



Trademark Administration Processes: Challenges and Solutions

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11 December 2024

2004



Manually typing office actions



Vienna classification using a book and writing the codes in index cards

2004



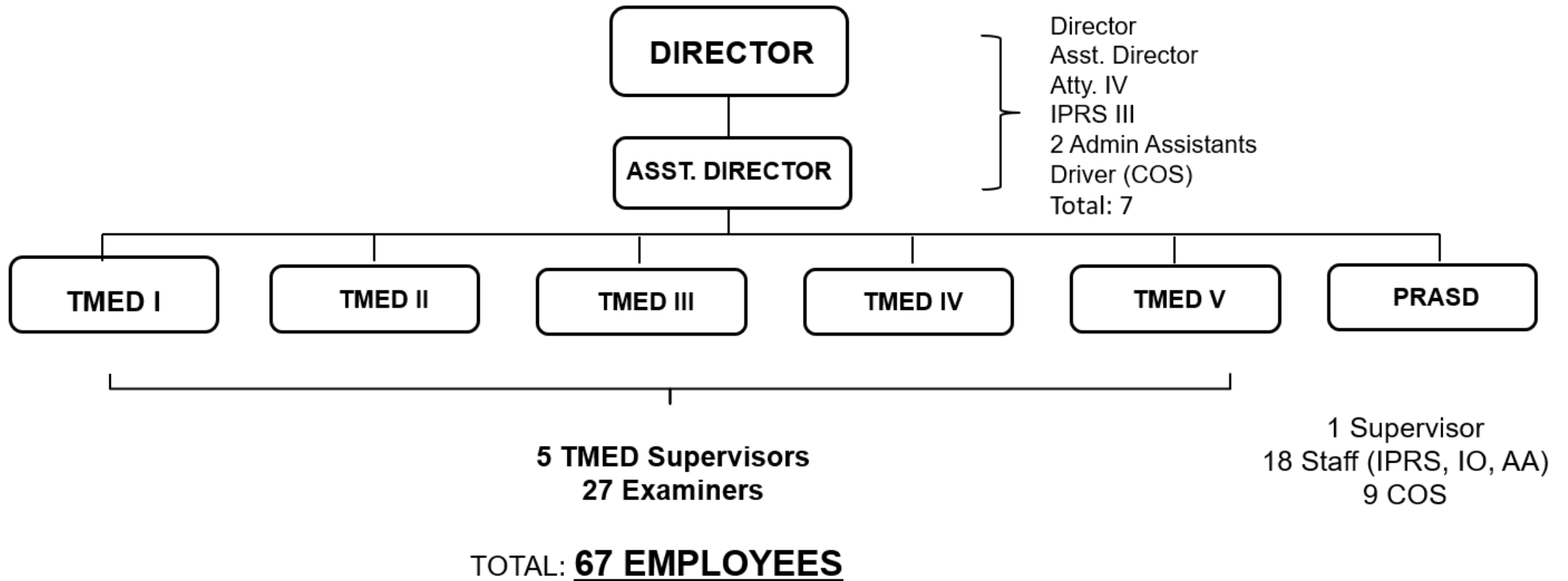
- **30 disposals / month**
- **TAT: 57.68 months from filing to registration**

2024



- **125 average disposal per month (1st sem 2024)**
- **TAT: 3.85 months from filing to registration (as of November 2024)**

