



# ICLG

The International Comparative Legal Guide to:

## Trade Marks 2018

**7th Edition**

A practical cross-border insight into trade mark work

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# Philippines

SyCip Salazar Hernandez & Gatmaitan

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Enrique T. Manuel



## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The Intellectual Property Office of the Philippines (IPOPHL) is the relevant trade mark authority.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The Republic Act 8293, otherwise known as the Intellectual Property Code of the Philippines (IP Code), is the relevant trade mark legislation.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Any visible sign capable of distinguishing the goods (trade mark) or services (service mark) of an enterprise, including a stamped or marked container of goods, may be registered.

### 2.2 What cannot be registered as a trade mark?

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; (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.

- 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.
- g. Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services.
- 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 colour alone, unless defined by a given form.
- m. Is contrary to public order or morality.

### 2.3 What information is needed to register a trade mark?

The application for the registration of the mark shall contain:

- a. A request for registration.
- b. The name and address of the applicant who may be a person or juridical entity.
- c. The name of a State of which the applicant is a national or where he is domiciled; 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 organised 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, an indication of:
  - (i) The name of the State with whose national office the

earlier application was filed or, if it was filed with an office other than a national office, the name of that office.

- (ii) The date on which the earlier application was filed.
- (iii) Where available, the application number of the earlier application.

g. Where the applicant claims colour as a distinctive feature of the mark, a statement to that effect, as well as the name or names of the colour or colours claimed and an indication, in respect of each colour, of the principal parts of the mark which are in that colour.

h. Where the mark is a three-dimensional mark, a statement to that effect.

i. One or more reproductions of the mark, as prescribed in the relevant regulations or subsequent issuances, which shall, among others, substantially represent the mark as actually used or intended to be used on or in connection with the goods and/or services of the applicant. The reproduction must be clear and legible, printed in black ink or in colour, if colours are claimed, and must be capable of being clearly reproduced when published in the IPO eGazette.

j. A transliteration or translation of the mark or of some parts of the mark, if the mark or of some parts of the mark is/are in foreign word(s), letter(s) and character(s), or foreign-sounding.

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. A signature by, or other self-identification of, the applicant or his representative. If there is more than one applicant, all of them should be named as applicants but any one of them may sign the application for and on behalf of all the applicants. If the applicant is a juridical person, any officer may sign the application on behalf of the applicant. In cases of co-ownership, each of the co-owners will sign the application.

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.

#### 2.4 What is the general procedure for trade mark registration?

An application for registration is prosecuted *ex parte* by the applicant. Applications shall be examined for registrability in the order in which the complete requirements for grant of the filing date are received by the IPOPHL. If the filing requirements are not satisfied, the IPOPHL shall notify the applicant who shall, within one (1) month from the mailing date of notice, correct the application as required; otherwise, the application shall be considered withdrawn. Where the IPOPHL finds that the required filing conditions have been fulfilled, it shall, upon payment of the prescribed fee, cause the application, as filed, to be published in the prescribed manner, for opposition purposes. When the period for filing the opposition has expired, or when the Director of the Bureau of Legal Affairs (BLA) has denied the opposition, the IPOPHL, upon payment of the required fee, shall issue the certificate of registration. Upon issuance of a certificate of registration, notice thereof making reference to the publication of the application shall be published in the IPOPHL e-Gazette.

In all applications, the IP Code requires that a declaration of actual use with evidence to that effect must be filed within three (3) years from the filing date of the application. Otherwise, the application shall be refused or the mark shall be removed from the Register if registration has been issued in the meantime. The IPOPHL shall

issue the registration certificate covering only the particular goods on which the mark is in actual use in the Philippines as disclosed in the declaration of actual use.

The registrant shall also file a declaration of use and evidence to that effect within one (1) year from the fifth anniversary of the date of the registration of the mark. Otherwise, the mark shall be removed from the Register by the IPOPHL.

