

Rules & Regulations on Trademarks, Service Marks, Tradenames and Marked or Stamped Containers

(as amended by Office Order No. 39 (2002), Order No. 40 (2002), Office Order No. 20 (2001), Office Order No. 08 (2000), Office Order No. 17 (1998))

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;

Now, therefore, pursuant to the provisions of 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 are hereby promulgated:

PART 1

Registration of Trademarks and Service Marks

RULE 10.-*Title.* — These regulations shall be known as the "Trademark Regulations". [As amended by Office Order No. 08 (2000)]

RULE 100. *Definitions.* — Unless otherwise specified, the following terms shall have the meaning provided in this Rule:

- (a) "Bureau" means the Bureau of Trademarks of the Intellectual Property Office;
- (b) "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;
- (c) "Competent authority" for purposes of determining whether a mark is well-known, means the Court, the Director General, the Director of the Bureau of Legal Affairs, or any administrative agency or office vested with quasi-judicial or judicial jurisdiction to hear and adjudicate any action to enforce the rights to a mark;
- (d) "Director" means the Director of the Bureau of Trademarks;
- (e) "Director General" means the head of the Intellectual Property Office;
- (f) "Examiner" means the trademark examiner or any official or employee of the Bureau of Trademarks authorized to examine applications for registration or renewals thereof;
- (g) "IP Code" means Republic Act No. 8293 otherwise known as the Intellectual Property Code of the Philippines;
- (h) "IPO Gazette" means the Intellectual Property Office's own publication where all matters required to be published under the IP Code shall be published;
- (i) "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;
- (j) "Office" means the Intellectual Property Office;

(k) "Regulations" means these set of rules and regulations and such Rules of Practice in Trademarks and Service Marks as may be formulated by the Director of Trademarks and approved by the Director General; and

(l) "Trade name" means the name or designation identifying or distinguishing an enterprise, also known or referred to as business identifier.

RULE 101. *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 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;

(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. Geographical indications are indications which identify a good as originating in the territory of a country which is a member of, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.

(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 or 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 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 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 102. *Criteria for determining whether a mark is well-known.* — In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- (b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
- (c) the degree of the inherent or acquired distinction of the mark;
- (d) the quality-image or reputation acquired by the mark;
- (e) the extent to which the mark has been registered in the world;
- (f) the exclusivity of registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;
- (h) the exclusivity of use attained by the mark in the world;
- (i) the commercial value attributed to the mark in the world;
- (j) the record of successful protection of the rights in the mark;
- (k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and,
- (l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his mark is a well-known mark.

RULE 103. *Trade Names or Business Names.* — (a) A name or designation may not be used as a trade name if by its nature or the use to which such name or designation may be put, it 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.

(b) 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.

(c) 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 tradenames *mutatis mutandis*.

(d) 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 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.

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.* — (a) 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 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 Intellectual Property Code.

(b) 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.* — (a) 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.

(b) 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.

(c) The country of origin of the applicant is the country in which he is a national, domiciled, or has a *bona fide* and effective industrial or commercial establishment.

(d) Nothing in this rule shall entitle the owner of a registration granted under this rule to sue for acts committed prior to the date on which his 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 himself of other remedies provided for under the law.

(e) 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 shall not thereafter serve as a basis for claiming a right of priority.

RULE 203. *Requirements for Applications Claiming Priority Right.*— An application with claim of priority right must be filed within six (6) months from the date the earliest foreign application was filed. Without need of any notice from the Office, Bureau or examiner, the applicant shall file an English translation of a certified copy of any of the following within three (3) months from the date of filing in the Philippines:

- a) Foreign application showing the date of filing
- b) Foreign registration indicating the date of filing

[as amended by Office Order No. 39 (2002)]

RULE 204. Declaration of Actual Use. — The Office will not require any proof of use in commerce in the processing of trademark applications. However, without need of any notice from the Office, all applicants or registrants shall file a declaration of actual use of the mark with evidence to that effect within three years, without possibility of extension, 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 *motu proprio*.

RULE 205. Contents of the Declaration and Evidence of Actual Use. — The declaration shall be under oath, must refer to only one application or registration, must contain the name and address of the applicant or registrant declaring that the mark is in actual use in the Philippines, list of goods where the mark is attached; list the name or names and the exact location or locations of the outlet or outlets where the products are being sold or where the services are being rendered, recite sufficient facts to show that the mark described in the application or registration is being actually used in the Philippines and, specifying the nature of such use. The declarant shall attach five labels as actually used on the goods or the picture of the stamped or marked container visibly and legibly showing the mark as well as proof of payment of the prescribed fee.

[As amended by Office Order No. 08 (2000)]

PART 3 Who May Apply for a Mark

RULE 300. The Applicant. — (a) Applicant may be a person or juridical person.

(b) Unless modified by this Chapter, all applications for a mark should be in the name of the applicant(s) who may sign the application. If there are more than one applicant, all of them should be named as applicant but anyone may sign the application for and in 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 in behalf of the said person. In case of an aliquot portion or undivided interest, each of the joint owners will sign the application.

RULE 302. Representation; Address for Service. — 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 Office, the name and address of a Philippine resident who may be served notices or process in proceedings affecting the mark. The written document shall be submitted to the Office within sixty (60) days from filing date without need of any notice from the Office. 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. *[As amended by Office Order No. 08 (2000)]*

RULE 303. Applicant may be represented by attorney. — The owner of a mark may file and prosecute his own application for registration, or he may be represented by any attorney or other person authorized to practice in such matters by the Office. The Office shall not aid in the selection of an attorney or agent other than the furnishing of the list of Attorneys or agents authorized to practice before the Office.

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 to submit within sixty (60) days from notice a power of attorney or authorization before he will be allowed to take an initial or further action in any application or registration.

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

[As amended by Office Order No. 08 (2000)]

RULE 305. *Death, insanity, incapacity of applicant.* — When the applicant dies, becomes insane or otherwise incapacitated, the legally appointed executor, administrator, guardian, conservator or representative of the dead or insane or incapacitated applicant may prosecute the application in behalf of the heirs and successors-in-interest of the applicant.

RULE 306. *Signature and other means of Self-identification.* — (a) Where a signature is required, the Office shall accept:

- (1) A hand-written signature; or
- (2) 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.

(b) No attestation, notarization, authentication, legalization or other certification of any signature or other means of self-identification referred to in the preceding paragraphs, will be required, except, where the signature concerns the surrender of a registration.

