

PART 2

Right to a Mark

RULE 200. *How Marks are Acquired.* — The rights in a mark shall be acquired through registration made validly in accordance with the law.

RULE 201. *International Conventions and Reciprocity.* — (a) Any 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 is otherwise entitled by the Intellectual Property Code.

(b) The registration of a mark of such person shall be independent of the registration in the country of origin and the duration, validity or transfer in the Philippines of such registration shall be governed by the IP Code and these Regulations.

RULE 202. *Priority Right; Basis for Claiming Priority Right.* — (a) An application for registration of a mark filed in the Philippines by a person referred to in Rule 201, and who previously duly filed an application for registration of the same mark in one of those countries, shall be considered as filed as of the day the application was first filed in the foreign country.

(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.

(c) The country of origin of the applicant is the country in which he is a national, domiciled, or has a *bona fide* and effective industrial or commercial establishment.

(d) Nothing in this rule shall entitle the owner of a registration granted under this rule to sue for acts committed prior to the date on which his mark was registered in the Philippines; *Provided, That*, notwithstanding the foregoing, the owner of a well-known mark, as defined in the IP Code and these Regulations, that is not registered in the Philippines, may, against an identical or confusingly similar mark, oppose its registration, or petition the cancellation of its

registration or sue for unfair competition, without prejudice to availing himself of other remedies provided for under the law.

(e) In like manner and subject to the same conditions and requirements, the priority right may be based upon a subsequent regularly filed application in the same foreign country: *Provided*, That any foreign application that was made the basis of the priority right and filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority shall not thereafter serve as a basis for claiming a right of priority.

RULE 203. *Requirements for Applications Claiming Priority Right.* - An application with claim of priority right must be filed within six (6) months from the date the earliest foreign application was filed. Without need of any notice from the Office, Bureau or examiner, the applicant shall file an English translation of a certified copy of any of the following within three (3) months from the date of filing in the Philippines:

- (a) Foreign application showing the date of filing
- (b) Foreign registration indicating the date of filing

[as amended by Office Order No. 39 (2002)]

RULE 204. *Declaration of Actual Use.* — 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 applicants or registrants shall file a declaration of actual use of the mark with evidence to that effect within three years, without possibility of extension, from the filing date of the application. Otherwise, the application shall be refused or the mark shall be removed from the register by the Director *motu proprio*.

RULE 205. *Contents of the Declaration and Evidence of Actual Use.* — The declaration shall be under oath, must refer to only one application or registration, must contain the name and address of the applicant or registrant declaring that the mark is in actual use in the Philippines, list of goods where the mark is attached; list the name or names and the exact location or locations of the outlet or outlets where the products are being sold or where the services are being rendered, recite sufficient facts to show that the mark described in the

application or registration is being actually used in the Philippines and, specifying the nature of such use. The declarant shall attach five labels as actually used on the goods or the picture of the stamped or marked container visibly and legibly showing the mark as well as proof of payment of the prescribed fee. *[As amended by Office Order No. 08 (2000)]*