

SIXTEENTH CONGRESS OF THE REPUBLIC )  
OF THE PHILIPPINES )  
Second Regular Session )



15 APR 16 P2:20

SENATE  
S. No. 2723

BY: \_\_\_\_\_  
SECRETARY

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Introduced by Senator Miriam Defensor Santiago

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AN ACT  
ESTABLISHING A REGISTRY OF WELL-KNOWN TRADEMARKS

EXPLANATORY NOTE

The Constitution, Article 12, Section 6 provides:

Section 6. The use of property bears a social function, and all economic agents shall contribute to the common good. Individuals and private groups, including corporations, cooperatives, and similar collective organizations, shall have the right to own, establish, and operate economic enterprises, subject to the duty of the State to promote distributive justice and to intervene when the common good so demands.

Section 14 further provides:

Section 14. The sustained development of a reservoir of national talents consisting of Filipino scientists, entrepreneurs, professionals, managers, high-level technical manpower and skilled workers and craftsmen in all fields shall be promoted by the State. The State shall encourage appropriate technology and regulate its transfer for the national benefit....

The purpose of this Act is to create a registry of internationally well-known trademarks for the purpose of simplifying evidentiary proceedings in Court when enforcing provisions of Republic Act No. 8293, otherwise known as the Intellectual Property Code.

The protection of well-known or famous marks is provided for under the Paris Convention for the Protection of Industrial Property and the Agreement on Trade-Related Aspects of Intellectual Property Rights<sup>1</sup> (the TRIPS Agreement) of which the Republic of

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<sup>1</sup> [https://www.wto.org/english/tratop\\_e/trips\\_e/t\\_agm0\\_e.htm](https://www.wto.org/english/tratop_e/trips_e/t_agm0_e.htm)

the Philippines is a signatory. The Philippines has complied with the TRIPS Agreement in large part through the enactment of the Intellectual Property Code as cited above. This code provides protection for internationally well-known marks, although they may not be registered in the Trademark Registry.

Proving, for the purposes of enforcing one's rights under the Intellectual Property Code, that one is an owner of an internationally well-known mark is a long, difficult, and expensive process, to say the least. A person must show, for instance, that his goods or services under the mark has been advertised and sold in a large number of countries. Each piece of evidence must go through a long process of verification, not only with the Court but with the Department of Foreign Affairs, Department of Trade and Industry, Department of Customs, and all other agencies related to international trade and industry. This is not to mention the possibility of having to prove this fact in many different lawsuits. The difficulty and expense of having to gather this gargantuan amount of evidence is inimical to the process of litigation.

It is therefore necessary, in the interest of the speedy disposition of lawsuits, to provide a registry of well-known marks, such that entry thereto will constitute *prima facie* evidence of being a well-known mark. One need only prove his claim once, and at his own convenience, to competent authorities in the Intellectual Property Office. Additionally, if one is able to prove his claim in Court at least once, this shall be sufficient to be entered into the registry without further evidence.

  
MIRIAM DEFENSOR SANTIAGO  
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Office of the Secretary

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Introduced by Senator Miriam Defensor Santiago

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*Be it enacted by the Senate and the House of Representatives of the Philippines in Congress assembled:*

1 AN ACT  
2 ESTABLISHING A REGISTRY OF WELL-KNOWN TRADEMARKS

3 SECTION 1. *Short Title.* – This Act shall be known as the “Well-Known Marks  
4 Registry Act”.

5 SECTION 2. *Definition of “Well-Known Mark”* - For the purposes of this Act, a  
6 ‘Well-Known Mark’ is understood in the same contemplation as an internationally well-  
7 known mark provided for in Section 123.1 (e) of Republic Act No. 8293 otherwise  
8 known as the “Intellectual Property Code of the Philippines”.

9 SECTION 3. *Designation of Lead Agency.* – The Intellectual Property Office  
10 (IPO) is hereby directed to establish, within one (1) year from the effectivity of this Act,  
11 an official Registry of Well-Known Marks, hereinafter referred to as ‘the registry’. The  
12 IPO shall likewise be responsible for the maintenance and publication of the registry, as  
13 well as all acts necessary for the efficient implementation of this Act. The IPO shall issue  
14 all pertinent implementing rules and regulations for the application of any mark into the  
15 registry, *Provided*, that no declaration of use in the Philippines shall be required for entry  
16 thereto.

17 SECTION 4. *Effect of Registry.* – Official entry into the registry shall constitute  
18 *prima facie* evidence that a mark under litigation is well-known. No further evidence

1 shall be required by the Court for determining whether a mark is well-known, *Provided*,  
2 that there are no fatal defects in the entry of the mark into the registry.

3 SECTION 5. *Automatic Registry By Order of the Court.* – Any mark deemed by  
4 the Court through final judgment, to be internationally well-known, shall be entered into  
5 the registry by operation of law.

6 SECTION 6. *Period of Registry.* – Entry into the registry shall be effective for a  
7 period of fifteen (15) years, subject to renewal.

8 SECTION 7. *Disclaimer.* – The registry is not an exclusive list. Nothing in this  
9 Act shall be interpreted to mean that a mark that is not registered is not well-known.

10 SECTION 8. *Separability Clause.* – If any provision or part hereof, is held invalid  
11 or unconstitutional, the remainder of the law or the provision not otherwise affected shall  
12 remain valid and subsisting.

13 SECTION 9. *Repealing Clause.* – Any law, presidential decree or issuance,  
14 executive order, letter of instruction, administrative order, rule or regulation contrary to  
15 or is inconsistent with the provision of this Act is hereby repealed, modified, or amended  
16 accordingly.

17 SECTION 10. *Effectivity Clause.* – This Act shall take effect fifteen (15) days  
18 after its publication in at least two (2) newspapers of general circulation.

Approved,

/aml 20March2015