

Questionnaire for Law Firms in Southeast Asian Nation Surveys 2020

フィリピン (Philippines)

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回答年月日 (Date of Filing Out)	2021/2/19
回答者名 (Name of the Answerer)	Rowanie A. Nakan

事務所概要 (Profile of Your Law Firm)	事務所名称 (Name of Your Law Firm)	Cruz Marcelo & Tenebrancia
	事務所住所 (Address)	9th, 10th, 11th & 12th Floors, One Orion 11th Avenue corner University Parkway Bonifacio Global City 1634 Metro Manila, Philippines
	設立年月 (Date of Establishment)	2013/7/30
	従業員数 (Number of Employees)	67 legal and 93 support staff
	電話番号 (Telephone Number)	632 88105858
	ファクシミリ番号 (Facsimile Number)	632 88103838
	代表メールアドレス (Main E-mail Address of Your Law Firm)	jp@cruzmarcelo.com
	事務所ホームページ (Website of Your Law Office)	www.cruzmarcelo.com

資格保持者人数 (Number of Licensed People)	弁護士 (Number of Barristers)	67
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コミュニケーション (Capability of Communication)	言語 (Language)	会話可能者数 (Number of Persons Who Are Able to Talk in the Language)	読み書き可能者数 (Number of Persons Who Are Able to Read and Write the Language)
	日本語 (Japanese)	8	8
	英語 (English)	160	160

主要業績 (Main Achievements)	業務内容 (Content of Business)	2018 (Year of 2018)	2019 (Year of 2019)	2020 (Year of 2020)
	国内特許出願代理件数 (Number of Domestic Patent Application Filings by Your Law Firm)	11-20	11-20	21 over
	外国特許出願代理件数 (Number of Incoming Patent Application Filings by Your Law Firm)	51-100	51-100	51-100
	国内実用新案 (小特許) 出願代理件数 (Number of Domestic Utility Model Application Filings by Your Law Firm)	11 over	21-50	21-50
	外国実用新案 (小特許) 出願代理件数 (Number of Incoming Utility Model Application Filings by Your Law Firm)	1-10	1-10	1-10
	国内意匠出願代理件数 (Number of Domestic Industrial Design Application Filings by Your Law Firm)	11-50	11-50	11-50
	外国意匠出願代理件数 (Number of Incoming Industrial Design Application Filings by Your Law Firm)	0	1-10	1-10
	国内商標出願代理件数 (Number of Domestic Application Filings for Trademark Registration by Your Law Firm)	101-300	101-300	101-300
	外国商標出願代理件数 (Number of Incoming Application Filings for Trademark Registration by Your Law Firm)	101-300	201-500	201-500

訴訟関連業務 (Lawsuits Related Service)	業務内容 (Content of Business)	2018 (Year of 2018)	2019 (Year of 2019)	2020 (Year of 2020)	
	知財関連刑事訴訟代理件数 (Number of Criminal Lawsuits Related to Intellectual Property cases)	5	4	1-10	
	知財関連民事訴訟 Related to Intellectual Property cases)	侵害訴訟代理件数 (Number of Infringement Proceedings)	24	50	1-10
		商標不使用取消審判代理件数 (Number of Trials for Cancellation of Trademark for Non-Use)			
無効審判代理件数 (Number of Trials for Invalidation)	2	0	1-10		

その他関連業務 (Other Related Service)	業務内容 (Content of Business)	2018 (Year of 2018)	2019 (Year of 2019)	2020 (Year of 2020)
	出願に関する先行技術調査件数 (Number of Prior Technology Searches related to Applications)	51 over	51-100	51-100
	模倣品に関する調査件数 (Number of Surveys related to Counterfeit goods)	1-5	1-5	1-5
	鑑定業務件数 (Number of Assessment Services)	1-10	1-10	1-10
	パテントクリアランス調査件数 (Number of Freedom-to-Operate Opinion Services)	1-10	1-10	1-10
	その他の業務の件数 (Other)	11 over	11 over	11 over

主要連絡先 (Main Contact List) 代表者名 (Name of the Representative Person of Your Law Firm) 日系企業対応者 (Name of the Contact Persons for Japanese Clients)	氏名 (Full Name)	電話番号 (Telephone Number)	ファクシミリ番号 (Facsimile Number)	メールアドレス (E-mail Address)	使用可能言語 (Languages capable)
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Cruz Marcelo & Tenefrancia is among the rare firms in the Philippines that provide the full spectrum of Intellectual Property ("IP") services. Our IP Department advises both local and foreign clients in their IP journey, from the creation of the IP until its commercialization.

