

SICAP AG.
Opposer,

-versus-

ICAP PLC
Respondent-Applicant.
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IPC NO. 14-2010-00159
Opposition to:

Appln.No.4-2007-001908
Date Filed: 23 February 2007
Trademark: LOGO IN SERIES
Order No.2011-40

DECISION
BASED ON COMPROMISE AGREEMENT

SICAP AG. ("Opposer") filed on 03 August 2009 an opposition to Trademark Application Serial No. 4-2007-001908. The application filed by ICAP PLC (" Respondent- Applicant") covers the mark ICAP LOGO IN SERIES for use on "computer programs software, magnetic cards and tapes, microfiche, fiche, videos, electronic publications" under Class 09, "investment, financing, broking, credit , foreign exchange services, financial guarantees, services relating to interest rate swaps, interest rate options, equity derivatives and commodity swaps, trading in financial investments, financial products and derivatives, debt trading services, financial evaluations, financial assessments and evaluations, fiscal assessments and valuations, financial advisory services, on line banking services" under Class 36; and "transmission of data, messages and information by computer electronic mail, computer communication services telecommunications of information (including web pages) computer programs and data, electronic mail services provision of telecommunications access links to computer databases and the internet" under Class 38. The Opposition is anchored on Sec. 123 paragraph (d), (e) and (f) and Sec. 138 or Rep, Act, No,8293, also known as the Intellectual Property Code of the Philippines.

The Respondent-Applicant filed its answer on 05 January 2011 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 07 February 2011 Order No, 2011-93 referring the case to Mediation.

On 04 April 2011, this Bureau received a "MEDIATOR'S REPORT" indicating the "successful mediation of the instant case. Attached to the report is the 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. 4-2007-001908 for the mark 'ICAP LOGO IN SERIES" by adding the following clause.

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

INVESTMENT, FINANCING, BROKING, CREDIT FOREIGN EXCHANGE, MONEY TRANSFER AND EXCHANGE SERVICES, FINANCIAL GUARANTEES; SERVICES RELATING TO INTEREST RATE SWAPS, INTEREST RATE OPTIONS, EQUITY DERIVATIVES AND COMMODITY SWAPS TRADING IN FINANCIAL INSTRUMENTS, FINANCIAL PRODUCTS AND DERIVATIVES DEBT TRADING SERVICES, FINANCIAL EVALUATIONS, FISCAL ASSESSMENTS AND VALUATIONS, FINANCIAL ADVISORY SERVICES; ON-LINE BANKING SERVICES

CLASS 38

TRANSMISSION OF DATA MESSAGES AND INFORMATION BY COMPUTER ELECTRONIC MAIL; COMPUTER COMMUNICATION SERVICES; TELECOMMUNICATIONS OF INFORMATION (INCLUDING WEB PAGES); COMPUTER PROGRAMS AND DATA; ELECTRONIC MAIL SERVICES PROVISION OF TELECOMMUNICATIONS ACCESS LINKS TO COMPUTER DATABASES AND THE INTERNET NOT INCLUDING ANY SERVICES RELATING TO THE DEVELOPMENT SALE, MAINTENANCE AND SUPPORT OF SOFTWARE FOR TRANSMITTING MESSAGES AND/OR DATA ON A COMMUNICATIONNETWORK FOR VOICE AND DATA PROCESSING, NAMELY SOFTWARE SOLUTIONS, SOFTWARE PRODUCTS AND SERVICES FOR ,MOBILE NETWORK OPERATORS WITH REGARD TO ALL BUSINESS AREAS

- 3 In consideration for the amendment by ICAP of the specification of goods and services in Classes 9, & 38 in Trademark Application 4-2007-001908 for the mark 'ICAP LOGO IN SERIES: SICAP Agrees to withdraw and dismiss with prejudice, Inter Parties Case No. 14-2010-00159, and thus allow the trademark application for "ICAP LOGO IN SERIES" to proceed for Classes 9 36 & 38 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, 13 April 2011.