PART 4 Trademark Application

RULE 400. *Requirements of application.* — 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 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, a declaration claiming the priority of that earlier application, together with an indication of:
 - the name of the state with whose national Office the earlier application was filed or if 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 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 statement to that effect;
- (i) a reproduction of the mark and facsimiles thereof as provided in these Regulations;
- (j) a 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;
- (m) a signature by, or other self-identification of, the applicant or his representative;
- (n) Power of Attorney if the filing is through a representative; and
- (o) sworn statement that the applicant is a small entity if such be the fact.

RULE 401. *Office Application Form.* — For the convenience of applicants, the Office shall draw up and make available a standard application form which may be reproduced at will by applicants and other persons at their own cost.

RULE 402. *Label.* — The applicant may include the label as actually used or intended to be used on the goods or a copy or duplicate made by photo engraving or some similar process.

The mark must be bigger and more dominant than the generic term of goods except in the case of medicine as required by law.

RULE 403. *Drawing.* — (a) The drawing of the mark shall be substantially exact representation thereof as actually used or intended to be used on or in connection with, the goods or services of the applicant.

(b) A typed drawing may be accepted by the Examiner if no special characteristics have to be shown such as design, style of lettering, color, diacritical marks, or unusual forms of punctuation.

A computer print-out may also be accepted by the Examiner if it substantially complies with the requirement that it must be the exact representation of the mark.

(c) The provisions of this Rule shall, however be construed liberally in determining whether the applications shall be considered complete for the purpose of granting a filing date.

RULE 404. *Drawing for a service mark may be dispensed with in certain cases.* — The drawing of a service mark may be dispensed with but the application must contain an adequate description of such mark.

RULE 405. *Drawing to be on Bristol board.* — The Drawing must be made upon pure white paper of a thickness of a Bristol board. The surface of the paper must be calendered and smooth.

RULE 406. *Size of board; "sight".* — The size of a sheet on which a Drawing is made must be exactly two hundred ten millimeters (210 mm) by two hundred ninety-seven millimeters (297 mm) or the size of an A4 paper. Nineteen millimeters (19 mm) from its edges, a single marginal line is to be drawn, leaving the "sight" precisely one hundred seventy-two millimeters (172 mm) by two hundred fifty-nine millimeters (259 mm). Within this margin all work and signatures must be included. One of the shorter sides of the sheet should be regarded as its top.

RULE 407. *Drawing to be with the Pen or by other processing giving satisfactory results.* — If colors are not claimed, all Drawings must be made with pen only or by a process which will give them satisfactory reproduction characteristics. Every line and letter, signatures included, must be absolutely black. This direction applies to all lines, however fine, and to shading. All lines must be clean, sharp, and solid, and they must not be too fine or crowded. Surface shading, when used, should be open.

RULE 408. *The Name of the Owner to be within Marginal Lines.* — The name of the proprietor of the trademark or service mark trade name must be within the marginal lines and should not encroach upon the drawing. It should be signed by the owner or his Attorney of record. However, a printed or stamped signature or the use of seal accompanied by an indication in letters of the name of signatory is also accepted.

RULE 409. *When board may be turned on its side.* — When the view is longer than the width of the sheet, the sheet should be turned on its side.

RULE 410. *Manner of mailing the Drawing to the Bureau.* — Drawing transmitted to the Office should be sent flat, protected by a sheet of heavy binder's board, or should be rolled for transmission in a suitable mailing tube. They should never be folded.

RULE 411. *Color.* — Where color is a material feature of the mark as used or intended to be used, the color or colors employed may be actually reproduced in the drawings and facsimiles. Otherwise, a statement must be made giving the name or names of the color or colors claimed indicating the principal part or parts of the mark which are in such color or colors.

RULE 412. *Informal Drawing.* — A Drawing not executed in conformity with the foregoing rules may be accepted for the purpose of examination, but the Drawing must be corrected or a new one furnished, as may be required, before the mark can be published for opposition or the application allowed. Substitute Drawings will not be accepted unless they have been required by the Examiner or unless correction of original Drawing would require that the mark or trade name be substantially entirely redrawn.

RULE 413. *Use of an old Drawing in a new application.* — In an application filed in place of an abandoned or rejected application, a new complete application is required, but the old Drawing, if suitable, may be used. The application must be accompanied by a request for the transfer of the Drawing, and by a permanent photographic copy, or an order for such copy, of the Drawing to be placed in the original file. A drawing so transferred or to be transferred cannot be amended.

RULE 414. *The small facsimiles of the Drawing, how prepared.* — The ten small facsimiles of the Drawing must be printed in black ink or in color, if colors are claimed, one facsimile on Bristol board and the other nine facsimiles on an ordinary coupon bond paper and must be capable of being satisfactorily reproduced when published in the IPO Gazette. The size of the sheet on which these facsimiles are to be printed must be seventy millimeters (70 mm) long and thirty-five millimeters (35 mm) wide.

RULE 415. *Translation/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 foreign word(s), letter(s) and character(s), or foreign sounding.

Transliteration is an act, process or instance of representing or spelling of words, letters or characters of one language in the letters and characters of another language or alphabet.

Translation is an act, process or instance of translating as rendering from one language or representational system into another.

RULE 416. *Nice Classification.* — The applicant must indicate 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 Nice Classification to which each group of goods or services belongs.

CLASSIFICATION OF GOODS

TITLE *Class*

- 1 Chemical products used in industry, science, photography, agriculture, horticulture, forestry; artificial and synthetic resins; plastics in the form of powders, liquids or plates, for industrial use; manures (natural and artificial); fire extinguishing compositions; tempering substances and chemical preparations for soldering; chemical substances for preserving foodstuffs; tanning substances; adhesive substances used in industry.
- 2 Paints, varnishes, lacquers, preservatives against rust and against deterioration of wood; coloring matters; dyestuffs; mordants; natural resins; metals in foil and powder form for painters and decorators
- 3 Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery; essential oils, cosmetics, hair lotions, dentrifices
- 4 Industrial oils and greases (other than edible oils and fats and essential oils);lubricants; dust laying and absorbing compositions; fuels (including motor spirit) and illuminants; candles, tapers, nightlights and wicks
- 5 Pharmaceutical, veterinary and sanitary substances; infants'; and invalids' foods; plasters, material for bandaging; material for stopping teeth, dental wax; disinfectants; preparations for killing weeds and destroying vermin
- 6 Unwrought and partly wrought common metals and their alloys; anchors, anvils, bells, rolled and cast building materials; rails and other metallic materials for railway tracks; chains (except driving chains for vehicles); cables and wires (non-electric); lock-smiths' work ; metallic pipes and tubes; safes and cash boxes; steel balls; horseshoes; nails and screws; other goods in non-precious metal not included in other classes; ores
- 7 Machines and machine tools; motors (except for land vehicles); machine couplings and belting (except for land vehicles); large size agricultural implements; incubators
- 8 Hand tools and instruments; cutlery, forks and spoons; side arms
- 9 Scientific, nautical, surveying and electrical apparatus and instruments (including wireless), photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life saving and teaching apparatus and instruments; coin or counter-freed apparatus; talking machines; cash registers; calculating machines; fire-extinguishing apparatus
- 10 Surgical, medical, dental and veterinary instruments and apparatus (including artificial limbs, eyes and teeth)
- 11 Installations for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes
- 12 Vehicles; apparatus for locomotion by land, air or water
- 13 Firearms; ammunition and projectiles; explosive substances; fireworks
- 14 Precious metals and their alloys and goods in precious metals or coated therewith (except cutlery, forks and spoons); jewelry, precious stones; horological and other chronometric instruments
- 15 Musical instruments (other than talking machines and wireless apparatus)
- 16 Paper and paper articles, cardboard and cardboard articles; printed matter, newspaper and periodicals, books; bookbinding materials; photographs; stationery, adhesive materials (stationery); artists' materials; paint brushes; typewriters and Office requisites (other than furniture); instructional and teaching material (other than apparatus);playing cards; (printers') type and cliches (stereotype)

