mark, a new application must be filed.

RULE 1201. *When to File Request for Renewal.* - The request for renewal may be made at any time within six (6) months before the expiration of the period for which the registration was issued or renewed, or within six (6) months after such expiration, subject to the payment of the prescribed additional fee or surcharge.

RULE 1202. *Jurisdiction of the Examiner.* - The Examiner shall have original jurisdiction over an application for renewal registration, and the decision, when final, is subject to appeal to the Director under the conditions specified in these Regulations. The Examiner shall notify the registrant of the final decision of refusal of the renewal and the reasons therefor.

RULE 1203. *Renewal Filed by Person Who is Not the Resident Agent of Record.* - If the registrant, assignee or other owner of the mark which is the subject of a petition for renewal registration is not domiciled in the Philippines, and if the petition for renewal is filed by a person who is not the authorized representative or agent of record, the power of attorney appointing the person filing

the petition as the representative of the registrant must be filed and, upon payment of the required fee, must be recorded before the Office can act upon the petition for renewal.

RULE 1204. *Certificate of Registration Issued Under Republic Act No. 166 to be Surrendered.* - The certificate of registration granted under Republic Act No. 166 must be surrendered to the Office upon renewal, if the official copy of such certificate of registration is not in the files of the Office.

After the surrender of the Certificate of Registration granted under Republic Act No. 166, the applicant for renewal may, upon request, obtain a certified copy thereof, upon payment of the appropriate fees.

RULE 1205. *Refusal of Renewal Registration; Appeal to the Director.* - The application for renewal may be refused by the Examiner for any valid reason. The application for renewal may then be completed or amended in response to the refusal, or the case may be appealed to the Director if the refusal has become final.

RULE 1206. *Certificate of Renewal of Registration.* - The Office shall issue a certificate of renewal upon payment of the required fee for the issuance thereof. The issuance of the certificate of renewal shall be published in the IOPHLE eGazette and shall be entered in the records of this Office.

The certificate of renewal of registration shall contain the following:

- (a) registration number;
- (b) the nature of the mark;
- (c) the mark subject of the renewal;
- (d) the date of original registration and renewal registration;
- (e) the duration of the renewal registration;
- (f) all the data required to be contained in a certificate of registration provided in these Regulations including any limitation contained in the order of the Director approving the renewal of the registration.

PART 13 PETITIONS AND APPEAL

RULE 1300. *Nature of the Function of Examiners.* - The function of determining whether an application for registration or renewal thereof should be allowed or denied under the facts disclosed in the application or the relevant document, and in the references consulted by the Examiner and under the applicable law (statutory and decisional) is a quasi-judicial function and involves the exercise of judicial discretion.

Thus, with respect to such function, the Director cannot exercise direct control and supervision over the Examiners but only general supervision, exercised through a review of the recommendation they may make for the grant of registration and of other actions, and through a review of their adverse decisions by petition or appeal.

RULE 1301. *Petition to the Director to Question the Correctness of the Action of an Examiner on a Matter not Subject to Appeal.* - A petition may be filed with the Director from any action or requirement of the Examiner which is not subject to appeal and in other appropriate

circumstances. Such petition, and any other petition which may be filed, must contain a statement of the facts involved and the point or points to be reviewed. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition. The Examiner may be directed by the Director to furnish a written statement setting forth the reasons for the decision upon the matter averred in the petition. If the Examiner is required to submit a written statement, a copy thereof shall be provided to the petitioner. The mere filing of a petition will not stay the maximum period of four (4) months counted from the mailing date of the Examiner's action subject of the appeal to reply to an Examiner's action nor will it act as a stay of other proceedings.

RULE 1302. Appeals to the Director. - Every applicant for the registration of a mark or other mark of ownership may, upon the final refusal of the Examiner to allow registration, appeal the matter to the Director. An appeal may also be made to the Director from any adverse action of the Examiner in any matter over which these Regulations give original jurisdiction to the Examiner. A second adverse decision by the Examiner on the same grounds may be considered as final by the applicant, petitioner, or registrant for purposes of appeal.

RULE 1303. Effect of a Final Decision of an Examiner Which is Not Appealed. - A final decision of an Examiner which is not appealed to the Director within the prescribed period, or, if appealed, the appeal is not granted, shall be considered as final for all intents and purposes, and shall have the effect of *res judicata* in respect of any subsequent action on the same subject matter.

If an application is considered abandoned for failure of the applicant to respond to an action of the Examiner on the merits, such as citation of confusingly similar marks, the order declaring the application as abandoned, which has become final shall likewise have the effect of *res judicata*.