The Intellectual Property Office has also issued Intellectual Property Office Memorandum Circular 17-010 requiring the submission of a Declaration of Actual Use within one (1) year from the end of the ten (10) year term of the registration sought to be renewed (Renewal DAU). Memorandum Circular 17-010 took effect on 1 August 2017.

#### 2.5 How is a trade mark adequately represented?

The drawing of the mark shall be substantially the exact representation thereof as actually used or intended to be used on, or in connection with, the goods or services of the applicant. Where the applicant wishes to claim colour as a distinctive feature of the mark, a statement to that effect, as well as the name or names of the colour or colours claimed and an indication, in respect of each colour, of the principal parts of the mark which are in that colour, are required.

#### 2.6 How are goods and services described?

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. The description of goods cannot include class headings of the Nice Classification or broad/indefinite terminologies, but must refer to definite, not overbroad, categories of goods. The applicant must provide specific/particular products falling within the broad categories.

#### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Trade mark protection granted in the Philippines is limited to the Philippines only.

#### 2.8 Who can own a trade mark in your jurisdiction?

Natural and juridical persons may be registered owners of trade marks.

#### 2.9 Can a trade mark acquire distinctive character through use?

Yes. The IPOPHL may accept as *prima facie* evidence that the mark has become distinctive 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.

#### 2.10 How long on average does registration take?

The registration process takes about six (6) to twelve (12) months from the filing of the application.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The estimated total cost of obtaining a trade mark registration, covering one class of goods or services from filing of the application (without a claim of Convention priority) up to the issuance of the certificate of registration, may come to approximately US\$1,500.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

To obtain registration in the Philippines, an application may be lodged either: (i) directly, by way of a national filing; or (ii) through the Madrid System by designating the Philippines.

### 2.13 Is a Power of Attorney needed?

The owner of a mark may file and prosecute his own application for registration, or he may be represented by any attorney or another person authorised to practise in such matters by the IPOPohl. Before any local agent will be allowed to file an application or take action in any case or proceeding, *ex parte* or *inter partes*, a power of attorney or authorisation must be filed in that particular case or proceeding. A power of attorney is required for, among others, filings, recordations and maintenance of a mark.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No. Notarisation and/or consular authentication of the Power of Attorney is not required.

### 2.15 How is priority claimed?

An application claiming a priority right must be filed within six (6) months from the date the earliest foreign application was filed. A certified copy of the corresponding foreign application, showing the date of filing together with an English translation, must be filed within three (3) months from the date of filing in the Philippines. A certified copy of the priority registration certificate indicating the date of filing is also required to be filed.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

The Philippines recognises collective marks as 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. Certification marks are not recognised in the Philippines.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

See question 2.2.

### 3.2 What are the ways to overcome an absolute grounds objection?

As regards signs or devices mentioned in paragraphs (j), (k), and (l) in question 2.2 above, 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.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A refusal of registration by the IPOPohl may be appealed in its entirety.

### 3.4 What is the route of appeal?

An applicant may, upon the final refusal of the Examiner to allow registration, appeal the matter to the Director of Trademarks. The decision or order of the Director of Trademarks shall become final and executory within thirty (30) days after receipt of a copy thereof by the appellant unless, within the said period, an appeal to the Director General has been perfected by filing a notice of appeal and paying the required fee.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

See question 2.2. The grounds used by an examiner to refuse registration are the same grounds that may be raised by a third party to oppose or cause the cancellation of a registration.

### 4.2 Are there ways to overcome a relative grounds objection?

See question 3.2.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

See question 3.3.

### 4.4 What is the route of appeal?

See question 3.4.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

See question 2.2.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any person who believes that he would be damaged by the registration of a mark may oppose a registration.

