



**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: **1513287** IR Date (Filing Date): 26 December 2019

Holder: Hanyuan County Sichuan Pepper Association [CN]

Mark: HANYUANHUAJIAO

Examiner: LEA F. DECENA

Supervisor: IRMA VERA P. MORCILLO

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):

The applicant should disclaim the exclusive right to use the Chinese characters translated and transliterated as "JIAO" which means a certain kind of plant, or a "pepper"; "HAN YUAN", which is the name of a county located in Sichuan province of China and "HUA JIAO" which means "Sichuan pepper" for being generic and descriptive of the kind, geographical origin and other characteristics of the goods covered by the application.

A disclaimer does not mean that the applicant has to remove the word/s, image/s to be disclaimed. It is only a statement that the applicant does not have the exclusive right to use/appropriate the word/s being disclaimed. In case of applicant's failure to file response within the period allowed under the Rules, the finding of the examiner shall become final and the unregistrable matter shall be disclaimed.

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 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.

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.