Composition of the Bureau of Trademarks



Filing Statistics

2023

Filings: **41,934**

Renewals: **5,498**

Registrations: **30,014**

Turnaround time from filing to registration: **4.36 months**

*includes the mandatory 30 days opposition period

TAT

Filing to Registration



ASEAN Average: **9.29 months**

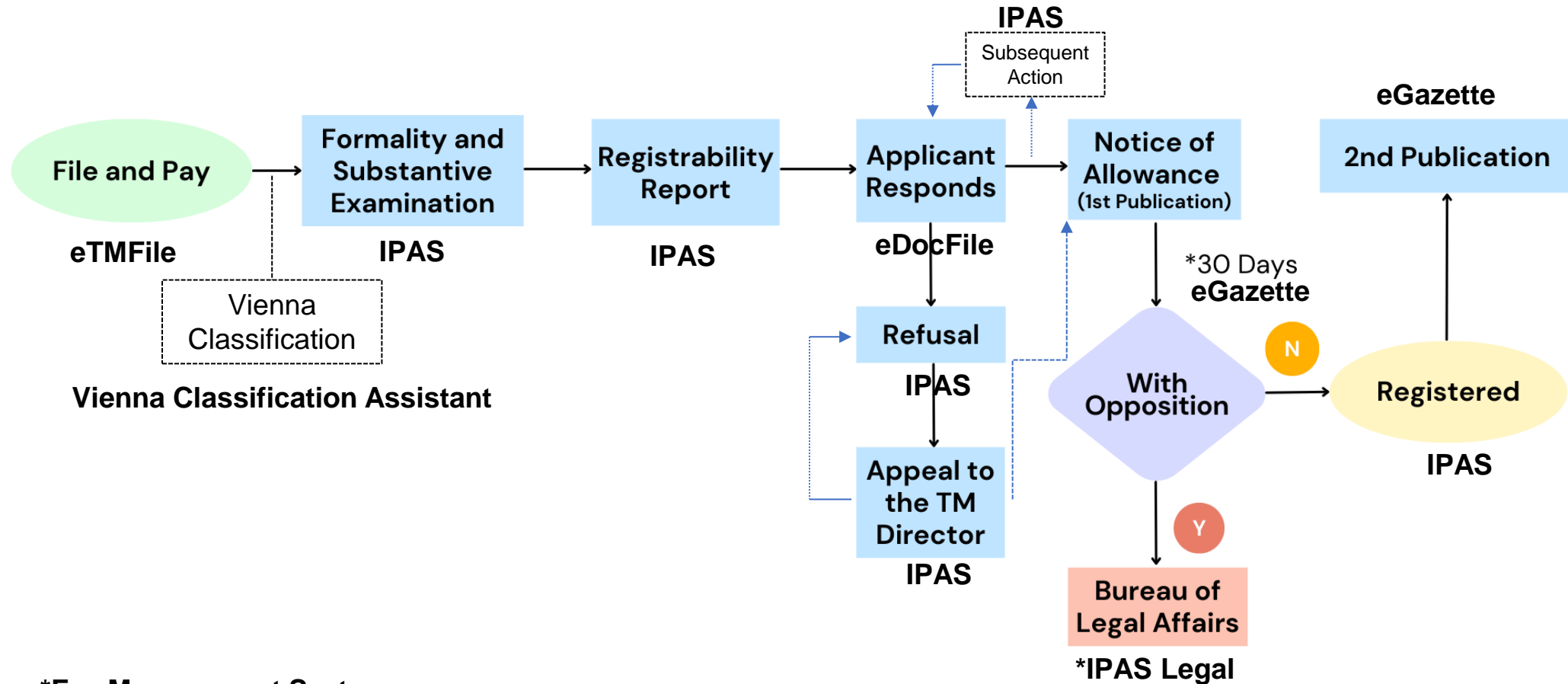
Philippines: **4.36 months**

Source: ASEAN TMTF SOD August 2024

HOW?

