

05 April 2013

Office Order No. 13-061
Series of 2013

Subject: Trademark Applications with Priority Right Claim

Whereas, Section 3 of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines (IP Code), grants “[a]ny 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;

Whereas, Section 131 of the IP Code provides that any trademark application filed by any person referred to in Section 3 quoted above shall be considered as filed as of the day the application was first filed in the foreign country but the mark shall be registered until such mark has been registered in the country of origin of the applicant;

Whereas, Section 131 does not require that the mark be registered prior to allowance of the application:

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

1. Section (b), Rule 202 is amended as follows:

(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. However, the mark may be allowed for publication for the purpose of opposition, but such publication shall be withheld until it has been ascertained that the mark has been registered in the country of origin of the applicant.

2. Rule 203 is hereby amended to read as follows:

Requirements for Applications Claiming Priority Right. – An application with a claim of priority must be filed within six (6) months from the date the earliest foreign application was filed. The application is not required to submit a certified copy of the foreign application or registration that serves as basis for the claim of priority right. However, the Examiner should be able to verify the fact of filing and/or registration of the foreign application from the official website of the foreign IP Office where the earliest application as filed. In the event that the foreign IP Office where the earliest application was filed does not have an online trademarks database, the applicant, without need of notice, shall submit a photocopy of the foreign application or registration and an English translation, if the application or registration is not in English.

3. Rule 618 is hereby amended as follows:

Allowance of applications with a claim of priority right. If the only issue remaining in an application with a priority right claim based on a foreign application is the registration of such foreign application, the Examiner shall allow the application.

The Examiner shall verify however or not the mark has been registered from the online trademarks database of the foreign IP Office where the application was filed. If the foreign application has been registered, the allowed mark shall be published for opposition upon payment of the required fees.

If the foreign application has not been registered at the time of allowance or if the foreign IP Office does not have an online trademarks database, the Examiner shall, in the notice of allowance, require the applicant to submit a photocopy of the foreign registration within six (6) months from mailing date of the notice. Upon request of the applicant and subject to the payment of the required fee, the period to submit a copy of the foreign registration may be extended for a period of one (1) year, counted from the request an extension or is unable to submit a copy of the foreign registration within the extension period, the claim to the right of priority shall be deemed waived. The application will thereafter be published for opposition upon payment of the required fees.

All rules and regulations, memoranda, circulars and office orders and parts thereof inconsistent with this Office Order are hereby repealed. This Office Order shall apply to all pending trademark applications and international registrations designating the Philippines.

This Office Order shall take effect within fifteen (15) days from publication in a newspaper of general circulation.

05 April 2013, Taguig City, Philippines.

RICARDO R. BLANCAFLOR
Director General