



PROCEDURES FOR TRADEMARK, PATENTS, INVENTIONS AND UTILITY MODELS

TRADEMARK

The following are the steps/procedures for Trademark applications before the Intellectual Property Office or IPO:

Action to be taken	Estimated Time
1. Examination of the trademark application	12 to 18 months from filing date
2. IPO issues a notice of allowance and publication for purposes of opposition	12 to 18 months from filing date
3. Applicant pays the publication fee prescribed by the IPO	2 months from mailing date of notice of allowance
4. IPO publishes the application in the Official Gazette for purposes of opposition	6 to 8 months from notice of allowance
5. Persons who may be prejudiced by the registration file an opposition to the application	30 days from release of IPO's Official Gazette
6. IPO issues Notice of Issuance (of Certificate of Registration) and Publication, assuming no opposition is filed	3 to 5 months from publication of the notice of allowance
7. Applicant pays the issuance and publication fees prescribed by the IPO	2 months from mailing date notice of issuance
8. IPO issues the Certificate of Registration	5 to 7 months from notice of issuance

Please note that during the examination process in item (1), action papers may be issued by the IPO and the applicant shall be required to reply to the said action papers.

The term of a trademark registration is ten (10) years from the date of issue.

Information/documents that are required to be submitted to the Philippine Intellectual Property Office ("IPO") for filing Trademark applications:

1. A duly accomplished Trademark Application Form which must contain the following information:
 - a) name and address of the applicant;
 - b) nationality of the applicant;
 - c) the State in which the applicant has his domicile, if any;
 - d) the State in which the applicant has a real and effective industrial or commercial establishment, if any;
 - e) where the applicant is a legal entity, the nature of that legal entity, and the State or territorial unit within a State under the law of which said legal entity was incorporated or organized;
 - f) if the applicant is a legal entity, the name and title/official designation of its authorized signatory;
 - g) where there is a claim of the priority date of an earlier foreign trademark application, the name of the country where said application was filed, the date and serial number of the foreign trademark application and a certified copy of the priority application;

- h) where there is a claim of color as a distinctive feature of the mark, the colors claimed and an indication, with respect to each color, of the principal parts of the mark which are in that color;
- i) where the mark is three-dimensional, information regarding the same; and
- j) if the mark includes or consists of a device, a detailed description of said device.

2. Formal Drawings and Ten (10) facsimiles of the mark.

PATENT

The documentary requirements for filing a new patent application are as follows:

1. Request for the Grant of a Philippine Patent, which shall contain a petition for the grant of the patent, the name and other data of the applicant, the inventor and the agent and title of the invention, utility model or industrial design;
2. Description of the invention, utility model or industrial design;
3. Drawings necessary for the understanding of the invention, utility model or industrial design;
4. One or more claims;
5. Abstract of the invention, utility model or industrial design, which shall consist of a concise summary of the disclosure of the invention, utility model or industrial design as contained in the description, claims and drawings in preferably not more than one hundred fifty (150) words; and
6. Certified copy of the foreign application, together with an English translation thereof, if the applicant wishes to claim a convention priority of a previous filing in a country which is a member of a treaty or convention affording the same privilege to Filipino citizens (e.g., Paris Convention for the Protection of Industrial Property).

Please note that item numbers (1), (2) and (4) above are required in order for the IPO to grant the patent application a filing date.

INVENTIONS

With respect to the procedure for the filing and prosecution of patent applications, under the Rules and Regulations on Inventions (the "Rules"), after the assignment of a filing date by the IPO, a formality examination of the invention patent application will be conducted and a search report will be submitted to the applicant. Within eighteen (18) months from filing date or priority date, the application will be published and third person observations with respect to the application may be communicated in writing to the IPO. A request for a substantive examination to determine compliance with the requirements of patentability must be made within six (6) months from the date of publication, otherwise the application shall be deemed withdrawn. After the substantive examination, and assuming that the application meets the requirements of the IP Code and the Rules, the IPO will grant the Letters Patent in favor of the applicant. Within six (6) months from the grant of Letters Patent, the invention will be published in the IPO Gazette together with other relevant information.

PATENT COOPERATION TREATY

The Patent Cooperation Treaty ("PCT") entered into force in the Philippines on 17 August 2001. Thus, with respect to the Philippines, the provisions of the PCT apply only to applications filed on or after the said date in any of the member-states of the PCT.

Entering the National Phase

To enter the national phase, the applicant should furnish the IPO a copy of the PCT international application in English wherein the Philippines is one of the designated states (unless already transmitted to the International Bureau); or if the application was filed in another language, its English translation, which shall include a translation into English of:

- a) the description;
- b) the claims as filed and, where applicable, as amended under PCT Article 19;
- c) any text matter of the drawings;
- d) the abstract; and

e) where applicable, amendments to the description, claims or drawings under PCT Article 34, as contained in the annexes to the international preliminary examination report. The said copy of the PCT international application or its English translation must be submitted to the IPO not later than twenty (20) months from the priority date based on PCT Article 22(1) (PCT Chapter I) or not later than thirty (30) months from the priority date based on PCT Article 39(1) (PCT Chapter II). Please note that if applicant's application was filed before the PCT entered into force in the Philippines, it would follow that the Philippines was not one of the designated states in the international application. Therefore, the applicant has no basis for entering into the "national phase" in the Philippines, even if the Philippines subsequently joined the PCT.

In such a case, a patent application may still be filed in the Philippines but this will not be treated as a "national phase" application but as a new and independent patent application. However, please note that under the IP Code, the registration of an invention which has already been previously publicly disclosed by the inventor will only be allowed if the patent application is filed in the Philippines within twelve (12) months from the disclosure of the information contained in the said patent application.

UTILITY MODELS AND INDUSTRIAL DESIGNS

With regard to procedure for filing and prosecution of utility models and industrial designs, under the Rules and Regulations on Utility Models and Industrial Designs (the "Regulations"), after the grant of a filing date by the IPO, a formality examination of the utility model/design patent application will be conducted and an examination report (the "Report"), as well as a search report, will be submitted to the applicant within at least two (2) months from filing date.

Within two (2) months from mailing date of the examination report, the applicant must request for a registrability report from the IPO. A registrability report contains the citations of relevant prior art documents with appropriate citations as to their degree of relevance which will serve as an aid in determining the validity of the utility model/industrial design with respect to the requirement of novelty or newness.

If the application meets all the requirements for registrability and the IPO fails to receive any action from the applicant (e.g., request for an amendment, a withdrawal of the application or a search report thereof), the utility model or industrial design shall be deemed registered upon the expiration of two (2) months from the mailing date of the search report and a Certificate of Registration will be issued in due course.

Within six (6) months from registration, the utility model/industrial design will be published in the form of a bibliographic data and representative drawing in the IPO Official Gazette, together with the registrability report if one was requested.

The term of an invention shall be twenty (20) years from the filing date of the invention patent application; however an invention patent shall cease to be in force and effect if the prescribed annual fees is not paid within the prescribed period. On the other hand, the term of a utility model is seven (7) years from the filing date of the utility model patent application, without any possibility of renewal, while the term of an industrial design is five (5) years from the filing date of the application, and may be renewed for not more than two (2) consecutive periods of five (5) years each.