1. Trademarks

Trademark Search

A strong brand is important for any business, small or big. It provides name recall and builds the goodwill of a company. Trademarks thus play an important part of a company's IP portfolio. Companies spend resources and time in creating and launching an effective brand. It is essential that such resources and time are not put to waste due to the adoption of an already existing mark belonging to a different entity.

With this in mind, we conduct trademark searches to ensure that the trademarks to be developed and used by the client are still available for use. We search the Philippine Intellectual Property Office ("IPO") database for possible confusingly similar marks to a client's proposed mark and provide an in-depth analysis and recommendation based on the search results.

Trademark Prosecution

Once a trademark has been cleared from the search, we obtain protection for their marks by filing the trademark application with the IPO. We ensure that our clients are able to obtain the broadest protection for their marks, by advocating for the client when we believe that there is an unnecessary limitation being imposed by the IPO, such as when there is a requirement to disclaim a word or element which we believe should not be disclaimed.

As an example, in a trademark application, we have successfully registered the mark "PREMIUM OUTLETS", which was previously objected for allegedly being descriptive. With the help of the entire team, the Bureau of Trademarks allowed the registration of said mark, with a claim of distinctiveness for the word "PREMIUM". (Confidential)

We have also obtained three-dimensional (3D) trademark registrations for another client, a well-known household name in the Philippines for health, hygiene, personal care, fabric, and homeware products, for its distinctive bottles/containers. Together with other types of registered IP rights, 3D marks may provide a more enduring and comprehensive protection to clients.

Trademark Maintenance and Monitoring

The life cycle of a mark does not end with obtaining a trademark registration. A trademark's strength is developed through actual use and the extent of its exclusive use.

To this end, we send our clients free of charge reminders of the trademark maintenance requirements and file on their behalf Declarations of Actual Use with the IPO. We also offer trademark watches and inform our clients in case any marks which we believe are confusingly similar to their marks are published in the IPO e-Gazette.

Trademark Litigation

In case of a confusingly similar mark, or in case of unauthorized use of the marks, we defend our clients' marks against infringers through filing opposition, cancellation or infringement and unfair competition cases.

Our trademark expertise led to positive results for our clients in landmark cases. We successfully represented In-N-Out Burger, Inc. in an unfair competition case that led to "In-N-Out" being declared as the first internationally well-known trademark by the Philippine Supreme Court (Schwani, Inc. and Benita's Frites, Inc. vs. In-N-Out Burger, Inc., G.R. No. 171053, 15 October 2007). Said case also resulted in the Supreme Court upholding the jurisdiction of the Philippine Intellectual Property Office over administrative cases for unfair competition and infringement [In-N-Out Burger, Inc. vs. Schwani, Inc. and/or Benita's Frites, Inc., G.R. No. 179127, 24 December 2008].

Trademark Portfolio Management and Licensing

We have assisted clients in licensing their trademarks to ensure that they maintain the integrity of their marks by making sure that the license agreements provide for sufficient control of the nature and quality of the goods of the trademark owner.

Given the above, our firm's trademark practice has become significant to local clients as they expand their businesses abroad, which means that they also have to protect homegrown brands in different countries. Our expertise in Philippine trademark laws, as well as extensive network abroad, enable us to service the international needs of our domestic clients. In fact, our firm filed several International Applications under the Madrid Protocol for local clients in order for the latter to have wider protection of their trademarks. In our firm's trademark practice, we are able to witness the use of IP, particularly trademarks, as part of nation building as we see local clients grow.

We represent clients in the fields of media and entertainment, clothing and apparel, cosmetics, food and beverage, information technology, oil, telecommunications, electronics, pharmaceuticals, biotechnology, construction, manufacturing, retail, banking and financial institutions, and even educational and research institutions. We have also established relationships with foreign firms from different countries/regions, such as the U.S.A., Europe, Japan, South America, China, India, and the ASEAN region, that have continuously entrusted to us the IP requirements of our mutual clients in the Philippines.

2. Patents

The bedrock of innovation is invention. It is thus important to obtain protection of an invention right at the start of an invention's life.