### 5.3 What is the procedure for opposition?

The person, upon payment of the required filing fee and within thirty (30) days after publication, may file an opposition to the application. Upon the filing of an opposition, the IPOPHL shall serve notice of the filing on the applicant, and of the date of the hearing thereof upon the applicant and the opposer and all other persons having any right, title or interest in the mark covered by the application. The IPOPHL shall issue a summons requiring the respondent-applicant to answer the petition. The respondent shall file his answer, together with the sworn statements and documentary evidence, and serve copies thereof upon the petitioner or opposer. Upon joinder of issues, the case will be referred to mediation. If the parties fail to settle the case during mediation, the preliminary conference shall be set. If the parties still fail to reach an amicable settlement during the preliminary conference, they will be required to submit their respective Position Papers, and thereafter the matter shall be deemed submitted for resolution.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

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

### 6.2 From which date following application do an applicant's trade mark rights commence?

An applicant's trade mark rights commence from the date of the issuance of the certificate of registration.

### 6.3 What is the term of a trade mark?

The registration of a mark is valid for ten (10) years from the date of the issuance of the certificate of registration.

### 6.4 How is a trade mark renewed?

Trade mark 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. Such request 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 prescribed additional fees. The request should contain the following:

- An indication that renewal is sought.
- The name and address of the registrant or his successor-in-interest.
- The registration number of the registration concerned.
- The filing date of the application which resulted in the registration concerned being renewed.

- Where the right-holder has a representative, the name and address of that representative.
- 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 Classification.
- A signature by the right-holder or his representative.
- In the case that there has been material variation in the manner of display, five (5) sets of the new labels must be submitted with the application.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Yes, the IPOPHL may record the assignment of the application for registration of a mark, or of its registration upon submission of a request for recordation, attaching the original notarised assignment document with the appointment of a resident agent and the relevant recordation fee.

### 7.2 Are there different types of assignment?

Yes. Trade mark applications/registrations may be assigned with or without the transfer of the goodwill of the business in which the mark is used. Moreover, trade mark applications/registrations may be assigned in whole or in part. If a trade mark application/registration covers several classes of goods and services, some of the classes covered by the application/registration may be assigned. However, if the application/registration covers only one class of goods or services, the goods or services of interest may not be assigned partially.

### 7.3 Can an individual register the licensing of a trade mark?

Yes. As a general rule, the recordation of a trade mark licence agreement is not mandatory under the IP Code. The non-recordation of a licence agreement does not affect the enforceability or validity of the agreement. However, parties to a licence agreement must ensure that their contract complies with the mandatory and prohibited clauses of the IP Code, otherwise the contract will be deemed automatically unenforceable, as mentioned above.

Although the IP Code does not require recordation of a licence agreement for it to be valid, it requires recordation of the agreement with the trade mark registry for the agreement to have effect against third parties. Even without such recordation, however, the trade mark licence agreement remains valid as between the parties thereto.

Please note that recordation of a licence agreement with the trade mark registry differs from the *registration* of a licence agreement. Under the IP Code, while registration of the licence agreement with the Documentation, Information and Technology Transfer Bureau (DITTB) – the office in the IPOPHL which is responsible for registering trade mark trials and appeals (TTAs) – is not mandatory, it may become necessary in the following instances: (i) when a party files an application with the DITTB for exemption from the prohibited and mandatory provisions; or (ii) when a party requests a certification that the TTA conforms with the mandatory and

prohibited provisions of the IP Code to enable the parties to avail themselves of preferential tax treatment under tax treaties.

Application for clearance of any trade mark licence agreement shall be made to the DITTB 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.

#### 7.4 Are there different types of licence?

Yes. There are, among others, voluntary, compulsory, exclusive and non-exclusive licences in the Philippines.

#### 7.5 Can a trade mark licensee sue for infringement?

The owner of a registered mark shall have the exclusive right to sue for infringement. An action for infringement initiated by a licensee must be made in the name of the trade mark owner.

#### 7.6 Are quality control clauses necessary in a licence?

Yes. Any licence contract concerning the registration of a mark, or an application therefor, shall provide for effective control by the licensor of the quality of the goods or services of the licensee in connection with which the mark is used; otherwise, the licence contract shall not be valid.

