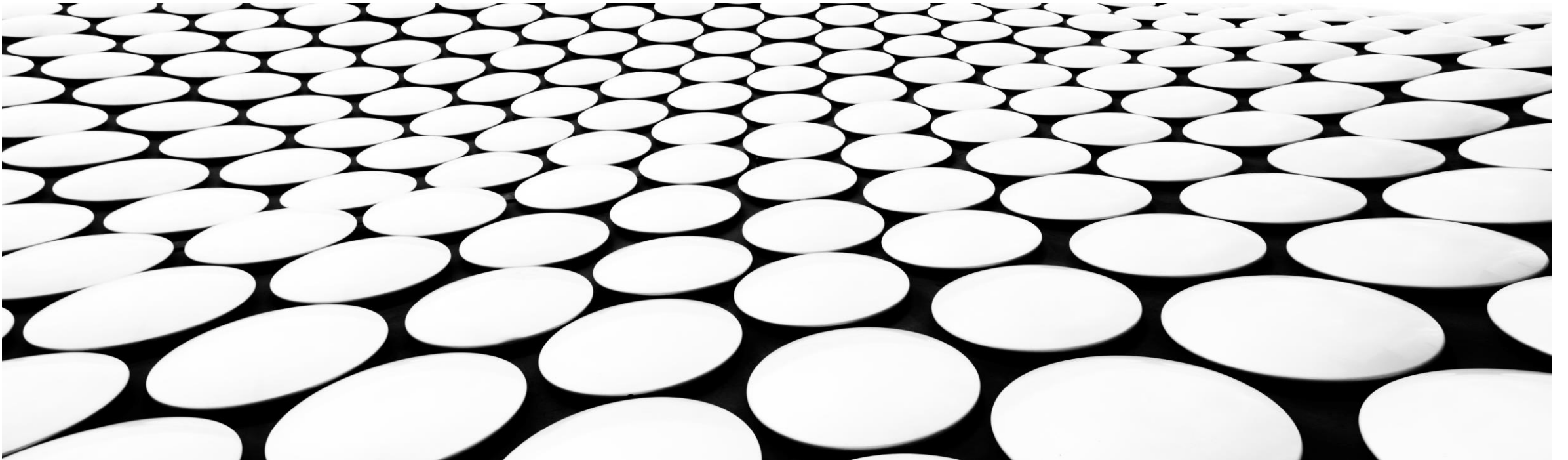

INTELLECTUAL PROPERTY LAW

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TRADEMARKS AND SERVICE MARKS



TRADEMARK

- Any word, name, symbol, emblem, sign or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured, sold or dealt in by others.
- It is any visible sign capable of distinguishing goods.
- When the mark pertains to services, it is called service mark.
- The owner of a trademark has no right of property to prevent others from manufacturing, producing or selling the same article to which it is attached. In other words, the trademark confers no exclusive rights in the goods to which the mark has been applied.



TRADE NAME

- A trade name means the name or designation identifying or distinguishing an enterprise.
- A name or designation may not be used as a trade name if by its nature or the use to which such name or designation may be put, it is contrary to public order or morals and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

ACQUISITION OF TRADEMARK

- The rights in a mark shall be acquired through registration made validly in accordance with the provisions of the law.
- The applicant or the registrant shall file a declaration of actual use of the mark with evidence to that effect within three (3) years from the filing date of the application. Otherwise, the application shall be refused or the mark shall be removed.
- A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate

NON-REGISTRABLE MARKS

- Consists of immoral, deceptive or scandalous matter, or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute;
- Consists of the flag or coat of arms or other insignia of the Philippines or any of its political subdivisions, or of any foreign nation, or any simulation thereof;
- Consists of a name, portrait or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the Philippines, during the life of his widow, if any, except by written consent of the widow;
- Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:
 - The same goods or services; or
 - Closely related goods or services, or
 - If it nearly resembles such a mark as to be likely to deceive or cause confusion (confusing similarity);

NON-REGISTRABLE MARKS (CON'T)

- Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services;
- Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services;
- Consists exclusively of signs that are generic for the goods or services that they seek to identify;
- Consists exclusively of signs or of indications that have become customary or usual to designate the goods or services in everyday language or in bona fide and established trade practice;

NON-REGISTRABLE MARKS (CON'T)

- Consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of the goods or rendering of the services, or other characteristics of the goods or services;
- Consists of shapes that may be necessitated by technical factors or by the nature of the goods themselves or factors that affect their intrinsic value;
- Consists of color alone, unless defined by a given form; or
- Is contrary to public order or morality.



TWO TYPES OF CONFUSIONS FOR IDENTICAL MARKS

- Confusion of Goods (Product Confusion) - when the products are competing.
- Confusion of Business (Source of Origin Confusion) - when the products are noncompeting but related enough to produce confusion of affiliation.

