

## Philippines: Registration of non-traditional visual marks and other changes to the rules on trademarks now in effect

### In brief

The Intellectual Property Office of the Philippines ("IPO") recently issued Memorandum Circular No. 2023-001 amending the Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers, and Memorandum Circular No. 2023-002 amending the applicable trademark-related fees ("**Circulars**"). The Circulars took effect on 14 February 2023.

The Circulars further streamline administrative procedures in the registration of trademarks, enhance the enforcement of trademark rights and recognize the protection of non-traditional visual trademarks, such as color marks, motion marks, position marks and hologram marks. The Circulars also require publication fees to be paid in advance upon the filing of a trademark application.

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### In more detail

#### I. Registration of non-traditional visual trademarks

The Circulars institutionalize the registration of non-traditional visual trademarks, such as color marks, position marks, motion marks, hologram marks, three-dimensional marks and certification marks. As a general requirement, applications for these marks must provide a reproduction of the mark and a clear and accurate description of the elements that are claimed and the unclaimed portions thereof. Unclaimed or disclaimed elements of the mark must likewise be depicted in necessary or dotted lines.<sup>1</sup> If the reproduction(s) submitted do not sufficiently depict the mark, the IPO may require the submission of additional representations as may be necessary.<sup>2</sup>

##### Color marks

Color marks not defined by a given form but that have acquired secondary meaning(s) may be registered with the IPO. A reproduction of the sample color must be filed together with a description of the shade of color to be claimed. In case of an application with a combination of multiple colors, a description detailing the systematic arrangement of the colors is required. The applicant would also have the option to submit a designation from an internationally recognized color matching or identification system to describe the colors claimed.<sup>3</sup> Where the description is complex, the applicant may submit a pictorial representation showing the color(s) claimed as applied on the goods, packaging, or service.<sup>4</sup>

<sup>1</sup> IPOPPL Memorandum Circular No. 2023-001, Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers of 2017, Rule 402.

<sup>2</sup> Id. Rule 605.

<sup>3</sup> Id. Rule 402, 604.

<sup>4</sup> Id. Rule 402, 604.

### Position marks

Position marks may now be registered with the IPO by submitting a drawing or reproduction of the mark showing the placement of the mark and its size or proportion relative to the relevant goods or packaging. In appropriate cases, the applicant may also provide a description of the positioning of the mark.<sup>5</sup>

### Motion marks

For motion marks, a clear and correct sequence of still images that corresponds to the movement depicted must be submitted as a single .jpeg file to register the mark with the IPO. The applicant is also required to provide a clear and detailed description explaining the movement in sequential order. The applicant may also submit a video clip in mp4 format or a series of still images in graphic interchange format (.gif) for clarity.<sup>6</sup>

In case of motion marks with priority claims wherein there are two varying representations — such that one filing is represented in a sequence of still images (e.g., jpeg) and the other in a video file (e.g., mp4) — the claim will only be accepted if all the elements of the video file and their complete movement are clearly identifiable in the sequence of still images. Otherwise, the marks will be considered non-identical and the priority claim will be rejected.<sup>7</sup>

### Hologram marks

For hologram marks, each of the various views that show all the material features of the mark must be depicted in the reproduction and must be filed in a single .jpeg file. The multiple views submitted must have only one commercial impression. For simple holograms, multiple views may not be necessary, and a single representation may be acceptable.<sup>8</sup>

In case of hologram marks with priority claims wherein there are two varying representations — such that one filing is a hologram represented in a series of graphic or photographic images (e.g., JPEG), and the other is represented in a video file (e.g., mp4) — the claim will only be accepted if all the elements of the video file and the different stages of the holographic effect are clearly identified in the series of graphic or photographic images.<sup>9</sup>

### Three-dimensional marks

For the three-dimensional marks, the Circulars clarify that one drawing of the three-dimensional mark in a single perspective view may be filed if it sufficiently depicts all its features. However, if one drawing is inadequate, the applicant may submit up to six (6) perspectives that are properly labeled (e.g., front view, side view, etc.) in one single jpeg file.<sup>10</sup> In addition, the unclaimed parts of the configuration, as well as the elements of the mark that are incapable of being registered as a trademark (e.g., functional or non-distinctive aspects), must be presented in broken lines to indicate that these elements are not claimed as part of the mark.<sup>11</sup>