RULE 1304. Time and Manner of Petition or Appeal. - Any petition or appeal must be taken by filing a petition or a notice of appeal, as the case may be, and payment of the required fee within two (2) months from the mailing date of the action appealed from. It must specify the grounds upon which the petition or appeal is taken, and must be signed by the petitioner or appellant or by the attorney of record. The period for filing the petition or the notice of appeal may be extended, upon written request and payment of the prescribed fee, for a period of two (2) months. However, in no case shall the period exceed four (4) months from the mailing date of the action appealed from.

RULE 1305. Appellant's Brief Required. - In case of an appeal, the appellant shall, within two (2) months, without extension, from the date of filing of the Notice of Appeal, file a brief of the authorities and arguments on which the appellant relies upon to maintain the appeal. In case of appellant's failure to file the brief within the time allowed, the appeal shall be dismissed.

The Appellant's Brief may also be filed together with the Notice of Appeal or Petition.

RULE 1306. Examiner's Answer. - If required by the Director, the Examiner shall submit a written statement in answer to the appellant's brief within two (2) months from the order of the Director to submit such answer. The appellant shall be furnished a copy of such answer.

RULE 1307. Appellant's Reply. - In case of an appeal, the appellant may file a reply brief addressing only such new points as may have been raised in the Examiner's answer, within one (1) month from the date of receipt of the copy of such answer.

RULE 1308. Appeal to the Director General. - The decision or order of the Director shall become final and executory thirty (30) days after receipt of a copy thereof by the appellant, unless within

the said period, a motion for reconsideration is filed with the Director, or an appeal to the Director General has been perfected pursuant to the IPOPPL Uniform Rules on Appeal. Only one (1) motion for reconsideration of the decision or order of the Director shall be allowed. A motion for reconsideration, however, is not required for purposes of filing an appeal to the Director General.

PART 14 MISCELLANEOUS PROVISIONS

RULE 1400. *Applications Pending on Effective Date of the IP Code.* - The following regulations shall apply to applications pending on the effective date of the IP Code on January 1, 1998 hereinafter referred to in this Rule as "pending applications":

- (a) *Filing Date of Pending Applications.* - Pending applications shall retain their priority date or original date of filing with the Bureau of Patents, Trademarks and Technology Transfer.
- (b) *Interference.* -In all cases where interference could have been declared under Republic Act No. 166, as amended, and its implementing rules and regulations, as amended, but the same could not be declared, such as when one of the applications has been amended and prosecuted under the IP Code while the other application or applications were not, the application which first meets all the requirements for registration shall be allowed and published for opposition in the IPOPPL eGazette in accordance with these Regulations. The other applicant or applicants shall have the right to file a notice of opposition, without need of paying the filing fee, to determine whether or not any of the applicant/s and or opposer/s has/have the right to the registration of the mark, and, all other issues, including the registrability of the mark.

RULE 1401. *Duration of Registration.* - A registration granted on or before December 31, 1997 and that remained pending on the effective date of the IP Code on January 1, 1998 shall be subject to the same conditions for maintenance as provided in these Regulations and shall have a term of twenty (20) years. The DAU requirement for registrations that have a term of twenty (20) years shall be filed within one (1) year from the 5th, 10th, and 15th anniversaries of the date of registration of the mark.

RULE 1402. *Duration of Renewal of Registration Granted Under Republic Act No. 166.* -Marks registered under Republic Act No. 166 shall remain in force and effect and shall be renewed within the time and manner provided for renewal of registration by these Regulations. The renewal shall be for a duration of ten (10) years. Trade names and marks registered in the Supplemental Register under Republic Act No. 166 that were subsisting as of January 1, 1998 shall remain in force but shall no longer be subject to renewal.

RULE 1403. *Registrations Subsisting on January 1, 1998.* -The registration, or extension thereof, in the Supplemental Register under Republic Act No. 166 of a trade name or mark which was subsisting on the effectivity of the IP Code on January 1, 1998 shall remain in force for the entire term for which it was granted. However, such registration shall no longer be subject to renewal.

RULE 1404. *Repealing Clause.* - All rules and regulations, orders, circulars and memoranda or parts thereof that are inconsistent with these Regulations are hereby repealed or modified accordingly.

RULE 1405. *Separability.* - If any provision in these Regulations or application of such provision to any circumstance is held invalid, the remainder of these Regulations shall not be affected thereby.

RULE 1406. *Effectivity.* - These Regulations shall take effect on# 1cArua/y 202 ? after publication in a newspaper of general circulation. The Office of the National Administrative Register at the UP Law Center, University of the Philippines, shall be furnished with three (3) copies hereof within one (1) week after its publication.

Done this 10th day of January; Taguig City, Philippines.


ROWEL S. BARBA
Director General

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