**Empowering Examiners Through
Capacity Building AND Harnessing IT
Solutions**

Trademark Registration Process



Madrid e-Filing

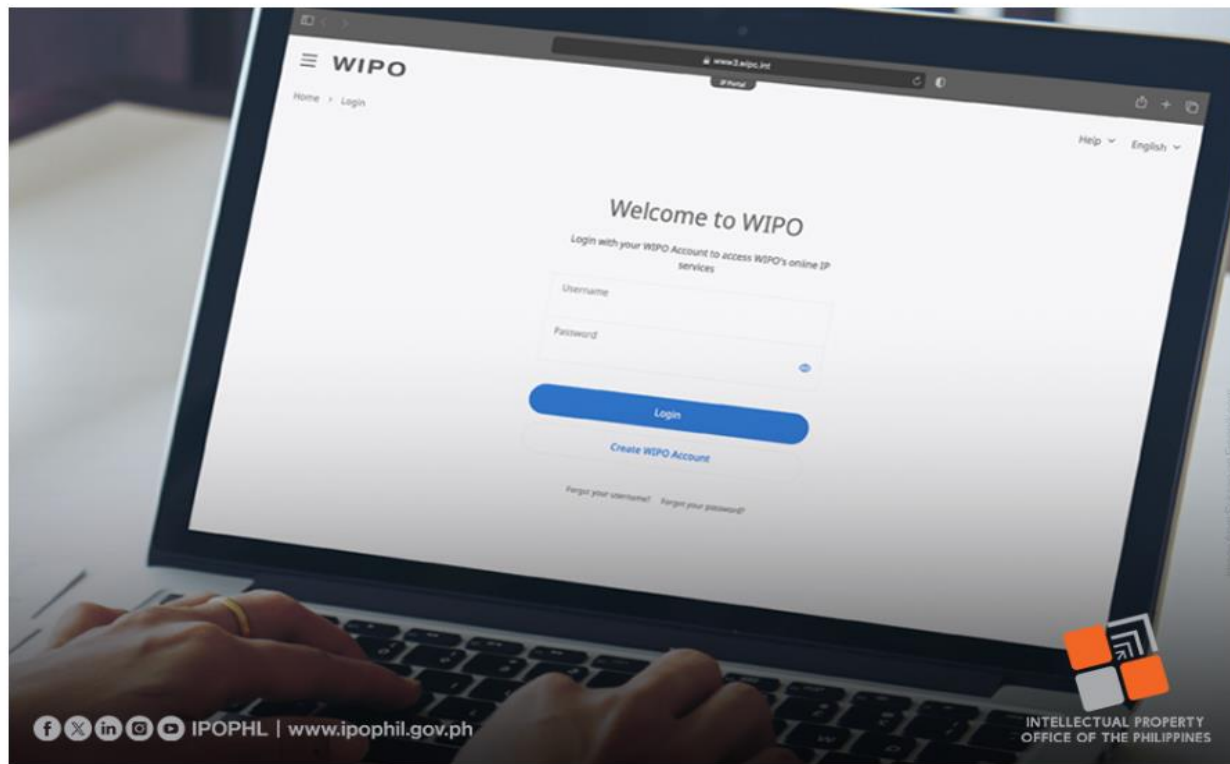


REPUBLIC OF THE PHILIPPINES
INTELLECTUAL PROPERTY OFFICE
OF THE PHILIPPINES

E-SERVICES

REPORT AN IP VIOLATION

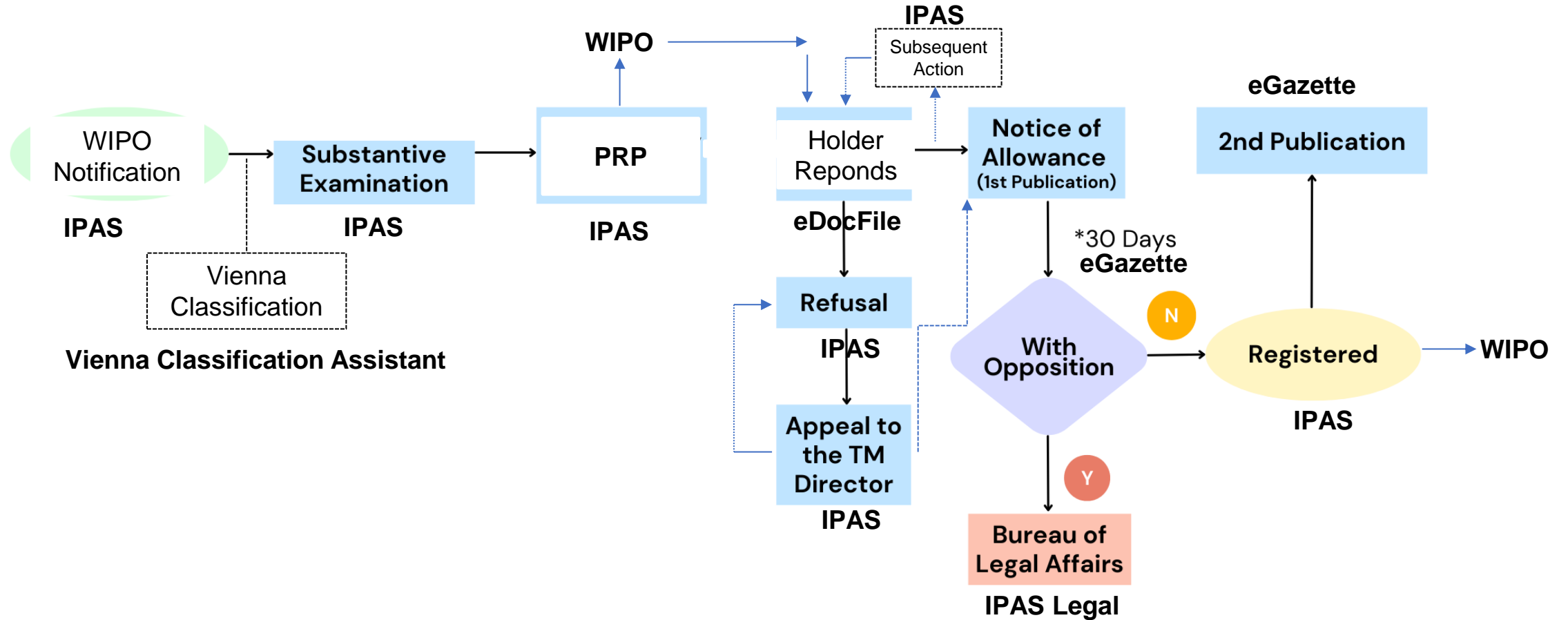
HELP & SUPPORT



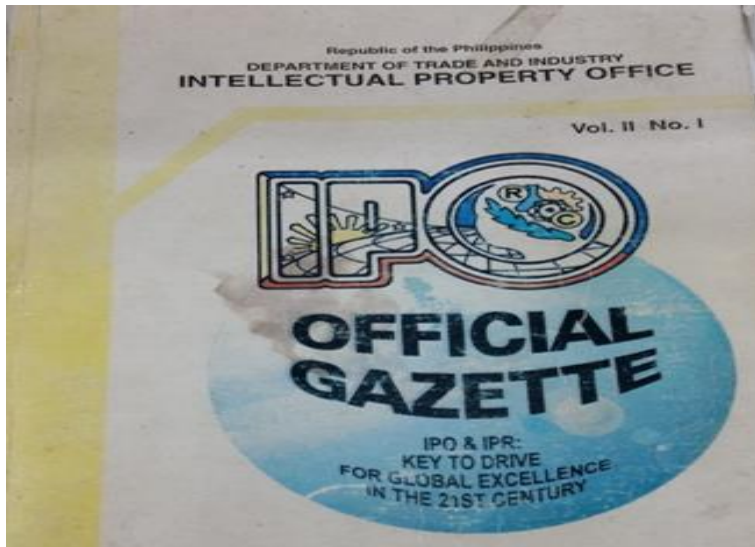
IPOPHL unveils Madrid e-Filing, empowering PH trademarks for global reach