- 17 Gutta percha, india rubber, balata and substitutes, articles made from these substances, and not included in other classes; plastics in the form of sheets, blocks and rods, being for use in manufacturers; materials for packing, stopping or insulating; asbestos, mica and their products; hose pipes (non-metallic)
- 18 Leather and imitations of leather, articles made from these materials, and not included in other classes; skins, hides, trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery
- 19 Building materials, natural and artificial stone, cement, lime, mortar, plaster and gravel; pipes of earthenware or cement; road-making materials; asphalt, pitch and bitumen; portable buildings; stone monuments; chimney pots
- 20 Furniture, mirrors, picture frames; articles (not included in other classes) of wood, cork, reeds, cane, wicker, horn, bone, ivory, whale-bone, shell, amber, mother-of-pearl, meerschaum, celluloid, substitutes for all these material, or of plastic
- 21 Small domestic utensils and containers (not of precious metal, nor coated therewith); combs and sponges; brushes (other than paint brushes); brush-making materials; instruments and materials for cleaning purposes; steel wool; unworked or semi-worked glass (excluding glass used in building); glassware, porcelain and earthenware not included in other classes
- 22 Rope, string, nets, tents, awnings, tarpaulins, sails, sacks; padding and stuffing materials (hair, capoc, feathers, seaweeds, etc.); raw textile materials
- 23 Yarns, threads
- 24 Tissues (piece goods); bed and table covers; textile articles not included in other classes
- 25 Clothing, including boots, shoes and slippers
- 26 Lace and embroidery, ribbons and braids; buttons, press buttons, hooks and eyes, pins and needles; artificial flowers
- 27 Carpets, rugs, mats and matting; linoleums and other materials for covering existing floors; wall hangings (non-textile)
- 28 Games and playthings; gymnastic and sporting articles (except clothing); ornaments and decorations for Christmas trees
- 29 Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams; eggs; milk and other dairy products; edible oils and fats; preserves, pickles
- 30 Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; flour, and preparations made from cereals; bread, biscuits, cakes pastry and confectionery, ices; honey, treachel; yeast, baking-powder; salt mustard; pepper, vinegar, sauces; spices; ice
- 31 Agricultural, horticultural and forestry products and grains not included in other classes; living animals; fresh fruits and vegetables; seeds; live plants and flowers; foodstuffs for animals, malt
- 32 Beer, ale and porter; mineral and aerated waters and other non-alcoholic drinks; syrups and other preparations for making beverages.
- 33 Wines, spirits and liqueurs
- 34 Tobacco, raw or manufactured; smokers' articles; matches

(b) CLASSIFICATION OF BUSINESS OR SERVICES

- 35 Advertising and business
- 36 Insurance and financial
- 37 Construction and repair
- 38 Communication
- 39 Transportation and storage
- 40 Material treatment
- 41 Education and entertainment
- 42 Miscellaneous

RULE 417. *Broad terms.* — In any application, the use of broad terms in identifying the goods, business or services shall be unacceptable. Applicants whose application are based on foreign registration shall be required to specify the goods covered by such foreign registration in all cases where the foreign registration used broad terms in identifying the goods, business or services.

RULE 418. *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 an application shall result in one registration.

RULE 419. *Division of Applications.* — (a) Any application referring to several goods or services referred to as the "initial application" may be divided by the applicant into two (2) or more applications hereafter referred to as the "divisional applications" by distributing among the latter the goods or services referred to in the initial application.

(b) A single class shall not be subdivided.

(c) The divisional applications must be submitted before examination of the initial application or within two (2) months from mailing date of the first action of the Bureau.

(d) Upon receipt of the divisional applications, the Office shall cancel the initial application together with its application number. New application numbers shall be given to the divisional applications but the filing date shall be the same as the filing date of the initial application. The divisional applications shall likewise preserve the benefit of the right of priority of the initial application.

PART 5 *The Filing Date*

RULE 500. *Filing Date.* — Subject to the provisions on priority right, the filing date of an application shall be the date on which the Office received the payment for the required fee and the following indications and elements in English or Filipino:

- (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.

RULE 501. *Application Number and Filing Date.* — (a) Before starting to examine the registrability of a 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 Bureau shall notify the applicant who shall, within a period of one (1) month from mailing date of the notice, complete or correct the application as required; otherwise, the application shall be considered withdrawn.

(b) If the application did not satisfy the requirements for 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.

PART 6 *Proceedings in the Examination of an Application for Registration*

CHAPTER 1

Nature of the Proceedings

RULE 600. *Application prosecuted ex parte; Protests.* — An application for registration is prosecuted ex parte by the applicant; that is, the proceedings are like a lawsuit in which there is a plaintiff (the applicant) but no defendant, the court itself (the Examiner) acting as the adverse party.

No attention shall be paid to *ex parte* statements or protests of persons concerning pending applications to which they are not parties, unless information of the pendency of these applications shall have been voluntarily communicated by the applicants.

RULE 601. *Proceedings a contest between Examiner and the Applicant.* — An *ex parte* proceeding in the Office for the registration of a mark is a law contest between the Examiner, representing the interest of the public and the applicant (or his attorney), representing his own private interests.

RULE 602. *Applicant supposed to look after his own interests.* — The Office, represented by the Examiner, is not supposed to look after the interest of an applicant. The law imposes that duty upon the applicant himself. The Examiner is charged with the protection of the interests of the public and hence must be vigilant to see that no registration issues for a mark contrary to law and these Regulations.

