

New Rules and Regulations on Trademarks, Service Marks, etc. in the Philippines

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1. Trademarks and other Marks

In 2017 the Intellectual Property Office of the Philippines (IPOPHL) has issued “The Revised Trademark Regulations of 2017”, to streamline the administrative procedures in registering trademarks and enhancing the enforcement of intellectual property rights in the Philippines. However, the said guidelines failed to include the non-traditional visual trademarks provided under Republic Act No. 8293 (otherwise known as the “IP Code”). To include this and in recognition of the developments on trademark principles and practice, IPOPHL Memorandum Circular No. 2023-001, “Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers of 2023, Replacing the Revised Trademark Regulations of 2017” was issued.



Additionally, this Memorandum Circular also formally establishes the online systems of filing, transmission, and receipt of official communications and payment to the IPOPHL for expediency.

We Discuss the salient provisions of the IPOPHL Memorandum Circular No. 2023-001 in detail below.

2. IPOPHL Memorandum Circular No. 2023-0001

The following are the relevant changes introduced by IPOPHL Memorandum Circular No. 2023-0001, which took effect on February 14, 2023

1. Rule 101 - The new rules provide for new definitions as follows:

- i. “Actual Use” - means use in the ordinary course of trade that demonstrates real commercial purpose targeting the public.
- ii. “Certification Mark” - means any sign, used or intended for use in commerce with the owner’s permission by someone other than its owner, to certify regional or other geographic origin, material, mode of manufacture, quality, accuracy, or other characteristics of someone’s goods or services, or that the work or labor on goods or services, or that the work or labor on goods or services was performed by members of a group or associations.

iii. “communication” - shall mean any response to an office action, petition, request, motion, or any submission in relation to maintenance requirement or document affecting title filed with the office, except compliance with filing date requirements.

iv. “Mailing date” - means the date it was initially sent through the e-correspondence system or sent to the designated registered e-mail if the applicant/registrant or its agent as the case may be. In case an office action or issuance has been received both through e-correspondence and e-mail, the reckoning date will be the later date of receipt.

v. Translation- means the equivalent meaning of a word in one language in another language such as expressing a French into English

vi. Transliteration - means converting of the words, letters or characters from one language to the corresponding words, letters or characters of another language or alphabet by means of their close similarity in sound like expressing Chinese characters into the Roman or Latin alphabet.

2. Rule 203 – the requirements for applications claiming priority rights have been amended listing down acceptable representations of non-traditional marks, particularly drawings that depict a series of movements and holograms.
3. Rule 206- Regarding the renewal of Declaration of Actual Use (DAU) - The previous regulations only mentioned that registered marks due for renewal on January 01, 2017 are required to file a DAU for the purpose of registration maintenance. Now the regulations specifically states that the renewal of DAU may be filed within the 6 month-period before the expiration of the registration.
4. Rule 210 - The accepted evidence of Actual Use of the mark has been amended as follows:

IPOP HL MC No. 17-010 (OLD)	IPOP HL MC No. 2023-001 (NEW)
<p>a. labels of the mark as these are used;</p> <p>b. Downloaded pages from the website clearly showing that the goods are being sold or the services are being rendered in the Philippines;</p> <p>c. Photographs (including digital photographs printed on ordinary paper) of goods bearing marks as these are actually used or of the stamped or marked container of goods and of the establishment/s where the services are being rendered;</p> <p>d. Brochures or advertising materials showing the actual use of the mark on the goods being sold or services being rendered in the Philippines;</p>	<p>a. Downloaded pages from the website clearly showing that the goods are being sold or the services are being rendered or made available in the Philippines</p> <p>a. Photographs (including digital photographs printed on ordinary paper) of the following:</p> <ul style="list-style-type: none"> (i) labels or packaging bearing the mark as actually used on the goods; (ii) The stamped or marked container of goods; or (iii) Signages bearing the mark on the facade or any area in the establishment/s where the mark is displayed. <p>b. Brochures or advertising materials</p>

<p>e. Receipts or invoices of sale of the goods or services rendered or other similar evidence of use, showing that the goods are placed on the market or the services are available in the Philippines;</p> <p>f. Copies of contracts for services showing the use of the mark.</p>	<p>showing the actual use of the mark on the goods being sold or services being rendered in the Philippines;</p> <p>c. Receipts or invoices of sale of the goods or services rendered or other similar evidence of use, showing that the goods are placed in the market or the services are available in the Philippines</p> <p>d. Copies of contracts for services showing the use of the mark; or</p> <p>e. Such other evidence of similar nature that the Director may determine as acceptable</p>
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5. Rule 400.2- A new rule on collective marks and certification marks have been added. It states that application for registration of a collective mark or certification mark shall designate the mark as such and shall be accompanied by a copy of the agreement, if any, governing the use of the collective mark or the copy of the standards set by the certifier governing the use of the certification mark, as the case may be.
6. Rule 402- the guidelines on the reproduction of the mark upon filing of the application has also been amended. Most importantly is the inclusion of rules on color marks, position marks, motion marks, holograms and 3D marks.
7. Rule 503- new provisions on the mode of filing and transmitting office communications has been added to formally implement filing and service by electronic mail or online. Now, the same must be submitted only through the online submission system, i.e. eTMFile, of the IPOPHL. Other communications to the IPOPHL can be submitted online using the IPOPHL online submission system, i.e., eDocFile.
8. Rule 601 - In addition to the instances given priority of action by the IPOPHL, now, applications for marks used or to be used on goods or services directly related to preparing or responding to pandemics, or to addressing public health emergencies, including pharmaceutical preparations or vaccines; personal protective equipment (PPE) such as face masks, face shields, gloves and laboratory gowns; medical and laboratory apparatus and equipment; sanitizers and disinfectants; scientific and laboratory services; and medical services.
9. Other rules, such as those on disclaimers (Rule 604) and contents of certificate of registration (Rule 803) have been amended to include rules on 3D marks, position marks and color marks.
10. Procedural rules have also been amended. For more details, please refer to the Trademark Regulations of 2023 (see: <https://drive.google.com/file/d/1kfczZkVpKiWuFiRSgG5OIIAKvYvRXsB9/view>).

3. What should companies do?

All concerned individuals and entities are advised on the effectivity of the new Rules and Regulations on trademark registrations. New rules on 3D marks, position marks, and color marks have also been issued, hence, concerned individuals are advised to apply accordingly. For more information, you may contact us on the details provided below.

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