

Subject: Amendment of the Provisions on Declaration of Actual Use of the Trademark Regulations

WHEREAS, it is the Policy of the Intellectual Property Office of the Philippines (IPOPIL) to streamline administrative procedures in registering trademarks.

WHEREAS, there is a need to amend the provisions of the Trademark Regulations on the Declaration of Actual Use to ensure the timely processing of these documents as well as clarify what will be accepted as proof of use.

Now, therefore pursuant to the foregoing the Trademark Regulations are hereby amended as follows:

RULE 204. Declaration of Actual Use – (a) The Office will not require any proof of use in commerce in the processing of trademark applications however without need of any notice from the Office all applications or registrants shall file a declaration of actual use (“declaration”) of the mark with evidence to that effect within three years from the filing date of the application. Otherwise the application shall be refused registration or the registered mark shall be removed from the register by the Director motu proprio

(b) A six-month extension period may be granted upon request of the applicant or registrant provided such request is made prior to the expiration of the three-year period and the required fee is paid. Actual use of the mark may commence within the extension period. The fee must be paid on the day of filing of the declaration of actual use or the request for extension of time to file the document. The date of payment shall be considered as the date of filing of the declaration. The date of first use of the mark shall not be required.

RULE 205. Contents of the Declaration and Evidence of Actual Use. – (a) The declaration shall be under oath and filed by the applicant or registrant (or the authorized officer in case of a juridical entity) or the attorney or authorized representative of the applicant or registrant. The declaration must refer to only one application or registration and shall contain the name and address of application or registrant declaring that the mark is in actual use in the Philippines the list of goods or services are being rendered. If the goods or services are available only by online purchase, the website must be indicated on the form in lieu of name or address of the establishment or outlet. The applicant or registrant may include other facts to show that the mark described in the application or registration is actually being used in the Philippines. The date of first use shall not be required.

(b) Actual use for some of the goods and services in the same class shall constitute use for the class of goods and services. Actual use for one class shall considered use for related classes. In the event that some classes are not covered in the declaration a subsequent declaration of actual use may be filed for the other classes of goods or services not included in the first declaration, provided that the subsequent declaration is filed within the three-year period or the extension period, in case an extension of time to file the declaration was timely made. In the event that no subsequent declaration of actual use for the other classes of goods and services is filed within the prescribed period, the classes shall be automatically dropped from the application or registration without need of notice to the applicant or registrant.

(c) The following shall be accepted as proof of actual use of the mark: (1) labels of the mark as these are used; (2) downloaded pages from the websites of the applicant or registrant clearly showing that

the goods are being sold or the services are being rendered in the Philippines; (3) photographs (including digital photographs printed on ordinary paper) of goods bearing the marks as these are actually used or the stamped or marked container of goods and of the establishment/s where the services are being rendered; (4) brochures or advertising materials showing the actual use of the mark on the goods being sold or services being rendered in the Philippines; (5) for online sale, receipts of the goods or services rendered or the similar evidence of use, showing that the goods are placed on the market or the services are available in the Philippines or that the transaction took place in the Philippines; (6) copies of contracts for services showing the use of the mark. Computer printouts of the drawing or reproduction of marks will not be accepted as evidence of use.

(d) The Director may, from time to time, issue a list of acceptable evidence of use and those that will not be accepted by the Office.

RULE 206. Filing of Declaration of Non-Use – in the following cases, a Declaration of Non-Use may be filed within three years from filing of the application or within the extension period if a request for extension was timely made: (1) where the applicant or registrant is prohibited from using the mark in commerce because of a requirement imposed by another government agency prior to putting the goods in the market or rendering of the services; (2) where a restraining order or injunction was issued by the Bureau of Legal Affairs, the courts quasi-judicial bodies prohibiting the use of the mark; or (3) where the mark is the subject of an opposition or cancellation case. The Declaration of Non-Use shall be under oath and shall clearly state the facts prohibiting the actual use of the make in commerce. The corresponding fee must also be paid upon filing of the declaration.

RULE 201. Duration – A certificate of registration shall remain in force for ten (10) years. Provided that without need of any notice from the Office the registrant 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 these Regulations within one (1) year from the fifth anniversary of the date of the registration of the mark. Otherwise the Office shall remove the mark from the Register. The evidence of use enumerated in Rule 205(c) shall likewise be accepted for the anniversary declaration.

This Office Order shall apply to all pending and registered marks 05 April 2013. Taguig City, Philippines

RICARDO R. BLANCAFLOR
Director General