RULE 603. *Preliminary adverse action of the Examiner valuable to Applicant.* — The positive value of a preliminary adverse action of the Examiner should be fully appreciated by the applicant or his attorney. A hard-fought application will produce a registration much more likely to stand in court than a registration which has slid through the

Office easily. The reason for this is that every point raised by the Examiner and finally decided by the Office in favor of the applicant will give the applicant a prima facie standing on that point in court.

The Office is empowered by law to pass upon applications for registration and, because of the authority vested in it, its decisions with respect to the grant of a registration, or on any point connected with it, are presumed to be correct by the courts.

RULE 604. *A preliminary rejection should not be taken literally; Examiner is only trying to be helpful.* — A preliminary rejection by the Examiner is never to be taken literally. An applicant should remember that the Examiner may not be actually rejecting his application. The Examiner may in fact be quite prepared to admit the application, and is only trying to give the applicant a chance to explain away some reference or some difficulty rather than have him wait until the registration is granted and become involved in a litigation, when it may then be difficult for him to make the explanation.

CHAPTER 2 *Manner of Examination of an Application for Registration; Action by the Examiner; Response by the Applicant; Abandonment; Revival*

RULE 605. *Order of examination; priority of action.* — (a) Applications shall be examined for registrability in the order in which the complete requirements for grant of 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 examined in advance 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.

(b) Priority of action and/or examination may be granted upon petition under oath with payment of fees and upon order of the Director, to trademark applications falling under any of the following:

1. Re-filing by the same registrant or assignee of a mark previously registered but cancelled for failure to meet the maintenance requirement.
2. Re-filing by the same applicant of a mark previously filed but abandoned and can no longer be revived.
3. An application for registration of a mark, names or abbreviation of names, logos of any nation, intergovernmental or international organizations.
4. 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 TM registration is necessary to promote goodwill or image before the commencement of the sports activity.
5. An application for registration of 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.
6. An application for registration of 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.
7. Domain names (as service mark); and,
8. Trademarks, servicemarks, and tradenames used or to be used in Information and Communications Technology (ICT) infrastructure. *[As amended by Office Order No. 20 (2001)]*

RULE 606. *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 *IPO Gazette* 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 problems arising from their pending applications only with the respective Examiners in charge and with no other person in the Office.

RULE 607. *Examination of the application; Action by the Examiner.* —

(a) If, after the examination, the applicant is found not entitled to registration for any reason, he will be so notified by the Examiner. He will be advised of the reasons therefor and of any formal requirements or objections, and he will be given such information and references as may be helpful to him in the further prosecution of his application. (b) All Examiners are required to include all grounds of objection existing at the time of the issuance of an action in that action. Piece meal action shall be prohibited.

Rule 608. 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 in the composite mark; (c) a matter which does not function as a trademark, or service mark or a trade name.

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 determines that any portion of a mark contains unregistrable matter which must be disclaimed, he shall communicate his finding to the Applicant by means of an Action document. If the applicant fails to respond within the time allowed under these Rules, the finding of the examiner shall become final and the unregistrable matter shall be disclaimed. *[as amended by Office Order No. 39 (2002)]*

RULE 609. *Interview with the Examiners: when no interview is permitted.* — Interviews with Examiners concerning applications pending before the Office can be held only upon written request specifying the query he would want to propound and after payment of the required fee, but in respect of which the Examiner has the discretion to grant the interview or instead reply to the query in writing. The interview shall take place within the premises of the Office and during regular office hours as specified by the Examiner. All interviews or conferences with Examiners shall be reduced to writing and signed by the Examiner and the applicant immediately after the conference. Such writing shall form part of the records of the Office. Interviews for the discussion of pending applications shall not be held prior to the first official action thereon.

RULE 610. *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 may be made with or without amendment and must include such proper action by the applicant as the nature of the action of the Examiner and the condition of the case may require. The period to respond may be extended upon written request and upon payment of the required fee but 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.

RULE 611. *Communications other than the original.* — "Communication" shall mean any response filed with the Office except compliance with filing date requirements. The Office shall accept communications to it by telecopier, or by electronic means. When communications are made by telefacsimile, the reproduction of the signature, or the reproduction of the seal together with, where required, the indication in letters of the name of the natural person whose seal is used, must appear. Within twenty-four (24) hours from receipt of the telefacsimile by a machine of the Office, the Examiner shall confirm the date of receipt of the telefacsimile by means of a notice requiring the applicant to pay the cost, as may be established by the Office from time to time, incurred by the Office to enable the Office to receive such telefacsimile. The original copy such communication and the payment of the cost herein provided must be received by the Office within one (1) month from date of receipt of the telefacsimile. Otherwise, the communication shall be deemed withdrawn and expunged from the records. In all cases, the burden of proof lies on the applicant that such documents have been received by the Office.

RULE 612. *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 613. *Final Action.* — On the first or any subsequent re-examination or reconsideration, the Examiner may state that the refusal of the registration or the insistence upon a requirement is final. Thus, the applicant's recourse is limited to an appeal to the Director or to a compliance with the requirement made by the Examiner.

RULE 614. *Abandonment; Incomplete Response.* — If an applicant fails to respond, or to 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 as of the day immediately following the last day of the aforesaid period.

RULE 615. *Revival of Abandoned Application.* — (a) An abandoned application may be revived as a pending application within three (3) months from the date of abandonment, if it is shown to the satisfaction of the Director, and upon payment of the required fee, that the delay was due to fraud, accident, mistake, or excusable negligence.

(b) 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 has been previously filed. Any application not revived within the specified time will be deemed forfeited upon the expiration of the three-month period to revive.

(c) There shall be no revival of an abandoned application that has been revived once before on the same issue.

RULE 616. *Time less than four months; when request for extension should be made.* — (a) The applicant may be required to prosecute his application in a time shorter than four months but not less than one (1) month from the mailing date of the examiner's action whenever such shorter time is deemed necessary or expedient. Unless the applicant is notified in writing that response is required in less than four months, a maximum period of four months is allowed.

(b) The time for reply, when a time less than four 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 months from the mailing date of the action.

RULE 617. *Suspension of action by the Bureau.* — Action by the Bureau 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. An Examiner's action, which is awaiting a response by the applicant, shall not be subject to suspension.