WIPO FOR OFFICIAL USE ONLY

International Registration Process



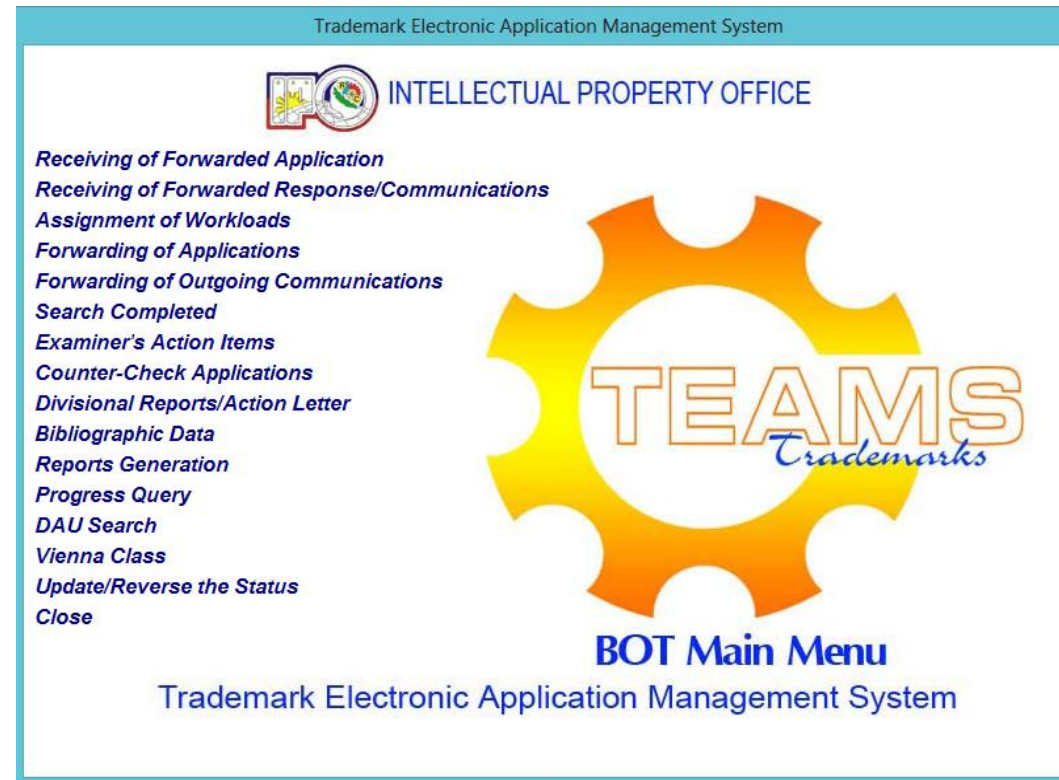
Big Improvements: Gone Were the Days of



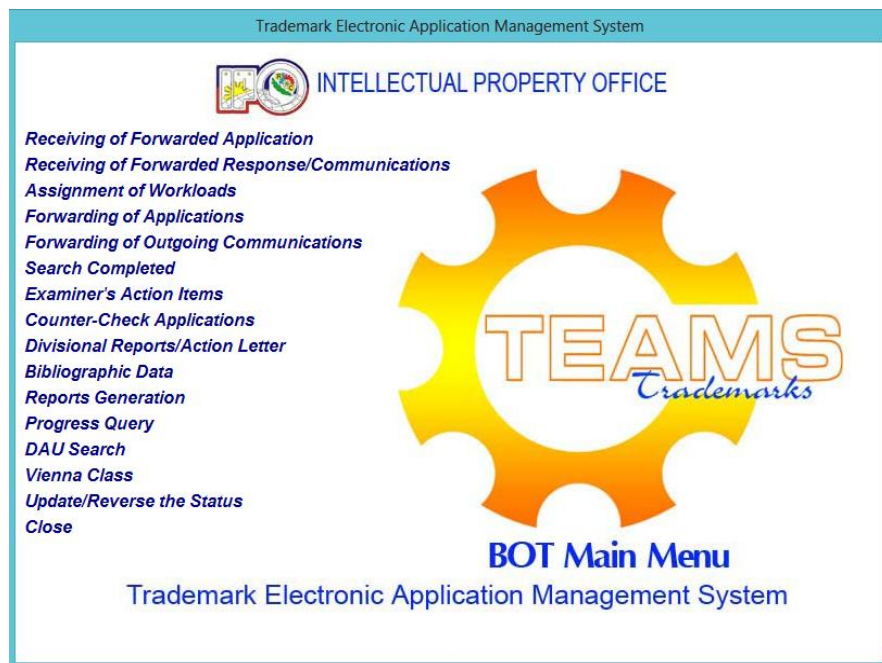
Challenges and Solutions

Non-automated processing - Paper Based Systems - Slow TAT

➔ Developed an internal TM management system



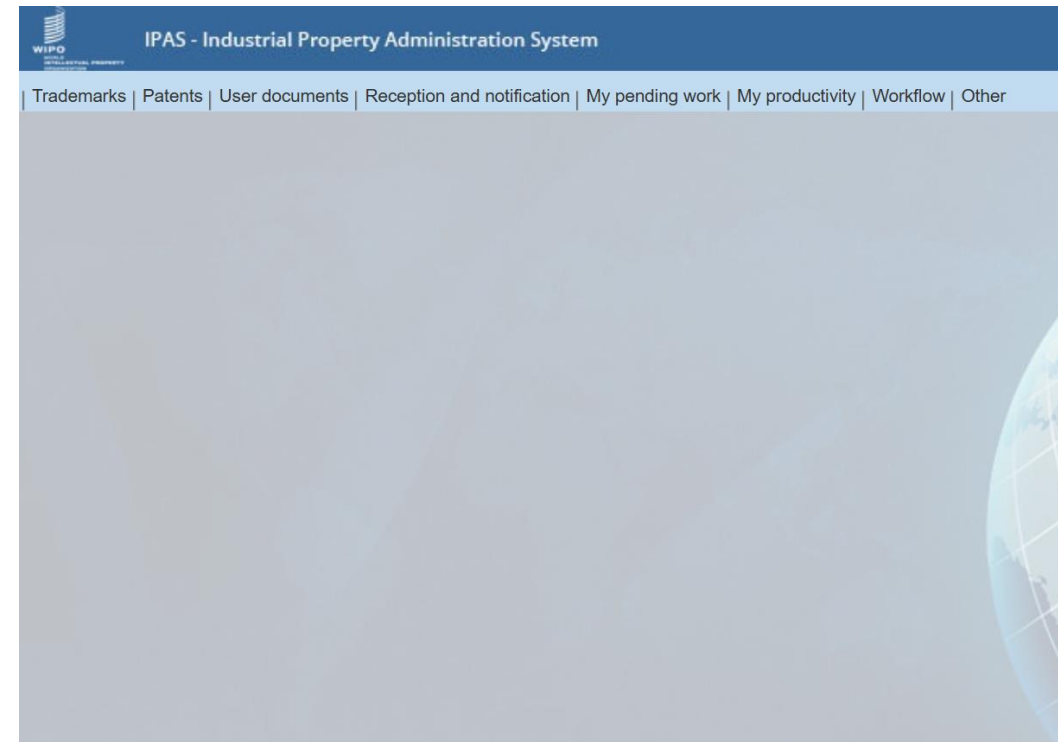
TEAMS



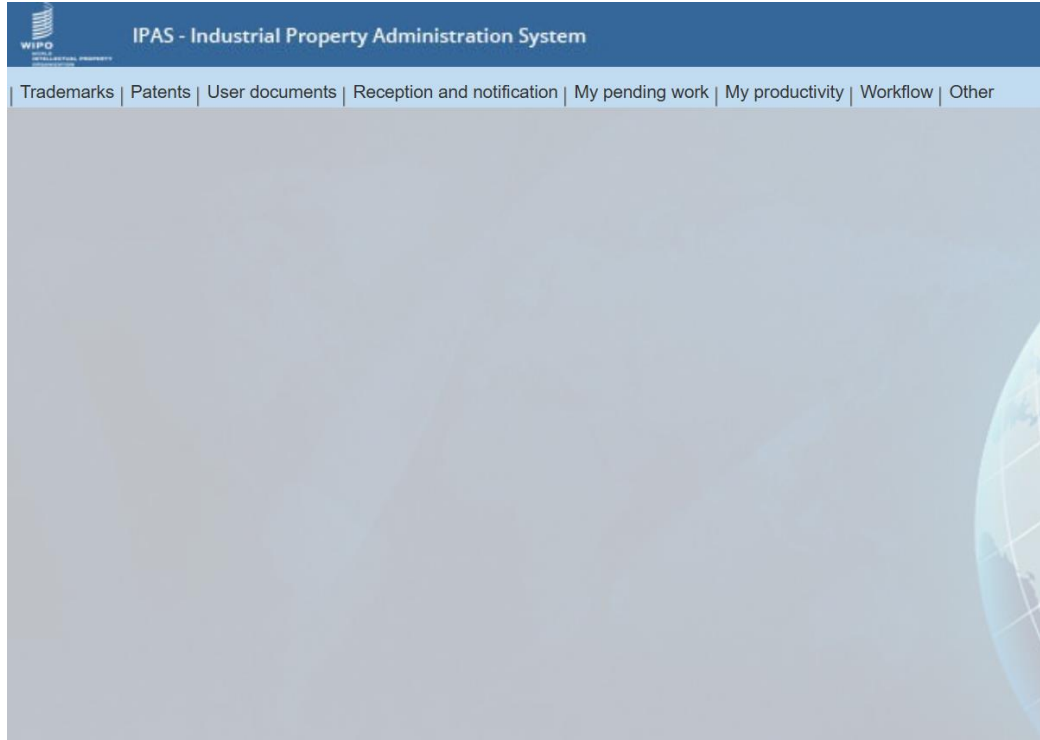
- Online searching of TM database
- Templates and forms for office actions and other issuances
- Online publication
- Generation of certificates
- Give reminders for ageing applications

Challenges and Solutions

➔ Upgraded to Industrial Property Administration System (IPAS)



IPAS



- More functionalities
- More Templates and forms for office actions and other issuances
- Office actions are saved inside the system
- Status of applications are easier to track
- Generation of certificates
- Easier to monitor examiner's workload
- Can generate some statistics
- Can be reconfigured if workflows are updated

Breakthrough Goal



TM in TM

Trademark in
Two Months

Challenges and Solutions

- Yearly increase in volume of applications
- Constant number of manpower
 - **We recruited and trained new examiners**
- Complex applications (bad faith)
 - **Continuous capacity building**

