



IP Litigation and Enforcement Guide: Philippines



IP Litigation & Enforcement in the Philippines

This is a brief guide addressing common questions and concerns of the IP litigation and enforcement landscape in the Philippines.

Is your jurisdiction a common law or civil law jurisdiction?

The Philippines is primarily a civil law jurisdiction, but its legal system has elements of common law as decisions of the Supreme Court are binding on lower courts and are a source of law.

What methods are there for enforcing IP rights in your jurisdiction?

IP Right	Civil	Administrative	Criminal	Customs
Trademark	Yes	Yes	Yes	Yes
Unfair competition/ passing off	Yes	Yes	Yes	-
Copyright	Yes	Yes	Yes	Yes
Registered designs/ design patents	Yes	Yes	Yes	Yes
Patent	Yes	Yes	Yes	Yes

What courts have jurisdiction to handle civil IP cases?

Courts designated as Special Commercial Courts (SCCs) have jurisdiction to handle civil IP cases.

Is there any bifurcation of proceedings? For example, for determining validity or damages?

Bifurcation of proceedings is not an option available under Philippine rules. Issues such as the liability of an infringer and the appropriate remedies are resolved in the same proceeding.

What are procedures for civil enforcement?

Civil enforcement to recover damages from the infringer and/or to enjoin the infringing action is initiated by filing a verified complaint with a SCC. The parties file complaints, answers, and such other pleadings as may be allowed by regulations. Remedies include preliminary injunctions, preliminary attachments, damages and fines.

Is a power of attorney needed for civil action to be brought? If so what are the procedures and time lines?

A power of attorney (“POA”) is needed when the complaint/civil action will be brought by an authorized representative of the IP owner. Examples include when a party-litigant is a corporation or the IP owner is not based in the Philippines. In such case, the POA must be filed together with the complaint, which needs to be verified under oath by the complainant or authorized representative of the complainant.

What is the average time to trial in a civil case?

Based on the timelines provided in the 2020 Revised Rules of Procedure for Intellectual Property Cases, the average time to trial in a civil case is about 6 months from the time of filing the complaint, as outlined below:

- a. Within five (5) days from the filing of the complaint, the SCC will issue a summons to the other party/respondent to file its Answer.
- b. The other party/respondent is required to file the Answer to the complaint within 30 days from receipt of the summons.
- c. The complainant has 15 days from receipt of Answer to respond to any counterclaim or cross-claim raised therein.

- Thereafter, a party has the option to avail of modes of discovery within 30 days from the joinder of issues (usually counted from the receipt of the Answer). The other party may object to the mode of discovery within 10 days from receipt of request. The requesting party will then have three (3) days from receipt of the objection to submit a comment. The court shall rule on the objection or comment no later than 10 days from receipt of the same.

d. Within five (5) days from expiration of 30 days to avail of modes of discovery or after the discovery requested has been completed, the court will issue a notice setting the case for pre-trial for simplification of issues and marking of evidence.

e. The pre-trial shall be terminated no later than 30 days from its commencement.

f. Clarification hearings may be conducted within 30 days from termination of pre-trial.

g. The trial proper shall commence within 60 days from the termination of the pre-trial.

h. The trial should be completed no later than 60 days from the date of the initial trial.

However, in practice, the timelines are likely to be adjusted depending on the availability of the parties and representatives attending the hearing and the calendar of the court.

What is the language of the proceedings? Is there a choice of language?

The proceedings are in English. Pleadings submitted are also in English. In case a witness can only speak a local or foreign language, a translator will be provided.

Is it possible to apply for summary judgment?

Yes, a summary judgement can be applied for. The plaintiff must prove that there is no genuine issue as to any material fact in order for a summary judgement to be granted.

On what basis are interim injunctions granted?

Interim injunction is a provisional remedy available to the parties in IP disputes. The applicant must prove their right to be protected, material invasion of such right, need to enjoin the action to prevent further damage, and that no other remedy exists to prevent the damage.

On what basis are permanent injunctions granted?

After trial, a grant of final injunction is proper if it has been shown that the applicant is entitled to have the act or acts complained of be permanently enjoined.

What appeal procedures are available from a first instance judgment?