TESTS IN DETERMINING LIKELIHOOD OF CONFUSION

- Dominancy Test - if the competing trademark contains the main or essential or dominant features of another, and confusion and deception is likely to result, infringement takes place.
- Holistic Test - entails a consideration of the entirety of the marks as applied to the products, including labels and packaging, in determining confusing similarity. The scrutinizing eye of the observer must focus not only on the predominant words but also on the other features appearing in both labels so that a conclusion may be drawn as to whether one is confusingly similar to the other.
- NOTE: In **Kolin Electronics Corporation, Inc. v. Kolin Philippines International, Inc.**, G.R. No. 228165, February 9, 2021 [*per J. Caguioa*], the Supreme Court has categorically abandoned the Holistic Test, and ruled that the Dominancy Test must invariably be used in determining whether there is likelihood of confusion.



RIGHTS AFFORDED TO TRADEMARK OWNERS

- The scope of protection afforded to registered trademark owners is not limited to protection from infringers with identical goods. It also extends to protection from infringers with related goods, and to market areas that are the normal expansion of business of the registered trademark owners.
- Doctrine of Unrelated Goods - one who has adopted, used and registered a trademark on his goods cannot prevent the adoption, use and registration of the same trademark by others on unrelated articles of a different kind.

GENERIC AND DESCRIPTIVE MARKS

- Generic marks are those which constitute “the common descriptive name of an article or substance,” or comprise the “genus of which the particular product is a species,” or are “commonly used as the name or description of a kind of goods,” or “refer to the basic nature of the wares or services provided rather than to the more idiosyncratic characteristics of a particular product,” and are not legally protectable.
- Descriptive marks are those which, as understood in its normal and natural sense, “forthwith conveys the characteristics, functions, qualities or ingredients of a product to one who has never seen it and does not know what it is,” and are likewise not legally protectable.
- Examples are Lyceum, Coffee, Milk, Yummy, Philippine, American, Potato.



ARBITRARY, FANCIFUL, AND SUGGESTIVE MARKS

- Arbitrary Marks - consist of common words which, when applied to certain goods or services, neither suggest nor describe any characteristic of those goods or services. (e.g. Apple, Papa, Sakura)
- Fanciful Marks - are "coined" words invented solely for the purpose of functioning as a mark. Archaic or obsolete terms may also function as fanciful marks. (e.g. Kodak, Clorox, Colgate)
- Suggestive Marks - those that suggest some quality of ingredient of the goods or services to which the marks are applied. (e.g. Mr. Clean, Soapman, Close-Up)



CATEGORIES OF MARKS

- Ranked from the most protectable to the unprotectable:
 1. Arbitrary Marks
 2. Fanciful Marks
 3. Suggestive Marks
 4. Descriptive Marks
 5. Generic Marks



DOCTRINE OF SECONDARY MEANING

- Under the doctrine of secondary meaning, a word or phrase originally incapable of exclusive appropriation with reference to an article in the market, because it is geographical or otherwise descriptive, might nevertheless have been used so long and so exclusively by one producer with reference to his article that, in the trade and to that branch of the purchasing public, the word or phrase has come to mean that the article was his produce.



GROUND TO CANCEL CERTIFICATE OF TRADEMARK REGISTRATION

- Failure to file declaration of actual use within one (1) year from the fifth anniversary of the trademark registration;
- Failure to file declaration of actual use within three (3) years from filing of the application for trademark registration;
- At any time, if the registered owner of the mark without legitimate reason fails to use the mark within the Philippines, or to cause it to be used in the Philippines by virtue of a license during an uninterrupted period of three (3) years or longer.

TRADEMARK INFRINGEMENT

- Any person who shall, without the consent of the owner of the registered mark:
 - Use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark or the same container or a dominant feature thereof in connection with the sale, offering for sale, distribution, advertising of any goods or services including other preparatory steps necessary to carry out the sale of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or
 - Reproduce, counterfeit, copy or colorably imitate a registered mark or a dominant feature thereof and apply such reproduction, counterfeit, copy or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, shall be liable in a civil action for infringement by the registrant for the remedies hereinafter set forth.
- Civil and Criminal Cases



UNFAIR COMPETITION

- Unfair competition has been defined as the passing off or attempting to pass off upon the public of the goods or business of one person as the goods or business of another with the end and probable effect of deceiving the public.
- Thus, the defendant gives his goods the general appearance of the goods of his competitor with the intention of deceiving the public that the goods are those of his competitor.
- Any person who shall employ deception or any other means contrary to good faith by which he shall pass off the goods manufactured by him or in which he deals, or his business, or services for those of the one having established such goodwill, or who shall commit any acts calculated to produce said result, shall be guilty of unfair competition, and shall be subject to an action therefor.

TRADEMARK INFRINGEMENT VS. UNFAIR COMPETITION

Trademark Infringement	Unfair Competition
Unauthorized use of a registered trademark	Passing off one's goods as those of another
Fraudulent intent is not necessary	Fraudulent intent is necessary
Prior registration of trademark is required	Prior registration of trademark is not required
There is no trademark infringement if the registered trademark is used for goods/services totally unrelated to the another goods/services.	There can be unfair competition even if two products are not related if there is passing off of one's product as that of another manufacturer.



END

THANK YOU AND STUDY WELL

