

## [ IPO, September 29, 1998 ]

### **RULES AND REGULATIONS ON TRADEMARKS, SERVICE MARKS, TRADE NAMES AND MARKED OR STAMPED CONTAINERS**

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 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.