

OFFICE ORDER NO. 139, SERIES OF 2012

Philippine Regulations Implementing the Protocol Relating to the Madrid Agreement
Concerning the International Registration of Marks

Whereas, the Intellectual Property Office of the Philippines (IPOP HL) recognizes the need of trademark holders to have access to a global infrastructure that would allow them to secure protection for their marks through a simple, transparent, and cost-effective manner;

Whereas, the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks ("Madrid Protocol") is an international procedure that allows trademark holders to secure protection in multiple jurisdictions following a single procedure;

Whereas, as part of the continuing improvements to the trademark system in the Philippines and the IPOP HL's thrust to continue to deliver timely and quality services to trademark owners, the Republic of the Philippines acceded to the Madrid Protocol and deposited its instrument of accession with the World Intellectual Property Organization (WIPO) on 25 April 2012;

Whereas, the Madrid Protocol does not amend the laws of the Philippines, including Republic Act No. 8293 (the Intellectual Property Code of the Philippines or the "IP Code");

Whereas, to implement the provisions of the Madrid Protocol and to supplement the provisions of the IP Code to govern the international registration of marks filed under the Madrid Protocol, there is a need for the IPOP HL to promulgate regulations implementing the Madrid Protocol in the Philippines;

Now, therefore, pursuant to the accession of the Philippines to the Madrid Protocol, the following regulations on the international registration of marks under the Madrid Protocol are hereby promulgated.

Chapter 1
General Provisions

Rule 1. *Title*.—These regulations shall be known as the "Philippine Regulations Implementing the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks" or the "Philippine Madrid Regulations".

Rule 2. *Definitions*.— For the purpose of these regulations:

(1) "Madrid Protocol" means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted in Madrid, Spain on June 27, 1989;

(2) "Common Regulations" means the Common Regulations under the 1 Madrid Agreement¹ and Madrid Protocol promulgated by the WIPO;

(3) "International application" means an application to obtain registration of a mark under the Madrid Protocol;

(4) "International registration" means the registration of a mark effected under the Madrid Protocol;

¹ Madrid Agreement refers to the Agreement Concerning the International Registration of Marks, which was adopted on 14 April 1891. The Philippines is not a party to the Madrid Agreement.

(5) "Applicant" refers to the natural person or legal entity in whose name the international application is filed;

(6) "Holder" refers to the natural person or legal entity in whose name the international registration is recorded in the International Register;

(7) "IPOP HL" means the Intellectual Property Office of the Philippines, and shall pertain to the Bureau of Trademarks when reference is made to the processing of all international applications with the IPOP HL as Office of Origin and international registrations designating the Philippines, as well as to communicating with the International Bureau;

(8) "IP Code" refers to Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines;

(9) "TM Regulations" refers to the "Rules and Regulations on Trademarks, Service Marks, Trade Names, and Marked or Stamped Containers", as amended, as well as office orders and memorandum circulars governing the registration of marks;

(10) "BLA Regulations" refers to the "Rules and Regulations on Administrative Complaints for Violation of Law Involving Intellectual Property Rights, as amended by Office Order No. 186, s. 2010," "Amendments to the Rules and Regulations on Inter Partes Proceedings (Office Order No. 99, s. 2011)," and office orders and memorandum circulars issued by the IPOP HL to govern oppositions and IP violations handled by the Bureau of Legal Affairs (BLA) of the IPOP HL;

(11) "International Bureau" means the International Bureau of WIPO;

(12) "International Register" means the official collection of data concerning international registration of marks maintained by the International Bureau;

(13) "Basic application" means an application for the registration of a mark, filed with the IPOP HL, and which is used as the basis for the filing of an international application under the Madrid Protocol;

(14) "Basic registration" means a mark registered by the IPOP HL under the IP Code, and which is used as the basis for the filing of an international application under the Madrid Protocol;

(15) "E-Gazette" pertains to the official online publication of data concerning the registration of marks maintained by the IPOP HL;

(16) "Office of Origin" means the intellectual property office of the Contracting Party where the international application originates;

(17) "Designated Contracting Party" is the country party to the Madrid Protocol that is designated in the international application.