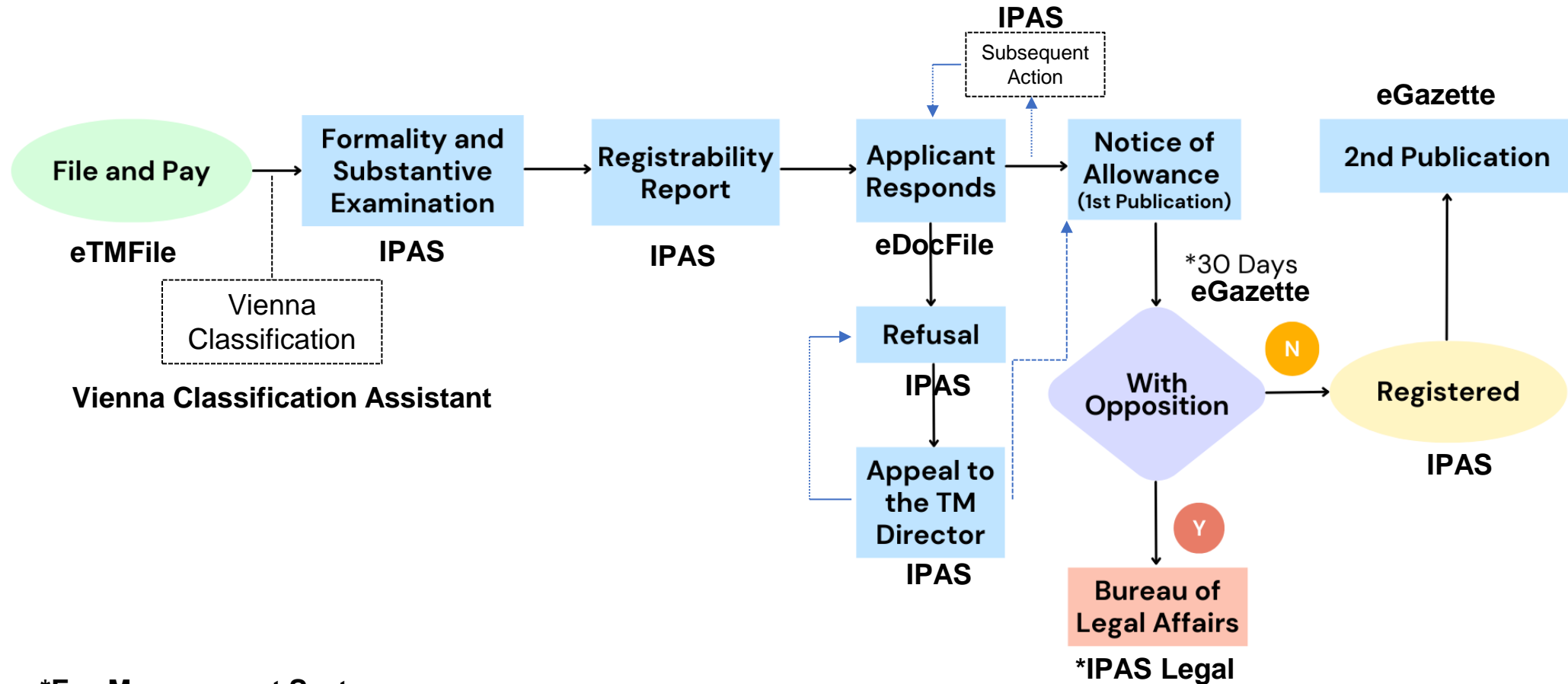


BACKLOGS

HOW?

**Empowering Examiners Through
Capacity Building AND Harnessing IT
Solutions**

Trademark Registration Process



Current Challenges and Possible Solutions On Vienna Classification

Manual encoding of Vienna codes in IPAS after consulting
WIPO's Vienna Classification Assistant

watercolor-tree-silhouette-5288326_3920.png

Back add.

CLASSIF.	DESCRIPTION
5.1.0	Trees or bushes in stylized form
5.1.3	Trees or bushes of some other shape
5.2.4	Birds or bats stylized
5.2.21	Other birds
5.2.36	Birds in flight or with outspread wings



To have an AI Vienna classification analysis tool within or connected with the IPAS system

Current Challenges and Possible Solutions On Classification of Goods and/or Services

The examiners consult classification databases outside IPAS

Tools: G/S Classification

WIPO NICE Classification

<https://www.wipo.int/classifications/nice/nclpub/en/fr/>

Madrid Goods and Services Manager (MGS)

<https://webaccess.wipo.int/mgs/>

ASEAN TM Class

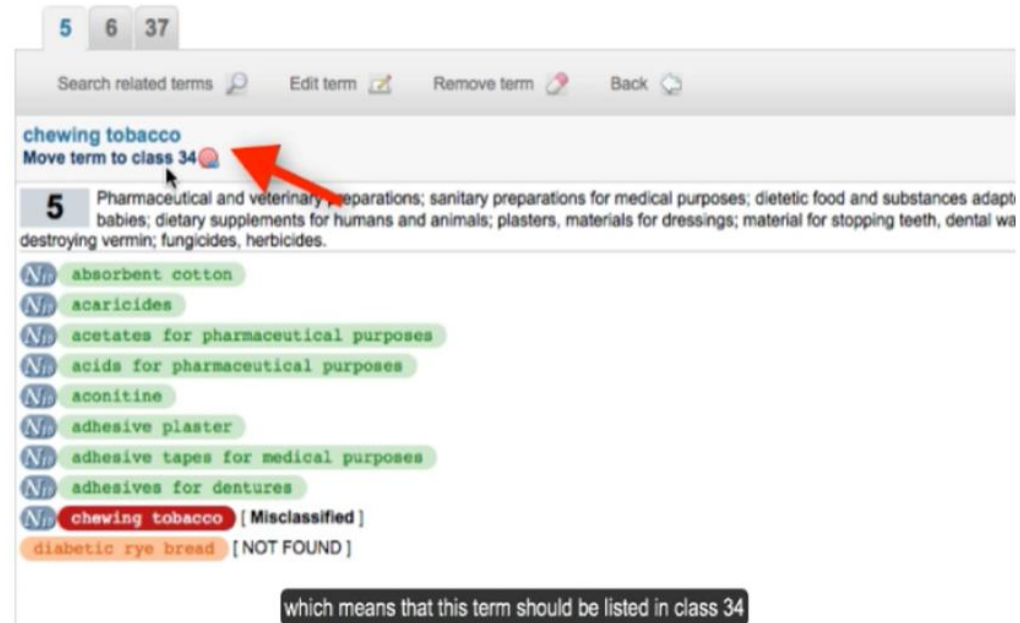
<http://www.asean-tmclass.org/ec2/>

USPTO

<https://idm-tmng.uspto.gov/id-master-list-public.html>

EUIPO TM Class

<http://euipo.europa.eu/ec2/>



5 6 37

Search related terms Edit term Remove term Back

chewing tobacco
Move term to class 34

5 Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; destroying vermin; fungicides, herbicides.