#### 7.7 Can an individual register a security interest under a trade mark?

Yes, they can.

#### 7.8 Are there different types of security interest?

Yes. The following, among others, are recognised:

- Chattel Mortgage – trade marks are personal property that may be recorded in the Chattel Mortgage Registry as security for the performance of an obligation.
- Pledge – the rights to a mark may be pledged by delivering possession of the registration certificate to the creditor as security for the performance of an obligation.
- Other security interests, provided they are not contrary to law, morals, good customs, public order or public policy.

### 8 Revocation

#### 8.1 What are the grounds for revocation of a trade mark?

A petition for the cancellation of a trade mark registration may be filed if, among others: the registered mark becomes the generic name for the goods or services; the registered mark has been abandoned; its registration was obtained fraudulently or contrary to the provisions of the IP Code; the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used; or the registered owner of the mark, without legitimate reason, fails to use the mark within the Philippines.

A petition for cancellation may also be filed by the owner of a well-known mark that is not registered in the Philippines against an identical or confusingly similar mark.

#### 8.2 What is the procedure for revocation of a trade mark?

A petition to cancel the registration of a mark under the IP Code may be filed with the Bureau of Legal Affairs. Insofar as applicable, the petition for cancellation shall be in the same form and procedure as that provided in question 5.3 above.

#### 8.3 Who can commence revocation proceedings?

A petition to cancel the registration of a mark may be filed by any person who believes that he is or will be damaged by the registration of a mark.

#### 8.4 What grounds of defence can be raised to a revocation action?

The following may be raised as a defence:

- Non-use of a mark may be excused if caused by circumstances arising independently of the will of the trade mark owner.
- The use of the mark in a form different from the form in which it is registered, which does not alter its distinctive character.
- 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.
- The use of a mark by a company related to the registrant or applicant shall inure to the latter's benefit.

#### 8.5 What is the route of appeal from a decision of revocation?

The decisions or final orders of the Director of the Bureau of Legal Affairs (BLA Director) shall become final and executory thirty (30) days after receipt of a copy thereof by the parties, unless, within the same period, an appeal to the Director General has been perfected.

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.

### 9 Invalidity

#### 9.1 What are the grounds for invalidity of a trade mark?

See question 8.1.

#### 9.2 What is the procedure for invalidation of a trade mark?

See question 8.2.

#### 9.3 Who can commence invalidation proceedings?

See question 8.3.

#### 9.4 What grounds of defence can be raised to an invalidation action?

See question 8.4.

#### 9.5 What is the route of appeal from a decision of invalidity?

See question 8.5.

### 10 Trade Mark Enforcement

#### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

All administrative complaints for violation of the IP Code or IP Laws shall be commenced by filing a verified complaint with the BLA of the IPOPIL.

A civil or criminal complaint may be filed before the Regional Trial Courts.

#### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

For civil cases, proceedings are commenced by the filing of the complaint and the service of summons on the defendant. Upon receipt of the summons, the respondent shall file an answer, setting out the defendant's affirmative and/or negative defences including any compulsory counterclaims and cross-claims. The case is then set for pre-trial conference, where the parties, among others, discuss the possibility of settlement or the referral of the case to alternative models of dispute resolution, proposed stipulation of facts, issues to be resolved, and documents and witnesses to be presented at trial. It may take anywhere from six (6) to twelve (12) months from the filing of the complaint for the case to reach trial proper in court.

For criminal cases, the complaint shall be filed with the Department of Justice or the office of the prosecutor that has jurisdiction over the offence charged. The information shall then be filed with the court. The judge may immediately dismiss the case if the evidence on record clearly fails to establish probable cause. If he finds probable cause, he shall issue a warrant of arrest, or a commitment order if the accused has already been arrested. Arraignment shall then be conducted. Before conducting the trial, the court shall call the parties to a pre-trial. During the pre-trial, a stipulation of facts may be entered into, or the propriety of allowing the accused to enter a plea of guilty to a lesser offence may be considered, or such other matters as may be taken to clarify the issues and to ensure a speedy disposition of the case. The pre-trial shall be terminated not later than thirty (30) days from the date of its commencement, excluding the period for mediation and judicial dispute resolution.

