

## FAQs on Trademarks

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## **FAQs on Trademarks**

### **1. What is a mark?**

Under the Intellectual Property Code (IP Code) of the Philippines, a “mark” is defined as 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.

### **2. What is a collective mark?**

"Collective mark" means any visible sign designated as such in the application for registration and capable of distinguishing the origin or any other common characteristic, 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.

### **3. What is a trade name?**

"Trade name" means the name or designation identifying or distinguishing an enterprise.

### **4. Can colors not defined by given forms be registered as marks?**

No. Section 123.1 (l) of the Intellectual Property Code (IP Code) provides that a mark that consists of color alone, unless defined by a given form, is not registrable.

### **5. Can shapes be registered as marks?**

Section 123 (k) of the Intellectual Property Code (IP Code) provides that a mark that 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 may not be registered as a trademark or service mark.

### **6. Can a signature identifying a particular living individual be registered as a mark?**

Section 123 of the Intellectual Property Code (IP Code) provides that a mark that consists of a name, portrait or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the Philippines, during the life of his widow, if any, except by written consent of the widow is not registrable.

### **7. What is the importance of registration of a mark or trade name?**

In the Philippines, registration of the mark or trade name is important. Under the Intellectual Property Code of the Philippines, 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 specified in the certificate. It is a pre-requisite to maintain an action for infringement or to refuse, by the customs officer, entry into the country of goods bearing the infringing mark which copies or simulates the

registered mark, based on copy of the certificate of registration duly recorded with the Bureau of Customs.

**8. Who may apply for registration?**

Only the owner of the mark or trade name may apply for its registration.

**9. Who may be appointed as resident agent of foreign applicant?**

If the applicant is not domiciled or has no real and effective commercial establishment in the Philippines, he shall designate by a written document filed in the Intellectual Property Office (IPO), the name and address of a Philippine resident who may be served notices or processes in proceedings affecting the mark. Such notices or services may be served upon the person so designated by leaving a copy thereof at the address specified in the last designation filed. If the person so designated cannot be found at the address given in the last designation, such notice or process may be served upon the Director of the IPO.

**10. Where should trademarks be registered?**

Trademarks, trade names, servicemarks and names or other marks of ownership are applied for registration, and are registered in the Intellectual Property Office (IPO) of the Philippines. Registration of marks is the function of the Bureau of Trademarks in the IPO.

**11. What are the requirements for registration of a mark under Philippine law?**

The application for the registration of the mark shall contain the following:

- (a) A request for registration;
- (b) The name and address of the applicant;
- (c) The name of a State of which the applicant is a national or where he 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) The appointment of an agent or representative, if the applicant is not domiciled in the Philippines;
- (f) Where the applicant claims the priority of an earlier application, an indication of:
  - The name of the State with whose national office the earlier application was filed or it filed with an office other than a national office, the name of that office;
  - The date on which the earlier application was filed; and
  - Where available, the application number of the earlier application;

(g) Where the applicant claims 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 statement to that effect;

(i) One or more reproductions of the mark, as prescribed in the Regulations;

(j) A transliteration or translation of the mark or of some parts of the mark, as prescribed in the 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; and

(l) A signature by, or other self-identification of, the applicant or his representative.

The applicant or the registrant shall file a declaration of actual use of the mark with evidence to that effect, as prescribed by the regulations within three (3) years from the filing date of the application. Otherwise, the application shall be refused or the mark shall be removed from the Register by the Director.

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.

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, it may require the applicant to submit sufficient evidence to remove the doubt.

### **12. When is the filing date of an application?**

The filing date of an application shall be the date on which the Intellectual Property Office (IPO) received the following indications and elements:

- (a) An express or implicit indication that the registration of a mark is sought;
- (b) The identity of the applicant;
- (c) Indications sufficient to contact the applicant or his representative, if any;
- (d) A reproduction of the mark whose registration is sought; and
- (e) The list of the goods or services for which the registration is sought.

No filing date shall be accorded until the required fee is paid.

### **13. What is a Declaration of Actual Use?**

A **Declaration of Actual Use** is a document that must be filed within 3 years from filing of the trademark application. This is a mandatory requirement in an application. Otherwise, the application shall be refused or the mark shall be removed from the Register by the Director.

**14. What is the duration of a trademark registration?**

A certificate of registration shall remain in force for ten (10) years: Provided, that the registrant shall file a declaration of actual use and evidence to that effect, or shall show valid reasons based on the existence of obstacles to such use, as prescribed by the regulations, within one (1) year from the fifth anniversary of the date of the registration of the mark. Otherwise, the mark shall be removed from the Register by the Office.

**15. What are the rights conferred to the owner of a registered mark?**

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 trademark 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 that 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.

**16. May an application for registration of a mark, or its registration be assigned or transferred?**

Yes. An application for registration of a mark, or its registration, may be assigned or transferred with or without the transfer of the business using the mark.

Such assignment or transfer shall, however, be null and void if it is liable to mislead the public, particularly as regards the nature, source, manufacturing process, characteristics, or suitability for their purpose, of the goods or services to which the mark is applied.