RULE 618. *Provisional Allowance.* — If the only issue remaining in an application based on foreign application claiming priority right is the submission of a certified copy of the foreign or home registration, the Examiner may provisionally allow the application and suspend the submission of the certified copy of the foreign or home registration for a period not exceeding twelve (12) months counted from allowance. On request of the applicant and subject to the approval of the Director and payment of the required fee, said twelve month period may be extended for good cause by an additional period not exceeding twelve (12) months. Should the applicant fail to submit the certified copy of the foreign or home registration within the maximum period of twenty four (24) months counted from allowance, the applicant may waive his claim to priority right in writing and request that the application be considered based on intent to use. Said waiver and request shall be filed within two (2) months, without extension, counted from the expiration of the maximum twenty four (24) month period without need of any notice from the Office. Otherwise, the application shall be deemed forfeited. After submission of the request for conversion to intent to use and upon payment of the required fees, the application shall be published by the Office for opposition. Furthermore, the declaration of actual use shall be filed within three (3) years without extension and without need of notice counted from the date of the filing of request for

conversion. Otherwise, the application shall be refused or the mark shall be removed from the register by the Director *motu proprio*. [As amended by Office Order No. 08 (2000)]

RULE 619. *Express Abandonment*. — An application may be expressly abandoned by filing with the Bureau a written declaration of abandonment signed by the applicant himself or by the assignee of record.

CHAPTER 3

Amendments to the Application; Response to Objections of the Examiner

RULE 620. *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 621. *Amendments to Description or Drawing*. — Amendments to the description or drawing of the mark may be permitted only if warranted by the mark as shown on the labels originally filed, but may not be made if the nature of the mark is changed thereby.

RULE 622. *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. All such amendments must be on sheets of paper separate from the papers previously filed, and written on only one side of the paper.

RULE 623. *Prohibition against marking of papers or records of the Office by applicants*. — The applicant or his representative 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 IPO Gazette; end of jurisdiction of the Examiner*. — An application for registration is subject to opposition proceeding before issuance of the certificate of registration. Thus, after examination or re-examination of an application for registration, if it should appear to the Examiner in charge of the examination thereof that the applicant is entitled to have his mark registered, the mark will, upon the recommendation of said Examiner, be ordered by the Director to be published in the *IPO Gazette* for opposition, and the applicant notified of such action.

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

RULE 701. *Examiner may Petition for the remand to his Jurisdiction, of an allowed application*. — After allowance and within one (1) month from publication of the allowed application, the Examiner may again exercise jurisdiction over an application upon petition by him to the Director on the ground of newly discovered *ex parte* objections to the registration of the mark.

After an application has been remanded to the Examiner, any amendment recommended by the Examiner may be approved by the Director and may be made without withdrawing the allowance, provided the payment for the issuance of the certificate has not been received by the Office.

RULE 702. *Examiner to be in charge of Publication for Opposition; Applications confidential prior to Publication*. — The Examiner shall be in charge of all matters relating to the publication for opposition of all marks and trade names ordered by the Director to be published as provided in these Regulations.

Access to files of pending applications will not be given to anyone prior to publication for opposition of the mark or trade name or name and other mark of ownership stamped on containers, without the written authority of the applicant. However, an index of pending applications stating the name and address of the applicant, a description of the mark or trade name or name and other mark of ownership, the goods, business or service or container with which the mark or trade

name or name or other mark of ownership is used, the class number, the application number and filing date of the application will be available for public inspection as soon as practicable after filing.

RULE 703. *Allowance of application and Issuance of Certificate of Registration.* — (a) Upon certification by the Director of the Bureau of Legal Affairs that no notice of opposition, whether or not verified and whether or not by means of the original copy, has been filed within one (1) month from the date of release for circulation of the IPO Gazette publishing the application for opposition, and upon payment of the required fee, the office shall issue the certificate of registration. The Director of the Bureau of Legal Affairs shall issue such certification within two (2) months from the date of release for circulation of any *IPO Gazette* publishing applications for opposition. The issuance of the certificate of registration shall be published in the *IPO Gazette* and shall be entered on the records of the Office.

(b) If the application is deficient in any formal matter relating to form, documents, or other papers necessary for the preparation and issuance of the certificate of registration or for the publication of such registration, the Examiner shall send a notice thereof to the applicant. The applicant shall complete such deficiency within two (2) months from mailing date of the notice; otherwise the application shall be declared abandoned. The abandoned application, however, may be revived subject to the requirements of these Regulations.

PART 8 Effect and Notice of Registration

RULE 800. *Rights Conferred.* — (a) 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.

(b) 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.* — A certificate of registration shall remain in force for ten (10) years; *Provided*, That, without need of any notice from the Office, 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 these Regulations, within one (1) year from the fifth anniversary of the date of the registration of the mark. Otherwise, the Office shall remove the mark from the Register. Within one (1) month from receipt of the declaration of actual use or reason for non-use, the Examiner shall notify the registrant of the action taken thereon such as acceptance or refusal.

RULE 802. *Non-use of a Mark When Excused.* — (a) 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.

(b) The special circumstances to excuse non-use in affidavits of non-use shall not be accepted unless they are clearly beyond the control of the registrant such as the prohibition of sale imposed by government regulation.

RULE 803. *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, 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.

RULE 804. *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 of the same class.

RULE 805. *Use of a Mark by Related Company.* — 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.

RULE 806. *Certificates of Registration; Records and copies in registered cases.* — 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.

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

RULE 807. *Contents of Certificate of Registration.* — The certificate of registration of a mark shall include a reproduction of the mark and shall mention its number, the name and address of the registered owner and, if the registered owner's address is outside the country, his address for service within the country; the dates of application and registration; if priority is claimed, an indication of this fact, and the number, date and country of the application, basis of the priority claims; the list of goods or services in respect of which registration has been granted, with the indication of the corresponding class or classes; and such other data as the Regulations may prescribe from time to time.

RULE 808. *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 9

Other Proceedings Affecting the Application or Registration

CHAPTER 1

Voluntary Surrender or Cancellation, Amendment, Disclaimer by the Registrant or by Assignee of Record, Correction of Mistakes

RULE 900. *Jurisdiction of the Examiner.* — The Examiner shall have original jurisdiction over all matters relating to voluntary surrender, voluntary cancellation, voluntary amendment, and voluntary disclaimer of registration, and his 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 him exclusively, or with such other officials and employees whom the Director may designate to assist him.

RULE 901. *Cancellation upon Application by Registrant.* — Upon application of the registrant, the Office may permit any registration to be surrendered for cancellation, and upon cancellation the appropriate entry shall be made in the records of the Office. The application for cancellation of registration shall be under oath and shall be duly authenticated or legalized if the registrant is a non-resident.

RULE 902. *Amendment or Disclaimer of Registration.* — (a) Upon application of the registrant 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. Appropriate entry shall be made in the records of the Office upon the certificate of registration or, if said certificate is lost or destroyed, upon a certified copy thereof.