#### 10.3 Are (i) preliminary and (ii) final injunctions available and if so on what basis in each case?

Yes. A preliminary injunction may be granted when it is established: (a) that the applicant is entitled to the relief demanded, and the whole or part of such relief consists in restraining the commission or continuance of the act or acts complained of, or in requiring the performance of an act or acts, either for a limited period or perpetually; (b) that the commission, continuance or non-

performance of the act or acts complained of during the litigation would probably work unfavourably against the applicant; or (c) that a party or any person is doing, threatening or attempting to do, or is procuring or suffering to be done, some act or acts probably in violation of the rights of the applicant regarding the subject to the action or proceeding and tending to render the judgment ineffectual.

If, after trial, it appears that the applicant is entitled to have the act or acts complained of permanently enjoined, a final injunction perpetually restraining the party or person enjoined from further commission of the act or acts or confirming the preliminary mandatory injunction may be granted.

#### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes. A subpoena *duces tecum* may be issued to compel the production of any book, paper, document, correspondence or other records which are material to the case.

The subpoena may be quashed if it is unreasonable or the relevance of the books, papers, documents, correspondence and other records does not appear, or if the persons on whose behalf the subpoena is issued fail to advance the reasonable cost of the production thereof.

#### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Submissions or evidence may be presented either in writing or orally. The witnesses/affiants whose sworn statements/affidavits were submitted must be subject to a cross-examination by the opposing counsel on the basis of their affidavits.

#### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

The earlier filing of a petition to cancel the mark with the BLA shall not constitute a prejudicial question that must be resolved before an action to enforce the rights to same registered mark may be decided.

#### 10.7 After what period is a claim for trade mark infringement time-barred?

No damages may be recovered under the provisions of the IP Code after four (4) years from the time the cause of action arose.

#### 10.8 Are there criminal liabilities for trade mark infringement?

Yes. Apart from imprisonment, the seizure and disposal of infringing goods may be imposed.

#### 10.9 If so, who can pursue a criminal prosecution?

The owner of a registered mark may initiate criminal proceedings.

#### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

This is not applicable.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The following grounds may be raised: (i) use in good faith; (ii) an infringer who is engaged solely in the business of printing the mark or other infringing materials for others is an innocent infringer; or (iii) the infringement is contained in or is part of paid advertisement in a newspaper, magazine or other similar periodical, or in an electronic communication.

Registration of the mark shall also 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. However, such use must be confined to the purposes of mere identification or information and cannot mislead the public as to the source of the goods or services.

A registered mark shall also have no effect against any person who, in good faith, before the filing date or the priority date, was using the mark for the purposes of his business or enterprise. However, his right may only be transferred or assigned together with his enterprise or business or with that part of his enterprise or business in which the mark is used.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

The following grounds may also be raised: (i) prescription; and (ii) lack of notice on the basis that the owner of the registered mark shall not be entitled to recover profits or damages unless the acts have been committed in the knowledge that such imitation is likely to cause confusion, or to cause mistake, or to deceive.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The following reliefs, among others, are available: (i) injunction; (ii) condemnation or seizure of products which are the subject of the offence; (iii) forfeiture of infringing paraphernalia; (iv) imposition of fines; (v) award of damages; and (vi) other analogous penalties or sanctions.