Decisions and final orders rendered by SCCs are appealable to the Court of Appeals through a petition for review under Rule 43 of the Rules of Court. The petition for review should be filed within fifteen (15) calendar days from notice of the decision or final order of the SCC. A fifteen (15)-calendar day extension to file a petition for review may be granted upon filing a proper motion and the full payment of legal fees.

Decisions or final orders rendered by the Directors of the Bureaus of IPOPHL for administrative cases can be appealed to the Office of the Director General. It is taken by filing an Appeal Memorandum to the Office of the Director General of the IPOPHL within thirty (30) days from notice of a decision or final order appealed from. The IPOPHL Director General's decision can be appealed to the Court of Appeals.

What are the procedures for criminal enforcement?

A complaint must first be filed with the Department of Justice. The complaint will be evaluated by a public prosecutor. If the public prosecutor confirms that there is probable cause that a violation of the IP Code is committed, a criminal information will be accordingly filed with the courts. Once the information has been raffled to a SCC, the criminal court will schedule the arraignment of the infringer and trial will thereafter commence.

What are the procedures for criminal appeals?

Criminal appeals are filed with the Court of Appeals. This can be done by filing a notice of appeal with the SCC who rendered the decision or final orders appealed from and by serving a copy of the same upon the adverse party. Such appeal must be taken within fifteen (15) days from the promulgation of the judgment or from notice of the final order appealed from. The period to perfect the appeal will be suspended from the time a motion for new trial or reconsideration is filed until notice of the order overruling the same motion have been served upon the accused or his counsel.

What are the procedures for administrative enforcement?

The Bureau of Legal Affairs (BLA) of the Intellectual Property Department has jurisdiction over administrative complaints for IP violations, provided the total damages claim is at least Php200,000.00 (approximately US\$4,000). The procedures provided in the *Rules & Regulations on Administrative Complaints for Violation of Laws Involving Intellectual Property Rights*, in sum, are as follows:

- a. An action is commenced by the filing of a Complaint;
- b. The BLA issues a Summons or Notice to Answer within three (3) days from receipt of Complaint;
- c. The Answer must be filed within 10 days from receipt of Summons or Notice to Answer;
- d. Upon joinder of issues (after receipt of Answer), the hearing officer will issue a notice setting the case for pre-trial conference and requiring the parties to submit a pre-trial brief;
- e. At the pre-trial conference, parties will be given the chance to, among others, agree on the trial dates;
- f. The case will be entered in the BLA's trial calendar and parties will be served with the notice/s of trial;
- g. The hearing on the case shall be terminated within 90 days (30 days allotted to complainant; 30 days for the respondent; and 30 days for rebuttal or sur-rebuttal).

The timelines above, however, are not strictly followed. In practice, hearing dates and deadlines are likely to be adjusted depending on the availability of the parties and representatives attending the hearing and the calendar of the BLA/hearing officer.

What are the measures for Customs border protection?

The first step in border protection is to secure the customs recordal of the IP before the Bureau of Customs (BOC). The application process requires the submission of several documents, including certified copies of registrations of IPs, and information about the legitimate channels of distribution of the goods of the IP owner. The customs recordal is effective for a two-year period and is renewable. The BOC will rely on the customs recordal in case there is a customs seizure/raid action. Brand familiarity trainings are recommended so the BOC agents are able to distinguish counterfeits from originals.

What IP treaties is your jurisdiction a member of?

- Madrid Agreement
- WTO – TRIPS Agreement
- WIPO – Copyright Treaty
- WIPO – Trademark Law Treaty
- WIPO – Performances and Phonograms Treaty
- Berne Convention
- Paris Convention
- Budapest Treaty
- Patent Cooperation Treaty

Further reading

Guides:

- [IP Enforcement Guide: Philippines](#)
- [BritCham Philippines - IP Rights Enforcement Manual for the Philippines](#)
- [Patent protection overview in four major ASEAN countries](#)
- [E-filings and hearings in Courts in South East Asia](#)

Articles:

- [Talent Shows and copyright infringement in the Philippines](#)
- [Fast tracking health related patents in the Philippines](#)
- [The Philippines mayor and the counterfeit sneakers](#)

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