

## CONTACT DETAIL



INTELLECTUAL PROPERTY  
OFFICE OF THE PHILIPPINES

### INTELLECTUAL PROPERTY OFFICE OF THE PHILIPPINES

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### CONTACT DETAILS OF NCIPR MEMBERS

#### DEPARTMENT OF TRADE AND INDUSTRY (DTI)

Trade & Industry Bldg., 361 Sen. Gil Puyat Ave,  
Makati City  
www.dti.gov.ph

#### BUREAU OF CUSTOMS

South Harbor Gate 3, Port Area, Manila  
www.customs.gov.ph

#### NATIONAL BUREAU OF INVESTIGATION (NBI)

Vtech Tower, Araneta cor Maria Clara St., Sto. Domingo,  
Quezon City  
www.nbi.gov.ph

#### PHILIPPINE NATIONAL POLICE (PNP)

Camp Crame, Quezon City  
www.pnp.gov.ph

#### OPTICAL MEDIA BOARD (OMB)

No. 35 Scout Limbaga St. Quezon City  
www.omb.gov.ph

#### FOOD AND DRUG ADMINISTRATION

Civic Drive, Filinvest Corporate City, Alabang, Muntinlupa City  
www.fda.gov.ph

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Youtube: EU International Intellectual Property Cooperation



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## IP ENFORCEMENT

### What should I do when I recognise that my IP rights have been violated?

Sending a cease-and-desist or demand letter to the infringer demanding that they cease and desist from using your IP rights is advisable.

### What enforcement agencies are responsible for protecting IP rights in the Philippines?

The Philippine National Police (PNP), the National Bureau of Investigation (NBI) and the Bureau of Customs (BOC) are the primary enforcement agencies responsible for IP enforcement.

The Intellectual Property Office of the Philippines (IPOPHL), through its Intellectual Property Rights Enforcement Office (IEO), is also responsible for enforcing IP rights.

### What enforcement measures can be taken to prevent or stop IP infringement?

A complaint from right holders about IP violation or a report from the public may be filed with the IPOPHL-IEO. The IPOPHL-IEO is empowered to issue warning letters as well as blocking, visitorial or compliance orders against the infringer.

A civil search-and-seizure order may also be applied for at the courts even before a civil action for infringement is filed. The applicant will be required to post a bond to be determined by the court. A case must be filed within forty-five (45) calendar days from the time of the issuance of the writ otherwise the court will lift the writ and order the return of seized goods. An application for a search warrant may also be filed in court by the law enforcement agency. Once issued, law enforcement agents will conduct a raid, search the premises where the infringement is taking place, and seize infringing objects.

### What legal remedies are available to IP holders whose rights have been infringed?

An IP owner may file a criminal, civil or administrative action for trade mark, copyright or patent infringement, unfair competition and/or other violations of the IP Code. The administrative action must be filed with the Bureau of Legal Affairs of the IPO (IPO-BLA) provided the amount of damages claimed is above PHP 200 000. A civil action may also be filed with the Regional Trial Court. A criminal action may be initiated by filing a complaint with the enforcement agencies or directly with the Office of the Prosecutor of the place where the infringement was committed.

### What procedures must be followed to request handling of IP infringement?

To submit a complaint with enforcement agencies, an Affidavit-Complaint or Letter Complaint must be filed together with supporting documents such as proof of ownership of the IP or its registration, special power of attorney, sample of infringing products or photos, among others.

To submit a complaint with the IPOPHL-IEO, a verified complaint must be filed stating details of the complainant, its ownership of the IP right, relevant facts and evidence of the violation.

### What evidence is needed to demonstrate IP infringement?

Some of the necessary evidence includes: proof of ownership of the IP right, such as registration certificates and affidavits of ownership of copyright; photos or specimens of the infringing goods or of other infringing materials such as brochures, invoices, and receipts; and proof of damages incurred such as financial and sales data of the infringing goods and testimony on loss of profit. In an administrative action filed with the IPO-BLA, evidence consisting of documents from a foreign country must be notarised, and thereafter legalised by an Apostille (or legalised by a Philippine foreign officer stationed in the foreign country, if the foreign country is not a party to the Apostille Convention).

### What alternative dispute resolution options are available, besides the court?

Alternative dispute resolution for IP cases and disputes is available at IPOPHL.

At IPOPHL, mediation is part of the adjudication proceedings, with all cases pending undergoing mandatory mediation, with the latter being handled by the Bureau of Legal Affairs' Alternative Dispute Resolution Services (BLA-ADRS). IPOPHL also offers Mediation Outside Litigation services where parties who have an impending IP issue or matter may submit it for mediation even before filing a suit in court or with IPOPHL. Lastly, IPOPHL has partnered with the World Intellectual Property Organization (WIPO) to provide the IPOPHL-WIPO Mediation Option which is available for all cases undergoing mandatory mediation and mediation outside litigation.

The IPOPHL is also exploring other modes of ADR, including arbitration.



## HOW TO ENFORCE YOUR IP RIGHTS IN THE PHILIPPINES

The leaflet covers enforcement content for three types of IP rights, including trade marks, industrial designs and geographical indications.



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## TRADE MARKS

### What is a trade mark?

A mark is any visible sign capable of distinguishing the goods of an enterprise and includes a stamped or marked container of goods.



