

**PART 9**  
**Other Proceedings Affecting the Application or Registration**

**CHAPTER 1**  
***Voluntary Surrender or Cancellation, Amendment, Disclaimer by the Registrant or by Assignee of Record, Correction of Mistakes***

**RULE 900. *Jurisdiction of the Examiner.*** — The Examiner shall have original jurisdiction over all matters relating to voluntary surrender, voluntary cancellation, voluntary amendment, and voluntary disclaimer of registration, and his decisions, when final, shall be subject to appeal to the Director in the same manner that final decisions of the Examiners in respect of applications for registration may be appealed to the Director. In all such matters, registrants or assignees, their attorneys or agents will deal with him exclusively, or with such other officials and employees whom the Director may designate to assist him.

**RULE 901. *Cancellation upon Application by Registrant.*** — Upon application of the registrant, the Office may permit any registration to be surrendered for cancellation, and upon cancellation the appropriate entry shall be made in the records of the Office. The application for cancellation of registration shall be under oath and shall be duly authenticated or legalized if the registrant is a non-resident.

**RULE 902. *Amendment or Disclaimer of Registration.*** — (a) Upon application of the registrant and payment of the prescribed fee, the Office, for good cause, may permit any registration to be amended or to be disclaimed in part: *Provided*, That the amendment or disclaimer does not alter materially the character of the mark. Appropriate entry shall be made in the records of the Office upon the certificate of registration or, if said certificate is lost or destroyed, upon a certified copy thereof.

(b) Upon application of the registrant and payment of the prescribed fee, a replacement certificate may be issued by the Office stating on its face the fact that it is a replacement and bearing the same entry regarding the amendment or disclaimer that was made on the certified copy of a lost or destroyed certificate. A duplicate original of such replacement certificate shall be kept in the records of the Office.

**RULE 903. *Correction of Mistakes Made by the Office.*** — Whenever a material mistake in a registration incurred through the fault of the Office is clearly disclosed by the records of the Office, a certificate stating the fact and nature of such mistake shall be issued without charge, recorded and a printed copy thereof shall be attached to each printed copy of the registration. Such corrected registration shall thereafter have the same effect as the original certificate; or in the discretion of the Director of the Administrative, Financial and Human Resource Development Service Bureau a new certificate of registration may be issued in accordance with these

Regulations and without charge. All certificates of correction heretofore issued and the registration to which they are attached shall have the same force and effect as if such certificates and their issuance had been authorized by the IP Code.

**RULE 904. *Corrections of Mistakes Made by Applicant.*** — (a) Whenever a mistake is made in a registration and such mistake occurred in good faith through the fault of the applicant, the Office may issue a certificate upon the payment of the prescribed fee: *Provided*, That the correction does not involve any change in the registration that requires republication of the mark.

(b) The application for correction must be under oath and must specify the mistake for which correction is sought, the manner in which it arose and must state that it occurred in good faith.

(c) A copy of the certificate of correction shall be attached to each copy of the registration.

**RULE 905. *Surrender, cancellation, amendment, disclaimer, and correction to be given publicity.*** — Notice of the cancellation, surrender, amendment, disclaimer, and correction shall be published in the IPO Gazette. The cost of publication shall be for the account of the registrant or assignee of record, except when the notice of correction refers to a mistake of the Office.

## CHAPTER 2

Recording of Assignments of Registration, or any Other Instrument Affecting the Title to any Registered Mark, Including Licenses;

### ***Division of Registration***

**RULE 906. *Assignment and Transfer of Application and Registration.*** — An application for registration of a mark, or its registration, may be assigned or transferred with or without the transfer of the business using the mark.

Such assignment or transfer shall, however, be null and void if it is liable to mislead the public particularly as regards the nature, source, manufacturing process, characteristics, or suitability for their purpose, of the goods or services to which the mark is applied.

