



**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>

IPAS FORM NO.	
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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: <b>1284180</b>	IR Date (Filing Date): 2 November 2015
Holder:	Watch Tower Bible and Tract Society of Pennsylvania [US]
Mark:	JW.ORG

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):**

**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.** — (a) *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.*

*(b) 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. [as amended by Office Order No. 13-61 (2013)]*

**2) The applicant should disclaim the exclusive right to use .ORG apart from the mark sought to be registered. The term is a generic top level domain (gTLD) of the Domain Name System (DNS) of the internet, as such it does not function as trademark and should 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 608. 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 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 determines that any portion of a mark contains unregistrable matter which must be disclaimed, he shall communicate his finding to the Applicant by means of an Action document. If the applicant fails to respond within the time allowed under these Rules, the finding of the examiner shall become final and the unregistrable matter shall be disclaimed. [As amended by Office Order No. 39 (2002)]

**Information relating to subsequent procedure:**

The applicant must respond in writing to this refusal within two (2) months from the date of notification appearing on the IPOPHL notice (to be found on the upper right corner 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 and within one (1) year from the fifth year anniversary of the date of grant of protection of the mark. The provisions governing the filing of the DAU are contained in the Trademark Regulations, as amended by Office Order No. 13-56, s. 2013.

  
**MARILOU R. VARRON**  
Trademark Examiner

  
**MARITES Q. SALVIEJO**  
Supervising Examiner