- absorbent cotton
- acaricides
- acetates for pharmaceutical purposes
- acids for pharmaceutical purposes
- aconitine
- adhesive plaster
- adhesive tapes for medical purposes
- adhesives for dentures
- chewing tobacco [Misclassified]
- diabetic rye bread [NOT FOUND]

which means that this term should be listed in class 34



To have an AI goods and/or services analysis tool within or connected with the IPAS system

Current Challenges and Possible Solutions On Conducting Search

Extensive research efforts outside IPAS

Because:

- ❖ IPAS has no image search capability
- ❖ No translation search capabilities
- ❖ The search system of IPAS is only for similarity search.
- ❖ The examiners are required to conduct an exhaustive search to ensure that the mark does not fall in any of the proscriptions under the law.

Current Challenges and Possible Solutions

❖ IPAS has no image search capability

☰ **WIPO**

Global Brand Database

BRAND NAME BRAND LOGO ADVANCED SEARCH EXPLORE VIENNA ASSISTANT G&S EXPLORER REPORTS

To classify images with Vienna codes, you can use our AI-based tool [Vienna Classification Assistant](#).

Drag & drop your image here, or

[Browse](#)

Vienna classification	US designs classification
Owner name	Feature
IP office	Designation country
Nice classification	Goods and services

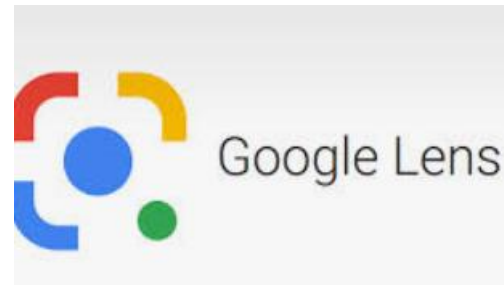
 Possibility of having an image search in IPAS

Current Challenges and Possible Solutions

- ❖ Exhaustive search requirements



Internet search

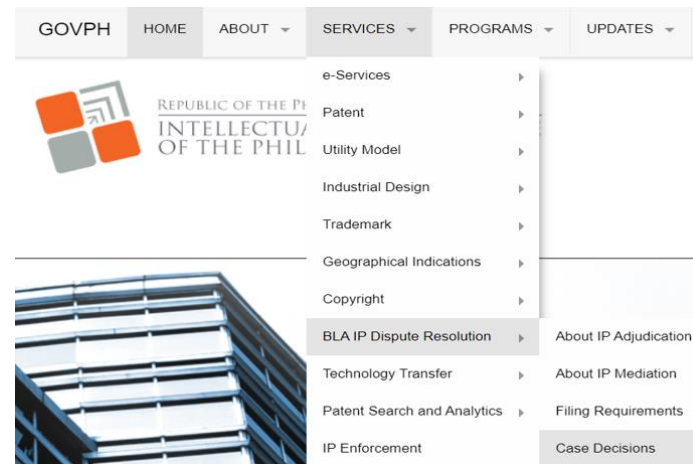


Current Challenges and Possible Solutions

❖ Exhaustive search requirements



eAmbrosia
eAmbrosia



Current Challenges and Possible Solutions

❖ Exhaustive search requirement

The screenshot shows the WIPO Madrid Monitor search interface. At the top, it says "WIPO" and "Help". Below that, there's a breadcrumb trail: "Madrid System > eMadrid > Madrid Monitor". A message states: "Keep up to date with your international registrations. Follow the status of your international application or trademark registration; access detailed information on all trademarks registered through the Madrid System; and keep an eye on competitors' trademarks." A yellow banner below that says: "You may experience some disruptions of our Madrid System online services today, Sunday, from 2:00 PM to 3:00 PM (Geneva time), due to scheduled maintenance of our internal systems." There are tabs for "Search", "WIPO Gazette", and "Support". On the left, there's a sidebar with search options: "simple search", "advanced search" (selected), "realtime search", and "image search". The main search area is titled "Search for" and has two sections: "Number" and "Mark". Under "Number", there are fields for "Int. Registration" (with example "e.g. 89000269, 97294*") and "Basic no." (with example "e.g. 402418, 402*"). Under "Mark", there are fields for "Trademark (combined)" and "Phonetic" (with example "e.g. WIPO OR OMPI").

The screenshot shows the USPTO Trademark Search System interface. The browser address bar shows "uspto.gov/trademarks/search". There are tabs for "BOT (Time In) WFH..." and "BOT (Time Out) WFH...". The main navigation bar has "Patents", "Trademarks", "IP Policy", and "Learning and Resources". Below that, there's a blue bar with "Home > Trademarks > Search our trademark database".

Search our trademark database

Trademark search system

With the retirement of the legacy Trademark Electronic Search System (TESS) on November 30, 2022, trademark applications and registrations. The cloud-based [trademark search system](#) provides a modern and new capabilities to meet your needs.

Watch the recorded webinars below to learn how to use the system. They're intended for both new users and covers more complex subject matter. You're welcome to attend all three, or you can choose them in full-screen, click play, then click on the YouTube logo in the bottom right corner of the video.

You can also register for an upcoming [Federal trademark searching: Overview webinar](#). These webinars show the system works, along with a discussion of the likelihood of confusion analysis used when conducting a search.

Are you a trademark practitioner or experienced searcher? Check out the [transitioning from TESS to the new search system](#).

If you want to send us your comments and suggestions about the new search system, use the feedback form.