(b) Upon application of the registrant and payment of the prescribed fee, a replacement certificate may be issued by the Office stating on its face the fact that it is a replacement and bearing the same entry regarding the amendment or disclaimer that was made on the certified copy of a lost or destroyed certificate. A duplicate original of such replacement certificate shall be kept in the records of the Office.

RULE 903. *Correction of Mistakes Made by the Office.* — Whenever a material mistake in a registration incurred through the fault of the Office is clearly disclosed by the records of the Office, a certificate stating the fact and nature of such mistake shall be issued without charge, recorded and a printed copy thereof shall be attached to each printed copy of the registration. Such corrected registration shall thereafter have the same effect as the original certificate; or in the discretion of the Director of the Administrative, Financial and Human Resource Development Service Bureau a new certificate of registration may be issued in accordance with these Regulations and without charge. All certificates of correction heretofore issued and the registration to which they are attached shall have the same force and effect as if such certificates and their issuance had been authorized by the IP Code.

RULE 904. *Corrections of Mistakes Made by Applicant.* — (a) 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.

(b) The application 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.

(c) A copy of the certificate of correction shall be attached to each copy of the registration.

RULE 905. *Surrender, cancellation, amendment, disclaimer, and correction to be given publicity.* — Notice of the cancellation, surrender, amendment, disclaimer, and correction shall be published in the IPO Gazette. The cost of publication shall be for the account of the registrant or assignee of record, except when the notice of correction refers to a mistake of the Office.

CHAPTER 2

Recording of Assignments of Registration; or any other Instrument Affecting the Title to any Registered Mark, Including Licenses Division of Registration

RULE 906. *Assignment and Transfer of Application and Registration.* — 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.

RULE 907. *Form of assignment or transfer.* — (a) 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.

RULE 908. *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 registration of marks shall be recorded at the Office on payment of the prescribed fee; 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.

RULE 909. *Assignment, other instruments affecting the registration, or license, and translation, to be submitted in duplicate.* — The original document of assignment, other instrument or license and its translation, together with a signed duplicate thereof, shall be submitted. After recordal, the Office shall retain the signed duplicate, and return the original to the party filing the instrument with a notation of the fact of recording.

RULE 910. *Date of receipt of instrument to be recorded considered its date of recording.* — The date of recording of an assignment, other document or license is the date of its receipt at the Office in proper form and accompanied by the full recording fee.

RULE 911. *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 must be issued to the assignee.

RULE 912. *Action may be taken by assignee of record in any proceeding in 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 take action.

RULE 913. *Clearance of Trademark License Agreement prior to recordal.* — Any trademark license agreement shall be applied for clearance with the Documentation Information and Technology Transfer Bureau (DITTB) of the Office and shall be recorded only upon certification by the Director of the DITTB that the agreement does not violate Sections 87 and 88 of the IP Code.

RULE 914. *Division of Registration.* — At any time during the life of a certificate of 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 name and address of the owner of record or his representative of record, the mark, the number and date of issuance of the certificate to be divided, 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 Bureau 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.

RULE 915. *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 916. *Contents of transfer certificates of registration.* — The transfer certificates of registration shall include a reproduction of the mark and shall mention their numbers, the name and address of the registered owner, and if the registered owner's address is outside the country, his address for service within the country; the name of the registered owner of the original certificate in case the owner of the transfer certificate be a different person; the date of request for division of the original registration; the date of the issuance of the transfer certificate of registration; the date of filing and registration of the original registration; if priority is claimed, an indication of this fact, and the number, date and country of the application which is the basis of the priority claims; the list of goods or services covered by the transfer certificate of registration with the indication of the corresponding class or classes; and such other data as the Regulations may prescribe from time to time.

CHAPTER 3

Renewal of Registration

RULE 917. *Request for Renewal.* — 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 request. The request shall contain the following indications:

- (a) An indication that renewal is sought;

- (b) The name and address of the registrant or his successor-in-interest, hereafter referred to as the "right holder";
- (c) The registration number of the registration concerned;
- (d) The filing date of the application which resulted in the registration concerned to be renewed;
- (e) Where the right holder has a representative, the name and address of that representative;
- (f) The names of the recorded goods or services for which the renewal is requested or the names of the recorded goods or services for which the renewal is not requested, grouped according to the classes of the Nice Classification to which that group of goods or services belongs and presented in the order of the classes of the said Classifications; and
- (g) A signature by the right holder or his representative.
- (h) In case there has been material variation in the manner of display, five (5) sets of the new labels must be submitted with the application.

RULE 918. *When to file request for Renewal.* — Such request shall be in Filipino or English and 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 it may be made within six (6) months after such expiration on payment of the additional fee herein prescribed.

RULE 919. *Jurisdiction of the Examiner.* — The Examiner shall have original jurisdiction over applications for renewal registration, and his decisions, when final, are subject to appeal to the Director under the conditions specified in these Regulations for appeals to the Director from the final decisions of the Examiners in respect of applications for registration. If the Office refuses to renew the registration, it shall notify the registrant of his refusal and the reasons therefor.

RULE 920. *Need for appointing a resident agent.* — 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 being filed by a person who is not his representative or resident-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 921. *Renewal of prior Act registration; use and proof thereof, required.* — Marks registered under Republic Act No. 166 shall remain in force and effect but shall be deemed to have been granted under the IP Code and shall be renewed within the time and manner provided for renewal of registration by these Regulations; provided, that marks whose registration have a remaining duration as of January 1, 1998 of more than six and one-half (6 ½) years shall be required to submit the declaration and evidence of actual use prescribed in these Regulations within one (1) year following the tenth and fifteenth anniversaries of the registration or renewal registration under Republic Act No. 166; provided, further, that marks whose registrations have a remaining duration of six and one-half (6 ½) years or less may no longer be subject to the requirement of declaration and evidence of use but shall be renewed within the time and in the manner provided for renewal of registration by these Regulations and, upon renewal, shall be reclassified in accordance with the Nice Classification. 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 whose registration, including any renewal thereof, was subsisting as of January 1, 1998 shall remain in force but shall no longer be subject to renewal.

RULE 922. *Prior Act certificate of registration to be surrendered.* — With the application for the renewal of a registration made under Republic Act No. 166 the certificate of registration to be renewed must be surrendered to the Office, if the official copy of such certificate of registration is not in the files of the Office.

After he has surrendered the certificate of registration granted under Republic Act No. 166, the applicant for renewal may, if he so desires, obtain a certified copy thereof, upon payment of the usual fees.

