

PHILIPPINES

INTELLECTUAL PROPERTY HANDBOOK

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Legislation

- R.A. 8293: The Intellectual Property Code, as amended by R.A.s 9150, 9502, and 10372;
- R.A. 623: Use of Duly-Stamped and Marked Containers (1951), as amended by R.A. 5700;
- Rules and Regulations on Trademarks, Service Marks, Trade names, and Marked or Stamped Containers of 2017;
- Philippine Regulations Implementing the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (2017).

Definition

"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.

Definition

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Your mark will **NOT BE** registered if it is:

• Descriptive

Examples are "DURABLE" for shoes (describes the quality), "A LITER" for cooking oil (quantity), and so is "KITCHEN" for cooking utensils (intended purpose).

• Misleading

Marks that are likely to deceive or have the tendency to misinform the consumers about the actual characteristics of the goods or services like "BOLPENS" for pencils, "COLA" for alcoholic beverages, "BULAKAN" for sweets not originating from or produced in Bulacan.

• Generic and Customary to Trade

Generic marks are names of products they seek to identify. For instance, "KAP KEYK" for cupcakes, "CAFFE" for coffee and "MAKINAH" for machines.

• Contrary to Public Order or Morality

Marks that are against the common standard of morality. An example is "PRO-TERRORISM" for clothing.

• Consists of Names, Portraits of Persons, Maps, Flags and Other Political Symbols

Marks that contain names or portraits of living individuals may be rejected unless the individual gives written consent. For instance, no one can use the picture of Manny Pacquiao as a trademark unless he is Mr. Pacquiao himself or he was duly authorized by Mr. Pacquiao.

• Shape and Color

Shapes must be distinctive from the usual shape of goods or containers of the goods, in order to be considered a trademark. One classic example is the COKE BOTTLE. Color alone is not accepted unless it is defined by a given form.

• Marks That May Cause Confusion

Our mark cannot be registered if it is identical with or similar to a registered mark or a mark with earlier filing date for goods and services that are exactly the same or for goods and services that are related. Consumers should not confuse your mark with the marks of others.

• Identical with, or confusingly similar to Well-Known Marks

Marks that are identical with or similar to marks that are known internationally and in the Philippines will be refused registration.

Membership

- ✓ - Paris Convention
- ✓ - Madrid Protocol

Philippines is a member of the Paris Convention from 1965, whereby applications from convention countries will be subject to the same priority date in Philippines. The application for priority has to be made within six months of the first application in a convention country.

Rule of Priority

“First to File” is the rule followed by Philippines in determining priority of trademarks.

Duration and Renewal

Your trademark registration shall be in force for (10) years from date of registration, and may be renewed indefinitely for periods of ten (10) years. A 6-months grace period is allocated after the expiry date for the renewal. Once the expiry date has passed, the trade mark will no longer have the benefit of any rights arising from registration. However, to maintain your trademark registration, the IP Code requires you to file a declaration and evidence of actual use, otherwise, the protection granted to your mark will lapse. Thus, by law, you must submit a Declaration of Actual Use and proof of use (e.g., labels, brochures, and other evidence that you are using the mark) within the following periods:-

- three (3) years from the date of filing your application; and
- one (1) year from the 5th anniversary of the date of registration of your mark.

The filing of Declarations of Actual use is also needed upon renewal and mid-renewal.

Procedures

Application

Every applicant is required to submit an application with Intellectual Property Office of the Philippines.

Examination

A Trademark application is examined 3 to 6 months from the date of filing.

Publication

The IPO then issues a notice of allowance and publishes the application 12 to 24 months from the filing date. An application fee is required to be paid within 2 months from mailing date of notice of allowance. IPO publishes the application in the official gazette for purpose of opposition within 6 to 8 months from notice.

Opposition

Aggrieved parties are required to submit oppositions within 30 days from the date of publication.

Notice of Issuance

Where no opposition is filed, a notice of issuance and publication is issued by the IPO within 3 months from the publication of the notice of allowance.

Registration

The IPO issues a certificate of registration within 5 to 7 months of notice of issuance subsequent to payment of fees by the applicant within 2 months from mailing date of notice of issuance.

Filing Requirements

The following information and/or documents are required to file an application for a trademark application in Philippines:-

- Application form.
- Power of Attorney.
- One (1) clear copy of the mark.
- The full name, nationality and registered address of the applicant.
- A list of goods or services (which closely follow the Nice International Classification).
- Description of claim if colour or a combination of colour or a combination of colours is claimed as Trademark.
- For marks that contain non-English words, a certified transliteration and translation.
- If convention priority is claimed, a certified copy of the priority.

