



PHILIPPINES

TRADEMARK HANDBOOK

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Disclaimer: This IP HANDBOOK is intended to provide general guidelines only and not advice with regard to specific cases. The information given is non-exhaustive. Please also note that the relevant law and its interpretation are subject to change.

You should contact us for advice specific to your own situation. Whilst every effort has been made to ensure the accuracy of the information, Pintas IP Group shall not be responsible for any inaccuracies or omissions, however caused therein. Nor can any responsibility be accepted for any loss or damage to any

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.

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.



"Today's Asset, Tomorrow's Value"

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

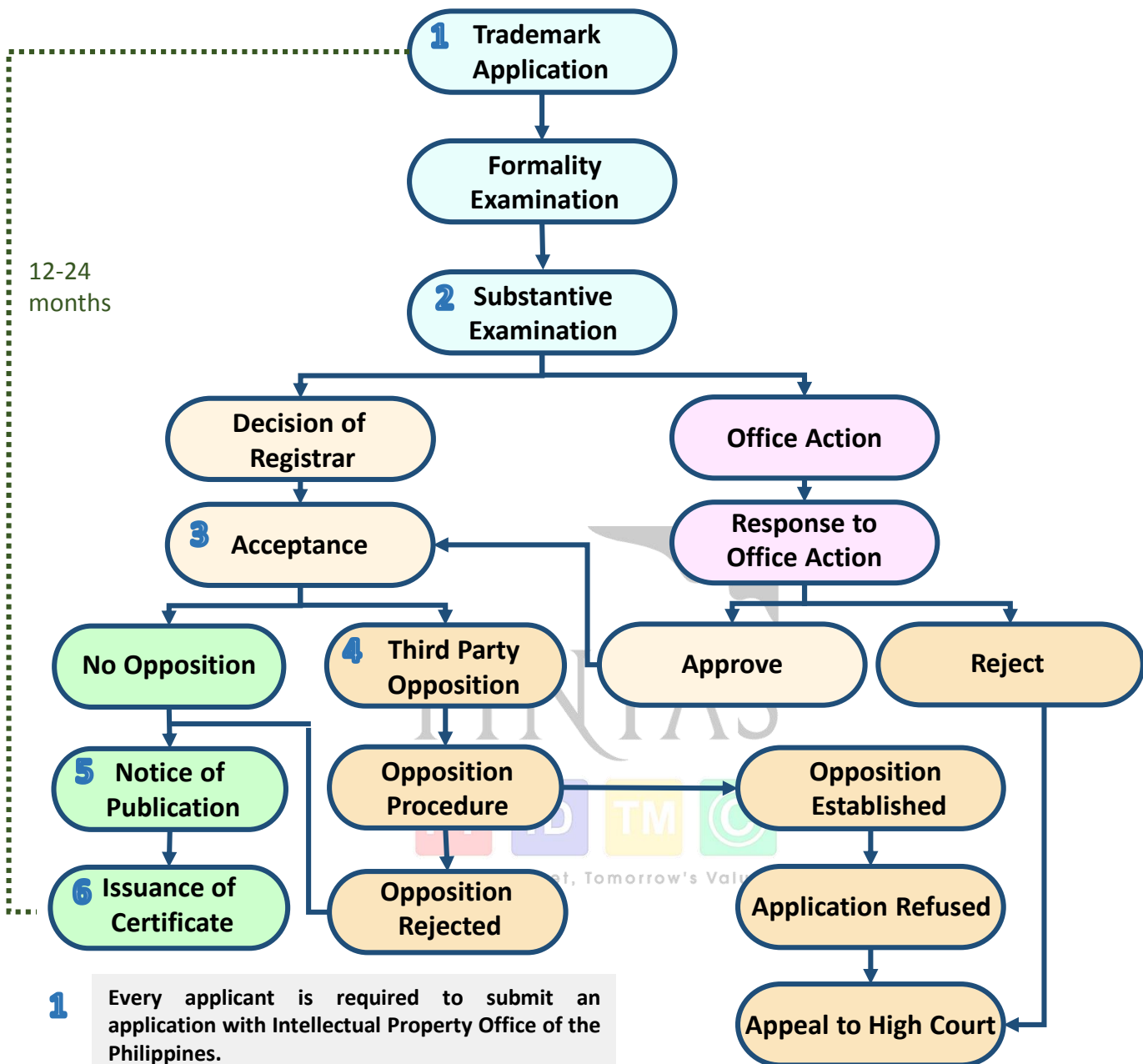
Documents	Remarks	Time of Filing
Copy of Deed of Assignment	Notarized	Upon filing of request

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

Trademark Registration Process in Philippines



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**MALAYSIA
OFFICE**

Kuala Lumpur / Corporate Office

Pintas Consulting Group Sdn Bhd (461057-W)

Adds: Suite 2B-21-1, Level 21, Block 2B, Plaze Sentral,
Jalan Stesen Sentral 5, KL Sentral, 50470 Kuala Lumpur,
Malaysia.

Selangor / Correspondence Operation Office

Adds: No.19, Jalan SS 1/36, 47300 Petaling Jaya, Selangor.

Tel: +603-7876 5050

Fax: +603-7876 2678

H/P: +6012-797 5077

Email: marketing@pintas-ip.com

**SINGAPORE
OFFICE**

Pintas Pte Ltd (20010467111)

Adds: Suite 12-14, Manhattan House, 151 Chin Swee Road,
Singapore 169876.

Tel: +65-6250 2070

Fax: +65-6737 1805

H/P: +65-9747 2579

Email: pintas.sg@pintas-ip.com

**CHINA
OFFICE**

Pintas Inc (Customer Service Office)

Adds: Room1811, 18th Floor, Far East Tower,
No. 1101 Pudong Road (s) Pudong, Shanghai,
200120, China.

Tel: +86-21 32180770

Fax: +86-13 022176477

Email: pintas.china@pintas-ip.com

**USA
OFFICE**

Pintas LLC (Customer Service Office)

Adds: P.O. Box 190943, Boise, Idaho
83719-0943, United States of
America.

Tel / Fax: +1 208 899 8528

Email: pintas.usa@pintas-ip.com

**BRUNEI
OFFICE**

Pintas Consulting Group (Customer Service Office)

Adds: P.O.Box 18, Anggerek Desa Complex,
BB3780 Brunei Darussalam.

Tel: +673-873 8478

Fax: +673-245 2112

Email: pintas.brunei@pintas-ip.com