### How can you protect your trade mark in Philippines, and what rights are conferred on the owner of a registered trade mark?

A mark is protected by means of registration under the Intellectual Property Code of the Philippines (IP Code). The registrant acquires the exclusive right to use the mark for the covered goods or services and those that are related thereto and to prevent others from using an identical or similar mark for identical or similar goods or services.

If a mark registered in the Philippines is recognised as 'well-known', the exclusive right of the owner extends to goods and services which are not similar to those for which the mark is registered, provided that use of that mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered mark, and that the interests of the owner of the registered mark are likely to be damaged by such use.

Certain marks are unregistrable, including: generic marks; descriptive marks; infringing marks (marks that are identical or confusingly similar to a registered mark, an earlier-filed mark, or a well-known mark); and immoral, deceptive, or scandalous marks.

### What acts are considered trade mark infringements?

Trade mark infringement occurs when, without the consent of the owner of a registered mark, a person:

- uses in commerce any reproduction or colourable imitation of a registered mark, a dominant feature thereof, or the same container; or
- reproduces or colourably imitates a registered mark or a dominant feature thereof, and applies such reproduction or colourable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce. These acts must be in connection with the sale, offering for sale, distribution, or advertising of goods or services, and must be likely to cause confusion, error, or deception.

### What constitutes 'use' of a trade mark?

Owners of registered marks are required to file a Declaration of Actual Use with evidence to that effect covering given periods to prevent the cancellation of the registration.

The following are acceptable proofs of use of a mark:

- labels bearing the mark;
- downloaded pages from a website clearly showing that the covered goods are being shipped to and sold in, or the covered services are being offered or rendered in, the Philippines;
- photos of the covered goods being sold in the Philippines bearing the mark or their stamped or marked container;
- photos of the establishment where covered services are being rendered in the Philippines;
- brochures, advertising materials, or contracts for services showing that the covered services are being rendered in the Philippines;
- receipts or invoices showing the sale of the covered goods, or the rendering of the covered services, in the Philippines; and
- other similar evidence.

### What types of contract exist for the use of trade marks?

Marks may be covered by technology transfer arrangements (TTA) which include licence contracts.

A TTA is any contract or agreement involving the transfer, assignment, or licensing of a mark. A TTA need not be recorded with the Philippine Intellectual Property Office (IPO) to be enforceable. However, if a TTA does not conform to the IP Code, it must be approved by and registered with the IPO, or it will be unenforceable.

A license contract involves the licensing of a registration or application of a mark. To be valid, it must provide for the effective control by the licensor of the quality of the goods or services of the licensee for which the licensed mark will be used. It must also be recorded with the IPO to bind third parties.

Marks may also be covered by franchise agreements which may or may not involve licenses and TTAs.



## INDUSTRIAL DESIGNS

### What is an industrial design?

An industrial design is any composition of lines or colours, or any three-dimensional form, whether or not associated with lines or colours, that gives a special appearance to, and can serve as a pattern for, an industrial product or handicraft. Only industrial designs which are new or ornamental benefit from protection under the IP Code.

### How can you protect your industrial design in the Philippines?

An industrial design is protected by means of registration made in accordance with the IP Code.

### Which objects can and cannot be registered as industrial designs?

In order to be registrable, an industrial design must be new or ornamental. The following industrial designs, however, are not registrable:

- those that are dictated essentially by technical or functional considerations to obtain a technical result; and
- those which are contrary to public order, health, or morality.

### Does a registered industrial design need to be used to retain protection?

Unlike marks, industrial designs need not be used to retain protection. Once an industrial design is registered, it may be renewed for up to two consecutive periods of 5 years each for a maximum 15-year term, by simply applying for renewal and paying a renewal fee.

### What acts are considered industrial design infringements?

Industrial design infringement comprises any of the following: the making, using, offering for sale, selling, or importing of products bearing or embodying a design which is a copy of, or substantially similar to, a protected design, without authorisation of the registrant.



## GEOGRAPHICAL INDICATIONS

### What is a geographical indication?

A geographical indication (GI) is a sign used on products that have a specific geographical origin and possess qualities or a reputation that are due to that origin. The IP Code considers a GI as an IP right. However, there is currently no registration system specific to GIs and the closest mechanism available to protect GIs is through the registration of a collective mark.

A collective mark may not fully protect GIs since marks consisting exclusively of descriptive indications as to geographical indication of the goods are not registrable under the IP Code. Thus, in addition to the name of the place of origin (which must be disclaimed), a distinctive sign may be added to identify a good as originating from that place.

### When does a geographical indication become a generic name?

Since a GI can at best be registered as a collective mark in the Philippines, the rules on marks apply. The IP Code does not specify circumstances when a mark, including a collective mark, becomes generic, but it provides that the primary significance of the registered mark to the relevant public, rather than the purchaser's motivation, must be the relevant test. A registered mark is not deemed generic solely because that mark is also used as a name of, or to identify, a unique product or service.

### What acts are considered geographical indication infringements?

The IP Code does not expressly provide for acts constituting GI infringement. Therefore, in the absence of a law punishing the act, there can be no GI infringement.

However, the following constitute unfair competition and false designation of origin or false representation: 1) passing off, by means of deceit, one's goods as those of another who has established goodwill in the goods or business or 2) acts that would tend to mislead as to, or misrepresent, the geographical origin of the goods.