The assignment of the application for registration of a mark, or of its registration, shall be in writing and require the signatures of the contracting parties. Transfers by mergers or other forms of succession may be made by any document supporting such transfer.

The assignments and transfers of registration of marks shall be recorded at the Intellectual Property Office (IPO) on payment of the prescribed fee. The assignment and transfers of applications for registration shall, on payment of the same fee, be provisionally recorded, and the mark, when registered, shall be in the name of the assignee or transferee.

The assignments and transfers shall have no effect against third parties until they are recorded at the Intellectual Property Office (IPO).

**17. What is an Affidavit of Use?**

Once the application is allowed and a certificate of registration is issued, the owner/registrant is required to file by the 6th year, an **Affidavit of Use** which shows that owner/registrant has been using the mark since its registration. In practical terms, the Declaration of Actual Use and the Affidavit of Use are one and the same. The difference only is that the Declaration of Actual Use is a prerequisite to registration and the Affidavit of Use is a prerequisite to the continuance of the certificate of registration up to its life of 10 years (renewable for periods of 10 years more).

**18. Can a certificate of registration be renewed?**

A certificate of registration may be renewed for periods of ten (10) years at its expiration upon payment of the prescribed fee and upon filing of a petition for renewal of registration.

The **Petition for renewal of Registration** must be signed by a duly authorized representative of the owner/registrant and must be notarized.

**19. What are the requirements for renewal of trademark registration?**

The owner/registrant is required to submit a **Petition for Renewal of Registration Form**. It must be signed by a duly authorized representative of the owner/registrant and must be notarized.

**20. When must the petition for renewal of the trademark registration be filed?**

The renewal must be filed within six (6) months before the expiration of the term of the trademark registration or within the six (6) months grace period after its expiration ( with payment of additional fee for late renewal).

**21. What are the requirements for recordal of change of name/address?**

Under Philippine law, there is no specific document required to substantiate the change of address of a registrant or an applicant. By practice, the Intellectual Property Office (IP Code) usually requires only written documents such as a certification from the corporate secretary of the applicant or registrant attesting to the change of address, or a similar corporate register evidencing the same.

**22. What is the procedure for cancellation of registration of a mark?**

A petition to cancel a registration of a mark may be filed with the Bureau of Legal Affairs (BLA), Intellectual Property Office by any person who believes that he is or will be damaged by the registration of a mark under the Intellectual Property Code (IP Code) as follows:

- (a) Within five (5) years from the date of the registration of the mark;
- (b) At any time, if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of the Intellectual Property Code (IP Code), or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic

name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used; and

(c) At any time, if the registered owner of the mark without legitimate reason fails to use the mark within the Philippines, or to cause it to be used in the Philippines by virtue of a license during an uninterrupted period of three (3) years or longer.

**23. What are the instances when non-use of a mark will not be a ground for cancellation of registration?**

- Non-use of a mark may be excused if caused by circumstances arising independently of the will of the trademark owner. Lack of funds shall not excuse non-use of a mark.
- The use of the mark in a form different from the form in which it is registered, which does not alter its distinctive character, shall not be ground for cancellation or removal of the mark and shall not diminish the protection granted to the mark.
- 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 of the same class.
- The use of a mark by a company related with the registrant or applicant shall inure to the latter's benefit, and such use shall not affect the validity of such 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 or services, such use shall inure to the benefit of the registrant or applicant.

**24. Who are liable for trademark infringement?**

Any person who shall, without the consent of the owner of the registered mark:

1. Use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark or the same container or a dominant feature thereof in connection with the sale, offering for sale, distribution, advertising of any goods or services including other preparatory steps necessary to carry out the sale of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or
2. Reproduce, counterfeit, copy or colorably imitate a registered mark or a dominant feature thereof and apply such reproduction, counterfeit, copy or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or



services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, shall be liable in a civil action for infringement by the registrant for the remedies hereinafter set forth: Provided, that the infringement takes place at the moment any of the acts stated are committed regardless of whether there is actual sale of goods or services using the infringing material.

**25. What are the remedies available to a trademark owner for trademark infringement?**

The owner of a registered mark may recover damages from any person who infringes his rights, and the measure of the damages suffered shall be either the reasonable profit which the complaining party would have made, had the defendant not infringed his rights, or the profit which the defendant actually made out of the infringement, or in the event such measure of damages cannot be readily ascertained with reasonable certainty, then the court may award as damages a reasonable percentage based upon the amount of gross sales of the defendant or the value of the services in connection with which the mark or trade name was used in the infringement of the rights of the complaining party.

On application of the complainant, the court may impound during the pendency of the action, sales invoices and other documents evidencing sale.

In cases where actual intent to mislead the public or to defraud the complainant is shown, in the discretion of the court, the damages may be doubled.

The complainant, upon proper showing, may also be granted injunction.

In any suit for infringement, the owner of the registered mark shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is likely to cause confusion, or to cause mistake, or to deceive. Such knowledge is presumed if the registrant gives notice that his mark is registered by displaying with the mark the words "Registered Mark" or the letter R within a circle or if the defendant had otherwise actual notice of the registration.