RULE 923. *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 924. *Certificate of renewal of Registration.* — The Office may issue a certificate of renewal of registration in all cases where the request for renewal is approved and the registrant requests in writing and pays the required fee for the issuance of said certificate. The certificate of renewal of registration shall contain the number of the certificate of registration and the mark being renewed, the date of original issuance thereof, the duration of the renewal registration, 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 10

Registration of Stamped or Marked Container

RULE 1000. *Rules or registration of Trademarks and Service Marks to apply.* — Unless otherwise provided by these Regulations, the registration of container marks shall be the same as that of trademarks and service marks.

RULE 1001. *"Stamped or marked container" defined.* — "Stamped or marked container" means, any container of goods upon which a mark is impressed or molded which will give a distinctive effect, provided that the mark cannot be deleted or removed from the container. The stamp or mark on the container must be legible and visible for registration.

RULE 1002. *No drawing required.* — No drawing is required for this registration. In lieu of the drawing, two (2) photographs of the container, duly signed by the applicant or his representative, showing clearly and legibly the mark sought to be registered, shall be submitted. The photographs shall be of the same size as required for trademarks and service marks. No "sight" is required.

RULE 1003. *No Labels required; Sample may be required.* — If the Examiner so requires, the applicant or his representative shall bring a sample of the container to the Bureau on a date and time specified by the Examiner. The sample shall not be left in the Office and shall be brought by the applicant or his representative with him immediately after the viewing thereof by the Examiner.

PART 11

Petitions and Appeal

RULE 1100. *Nature of the function of Examiners.* — The function of determining whether or not an application for registration or renewal thereof should be allowed or denied under the facts disclosed in the application 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 lawfully exercise direct control, direction 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 1101. *Petition to the Director to question the correctness of the action of an Examiner on a matter not subject to appeal.* — Petition may be filed with the Director from any repeated 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, as the case may be, may be directed by the Director to furnish a written statement setting forth the reasons for his decision upon the matter averred in the petition, supplying a copy thereof to the petitioner. The mere filing of a petition will not stay the maximum period of four

months counted from the mailing date of the Examiner's action subject of the appeal for replying to an Examiner's action nor act as a stay of other proceedings.

RULE 1102. *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. Appeal may also be taken 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 1103. *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 time permitted, or, if appealed, the appeal is not prosecuted, shall be considered as final to 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 e.g. 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 1104. *Time and manner of appeal.* — Any petition or appeal must be taken by filing the petition in duplicate 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, must specify the various grounds upon which the appeal is taken, and must be signed by the petitioner or appellant or by his attorney of record. The period herein provided shall, in no case, exceed the maximum period of four (4) months from the mailing date of the action appealed from.

RULE 1105. *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 he relies to maintain his appeal. On failure to file the brief within the time allowed, the appeal shall stand dismissed.

RULE 1106. *The Examiner's answer.* — The Examiner shall furnish a written statement in answer to the petition or appellant's brief, as the case may be, within two (2) months from the order of the Director directing him to submit such statement. Copy of such statement shall be served on the petitioner or appellant by the Examiner.

RULE 1107. *Appellant's reply.* — In case of an appeal, the appellant may file a reply brief directed only to such new points as may be raised in the Examiner's answer, within one (1) month from the date copy of such answer is received by him.

RULE 1108. *Appeal to the Director General.* — The decision or order of the Director shall become final and executory fifteen (15) 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 by filing a notice of appeal and payment of the required fee.

Only one motion for reconsideration of the decision or order of the Director shall be allowed.

RULE 1109. *Appellant's brief required.* — The appellant shall, within one (1) month from the date of filing of the notice of appeal, file a brief of the authorities and arguments on which he relies to maintain his appeal. On failure to file the brief within the time allowed, the appeal shall stand dismissed.

RULE 1110. *Director's comment.* — The Director shall submit within one (1) month his comments on the appellant's brief if so required by the Director General.

RULE 1111. *Appeal to the Court of Appeals.* — The decision of the Director General shall be final and executory unless an appeal to the Court of Appeals is perfected in accordance with the Rules of Court applicable to appeals from decisions of Regional Trial Courts. No motion for reconsideration of the decision or order of the Director General shall be allowed.

FINAL PROVISIONS

SECTION 1. *Correspondence.* — The following regulations shall apply to correspondence between registrants/applicants and the Office or the Bureau:

- (a) *Business to be transacted in writing.* All business with the Office or Bureau shall be transacted in writing. Actions will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding.
- (b) *Personal attendance of applicants and other persons unnecessary.* Unless otherwise provided, the personal attendance of applicants and other persons at the Office is unnecessary. Their business can be transacted by correspondence.
- (c) *Correspondence to be in the name of the Director of Trademarks.* All Office letters with respect to matters within the jurisdiction of the Bureau must be sent in the name of the Director of Trademarks. All letters and other communications intended with respect to such matters must be addressed to him and if addressed to any other officer, they will ordinarily be returned.
- (d) *Separate letter for each case.* In every case, a separate letter shall be written in relation to each distinct subject of inquiry.
- (e) *Letter relating to applications.* When a letter concerns an application it shall state the name of the applicant, the mark or trade name or name or other mark of ownership sought to be registered, the application number and the filing date of the application.
- (f) *Letters relating to registrations.* When the letter concerns a registered mark, it shall state the name of the registrant, the mark registered, the number and date of the certificate of registration, and the classes of goods or services according to the Nice Classification.
- (g) *Subjects on which information cannot be given.* The Office cannot respond to inquiries as to whether or not a mark is acceptable for registration in advance of the filing of an application.

On the propriety of making an application for the registration of a mark, the applicant must judge for himself or consult an attorney-at-law. The Office is open to him, and its records pertaining to all registrations granted may be inspected either by himself or by any attorney or agent he may call to his aid. Further than this the Office can render him no assistance until his application comes regularly before it in the manner prescribed by law and by these Regulations. A copy of the law, rules, or circular of information, with a section marked, set to the individual making an inquiry of the character referred to, is intended as a respectful answer by the Office.

Examiners' digests are not open to public inspection. The foregoing shall not, in any way, be interpreted to prohibit the Office from undertaking an information dissemination activity in whatever format, to increase awareness on the trademark law.

SECTION 2. *Fees and Charges to be Prepaid; Fees and Charges Payable in Advance.* — Express charges, freight, postage, telephone, telefacsimile including cost of paper and other related expenses, and all other charges on any matter sent to the Office must be prepaid in full. Otherwise, the Office shall not receive nor perform any action on such matters.

The filing fees and all other fees and charges payable to the Office shall be collected by the Office in advance of any service to be rendered.

SECTION 3. *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 (referred to in this Section as "pending applications"):

SECTION 3.1. *Amendment of Pending Applications.* — On or before December 15, 1998, all pending applications may be amended, if practicable, to bring them under the provisions of the IP Code. Accordingly, applicants with pending applications for registration in the former Supplemental Register who wish to pursue the grant of registration may amend their applications to comply with requirements for registration under the IP Code.

