INTA Submission to Proposed Amendments to Philippines IP Code
November 30, 2016

The International Trademark Association (INTA) greatly appreciates the opportunity to submit comments to the IP Offices of the Philippines (IPOPHL) on amendments to the IP Code. These comments were prepared by the Asia-Pacific Subcommittee of the Trademark Office Practice Committee and INTA Staff.

INTA is a membership association of more than 7,000 trademark owners and professionals from more than 190 countries. In the Philippines, we have 45 members. The Association's member organizations represent 30,000 trademark professionals and include brand owners from major corporations as well as small- and medium-sized enterprises, law firms and nonprofits. INTA undertakes advocacy work throughout the world to advance trademarks and related rights, and offers educational programs and informational and legal resources of global interest. A key objective of INTA's work is to protect consumers and to promote fair and effective commerce. If you have any comments please contact Asia-Pacific Chief Representative, Seth Hays, at shays@inta.org.

Section	Proposed Amendments	Remarks/Explanation
Section 131.2 - No registration of a mark in the Philippines by a person claiming priority right shall be granted until such mark has been registered in the country of origin	Delete Section 131.2.	Sec. 131.2 appears to have been erroneously carried over from Section 37 of the old trademarks law, Republic Act No. 166, which provided that: "No registration of a mark (or trade-name) in the Philippines by a person described in the preceding paragraph of this section shall be granted until such mark (or trade-name) has been registered in the country of origin of the applicant, unless the applicant alleges use in commerce." R.A. 166 adopted the first-to-use system of trademark registration. This meant that a mark had to be in use in the Philippines to qualify for registration. An exception is in the case of an application based on a foreign registration (from a Paris Convention country) which could be registered without prior use. An application based on a foreign registration then need not have been accompanied by a claim of

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		priority. With the enactment of the Intellectual Property Code in 1998, the first-to-file system of trademark registration was adopted, dispensing with the first-to-use system. Trademark rights are now acquired by registration. The provisions of R.A. 166 were modified accordingly, but the lawmakers failed to revise or remove what is now Section 131.2 of the IP Code. This section should be deleted, as the Philippine application should mature to registration regardless of what happens to the mark from which priority is claimed, consistent with the requirements of the Paris Convention.
124.2. The applicant or the registrant shall file a declaration of actual use of the mark with evidence to that effect, as prescribed by the Regulations within three (3) years 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. Sec. 145. Duration.- A certificate of registration shall remain in force for ten (10) years: Provided, That the registrant shall file a declaration of actual use and evidence to that effect, or shall show valid reasons based on the existence of obstacles to such use, as prescribed by the Regulations, within one (1)	Delete Section 124.2 and amend Section 145 to delete the requirement to submit a declaration of use or non-use.	The Philippines is one of the only few remaining countries that still require that declarations of actual use be filed to maintain a registration. The current law and regulation sufficiently provide third parties with remedies to petition the cancellation of a mark if it is not used in commerce within a consecutive period of 3 years or longer.

year from the fifth anniversary of the date of the registration of the mark. Otherwise, the mark shall be removed from the Register by the Office.		