Documents To Be Furnished For Filing Trade / Service Mark Application

Basic Requirements		
Documents	Remarks	Time of Filing
Power of Attorney	Signed. No need for notarization/ certification/ legalization	May be submitted later or up to 2 months from date of filing of application.
Image/ representation of the mark	Must be 2in. X 3in. in dimension; must show the colors being claimed if applicable	On filing date.

Additional Documents for Claiming a Convention Priority		
Documents	Remarks	Time of Filing
Certified true copy of the priority application	Must have English translation if in another language	3 months from date of filing of application.
Certified true copy of the priority registration	Must have English translation if in another language	Upon completion of all requirements of registrability as assessed by Examiner; 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.

Documents for Filing a Request of Recordals of Assignments & Changes		
Documents	Remarks	Time of Filing
Copy of Deed of Assignment	Notarized	Upon filing of request

Declaration of Actual Use (DAU)		
Documents	Remarks	Time of Filing
POA	Signed	On filing date
DAU Form	Notarized	On filing date
Evidence		On filing date

Documents for Filing an Opposition of Counter-Opposition (Deadline for Applying is during 3 Months Publication Period of the Trade Mark Application to be Opposed)		
Documents	Remarks	Time of Filing
Notice of Opposition		Within 30 days from Publication of mark to be opposed
Extension to File Verified Motion of Opposition		Opposer is allowed 3 extensions that has to be filed every 30 days from First notice mentioned above allowing time to put together the Verified Motion of Opposition
Power of Attorney	Notarized and duly authenticated by the Philippine Consulate Office.	Upon Filing Verified Motion of Opposition
Verification and Certification of Non-Forum Shopping	Notarized and duly authenticated by the Philippine Consulate Office.	Upon Filing Verified Motion of Opposition
Affidavit-direct testimony of witness opposing company	Notarized and duly authenticated by the Philippine Consulate Office. This affidavit should contain some information on the company, some history on the marks, a list of worldwide registration and application of the mark, some samples of said trademark registrations, information on worldwide sales, and Philippine sales, some information on expenditures on advertising and promotions worldwide and in the Philippines.	Upon Filing Verified Motion of Opposition
Affidavit-direct testimony from distributor or representative office or branch	This document needs to be notarized only, and can include information as to its organization, sales and advertisements, list of dealers or stores products or goods covered by the mark concerned.	Upon Filing Verified Motion of Opposition

In Philippines, patent protection is obtainable by way of either entering the national phase of a Patent Cooperation Treaty (PCT) application or filing a direct national application.

Legislation

- R.A. 8293: The Intellectual Property Code, as amended by R.A.s 9150, 9502, and 10372,
- R.A. 9502: Universally Accessible Cheaper and Quality Medicines Act (2008)
- The Revised Implementing Rules and Regulations (IRR) for Patents, Utility Models and Industrial Designs Recently amended by Memorandum Circular No. 17-013
- Implementing Rules and Regulations of the Universally Accessible Cheaper and Quality Medicines Act of 2008.

Patentability Criteria

Any technical solution of a problem in any field of human activity which is new, involves an inventive step and is industrially applicable shall be patentable. It may be, or may relate to, a product, or process, or an improvement of any of the foregoing.

Non- Patentable Subject Matter

An invention is not patentable if it contains the following:-

- Discoveries, scientific theories and mathematical methods;
- Schemes, rules and methods of performing mental acts, playing games or doing business, and programs for computers;
- Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practiced on the human or animal body. This provision shall not apply to products and composition for use in any of these methods;
- Plant varieties or animal breeds or essentially biological process for the production of plants or animals. This provision shall not apply to micro-organisms and non-biological and microbiological processes.
- Provisions under this subsection shall not preclude Congress to consider the enactment of a law providing sui generis protection of plant varieties and animal breeds and a system of community intellectual rights protection:
- Aesthetic creations; and
- Anything which is contrary to public order or morality.

Utility Models

Utility models are registrable in the Philippines. A utility model must fulfill the criteria of new and industrial applicability (but not inventiveness). The term is seven (7) years without renewal.

Membership

- ✓ - Paris Convention
- ✓ - PCT

Philippines is a member of the Paris Convention from 1965, whereby applications from convention countries will be subject to the same priority date in Philippines. The application for priority has to be made within six months of the first application in a convention country.