Current Challenges and Possible Solutions

❖ Exhaustive search requirements

To further improve the quality of office actions issued by the Bureau, all examiners are required to adhere to the following examination standards:

1. Conduct of trademark search and proper documentation of search results

a. The search results must include the following, as applicable:

- Phonetic Search
- Manual Search
- Logo Search/Image Search, as applicable
- Internet Search
- INN Search for goods in Class 5
- GI Search using GI View or eAmbrosia if the goods include agricultural products and/or wines and spirits
- Plant Variety Search on the DA website for goods in Class 31 (fruits, vegetables, trees, plants, seeds and other agricultural produce)
- Other searches as deemed appropriate by the examiner



Possibility of having a centralized AI-assisted search module that can search a variety of databases in one place

Current Challenges and Possible Solutions On Documenting Search Results

Search results are documented outside IPAS

- ❖ Search link is manually incorporated in IPAS
- ❖ Possible loss of search results

(512) Nice class(es)

Ed	Nbr	Status	Description
11	5	Pending	Pharmaceuticals

(730) Owner(s)

Name	Id nbr	Street	City	State	ZIP	Country	Ownership notes
Raquel-Abbas Pharmaceuticals & General Merchandise		No. 17 Madre Isabella di Rocis St., Multinational Village, Moonwalk	Paranaque City	Metro Manila	1708	PH	

Reception date

15/11/2024 00:00:00

(220) Filing date

15/11/2024 15:26:00

(740) Representative

Name	Id nbr	Street	City	State	ZIP	Country
Presaldo, Ligaya		No. 17 Madre Isabella di Rocis St., Multinational Village, Moonwalk	Paranaque City	Metro Manila	1708	PH

Notes

<https://docs.google.com/document/d/1hSJ1tenJTXVzqtqY8tVE-MU9Txy8uhhrF2bAlr4badw/edit?tab=t.0>

Current Challenges and Possible Solutions

On Documenting Search Results

- ❖ Search results are documented outside IPAS and the link is manually incorporated in IPAS; Possible loss of search results

b. The following guidelines for the documentation of search results must be observed:

1. Use one (1) Google Document per application;
2. Use headings indicating the type of search done (phonetic, manual, internet) with the search screenshots under such heading;
3. In case marks that are identical or similar with the subject mark forms part of the search but were not cited by the examiner for confusing similarity or double registration, the reason for such decision (e.g., no 3rd DAU) must be indicated; and
4. The Google Document must be shared to “Intellectual Property Office” with restriction “viewer” and the link must be included in IPAS for reference of the supervisor during the review and approval of the office action or recommendation for allowance and by other examiners when conducting their trademark search.

Please see attachments for reference.



To have a functionality inside IPAS to save all the search results in pdf format just like how the office actions and responses are saved

Current Challenges and [Possible] Solutions

On Substantive Examination

A lot of manual editing

- ❖ Manual editing and/or formatting of office actions are done outside IPAS
- ❖ The Examiner has to manually encode applicable jurisprudence to his/her office actions

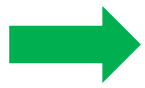


Select action on the office doc image

Help  Configuration 

Current Challenges and [Possible] Solutions

On Substantive Examination



A database of case law connected to IPAS and categorized according to the grounds for refusal



AI assisted generation of office actions for application with substantive objections



Incorporation of an AI tool within the IPAS system that can check the spelling, grammar, and other writing errors in the generated office action

Current Challenges and [Possible] Solutions

On Madrid IR Examination

Manual encoding of start and end dates to file response



**INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES**
BUREAU OF TRADEMARKS
Intellectual Property Center, 28 Upper
McKinley Rd., McKinley Hill Town Center, Fort
Bonifacio, Taguig City 1634, Philippines
Website: <http://www.ipophil.gov.ph>

DOCUMENT NO.	2024/205995
Response Period	START DATE: 25 Oct 2024 END DATE: 25 Dec 2024



The International Bureau
World Intellectual Property Organization
34, chemin des Colombettes
1211 Geneva 20
Switzerland

**NOTIFICATION OF A PROVISIONAL REFUSAL OF PROTECTION
OF AN INTERNATIONAL REGISTRATION DESIGNATING
THE PHILIPPINES
Rule 17(1)**

- ❖ IPAS enhancement for automatic appending of start and end dates

Current Challenges and [Possible] Solutions

On IPAS Legal

Copies of decisions from the Bureau of Legal Affairs are not uploaded in IPAS

22/03/2024	(automatic) Publication of the journal		Details
19/04/2024	(automatic) Date is due	Rcvd Ext to File Oppo on 18/04/2024.	Details
19/04/2024	Opposition was filed	Approved, no notification needed (20/04/2024) .	Details PDF

❖ IPAS enhancement

Current Challenges and Possible Solutions

On TM Administration

Numerous status inquiry from applicants



SOLUTIONS:
IPOPHL Call Center
IPOPHL Mobiliz App



Current Challenges and Possible Solutions

On TM Administration

Numerous status inquiry from applicants

Other Possible Solutions:



Make IPAS Public “public”



Applicant’s TM Portfolio or Dashboard

Current Challenges and Possible Solutions

On TM Administration

IPAS has no capability to generate and show analysis of statistics that can be used for policy matters



SOLUTION: An internal statistics tool was developed by internally by IPOPHL's MIS Bureau



Further suggested improvement/s: Generation of statistics in IPAS

Current Challenges and Possible Solutions

On TM Administration

System Downtime

Application error

The application encountered an unexpected exception, please contact your system administrator and notify him/her of this problem.

Application Home



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

THANK YOU!

Rising. Shining. Beckoning.