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NEWSLETTER

issue 22 . 2017

IP UPDATE



Anna Mae Koo PARTNER

MA (Law) (Hons), University of Cambridge (Prince Philip Scholar)

- Asialaw Rising Star Lawyer in Intellectual Property 2016
- Techstars Mentor 2015
- IP Rising Star (Euromoney Women in Business Law Awards) 2013
- Litigation Committee Member, International Bar Association
- Anti-Counterfeiting Committee (2016), Internet Committee (2014-2016), INTA



Erica Yee ASSOCIATE

LLB, University of London

Customs Recordation & New Practice on Declaration of Actual Use ("DAU") in the Philippines

In assisting clients with their Asian portfolio, we have come across a few updates and tips in the Philippines.

Customs Recordal to Avoid Court Proceedings in Enforcement

The main benefit of customs recordal in the Philippines is the ability to stop the entry of goods or products that may be in violation of the recorded intellectual property rights ("IPR"). In our experience, recordal with the Bureau of Customs ("BOC"), along with sending cease and desist letters, is the most efficient way to stop the importation of counterfeit goods.

Recordal of IPR with the BOC allows for seizure and forfeiture at the border. The IPR holder does not need to apply for a judicial search warrant to seize unauthorized imports. Thus, it is an expedited way of enforcing IPR because it no longer requires lengthy hearings through the court system.

The recordation of IPR shall be valid for two years from date of the recordal and renewable every two years thereafter.

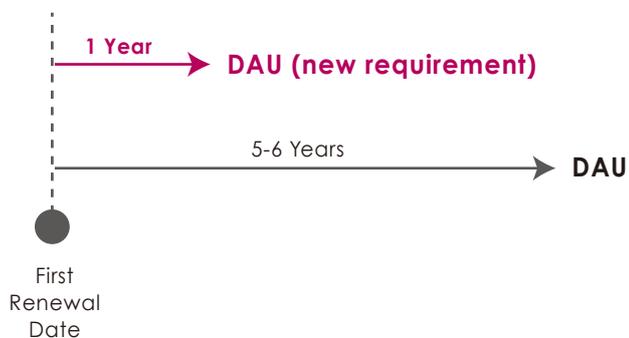
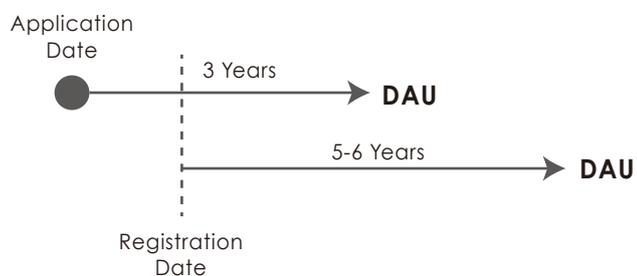
In filing the request for recordation of IPR, the applicant must provide the following to the BOC:-

1. Original Special Power of Attorney ("SPA") to file the request for recordation on behalf of the applicant (notarization and legalization is required);
2. Affidavit of the applicant's rightful ownership of the IPR (notarization and legalization is required);
3. Details of the product relating to the IPR, including (i) the estimated price range of the product; (ii) the date when the product was first introduced into the Philippines; (iii) whether the product is exclusively marketed in the Philippines; and (iv) whether the product is currently available in the Philippines;
4. Product samples;
5. Three certified true copies of the Certificate of Registration of the IPR as issued by the Intellectual Property Office of the Philippines ("IPOPHL"); and
6. Electronic images of the products relating to the IPR (in diskette or compact disk).

DAU Now Required within One Year from Date of Renewal

The IPOPPL now requires the submission of a DAU within one year from date of renewal. Otherwise, the registration shall be removed from the Register. The said requirement is applicable to trademark registrations that are due for renewal on 1 January 2017 onwards.

What was the PAST and What is the PRESENT?



Key Points to Note:-

1. If the trademark owner cannot provide evidence of use within one year from the date of renewal, no extension of time is available in filing DAU.
2. The trademark owner can re-file a new trademark application for the same mark with the same class and goods/services at any time prior to the lapse of the DAU submission timeframe, to extend the trademark rights for another 3 years.
3. It is uncertain whether the new DAU requirement is applicable to the subsequent renewals (i.e. 21st, 31st, 41st anniversary and so on). Stay posted for further updates from us.