Philippines is also a member of the PCT since 2001. An applicant who has made an international patent application may file and/or prosecute the patent application during its national phase entry into Philippines within 30 months from the filing date of the international application or from the earliest priority date of the application if a priority is claimed.

Rule of Priority

“First to file” is the rule followed by Philippines in determining priority of patent.

Duration and Renewal

For patents filed under RA 8293 (CURRENT LAW)

- A patent application once registered is valid for 20 years from the date of application.
- Payment of the annual fee may be made 3 months before the due date.
- A grace period of six (6) months shall be granted for the payment of the annual fee, upon payment of the prescribed surcharge for delayed payment.

For patents filed under RA 165 (old law)

- A patent application once registered is valid for 17 years from the date of application.

Procedures

▼ Application

Every applicant is required to submit an application to the registrar of patents within 12 months of priority date.

▼ Examination

After the assignment of a filing date the application will be examined. And a search report be submitted to the applicant.

▼ Publication & Substantive Examination

The application will be published within 18 months from the date of filing. Request for substantive examination has to be made within 6 months from the date of publication. Letters of patent will be granted on completion of substantive examination. The invention will be published in the IPO Gazette together with other relevant information.

▼ Opposition

Third parties are invited to oppose the applications within the stipulated publication period.

▼ Registration

Finally on completion of objections and opposition a Certificate of Registration will be issued subject to the payment of a fee. The duration of registration could take a minimum period of 2-3 weeks. The registration is effective from date of application.

Filing Requirements

The following information and/or documents are required to file an application for a patent application in Philippines:-

Direct National Application:-

- Request for the grant of a patent:-
 - Δ the name, nationality and address of the applicant;
 - Δ the name, nationality and address of the inventor;
 - Δ a specification comprising a description, claims and any necessary drawings; and
 - Δ the country and filing particulars of basic application whose priority is claimed.
- Appointment of Patent Agent.
- If the applicant is not the inventor, a statement explaining how the applicant derives its right to the patent from the inventor, normally by virtue of assignment or employment.
- There is no requirement for the filing of an assignment from inventor to applicant.

PCT National Phase Application:-

- A copy of the PCT application in English language (i.e. request form PCT/RO/101);
- The details of the PCT application (suitably, the bibliographic page as published by WIPO);
- One copy of the PCT specification as originally filed (in or translated to English);
- One copy of any amendments filed in the international phase (in or translated to English);
- An Appointment of Agent form signed by the applicant; and
- If the applicant is not the inventor, a statement explaining how the applicant derives its right to the patent from the inventor, normally by virtue of assignment or employment.

Documents To Be Furnished For Filing A Patent Application in Philippines

Basic Requirements		
Documents	Remarks	Time of Filing
Patent specification, claims and abstract in English	No legalization	On filing date or within two months from the date of entry
Drawings	(If Any)	On filing date

Note:

- The set of drawings must be signed by the applicant or by his attorney or agent;
- The set of drawings must be made in a Bristol board or in a paper that is flexible, strong, white, smooth, non-shiny and durable;
- The set of drawings must be made in a pen or by photolithographic which give the satisfactory reproduction characteristics; shading and lines were not present in the sectional view;
- The sectional view of the set of drawings must be indicated on the general view by a broken or dotted line;
- The space in the heading must be reserved at the right and the signature placed on the left, one figure must be placed upon another or within the outline of another.
- The drawing must show every feature of the utility model or industrial design covered by the claim(s), and the figures should be consecutively numbered.

Additional Documents for Convention Patent Application		
Documents	Remarks	Time of Filing
Priority documents	Certified copy of the basic patent application	On filing date or 6 months from the date of entry
Power of Attorney	Certified copy of the basic patent application	On filing date or within 2 months from the date of entry

Additional Documents for Entry of PCT National Phase in Philippines	
Documents	Time of Filing
English translation of the international application (if it is filed in a language other than English)	On filing date
A copy of the International Search Report (form PCT/ISA/210)	On filing date or within 2 months from the date of entry
A copy of Notification Concerning Submission or Transmittal of Priority Document (form PCT/IB/304)	On filing date or within 2 months from the date of entry
Details of the PCT application (suitably, the bibliographic page as published by WIPO).	On filing date
International preliminary examination report international search report (chapter 2).	On filing date (if available) or anytime during the pendency of the examination or anytime while the examination is active
Notification of Recording of a Change: Inventor, Name and Applicant	On filing date (if available) or anytime during pendency of the application
One copy of the PCT specification as originally filed (in or translated to English).	On filing date
One copy of any amendments filed in the international phase (in or translated to English).	On filing date or anytime while the application is active

