

Title:

Rules on well-known marks in the Philippines

Brief Overview:

The IPOPHL's new rules (MC 2025-009) streamline the process for declaring a trademark as "well-known." The new, non-adversarial procedure allows brand owners to file an application with evidence of the mark's use, market share, and reputation. A declared mark is entered into a public register, giving it enhanced protection even if unregistered.

Full Article:

The Intellectual Property Office of the Philippines (“IPOPHL”) has introduced new rules to streamline the process for declaring and registering well-known trademarks. Outlined in Memorandum Circular (“MC”) No. 2025-009, these regulations, which took effect on April 28, 2025.

Intellectual Property Code of the Philippines (“IP Code”) recognizes the existence of well-known marks. It prevents the registration of any mark that is identical or confusingly similar to a brand already considered well-known internationally and in the Philippines.¹

Prior to MC No. 2025 -009, Philippine Jurisprudence established the criteria for the determination of a mark's well-known status. In 2021, Supreme Court held that the courts, the Director General of the IPOPHL, and the Director of the Bureau of Legal Affairs are the competent authorities that can officially declare a mark as well-known.²

Once a mark is deemed well-known, its protection extends beyond its registered goods or services. It can even be protected from use on unrelated products if that use would suggest a false connection with the brand owner and is likely to cause damage to their interests.³ This protection applies even if the well-known mark is not registered in the Philippines.⁴

MC No. 2025-009 establishes a clearer reference to well-known marks in the Philippines. The rule creates an *ex-parte* procedure for establishing a mark's well-known status and compiling an official register. This initiative aims to strengthen intellectual property rights and make the trademark registration process more efficient.

The Declaration Process and Key Criteria

Under the new rules, a brand owner can file a notarized application with the IPOPHL, providing detailed information about the mark, its use, and a comprehensive set of evidence supporting its claim to being well-known.

To be considered a well-known mark, the application must provide evidence for the following four mandatory criteria:

- a. The duration, extent, and geographical area of the mark's use and promotion.
- b. The market share held by the mark.
- c. Its inherent or acquired distinctiveness.
- d. The mark's global registration and use.⁵

¹ Section 123.1, Intellectual Property Code of the Philippines, Republic Act No. 8293 (hereinafter “IP Code”).

² *Suyen Corporation v. Danjac LLC*, G.R. No. 250800 (July 6, 2021).

³ Section 147.2, IP Code; *246 Corporation v. Daway, et al.*, G.R. No. 157216 (November 20, 2003).

⁴ *Fredco Manufacturing Corporation v. President and Fellows of Harvard College*, G.R. No. 185917 (June 01, 2011).

⁵ Rule 5, Rules and Regulations for the Declaration and Creation of the Register of Well-Known Marks (IPOPHL Memorandum Circular No. 2025-009) April 8, 2025 (hereinafter “**IPOPHL MC No. 2025-009**”).

Additionally, the IPOPHL may consider other factors, such as the mark's quality, reputation, commercial value, successful protection records, and outcomes of any related litigation. Once the application is filed, an Examiner reviews the evidence and may request further documentation. The process is *ex-parte*, meaning it doesn't initially involve a third party.⁶

Upon approval, the declared well-known mark is published in the E-Gazette. Interested third parties then have one month to file an observation with supporting documents, to which the applicant may respond. This process is reviewed by a consultative committee before the final decision is made by the Director of Trademarks.⁷

A declaration of well-known status is valid for 10 years and serves as *prima facie* evidence of the mark's status for the specified goods or services. It also ensures the mark is included in the new Register of Well-Known Marks, which Examiners will use as a reference when evaluating new trademark applications. The declaration can be renewed every ten years, provided the owner submits proof of the mark's continued use and well-known status.⁸

Owners of marks that were previously declared well-known by a court or other authority can also apply to have their marks included in the new Register by submitting the relevant documents and proof of continuous use within five years of the new rules' effectivity.⁹

The IPOPHL's new rules for well-known marks pose a positive step for Philippine intellectual property by creating a clear, efficient process for declaring and registering these marks as well as providing brand owners with stronger legal protection. This streamlined system fosters a more confident business environment, attracting investment and safeguarding brand reputations in the digital age.

Authors:

Enrique V. Dela Cruz, Jr.

Senior Partner, DivinaLaw

enrique.delacruz@divinalaw.com

Janna Mae B. Tecson

Partner, DivinaLaw

janna.tecson@divinalaw.com

Mary Zoelli R. Velasco-Manalastas

Senior Associate, DivinaLaw

zoe.velasco@divinalaw.com

Clarizza Grace D. Napa

Associate, DivinaLaw

clarizza.napa@divinalaw.com

⁶ *Id.*

⁷ Rule 11 and 12, IPOPHL MC No. 2025-009.

⁸ Rule 14 and 15, IPOPHL MC No. 2025-009.

⁹ Rule 15, IPOPHL MC No. 2025-009.

