



**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>

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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)**

International Registration No: **1400991**

IR Date (Filing Date): 21 August 2017

Holder: OCTOVISIO GMBH [DE]

Mark: EXATHLON BRASIL WORLD'S MOST CHALLENGING PERFORMANCE GAME

Examiner: MARIE KIM B. GAYOSO

Supervisor: MARITES Q. SALVIEJO

The mark has been examined, but the issues below prevent the Intellectual Property Office of the Philippines (IPOPHL) from granting the registration of the mark for **all the goods and/or services**.

Registrability Issue(s):

This provisional refusal is for all the goods and/or services.

(1) The applicant should submit a copy of the foreign registration or provide information in the response to this provisional refusal on whether or not the mark has been registered in the foreign country. Section 131 of the IP Code requires that the mark be registered in the foreign country of first filing before the mark subject of this application can be registered by the IPOPHL.

SEC. 131. Priority Right

131.1. An application for registration of a mark filed in the Philippines by a person referred to in Section 3, and who previously duly filed an application for registration of the same mark in one of those countries, shall be considered as filed as of the day the application was first filed in the foreign country.

131.2. No registration of a mark in the Philippines by a person described in this section shall be granted until such mark has been registered in the country of origin of the applicant.

RULE 202. Priority Right; Basis for Claiming Priority Right. — *An application for registration of a mark filed in the Philippines by a person referred to in Rule 201, and who previously duly filed an application for registration of the same mark in one of those countries, shall be considered as filed as of the day the application was first filed in the foreign country.*

No registration of a mark in the Philippines by a person described in this Rule shall be granted until such mark has been registered in the country of origin of the applicant. However, the mark may be allowed for publication for the purpose of opposition, but such publication shall be withheld until it has been ascertained that the mark has been registered in the country of origin of the applicant. The country of origin of the applicant is the country in which the applicant is a national, domiciled, or has a bona fide and effective industrial or commercial establishment.

(2) The applicant should disclaim the exclusive right to use BRASIL and WORLD'S MOST CHALLENGING PERFORMANCE GAME apart from the mark sought to be registered for being descriptive of the kind, nature, quality, geographical origin, intended purpose, and other characteristics of the goods and services covered

by the application. Disclaimer does not mean deletion of the aforementioned words from the mark but merely waiver of the exclusive right over the words for reasons stated in the preceding.

SEC. 126. Disclaimers – *The Office may allow or require the applicant to disclaim an unregistrable component of an otherwise registrable mark but such disclaimer shall not prejudice or affect the applicant's or owner's rights then existing or thereafter arising in the disclaimed matter, nor such shall disclaimer prejudice or affect the applicant's or owner's right on another application of later date if the disclaimed matter became distinctive of the applicant's or owner's goods, business or services. (Sec. 13, R.A. No. 166a)*

RULE 604. Disclaimers. – *The basic purpose of disclaimers is to make of record, that a significant element of a composite mark is not being exclusively appropriated apart from the composite. The following portions of a mark, when forming part of the composite mark, must be disclaimed to permit registration, namely: (a)a generic term;(b)a descriptive matter in the composite mark; (c)a customary term, sign or indication; or (d)a matter which does not function as a trademark, or service mark or a trade name.*

Such disclaimer shall not prejudice or affect the applicant's rights then existing under some other law or thereafter arising in the disclaimed matter, nor shall such disclaimer prejudice or affect the applicant's rights to registration on another application of later date, where the disclaimed matter has become distinctive of the applicant's goods, business or services.

Where the Examiner has determined that any portion of a mark contains unregistrable matter which must be disclaimed, the Examiner shall communicate the findings to the applicant in the office action. If the applicant fails to comply with the Examiner's requirement for a disclaimer, the Examiner must make the requirement final if the application is in condition for a final action.

Partial disclaimer may be allowed with respect to some classes or some goods and/or services.

(3) Clarify if color is a material feature of the mark. If it is, holder should indicate the name(s) of the color(s) being claimed and remit the appropriate color claim fee of Php 610.00. Otherwise, provide a reproduction of the mark in black and white.

If the holder fails to address the issue above, the Office shall record the mark as filed in black and white.

SEC. 124.1. (g) *Where the applicant claims color as a distinctive feature of the mark, a statement to that effect as well as the name or names of the color or colors claimed and an indication, in respect of each color, of the principal parts of the mark which are in that color;*

RULE 400 (g) *where the applicant wishes to claim color as a distinctive feature of the mark, a statement to that effect, as well as the name or names of the color or colors claimed and an indication, in respect of each color, of the principal parts of the mark which are in that color;*

RULE 402. Reproduction of the Mark. - *One (1) reproduction of the mark shall be submitted upon filing of the application which shall substantially represent the mark as actually used or intended to be used on or in connection with the goods and/or services of the applicant. The reproduction may be added or pasted on the space provided for in the application form or printed on an ordinary bond paper. The reproduction must be clear and legible, printed in black ink or in color, if colors are claimed, and must be capable of being clearly reproduced when published in the IPO eGazette. An electronic copy of the reproduction may likewise be submitted in lieu of the printed reproduction. The electronic reproduction should be in .jpg format and must not exceed one (1) megabyte.*

Information relating to subsequent procedure:

The applicant must respond in writing to this refusal within two (2) months from the digital signature date found at the end of this notice. The response must be filed by a duly authorized representative with a local address in the Philippines (the list of agents in the Philippines is available on the IPOPHL website). Within the two (2) month-period, the applicant may request an extension of time of another two (2) months to respond to this provisional refusal. The request for extension must be filed by the applicant's local representative in the Philippines. The request for extension can only be made once.

Failure to respond to the provisional refusal, submission of an incomplete response, or failure to request an extension of time to respond within the two-month period will result in the abandonment of the application. In case of abandonment, the applicant has three (3) months from the abandonment date (counted from the lapse of the period to respond) to request the revival of the application. Failure to revive an abandoned application will result in its final abandonment and the confirmation of the total provisional refusal.

If the applicant is able to overturn the objections raised by the Examiner in the provisional refusal, the mark will be published for purposes of opposition. If no opposition to the registration of the mark is filed, the Office will issue a statement of grant of protection.

All responses or communications should be addressed to: THE DIRECTOR OF TRADEMARKS, Intellectual Property Office of the Philippines, 14/F Intellectual Property Center, No. 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio, Taguig City 1634, Philippines.

Additional information:

The IPOPHL requires the submission of the Declaration of Actual Use (DAU) within three (3) years from the date of international registration or the date of subsequent designation, as the case may be; within one (1) year from the fifth anniversary of the date of grant of protection of the mark; within one (1) year from the renewal date; and within one (1) year from the fifth anniversary of each renewal. The provisions governing the filing of the DAU are contained in the Trademark Regulations of 2017.