Prior Art Searches

We guide clients at the start of the invention's life cycle by providing prior art search services. By helping clients identify the closest prior art, clients can define the scope of protection that they want to include in their patent claims. Conducting prior art search prior to filing a patent application saves client 1) money, e.g., amending the proposed claims based on the search results prior to actual filing the application and therefore reducing claims fee; and 2) time, by reducing the prosecution period since claims filed after the search have already been amended based on the prior arts found and therefore reduces the office actions/objections during prosecution.

Patent Prosecution

Our lawyers have strong backgrounds in physics, chemistry, and engineering, among others. A number of our lawyers are also registered patent agents after being among the top passers in the Patent Agent Qualifying Exams (PAQE) jointly administered by the Philippine Intellectual Property Office ("IPO") and the European Patent Office (EPO) in the chemical and non-chemical fields. Our lawyers have also attended various trainings abroad such as the Patent Surgery Course administered by the World Intellectual Property Organization, the FICPI South East Asian Patent Drafting Course and the training courses sponsored by the Japan Patent Office. We likewise conduct in-house trainings to continuously hone our skills and ensure that we are apprised of developments in the various fields of IP.

Our roster of paralegals includes specialists with different trainings and backgrounds, including Applied Physics, Biology, and Healthcare. In all the work that we do, whether contentious like litigation or non-contentious like prosecution, we ensure strong collaboration between our lawyers and paralegals to ensure that we are able to spot all issues and address the needs of our clients in a timely manner.

Unlike other firms, our credentials allow us to not just file our clients' applications, but also to draft the specification and claims of the patent, utility model, and industrial design applications. We collaborate with the client in analyzing the technology or invention to determine how the application can be worded to best protect the invention. We also prepare responses to office actions issued by the IPO, including overcoming issues that involve substantive revision of the client's claims or presentation of arguments on novelty and inventiveness.

Freedom-to-Operate ("FTO") Searches and Opinions

In addition to prosecution and valuation of government-funded technologies, DOST-TAPI also selected our firm to conduct FTO Searches for seven (7) technologies in the food and beverage industry. Our lawyers used local and international patent, utility model, and design databases to thoroughly search and analyze applications or registrations to determine whether the use of the technologies will result in infringement. In our output, we also advised on how the applications or registrations we found may affect the use of the technologies and whether there is risk of infringement in case these technologies are launched in the market.

We also regularly render FTO Opinions to foreign pharmaceutical companies in connection with their plans to launch generic drugs in the country.

Patent Litigation

Our lawyers also handle a wide variety of infringement, unfair competition, enforcement, border control, and domain name dispute actions. They also regularly appear before administrative and judicial tribunals at all levels. We represent one of the largest pharmaceutical companies in the ASEAN region, United Laboratories, Inc. (Unilab) in both contentious and non-contentious matters. We have successfully defended Unilab's interests as a generics manufacturer in multiple fora, including the Philippine Supreme Court.

3. Commercialization

Commercialization of IP rights is important not just to obtain monetary benefits for the innovator but also to be able to create source of funds for further research and development activities.

We regularly advise foreign and Philippine clients on IP commercialization and marketing, including the navigation of the Philippine regulatory framework for foreign investors and businesses.

We advise the Technological Institute of the Philippines ("T.I.P."), one of the leading and most innovative private educational and research institutions in the Philippines, on the commercialization of the software which it had developed through its technopreneurship programs involving academic and registration systems and enterprise resource planning. We also regularly review T.I.P.'s licensing agreements, sublicenses, confidential disclosure agreements, technology transfer agreements, royalty agreements, or other contracts relating to its IP such as patents, trademarks, know-how, inventions, and trade secrets, and the provision of template agreements to ensure protection of T.I.P.'s IP rights.

Patent Valuation

Beyond patent filing and prosecution services, we have developed niche expertise in highly technical and specialized patent-related services owing to the scientific, technical and legal expertise of the members of our IP Department. Further, while most Philippine IP firms are mere local agents of foreign applicants, we have taken a more proactive role and assisted local inventors, particularly those from state universities, file their patent applications locally and in other countries. We are among a very select pool of firms that have been tapped by the Department of Department of Science and Technology - Technology Application and Promotions Institute ("DOST-TAPI") to conduct a wide array of highly specialized services such as patent drafting, patent prosecution and IP valuation of different technologies. As a testament to DOST-TAPI's continued confidence in our capabilities, DOST-TAPI again selected our firm in 2020 to conduct valuation of several technologies involving, agricultural machines, mechanical devices, fortified food and beverage, and transportation system/technology, and rubber industry-related technology.