Rule 3. Coverage & Applicability of the Philippine Madrid Regulations and the Common Regulations.-The relevant provisions of the Common Regulations pertaining to the Madrid Protocol are hereby adopted and applied in conjunction with the Philippine Madrid Regulations. These Regulations and the Common Regulations shall apply to all international applications filed under the Madrid Protocol where IPOP HL is the Office of Origin, and international registrations where the Philippines is a Designated Contracting Party.

Rule 4. *Language.*-International applications and any communication for transmittal to the International Bureau through the IPOP HL shall be in English. All other documents required to be submitted directly to the IPOP HL by the applicant or holder shall also be in English.

Chapter 2 International Applications Originating from the Philippines

Rule 5. *Minimum Requirements for Acceptance of International Applications filed with the IPOP HL as Office of Origin.*-The following minimum requirements shall be contained in the application form:

- (1) name and address and contact details of the applicant or the address and contact details of his representative, if any;
- (2) the Designated Contracting Parties;
- (3) reproduction of the mark;
- (4) indication of the goods and services for which registration of the mark is sought.

Rule 6. *Examination of International Applications with the IPOP HL as Office of Origin.*-Where an international application is filed with the IPOP HL for transmittal to the International Bureau, the IPOP HL shall verify if the Philippines may be considered as the country of origin in respect of that application, and that the relevant particulars appearing in the international application correspond to those appearing in the basic application or basic registration, as the case may be, in accordance with the provisions of the Common Regulations.

Rule 7. *Certification.*

(1) Where the international application complies with the prescribed requirements, the IPOP HL shall so certify in the international application, indicating also the date on which the international application was received, and shall forward the international application to the International Bureau.

(2) Where the international application does not meet the prescribed requirements, the IPOP HL shall not forward it to the International Bureau, and shall inform the applicant accordingly.

Rule 8. *Handling Fee.*-Aside from the fees collected by the International Bureau, a non-refundable handling fee shall be payable to IPOP HL upon the filing of an international application for the processing, certification, and transmittal of the application to the International Bureau. The application will not be processed unless the handling fee is paid in full.

Chapter 3 International Registrations with the Philippines as a Designated Contracting Party

Rule 9. *Allowance of a Mark; Publication for Opposition.*-Where the Philippines has been designated in an international registration, the IPOP HL shall undertake the substantive examination of the mark in accordance with the IP Code and the TM Regulations. Upon completion of the substantive examination and the mark is allowed, the mark shall be published for purposes of opposition in the IPOP HL's e-Gazette. Opposition proceedings shall be governed by the provisions of the IP Code, the TM Regulations, the BLA Regulations, and the Uniform Rules on Appeal.

Rule 10. *Ex-Officio Provisional Refusal of Protection.*-Where the IPOP HL finds that, in accordance with the IP Code and the TM Regulations, the mark that is the subject of an international registration designating the Philippines cannot be protected, the IPOP HL shall, before the expiry of the refusal

period under Article 5(2)(b) of the Madrid Protocol, notify the International Bureau of a provisional refusal of protection following the requirements of the Madrid Protocol and the Common Regulations. The holder of that international registration shall enjoy the same remedies as if the mark had been filed for registration directly with the IPOP HL.

Rule 11. *Provisional Refusal Based on an Opposition.*-Where an opposition is filed with the IPOP HL in respect of an international registration designating the Philippines, the IPOP HL shall, before the expiry of the refusal period under Article 5(2)(c) of the Madrid Protocol, notify the International Bureau of a provisional refusal based on an opposition following the requirements of the Madrid Protocol and the Common Regulations. The holder of that international registration shall enjoy the same remedies as if the mark had been filed for registration directly with the IPOP HL under the IP Code and the TM Regulations.

Rule 12. *No Grounds for Refusal; Statement of Grant of Protection.*Where all procedures, including publication for opposition, before the IPOP HL have been completed, and there is no ground for the IPOP HL to refuse protection, the IPOP HL shall, as soon as possible and before the expiry of the refusal period under Article 5(2) of the Madrid Protocol, send to the International Bureau a statement to the effect that protection is granted to the mark in the Philippines.