On the application for trade mark infringement of the individual, the court may impound during the pendency of the action, sales invoices and other documents evidencing sales. This allows an intellectual property holder, or his duly authorised representative in a pending civil action or who intends to commence such an action, to apply *ex parte* for the issuance of a writ of search and seizure from Regional Trial Courts in order to allow the search, inspection, photocopying, photographing, audio and audiovisual recording or seizure of any document or article specified in the order.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Yes, costs may be recovered. A claimant must produce competent proof or the best evidence obtainable, such as receipts to justify

the award thereof. Actual or compensatory damages cannot be presumed but must be proved with reasonable certainty.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

Under the rules governing *inter partes* proceedings, a party may appeal a decision or final order of the BLA Hearing Officer to the BLA Director on both factual and legal issues within 10 days after receipt of the decision or final order, together with the payment of the applicable fees.

After the resolution by the BLA Director of the case, further recourse at IPOPHL level is available through the Office of the Director General (ODG). The decision and order of the BLA shall become final and executory thirty (30) days after the receipt of a copy thereof by the party affected unless within the said period an appeal to the Director-General has been perfected. Decisions of the Director-General shall be final and executory unless an appeal to the Court of Appeals or Supreme Court is perfected in accordance with the Rules of Court applicable to appeals from decisions of Regional Trial Courts.

For civil proceedings, the decision of the trial court may be appealed to the Court of Appeals on both factual and legal issues.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

In order for newly discovered evidence adduced on appeal to be considered, it must be shown that: (1) the evidence was discovered after trial; (2) such evidence could not have been discovered and produced at the trial even with the exercise of reasonable diligence; (3) it is material, not merely cumulative, corroborative or impeaching; and (4) the evidence is of such weight that it would probably change the judgment if admitted.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

The Bureau of Customs keeps registry books for patents, trade marks and copyrights. The Customs Examiners conduct actual examinations of the suspected cargo or shipment and immediately submit a recommendation to the Commissioner of Customs for the issuance of a Warrant of Seizure and Detention against such cargo or shipment. Goods finally found in seizure proceedings to be counterfeit or infringing are forfeited in favour of the government and destroyed, unless the same are used as evidence in court proceedings. Under the relevant regulations, examination must be conducted within 24 hours of receipt of the notice of the alert or hold order. If the goods are *prima facie* found to be infringing, the matter will be referred within 24 hours to the Collector of Customs for Seizure Proceedings.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Under Section 168 of the IP Code, a person who has identified in the mind of the public the goods he manufactures or deals in, his business or services as distinct from those of others, whether or not a registered mark or trade name is employed, has a property right in the goodwill of the said goods, business or services so identified, which will be protected in the same manner as other property rights.

### 15.2 To what extent does a company name offer protection from use by a third party?

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. 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.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

This is not applicable.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any natural or juridical person can own a domain name.

### 16.2 How is a domain name registered?

The official domain registry of the “.ph” domain is dotPH Domains, Inc. dotPH Domains, Inc. holds and maintains the database of all PH domain names; specifically, “.ph”, “.com.ph”, “.net.ph”, “.org.ph”, “.mil.ph”, “.ngo.ph” and “.i.ph”. “.ph” domain names are registered on a first-paid, first-served basis. Persons wishing to apply for the Domain Name Service of dotPH Domains, Inc. (dotPH) need only register online at [www.dot.ph](http://www.dot.ph) and submit their contact information. There are no other requirements.

### 16.3 What protection does a domain name afford per se?

In the absence of any successful legal challenge, the name-holder has the right of first refusal to the domain name. This right expires on the last day of the initial or then existing term of service for which dotPH has received payment. The name-holder further agrees to abide by dotPH’s policies, especially its Dispute Resolution Policy, patterned after the Uniform Domain-Name Dispute-Resolution Policy (UDRP) of the Internet Corporation for Assigned Names and Numbers (ICANN).

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The relevant regulations now require all applicants or registrants to file a Declaration of Actual Use (DAU) of the mark with evidence to that effect within one (1) year from the fifth anniversary of each renewal; otherwise, the application shall be refused registration or the registered mark shall be removed from the Register by the Director.