Legislation

- R.A. 8293: The Intellectual Property Code, as amended by R.A.s 9150, 9502, and 10372,
- The Revised Implementing Rules and Regulations (IRR) for Patents, Utility Models and Industrial Designs. Recently amended by Memorandum Circular No. 17-013
- Layout-Designs (Topographies) of Integrated Circuits Regulations (2002)

Definition

An industrial design is the ornamental or aesthetic aspect of an article. The design may consist of three-dimensional features, such as the shape or surface of an article, or of two-dimensional features, such as patterns, lines or color. Industrial designs are applied to a wide variety of products of industry and handicraft: from technical and medical instruments to watches, jewelry, and other luxury items; from house wares and electrical appliances to vehicles ; from textile designs to leisure goods. To be protected under most national laws, an industrial design must be non-functional. This means that an industrial design is primarily of an aesthetic nature and any technical features of the article to which it is applied are not protected.

Topography of integrated circuits. Similar in nature, **layout designs of integrated circuits** (sometimes referred to as "topography") are defined by the law as "the three-dimensional disposition, however expressed, of the elements, at least one of which is an active element, and of some or all of the interconnections of an integrated circuit. or such a three-dimensional disposition prepared for an integrated circuit intended for manufacture." In other words, they are the 3D map of the surface on an integrated circuit, composed of elements (at least one should be working) and interconnections among them.

Criteria

Only industrial designs that are new or original shall benefit from protection. Industrial designs dictated essentially by technical or functional considerations to obtain a technical result or those that are contrary to public order, health or morals shall not be protected.

Rule of Priority

Applications for priority have to be made within six months from the earliest filing date of the corresponding foreign application.

Duration and Renewal

A design once registered is valid for a term of 5 years from the date of filing of the application and may be renewed for not more than 2 consecutive periods of 5 years each.

Procedures

▼ Application

Every design application has to be filed with the Intellectual Property of Philippines.

The Office shall accord as the filing date the date of receipt of the application containing indications allowing the identity of the applicant to be established and a representation of the article embodying the industrial design or a pictorial representation thereof.

If the application does not meet these requirements the filing date should be that date when all the requirements are filed or the mistakes corrected.

▼ Examination

A formalities examination will be conducted after the issuance of a filing date to ensure formalities as to the size, quality of the representation and classification are met.

▼ Objections

If there are any amendments or deficiencies spotted in the formalities examination, the examiners will notify the applicant and the applicant would have to correct this non-compliance within a given period.

▼ Registration

Once an application is in order, a registration certificate will be issued and the application will be published in the Design Journal. Once published, the published designs are made available for public inspection. It takes about 12 months from the submission of the application to the successful registration of a design.

Filing Requirements

The following information and/or documents are required to file an application for an industrial design application in Philippines:-

- A request for registration of the design:-
 - Δ information identifying the applicant;
 - Δ indication of the kind of article of manufacture of handicraft to which the design shall be applied;
 - Δ the name and address of the creator; and
 - Δ where the applicant is not the creator, a statement indicating the origin of the right to the industrial design registration according to intellectual property protection in the Philippines.
- Power of Attorney signed by the applicant.
- A representation of the design (drawings, photographs or other adequate graphic representation of the design).
- Priority documents and certified English translation of the priority document.

Documents To Be Furnished For Filing An Industrial Design Application in Philippines

Basic Requirements		
Documents	Remarks	Time of Filing
Power of Attorney	Signed; Notarization is not required. To be translated to English (if necessary).	Two months from filing date
Description of Design	A specification containing the following: • title; • brief description of the different views of the drawings; • characteristic-feature description of the design; and • claim. To be translated to English (if necessary).	On filing date
Drawings	Drawings or photographic of the different views of the design showing the complete appearance thereof including the signature of the applicant or representative. To be translated to English (if necessary)	On filing date
Deed of Assignment	(if applicable) Notarized. To be translated to English (if necessary).	• anytime during the pendency of the formality examination of the design application; or • anytime while the design registration is still active status.
Priority documents	To be translated to English (if necessary).	Within six months from filing

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