Rule 13. *Final Decision Following the Notification of a Provisional Refusal.*

(1) *Statement of Grant of Protection.* Where the IPOP HL has notified to the International Bureau a provisional refusal of protection in accordance with Rule 10 or Rule 11, with all the procedures before the IPOP HL having been completed and such provisional refusal has been either totally or partially withdrawn, the IPOP HL shall send to the International Bureau either

(a) a statement to the effect that the provisional refusal is withdrawn, and that protection of the mark is granted in the Philippines for all the goods and services for which protection has been requested; or

(b) a statement to the effect that the provisional refusal is withdrawn, and that protection of the mark is granted in the Philippines for some of the goods and services for which protection has been requested, and specifying therein the goods and services for which protection is granted.

(2) *Confirmation of Total Refusal.* Where the IPOP HL has sent to the International Bureau a notification of provisional refusal in accordance with Rule 10 or Rule 11, with all the procedures before the IPOP HL having been completed, and the IPOP HL has decided to confirm such refusal of protection of the mark in the Philippines for all the goods and services for which protection has been requested or the opposition to the registration of the mark has been upheld by the Director of the Bureau of Legal Affairs of the IPOP HL or by the Director General of IPOP HL upon an appeal, but regardless of any appeal to the regular courts, the IPOP HL shall send to the International Bureau a statement to the effect that there is total refusal of protection of the mark.

Rule 14. *Further Decision Affecting Protection of a Mark.* Notwithstanding the statements sent to the International Bureau in accordance with Rule 13, the IPOP HL shall notify the International Bureau of any subsequent decision affecting the protection of the mark in the Philippines as soon as it receives any such information from the applicant, the court, or any interested party. The notification shall contain a statement indicating the goods or services for which the mark is protected in the Philippines.

Rule 15. *Effects of an International Registration.*

(1) An international registration designating the Philippines shall have the same effect, from the date of the international registration, as if an application for the registration of the mark had been filed directly with the IPOPHL under the IP Code and the TM Regulations.

(2) If no refusal is notified by the IPOPHL to the International Bureau in accordance with the Madrid Protocol and the Common Regulations, or if a refusal has been so notified but has been subsequently withdrawn, or if a statement of grant of protection is sent by the IPOPHL, the protection of the mark in the Philippines shall be the same as if the mark had been registered directly by the IPOPHL on the date of the international registration.

Rule 16. *Cancellation.*-Where the effects of an international registration are cancelled in the Philippines, and the cancellation is no longer subject to appeal, the IPOPHL shall, as soon as it is informed of that decision, notify accordingly the International Bureau in accordance with the relevant provisions of the Madrid Protocol and the Common Regulations.

Rule 17. *Ceasing of Effect of the Basic Application or Basic Registration.*-Where, in accordance with Article 6 of the Madrid Protocol, the basic application, the registration resulting from such application, or the basic registration, ceases to have effect, the IPOPHL, as the Office of Origin, shall inform the International Bureau accordingly, and shall request the cancellation of the international registration in respect of the goods and services affected.

Rule 18. *Recordings in the International Register.*-Any recording made in the International Register in respect of an international registration, shall, to the extent that it applies to the Philippines as a Designated Contracting Party, have the same effect as if it had been recorded by the IPOPHL in its register of marks. In the case of license contracts, publication by the International Bureau shall have the effect of national publication stipulated in Section 150.2 of the IP Code. However, within 2 months from the recording of the license contract with the International Bureau, the holder must provide a copy of the license contract directly to the IPOPHL showing compliance with Sections 87, 88, and 150.1 of the IP Code, otherwise the recording of the license contract shall not have effect in the Philippines. The license contract shall be reviewed and a certification of compliance with the IP Code provisions shall be issued in accordance with the TM Regulations, otherwise the contract shall not be enforceable.

Rule 19. *Collective Marks.*-Where an international registration designating the Philippines is a collective mark, a copy of the agreement governing the use of such collective mark shall be submitted directly by the holder of the international registration to the IPOPHL within two months from the date of international registration with the International Bureau. The international registration will not be examined unless the agreement is received by the IPOPHL.

Rule 20. *Declaration of Actual Use.*

(1) All holders of international registrations that designate the Philippines shall file a declaration of actual use of the mark directly with the IPOPHL, with the required evidence attached thereto, within three years from the date of the international registration. The holder may, within the same three-year period, request a non-extendible period of six months within which to file the declaration of actual use. The actual use of the mark may commence within the extension period. In the event that the holder fails to submit the declaration of actual use within the period, the mark shall be removed by the IPOPHL from its register. The IPOPHL shall inform the International Bureau accordingly.

