



**BAYERISCHE MOTOREN WERKE  
AKTIENGESELLSCHAFT,**

*Opposer,*

-versus-

**SINO MOTORS CORPORATION,**

*Respondent-Applicant.*

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**IPC NO. 14-2011-00293**

Case Filed: 19 July 2011

**Opposition to:**

Appln. No. 4-2010-011753

Date Filed: 28 Oct. 2010

Title : **"SINOBYD MARK &  
DEVICE"**

**Decision No. 2012- 53**

**DECISION BASED ON  
COMPROMISE AGREEMENT**

BAYERISCHE MOTOREN WERKE AKTIENGESELLSCHAFT ("Opposer"), filed on 19 July 2011 an Opposition to Application No. 4-2010-011753. This Bureau issued a Notice to Answer dated 08 August 2011 and served upon a copy thereof to SINO MOTORS CORPORATION ("Respondent-Applicant"), on 08 August 2011. The Respondent-Applicant filed its Answer on 22 September 2011.

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 Settlement Period*"), this Bureau issued on 25 October 2011 Order No. 2011-311 referring the case to mediation.

On 07 March 2012 the ADR Services of this Bureau submitted a Mediator's Report indicating a settlement by the parties' of the case. Attached to the report is the parties' COMPROMISE AGREEMENT. The pertinent portions of which read, as follows:

"1. SMC acknowledges BMW's rights in and to the BMW roundel mark and logo, together with all the goodwill associated therewith. Attached as Annex A to this Agreement is a list of BMW's registration for the BMW roundel mark and logo with the IPO.

"2. SMC agrees and undertakes to desist from using, registering or seeking to register, and/or claiming or asserting any right to own, the BMW roundel mark and logo or variants thereof in relation to any goods or services.

"3. SMC agrees to voluntarily withdraw Application No. 4-2010-011753 and to file a new trademark application for the trademark depicted below, subject to the specific condition that the new application will claim the color silver or grey on

the upper half of the inner circle as a material feature of the mark:



"4. Subject to compliance with paragraph no. 3, particularly with respect to the claim of color, BMW shall not commence any opposition, cancellation action, or any type of legal proceeding against SMC's trademark application, and any registration resulting therefrom, or any other application or registration covering the trademark shown in the preceding paragraph.

"5. SMC undertakes to perpetually desist from using or seeking the registration of the mark originally applied for registration under Application No. 4-2010-011753.

"6. The Parties shall abide by the terms and conditions of this Agreement in utmost good faith and, to this end, shall not issue, state or make any derogatory, malicious or negative statements, announcements or press releases with respect to the other Party.

"7. The parties acknowledge that their respective signatories have full authority and/or have secured the necessary approvals to execute, and do execute, this Agreement on behalf of their principals and those acting under their principal's authority and that the Parties have the authority to comply with the promises, obligations, undertaking and acknowledgements made in this Agreement. The parties hereto further acknowledge that they have executed this Agreement voluntarily with full knowledge of its consequences under the law.

"8. Each Party shall bear its own costs and expenses incurred in carrying out each of their respective undertakings and obligations required by this Agreement.

"9. This Compromise Agreement shall be binding upon and inure to the benefit of the parties and their employees and officers and assigns or successors in the interest. The terms and conditions of this Agreement may be amended, waived or modified only by agreement in writing signed by the Parties or their respective assigns or successors interest.

"10. Except to the extent that the parties will submit this Agreement to the Intellectual Property Office for approval, both Parties shall not disclose to any third party or publicly disseminate any information relating to the transactions or negotiations between them and/or their representatives with respect to this Agreement."

This Bureau evaluated the COMPROMISE AGREEMENT and finds that the same 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.



A handwritten mark or signature, possibly initials, located at the end of the final paragraph.

Accordingly, an approved Compromise Agreement 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.<sup>1</sup>

**WHEREFORE**, premises considered, the parties' COMPROMISE AGREEMENT is hereby **APPROVED**. The parties are hereby enjoined to comply with the terms and conditions set forth therein. Let the filewrapper of trademark Application Serial No. 4-2010-011753 be returned, together with a copy of this Decision to the Bureau of Trademarks (BOT) for information and appropriate action.

**SO ORDERED.**

Taguig City, 19 March 2012.

  
**ATTY. NATHANIEL S. AREVALO**  
Director IV  
Bureau of Legal Affairs 

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<sup>1</sup> Office Order No. 154 Series of 2010