**RULE 907. *Form of assignment or transfer.*** — (a) The assignment of the application for registration of a mark, or of its registration, shall be notarized and require the signature of the applicant, registrant or the assignee of record in case of subsequent assignment. Transfers by mergers or other forms of succession may be evidenced by the deed of merger or by any document supporting such transfer.

**RULE 908. *Recordal of Assignment or Transfer.*** — Assignments and transfers shall have no effect against third parties until they are recorded at the Office. Assignments and transfers of registration of marks shall be recorded at the Office on payment of the prescribed fee; assignment and transfers of applications for registration shall, on payment of the same fee, be provisionally recorded, and the mark, when registered, shall be in the name of the assignee or transferee.

**RULE 909. *Assignment, other instruments affecting the registration, or license, and translation, to be submitted in duplicate.*** — The original document of assignment, other instrument or license and its translation, together with a signed duplicate thereof, shall be submitted. After recordal, the Office shall retain the signed duplicate, and return the original to the party filing the instrument with a notation of the fact of recording.

**RULE 910. *Date of receipt of instrument to be recorded considered its date of recording.*** — The date of recording of an assignment, other document or license is the date of its receipt at the Office in proper form and accompanied by the full recording fee.

**RULE 911. *A new certificate of registration must be issued to assignee.*** — Upon written request of an assignee of record, and upon payment of the required fee, a new certificate of registration for the unexpired period of the registration must be issued to the assignee.

**RULE 912. *Action may be taken by assignee of record in any proceeding in Office.*** — Any action in any proceeding in the Office which may or must be taken by a registrant or applicant may be taken by the assignee to the exclusion of the original owner, registrant, applicant or earlier assignee, provided the assignment has been recorded. Unless such assignment has been recorded, no assignee will be recognized to take action.

**RULE 913. *Clearance of Trademark License Agreement prior to recordal.*** — Any trademark license agreement shall be applied for clearance with the Documentation Information and Technology Transfer Bureau (DITTB) of the Office and shall be recorded only upon certification by the Director of the DITTB that the agreement does not violate Sections 87 and 88 of the IP Code.

**RULE 914. *Division of Registration.*** — At any time during the life of a certificate of registration, and upon payment of the required fee, the owner of the registered mark may request in writing and under oath that the registration be divided. The request must state the name and address of the owner of record or his representative of record, the mark, the number and date of issuance of the certificate to be divided, the goods and/or services into which the registration is to be divided specifying the number of the class of said goods and/or services according to the Nice Classification.

The Bureau may grant the request to divide the registration provided that the division shall not involve any change in the registration that requires republication of the mark and provided that a single class shall not be subdivided.

**RULE 915. *Cancellation of Original Certificate and issuance of transfer certificates of registration.*** — Upon approval of the request to divide a registration and payment of the required fee, the Director shall order that the original certificate be cancelled and new certificates of registration be issued for the remainder of the term covered by the original certificate.

**RULE 916. *Contents of transfer certificates of registration.*** — The transfer certificates of registration shall include a reproduction of the mark and shall mention their numbers, the name and address of the registered owner, and if the registered owner's address is outside the country, his address for service within the country; the name of the registered owner of the original certificate in case the owner of the transfer certificate be a different person; the date of request for division of the original registration; the date of the issuance of the transfer certificate of registration; the date of filing and registration of the original registration; if priority is claimed, an indication of this fact, and the number, date and country of the application which is the basis of the priority claims; the list of goods or services covered by the transfer certificate of registration with the indication of the corresponding class or classes; and such other data as the Regulations may prescribe from time to time.