(2) All holders of international registrations shall file a declaration of actual use and evidence to that effect, or shall show valid reasons based on the existence of obstacles to such use, as prescribed by the TM Regulations, within one (1) year from the fifth anniversary of the date of the international registration of the mark and within one (1) year from the fifth anniversary of the date of renewal of registration of the mark. If the declaration of actual use is not submitted within the prescribed period, the IPOPHL shall remove the mark from the Register and notify the International Bureau accordingly.

The requirements for the filing of the declaration of actual use under paragraphs 1 and 2 shall be the same as those prescribed in the TM Regulations.

Rule 21. Replacement.

(1) (a) The holder of an international registration may request the IPOPHL to take note of that international registration in the register where

(i) a mark registered in the Philippines is also the subject of an international registration, and the protection resulting therefrom extends to the Philippines; and

(ii) the same person is recorded as holder of the registration in the Philippines and of the international registration; and

(iii) all the goods and services listed in the registration in the Philippines are also listed in the international registration in respect of the Philippines; and

(iv) the extension of that international registration to Philippines took effect after the date of registration of the mark in Philippines.

(b) The request for replacement filed with the IPOPHL in accordance with paragraph 1(a), shall be made in the prescribed form and shall be subject to the payment of the prescribed fee.

(c) Replacement is without prejudice to any rights acquired by virtue of the earlier national registration.

(2) Where the IPOPHL has taken note of an international registration in accordance with paragraph (1)(a), the IPOPHL shall notify the International Bureau accordingly. Such notification shall indicate the following:

(a) the number of the international registration;

(b) where only some of the goods and services listed in the international registration are concerned, those goods and services;

(c) the filing date and number of the application for registration of the mark in the Philippines;

(d) the registration date and number of the registration in the Philippines; and

(e) the priority date, if any, of the registration in the Philippines.

Rule 22. Transformation.

(1) (a) Where an international registration designating the Philippines is cancelled at the request of the Office of Origin, in accordance with Article 6(4) of the Madrid Protocol, in respect of all

or some of the goods and services listed in the international registration, an application may be made to the IPOP HL, within three months from the date on which the international registration was cancelled, by the person who was the holder of the international registration at the date of its cancellation, for registration of the same mark ("an application resulting from transformation"), in respect of goods and services covered by the list of goods and services contained in the international registration.

(b) Subject to paragraphs (2) and (3), the provisions applicable to a trademark application filed directly with the IPOP HL shall apply *mutatis mutandis* to an application resulting from transformation.

(2) (a) An application resulting from transformation shall be made in the prescribed form and shall, in addition, include the following:

- (i) a statement that the application is made by way of transformation;
- (ii) the international registration number of the international registration which has been cancelled;
- (iii) the date of the said international registration, or the date of recording of the territorial extension made subsequently to the international registration, as appropriate;
- (iv) the date on which the cancellation of the international registration was recorded; and
- (v) where applicable, the date of any priority claimed in the international application and recorded in the International Register;

(b) An application resulting from transformation shall be subject to the payment of the prescribed transformation fee.

(3) (a) Where an international mark has become protected in the Philippines on or before the date on which the international registration was cancelled and, provided that all the requirements relating to an application resulting from transformation have been met, that mark shall be registered by the IPOP HL without need to undergo another substantive examination. The date of registration shall be the date of the cancelled international registration, or the date of recording of the territorial extension to the Philippines made subsequently to the international registration, as appropriate, and that registration shall enjoy any priority enjoyed by the cancelled international registration.

(b) Where an international mark has not yet become protected in the Philippines on or before the date on which the international registration was cancelled, any procedures or measures already undertaken on or before the date on which an application resulting from transformation is filed for the purpose of the international registration shall be considered as having been undertaken for the purposes of the application resulting from transformation. The filing date of the application resulting from transformation shall be the date of the international registration or the date of recording of the territorial extension to the Philippines made subsequently to the international registration, as appropriate.

Chapter 3 Final Provisions

Rule 23. *Separability*.-In the event that any provision of these regulations or the application of any provision is declared invalid, the remaining provisions of the regulations will not be affected by such declaration.

Rule 24. *Effectivity*. -These regulations shall take effect on 25 July 2012, after publication in a newspaper of general circulation.

Done this 13th day of June 2012; Taguig City, Philippines.

RICARDO R. BLANCAFLOR
Director General