### Certification marks

A certification mark may be applied for registration, provided that the application designates the mark as such and is accompanied by a copy of the standards set by the certifier governing the use of the certification mark.<sup>12</sup> A certification mark means any sign, used or intended for use in commerce with the owner's permission by someone other than its owner, to certify regional or other geographic origin, material, mode of manufacture, quality, accuracy, or other characteristics of someone's goods or services, or that the work or labor on goods or services was performed by members of a group or associations.<sup>13</sup>

## II. Zero-contact policy; exceptions

Embracing a zero-contact policy, the Circulars prescribe that the filing of applications or any related communication must be made only through the IPO's online application system, or eTMFile. Any other communication to the office must be filed using the IPO's online submission system, or eDocFile.

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<sup>5</sup> Id. Rule 402.

<sup>6</sup> Id. Rule 402.

<sup>7</sup> Id., Rule 203.

<sup>8</sup> Id., Rule 402.

<sup>9</sup> Id., Rule 203.

<sup>10</sup> Id., Rule 402.

<sup>11</sup> Id., Rule 604.

<sup>12</sup> Id. Rule 400.2.

<sup>13</sup> Id., Rule 101(c).

Likewise, all notices from the IPO will be sent to the applicant's or registrant's official or registered email address, or to the applicant's/registrant's email address stated or entered into eTMFile.<sup>14</sup> For purposes of reckoning the applicable prescriptive periods, the "mailing date" is deemed to be the date when the notice, action or issuance is initially sent through the e-correspondence system or sent to the designated registered email of the applicant/registrant or its agent, as the case may be. However, in case a notice, action or issuance is received both through e-correspondence and email, the reckoning date will be the later date of receipt.<sup>15</sup>

However, under exceptional circumstances, such as natural calamities and prolonged system downtime, trademark applications and other communications to the IPO may be filed via email (e.g., [bot@ipophil.gov.ph](mailto:bot@ipophil.gov.ph)), by personal delivery, courier service or registered mail, as may be ordered by the IPO director general or the director of trademarks.<sup>16</sup>

### III. Consequences of non-compliance

The Circulars provide that the applicant's failure to submit a written designation of its local representative (in case of foreign applicants) or power of attorney within two (2) months from the mailing date of the IPO's office action may result in the abandonment of the application.<sup>17</sup>

The applicant and/or registrant is required to use the IPO-prescribed form(s) when making submissions before the IPO, and such documents must be complete and compliant with all existing requirements. Otherwise, the submission will be deemed as not submitted and will not stop the running of the prescriptive period, if any.<sup>18</sup> However, if the applicant or registrant simply fails to use the prescribed form, the IPO may still allow the applicant and/or registrant to comply with the requirement and adopt the prescribed form within thirty (30) days from the mailing date of the office action requiring its submission.<sup>19</sup>

The Circulars further provide that communications submitted to the IPO that are not responsive to the office action, including irrelevant attachments, will not be considered as filed and shall be stricken from the record.<sup>20</sup>

### IV. Other salient provisions of the Circulars

Apart from the foregoing, the Circulars have likewise introduced the following changes in respect of trademark prosecution and maintenance:

#### One-time filing fee

The Circulars prescribe a one-time filing fee for trademark applications. Unlike in the previous system where additional fees would have to be paid later on during the course of the prosecution of the application, the Circulars now require the advance payment of the publication for opposition fee, and if applicable, the convention priority claim fee, priority examination fee and issuance and second publication fee.<sup>21</sup> Moreover, in case of non-payment or insufficient payment of filing fees, the applicant is only allowed three (3) calendar days to complete the filing fees to be accorded the original filing date.<sup>22</sup> These fees shall be deemed forfeited should the application not proceed to registration for any reason.<sup>23</sup>

In view of the foregoing, the upfront filing fee for a trademark application has been increased, while the publication fees have correspondingly been removed from the IPO's schedule of trademark-related fees.<sup>24</sup>

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<sup>14</sup> Id., Rule 101 (o), 302.