SECTION 3.2. *Filing Date of Pending Applications; Declaration of Actual Use.* Pending applications shall retain their priority date or original date of filing with the Bureau of Patents Trademarks and Technology Transfer. Applicants which elected to prosecute their applications under Republic Act No. 166 and its Implementing Rules and Regulations under which they were required to submit proof of use of the Mark, particularly with reference to applications for registrations based on use in the Philippines, shall file the corresponding declaration of actual use with evidence to that effect as prescribed by these Regulations, without need of any notice from the Office, within three (3) years from the effectivity of these Regulations, without possibility of extension. Otherwise, the application shall be refused or the mark shall be removed from the register by the Director *motu proprio*. [As amended by Office Order No. 17 (1998)]

SECTION 3.3. *Processing of Pending Applications.* — Pending applications amended in accordance with this Section shall be proceeded with and registration thereof granted in accordance with these Regulations. Where there are no applicable provisions in the IP Code and these Regulations, pending applications that are not amended in accordance with this Section shall be proceeded with and registration thereof granted in accordance with the laws and regulations under which they were filed.

SECTION 3.3.1. *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 can 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 IPO Gazette 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 oppositor/s has the right to the registration of the mark, and, all other issues including the registrability of the mark.

SECTION 3.4. *Duration of Registration.* — A certificate of registration granted to an application filed on or before December 31, 1997 and therefore 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 or ten (10) years as follows:

- (a) Twenty (20) years, in the case of pending applications published for opposition prior to the effectivity of these Regulations with respect to which no notice of opposition was filed within the prescribed period under Republic Act No. 166 of thirty (30) days from release for circulation of the corresponding Official Gazette (BPTTT or IPO) as certified by the Caretaker/Officer-in-Charge or Director of the Bureau of Legal Affairs.
- (b) Ten (10) years, in the case of pending applications published for opposition after the effectivity of these Regulations with respect to which no notice of opposition is filed as certified by the Caretaker/Officer-in-Charge or Director of the Bureau of Legal Affairs in accordance with these Regulation.
- (c) Ten (10) years, in the case of pending applications subject of opposition or any other proceeding before the Office.

SECTION 3.5. *Duration of Renewal of Registration Granted Under Republic Act No. 166.* — The renewal of a registration granted under Republic Act No. 166 shall have the same term of ten (10) years and shall be subject to the same requirements for renewal as a registration granted under the IP Code.

SECTION 3.6. *(a) Abolition of the Supplemental Register.* - In compliance with the state policy declared in the IP Code, the IPO shall endeavor to issue certificates of registration that can stand up to scrutiny in infringement and other cases. Considering that (i) marks or trade names that are not registrable on the principal register under Republic Act No. 166 are registrable in the Supplemental Register; (ii) marks or trade names not registrable on the said principal register are not registrable under the IP Code; and , (iii) the Supplemental Register was abolished by the IP Code, all applications for registration in the Supplemental Register pending upon effectivity of the IP Code shall be examined in accordance with

the IP Code and such applications which do not meet requirements for registration under the IP Code shall be rejected. *[as amended by Office Order No. 40 (2002)]*

(b) Release of Certificates of Registration of Applications in the Supplemental Register Allowed Prior to Effectivity of the IP Code. A Certificate of registration may be released covering an application for registration in the Supplemental Register provided that all the following requirements occurred prior to the effectivity of the IP Code, i.e. on or before 31 December 1997 : (1) such application had been allowed and the allowance was approved by Atty. Rosario N.E. Macatangay, Chief of the Trademark Examining Division of the then Bureau of Patents Trademarks and Technology Transfer as evidenced by the original copy of the Allowance in the file wrapper of the application; (2) Notice of Issuance of Certificate of Registration had been issued as evidenced by the original copy of the Notice in the file wrapper of the application or the applicant's original copy thereof, and (3) all the required fees were fully paid for by the applicant as evidenced by the original copy of the Official Receipt, a photocopy of which shall be submitted by the applicant to the Bureau for inclusion in the corresponding file wrapper. The Registration shall remain in force for twenty (20) years from the date of allowance, without possibility of renewal, and subject to compliance with all the requirements for maintenance of the registration. The mark shall be published in the IPO Gazette and may be subject to cancellation on grounds provided under the law. *[as amended by Office Order No. 40 (2002)]*

SECTION 3.7. *Renewal of a Registration in the Supplemental Register.* — The following regulations shall apply to the renewal of a registration in the Supplemental Register under Republic Act No. 166:

SECTION 3.7.1 *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.

SECTION 3.7.2 *Registrations, or Extension Thereof, with Term Ending on or Before December 31, 1997.* — The renewal of a registration, or any extension thereof, in the Supplemental Register whose term ended on or before December 31, 1997 may be granted as follows :

- (a) The application for renewal of registration in the Supplemental Register was seasonably filed including full payment of the required fee pursuant to Section 15 of Republic Act No. 166 and the applicable regulations;
- (b) Full compliance with all the requirements for renewal shall have been made by the applicant on or before December 31, 1998;
- (c) The renewal shall be for a term of twenty (20) years counted from the date of expiration of the registration or renewal subject of the application; and,
- (d) The renewal herein granted shall no longer be subject to renewal.

SECTION 3.7.3. *Notice to Comply.* — For the effective implementation of Section 3.7.2 (b), all concerned examiners together with the Chief of the Trademark Examining Division of the former Bureau of Patents Trademarks and Technology Transfer have been directed to mail to the applicants the corresponding notice to comply with requirements for renewal of registration, or extension thereof, on or before October 31, 1998. Further, applicants who have not received said notice may request for a copy thereof from the examiner concerned who shall issue said copy within two (2) working days from receipt of the request.

SECTION 4. *Repeals.* — All rules and regulations, memoranda, circulars, and memorandum circulars and parts thereof inconsistent with these Regulations particularly the Rules of Practice in Trademark Cases, as amended, are hereby repealed; Provided that such earlier rules or parts thereof shall be continued only for the purpose of prosecuting applications for registration in the principal register filed as of December 31, 1997 wherein the applicants expressly elected to prosecute said applications under Republic Act No. 166; and, Provided, further, that there are no applicable provisions in these Regulations.

SECTION 5. *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.

SECTION 6. *Effectivity.* — These rules and regulations shall take effect fifteen (15) days after publication in a newspaper of general circulation.

Done this 29th day of October 1998.

Recommended by:

Approved by:

(Sgd.) LENY B. RAZ

Director General *officer-in-Charge, Bureau of Trademarks*

(Sgd.) EMMA C. FRANCISCO

Assistant Director