This new requirement only applies to registered marks due for renewal on 1 January 2017 and onwards, regardless of the filing date of the Request for Renewal.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

#### a. *Seri Somboonsakdikul v. Orlane S.A. (G.R. No. 188996, 1 February 2017)*

Seri Somboonsakdikul filed an application for registration of the mark LOLANE with the IPOPohl for goods classified under Class 3 (personal care products). Orlane S.A. filed an opposition to the petitioner’s application, on the ground that the mark LOLANE was similar to ORLANE in presentation, general appearance and pronunciation, and covered similar and related goods, amounting to an infringement of its mark. Orlane S.A. also alleged that ORLANE was an internationally well-known mark which had been used by the company since 1948.

The IPOPohl ruled in favour of Orlane S.A., finding confusing similarity between the competing marks. It found that the dominant feature in both marks was the word LANE, and that the marks had a strong visual and aural resemblance that could cause confusion to the buying public. This resemblance was amplified by the relatedness of the goods. The Court of Appeals, applying the Dominancy Test, affirmed the BLA’s decision.

The Supreme Court agreed with the Court of Appeals’ use of the Dominancy Test, but arrived at a different conclusion. It ruled that there was no colourable imitation between the marks LOLANE and ORLANE which would lead to any likelihood of confusion on the part of ordinary purchasers. The Supreme Court observed that there were visual differences between LOLANE and ORLANE since the mark ORLANE was in plain block upper-case letters, while the mark LOLANE was rendered in stylised words with the second letter L and the letter A co-joined. Also, the two marks were aurally dissimilar. Finally, Orlane S.A. failed to show proof that the suffix LANE had registered in the mind of consumers that such suffix was exclusively or even predominantly associated with ORLANE products. The mark LOLANE was thus allowed registration.

#### b. *Wilton DY and/or Philites Electronic & Lighting Products v. Koninklijke Philips Electronics, N.V. (G.R. No. 186088, 22 March 2017)*

Philites filed a trade mark application for its PHILITES & LETTER P DEVICE trade mark covering a fluorescent bulb, incandescent light, starter and ballast. Koninklijke Philips opposed said application on the ground that it is confusingly similar to its registered and well-known mark PHILIPS covering similar goods.

The IPOPohl concluded that the PHILIPS and PHILITES marks were unlike, both visually and aurally. The Court of Appeals reversed the

IPOPHL ruling, finding it odd that Philites chose a mark with the letters "PHILI", which are the same prevalent or dominant five letters found in Koninklijke Philips' trade mark PHILIPS for the same products.

The Supreme Court ruled in favour of Koninklijke Philips. In applying both the Dominancy and Holistic Tests, the Court found that the mark PHILITES bore an uncanny resemblance or confusing similarity with the mark PHILIPS. It ruled that the dominant feature of both marks was the five-letter "PHILI", despite the aural differences. The consuming public does not have the luxury of time to ruminate on the phonetic sounds of the trade marks, to find out which one has a short or long vowel sound. Fundamentally, the letters "PHILI" would visually catch the attention of the consuming public.

Furthermore, the fact that the parties' wrapper or packaging reflected negligible differences considering the use of a slightly different font and hue of the yellow, was concluded to be of no consequence. Taken in its entirety, the trade mark PHILITES was considered likely to cause confusion or deception to the ordinary purchaser with a modicum of intelligence. Thus, the mark PHILITES was not granted registration.



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### 17.3 Are there any significant developments expected in the next year?

The National Intellectual Property Strategy of the Philippines (NIPS) Project, which was launched on 30 May 2017, is expected to commence implementation in April 2018. The NIPS Project aims to craft deliberate and focused strategic approaches to address issues and concerns that hinder Filipinos from benefiting fully from the IP system.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

The Intellectual Property Rights Enforcement Office of the IPOPHL continues to receive information, complaints and reports from IP rights holders, other government agencies and the public in general, relative to intellectual property rights violations.



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Founded in 1945, SyCip Salazar Hernandez & Gatmaitan is one of the more established and prominent full-service firms in the Philippines.

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