<sup>15</sup> Id., Rule 101(i).

<sup>16</sup> Id., Rule 401, 503.

<sup>17</sup> Id., Rule 302, 304.

<sup>18</sup> Id., Rule 500, 1006.

<sup>19</sup> Id., Rule 1006.

<sup>20</sup> Id., Rule 607.

<sup>21</sup> Id., Rule 501.

<sup>22</sup> Id. Rule 500.

<sup>23</sup> Id., Rule 501.

<sup>24</sup> Circular 2023-002, Section 1.

### Time to file the renewal Declaration of Actual Use

The renewal of the Declaration of Actual Use may now be filed either (i) after renewal and within the one (1) year period after the date of renewal,<sup>25</sup> or (ii) before renewal, within the six (6)-month period before the expiration of the registration.<sup>26</sup>

### Acceptable proof of use

The Circulars clarify that photographs of (i) labels or packaging bearing the mark as actually used on the goods, (ii) the stamped or marked container of goods, or (iii) signages bearing the mark on the façade or any area in the establishment(s) where the mark is displayed may be submitted as proof of use.<sup>27</sup> The Circulars also provide that any other evidence of similar nature that the director of the Bureau of Trademarks may deem as sufficient may be accepted as proof of use.<sup>28</sup> However, the Circulars make it clear that "actual use" means the use in the ordinary course of trade that demonstrates real commercial purpose targeting the public.<sup>29</sup>

### Divisional applications

Unlike in the previous regime that only allowed divisional applications for applications referring to several classes of goods and/or services, the Circulars now provide that a single-class may be subdivided into two (2) or more separate applications upon payment of the prescribed fees.<sup>30</sup> Moreover, the request to divide an application may now be submitted any time prior to its registration,<sup>31</sup> unlike in the previous regulations where these requests may only have been filed prior to publication.

### Submission of foreign registration for marks with claim of priority

For applications with priority claims, the Circulars extend the period within which to submit proof of the registration of the foreign application from six (6) months to one (1) year. As such, under the Circulars, if the foreign application has not matured to registration at the time of allowance, the applicant will be given a period of one (1) year from the mailing date of the examiner's notice within to submit a photocopy of the foreign registration. Upon request of the applicant and subject to the payment of the required fee, this period may be extended further for another one (1) year period, counted from the expiry of the initial period of one (1) year.<sup>32</sup>

### Authentication of deeds of assignment, license agreements and other similar documents

The Circulars state that the originals or certified true copies of the deeds of assignment, license agreements and other similar documents (and their verified translation, if necessary) must be submitted to the IPO, and if executed and notarized abroad, must be authenticated or apostilled, as appropriate.<sup>33</sup>

### Publication of other matters

The Circulars direct the re-publication of marks in the IPO Electronic Gazette in the following cases: (i) in instances when the mark is subject of a settlement and/or compromise agreement, and there was an amendment to the mark, its description, and/or specification,<sup>34</sup> or (ii) in cases of voluntary cancellation, fifteen (15) days prior to the actual cancellation of the registration.<sup>35</sup>

### Recommended actions

Clients are advised to take note of the IPO's updated procedures, requirements and guidelines for trademark prosecution and maintenance. Clients may likewise take advantage of the Circulars' recognition of non-traditional visual marks, and consider applying as soon as possible for the registration of their color marks, position marks, motion marks, hologram marks, three-dimensional marks and certification marks, to obtain protection under the Philippine trademark system.

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<sup>25</sup> Id., Rule 204.

<sup>26</sup> Id., Rule 206.

<sup>27</sup> Id., Rule 210.

<sup>28</sup> Id., Rule 210.

<sup>29</sup> Id., Rule 101(a).

<sup>30</sup> Id., Rule 408.

<sup>31</sup> Id., Rule 408.

<sup>32</sup> Id., Rule 614.

<sup>33</sup> Id., Rule 1103.

<sup>34</sup> Id., Rule 704.

<sup>35</sup> Id., Rule 1001.

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The law is stated as of 2 March 2023.

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