### **CHAPTER 3** ***Renewal of Registration***

**RULE 917. *Request for Renewal.*** — A certificate of registration may be renewed for periods of ten (10) years at its expiration upon payment of the prescribed fee and upon filing of a request. The request shall contain the following indications:

- (a) An indication that renewal is sought;
- (b) The name and address of the registrant or his successor-in-interest, hereafter referred to as the "right holder";
- (c) The registration number of the registration concerned;
- (d) The filing date of the application which resulted in the registration concerned to be renewed;
- (e) Where the right holder has a representative, the name and address of that representative;

(f) The names of the recorded goods or services for which the renewal is requested or the names of the recorded goods or services for which the renewal is not requested, grouped according to the classes of the Nice Classification to which that group of goods or services belongs and presented in the order of the classes of the said Classifications; and

(g) A signature by the right holder or his representative.

(h) In case there has been material variation in the manner of display, five (5) sets of the new labels must be submitted with the application.

**RULE 918. *When to file request for Renewal.*** — Such request shall be in Filipino or English and may be made at any time within six (6) months before the expiration of the period for which the registration was issued or renewed, or it may be made within six (6) months after such expiration on payment of the additional fee herein prescribed.

**RULE 919. *Jurisdiction of the Examiner.*** — The Examiner shall have original jurisdiction over applications for renewal registration, and his decisions, when final, are subject to appeal to the Director under the conditions specified in these Regulations for appeals to the Director from the final decisions of the Examiners in respect of applications for registration. If the Office refuses to renew the registration, it shall notify the registrant of his refusal and the reasons therefor.

**RULE 920. *Need for appointing a resident agent.*** — If the registrant, assignee or other owner of the mark which is the subject of a petition for renewal registration is not domiciled in the Philippines, and if the petition for renewal is being filed by a person who is not his representative or resident-agent of record, the power of attorney appointing the person filing the petition as the representative of the registrant must be filed and, upon payment of the required fee, must be recorded before the Office can act upon the petition for renewal.

**RULE 921. *Renewal of prior Act registration; use and proof thereof, required.*** — Marks registered under Republic Act No. 166 shall remain in force and effect but shall be deemed to have been granted under the IP Code and shall be renewed within the time and manner provided for renewal of registration by these Regulations; provided, that marks whose registration have a remaining duration as of January 1, 1998 of more than six and one-half (6 ½) years shall be required to submit the declaration and evidence of actual use prescribed in these Regulations within one (1) year following the tenth and fifteenth anniversaries of the registration or renewal registration under Republic Act No. 166; provided, further, that marks whose registrations have a remaining duration of six and one-half (6 ½) years or less may no longer be subject to the requirement of declaration and evidence of use but shall be renewed within the time and in the manner provided for renewal of registration by these Regulations and, upon renewal, shall be reclassified in accordance with the Nice Classification. The renewal shall be for a duration of ten (10) years. Trade names and marks registered in the Supplemental Register under Republic Act No. 166 whose registration, including any renewal

thereof, was subsisting as of January 1, 1998 shall remain in force but shall no longer be subject to renewal.

**RULE 922. *Prior Act certificate of registration to be surrendered.*** — With the application for the renewal of a registration made under Republic Act No. 166 the certificate of registration to be renewed must be surrendered to the Office, if the official copy of such certificate of registration is not in the files of the Office.

After he has surrendered the certificate of registration granted under Republic Act No. 166, the applicant for renewal may, if he so desires, obtain a certified copy thereof, upon payment of the usual fees.

**RULE 923. *Refusal of renewal registration; appeal to the Director.*** — The application for renewal may be refused by the Examiner for any valid reason. The application for renewal may then be completed or amended in response to the refusal, or the case may be appealed to the Director if the refusal has become final.

**RULE 924. *Certificate of renewal of Registration.*** — The Office may issue a certificate of renewal of registration in all cases where the request for renewal is approved and the registrant requests in writing and pays the required fee for the issuance of said certificate. The certificate of renewal of registration shall contain the number of the certificate of registration and the mark being renewed, the date of original issuance thereof, the duration of the renewal registration, all the data required to be contained in a certificate of registration provided in these Regulations including any limitation contained in the order of the Director approving the renewal of the registration.