

SICAP AG.,
Opposer,

-versus-

ICAP PLC

Respondent-Applicant.

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IPC NO. 14-2009-00004
Opposition to:

Appln.No.4-2009-000403
Date Filed: 11 January 2008
Trademark: ICAP I-TRADE &
DEVICE
Order No.2011-48

DECISION
BASED ON COMPROMISE AGREEMENT

SICAP AG. (“Opposer”) filed on 05 January 2009 an opposition to Trademark Application Serial No. 4-2009-000403. The application filed by ICAP PLC (“ Respondent- Applicant”) covers the mark ICAP I-TRADE & DEVICE for use on “computer hardware and software for use in connection with the provision of broker services and for trading and clearing of financial instruments, computer hardware and software for use in connection with the execution, trading and clearing of futures and adoptions’ under Class 09; and “broker services; brokers services provided by a computer network services associated with the execution, trading and clearing of financial instruments; services associated with the execution, trading and clearing of futures and options” under Class 38. The opposition is anchored on Section 123 paragraphs (d), (e) and (f) and Sections 3 and 160 or Rep. Act. No. 8293, also known as the Intellectual Property Code of the Philippines.

The Respondent-Applicant filed its answer on 19 June 2009 refuting the material allegations of the Opposer.

In compliance to Office Order No. 154, s. 2010 (“Rules of Procedure for IPO Mediation Proceedings) and Office Order No. 197 s. 2010) Mechanics for IPO Mediation and Settlement Period). This Bureau issued on 08 March 2011 OrderNo, 2011-142 referring the case to Mediation.

On 31 May 2011, this Bureau received a “MEDIATOR’s REPORT” indicating the “successful mediation of the instant case. Attached to the report is he parties’ COMPROMISE AGREEMENT submitted to this Bureau for approval. The Agreement states among other things:

“NOW THEREFORE, for and in consideration of the foregoing premises, the parties have agreed, as they hereby agree to enter into this Compromise Agreement under the terms and conditions set forth below:

1. ICAP agrees to amend the specification for the goods and services to Classes 9& 38 covered by Trademark Application No. 4-2008-000403 for the mark ‘ICAP I-TRADE & DEVICE “ as follows:

A. The following clause shall be added to the description of goods in Class 9:

“not including any goods relating to the development, sale, maintenance and support of software for transmitting messages, and/or data on a communication network for voice and data processing namely software solutions, software products and services for mobile network operators with regard to all business areas.

B. ‘Class 38’ shall be amended to read ‘Class 36 and shall cover the following goods and services “broker services provided by a computer network, services association with the execution, trading and clearing of financial instruments,

services associated with the execution, trading and clearing of futures and options”

2. Accordingly the goods and services covered by the subject application should now read completely as follows:

CLASS 09

COMPUTER PROGRAMS, COMPUTER SOFTWARE, MAGNETIC CARDS, DISKS AND TAPES, MICROPCHE, FILMS, VIDEOS, ELECTRONIC PUBLICATIONS, NOT INCLUDING ANY GOODS RELATING TO THE DEVELOPMENT, SALE MAINTENANCE AND SUPPORT OF SOFTWARE FOR TRANSMITTING MESSAGES AND/OR DATA ON A COMMUNICATION NETWORK FOR VOICE AND DATA PROCESSING, NAMELY SOFTWARE SOLUTIONS, SOFTWARE PRODUCTS AND SERVICES FOR MOBILE NETWORK OPERATORS WITH REGARD TO ALL BUSINES AREAS.

CLASS 36

BROKER SERVICES, BROKER SERVICES PROVIDED BY A COMPUTER NETWORK, SERVICES ASSOCIATED WITH THE EXECUTION, TRADING AND CLEARING OF FINANCIAL INSTRUMENTS: SERVICES AND ASSOCIATED WITH THE EXECUTION, TRADING AND CLEARING OF FUTURES AND OPTIONS.

- 3 In consideration for the amendment by ICAP of the specification of goods and services in Classes 9, 8, & 36 in Trademark Application 4-2008-000403 for the mark ‘ICAP I-TRADE & DEVICE: SICAP Agrees to withdraw and dismiss with prejudice, Inter Parties Case No. 14-2009-000094, and thus allow the trademark application for “ICAP ITRADE & DEVICE to proceed for Classes 9 & 36 without further objection.
- 4 Both parties agree that this Compromise Agreement shall be submitted for judicial approval, and for judgment by the IPO on the basis of the same, which they acknowledge shall be res judicata and immediately executory between them.

This Bureau finds that the Agreement has been duly entered into by the parties with the terms and conditions thereof not contrary to law, morals, good customs, public order or public policy,

In this regard, an approved Compromise Agreement shall have shall have the effect of a decision or judgment on the case and shall be enforced accordingly in accordance with the pertinent rules of IPO and the Rules of Court (Sec. 5 Office Order No. 154, s. 2010)

WHEREFORE, premises considered the submitted the parties’ COMPROMISE AGREEMENT is hereby APPROVED. Accordingly, the instant opposition case is DISMISSED, Let the filewrapper of Trademark Application be returned, together with s copy of this Decision to the Bureau of Trademark (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 03 June 2011.