



DAIMLER AG,  
Opposer,

-versus-

ELECTRO-SYSTEMS INDUSTRIES  
CORPORATION,  
Respondent-Applicant.

x-----x

}  
} IPC No. 14-2011-00201  
} Opposition to:  
} Appln. Serial No.4-2010-005538  
} Date filed: 24 May 2010  
} TM: "SMART ENERGY"

**NOTICE OF DECISION**

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Unit 15J, 15<sup>th</sup> Floor, Cyber One Bldg.  
Eastwood City, Bagumbayan  
Quezon City

**GREETINGS:**

Please be informed that Decision No. 2012 - 96 dated June 06, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 06, 2012.

For the Director:

*Adoracion U. Zare*  
**Atty. ADORACION U. ZARE**  
Hearing Officer, BLA

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*Sharon S. Alcantara*  
**SHARON S. ALCANTARA**  
Records Officer II  
Intellectual Property Office - IPO



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IPC NO. 14-2011-00201

Case Filed: 24 May 2011

Opposition of:

Appln. No. 4-2010-005538

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Title : "SMART ENERGY"

Decision No. 2012- 96

### DECISION BASED ON COMPROMISE AGREEMENT

DAIMLER AG ("Opposer"), filed on 24 May 2011 an opposition to Trademark Application No. 4-2010-005538. The application filed by Electro-Systems Industries Corp. covers the mark "Smart Energy" for use in goods under Classes 12 & 35. This Bureau issued a Notice to Answer dated 10 June 2011 and served upon a copy thereof to ELECTRO-SYSTEMS INDUSTRIES CORPORATION ("Respondent-Applicant"), on 23 June 2011. The Respondent-Applicant filed its Answer on 22 August 2011.

On 04 May 2012 the parties submitted a JOINT MOTION TO APPROVE AND ISSUE DECISION BASED ON COMPROMISE AGREEMENT, the substantive portions of which state, to wit:

"1. Respondent-Applicant ELECTRO-SYSTEMS INDUSTRIES CORP. has filed Trademark Application No. 4-2010-005538 for the mark 'SMART ENERGY' covered under Classes 12 and 35. On the other hand, Opposer is the registered owner of the following trademark registrations issued by the Intellectual Property Office of the Philippines (IPPHL):

Trademark	Registration No.	Date Registered	Class
SMART	4-1995-105982	January 20, 2003	42
SMART	4-1995-103733D	January 20, 2003	39
SMART	4-1995-103734D	October 05, 2004	41
SMART	4-1995-103730D	August 10, 2005	12
SMART	4-1995-103732D	July 23, 2005	37
SMART	4-1995-103731D	December 19, 2005	36
SMART WITH BLACK TRIANGLE	4-1997-119771	September 28, 2003	41
SMART WITH BLACK TRIANGLE	4-1997-119770	December 19, 2005	39

"2. The Parties have voluntarily and amicably settled their differences and that Opposer shall withdraw its opposition to the application of Respondent-Applicant under the following conditions, to wit:

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Records Officer II 1  
Bureau of Legal Affairs, IPO

2.1 Respondent-Applicant agrees and undertakes to have its trademark application no. 4-2010-005538 amended to delete Class 12, and undertakes not to apply for and/or use the mark 'SMART ENERGY' for goods under Class 12.

2.2 Respondent-Applicant undertakes not to apply for and/or use the mark 'SMART ENERGY' for all goods and services related to vehicle for land transportation.

2.3 Respondent-Applicant agrees and undertakes to have the specification of services in Class 35 in its trademark application no. 4-2010-005538 amended as follows:

From: 'advertising a kind of vehicle for land transportation'

Amended To: 'advertising an establishment engaged in installation services, except services involving and/or related to vehicle for land transportation'

2.4 Opposer has no objection to Respondent-Applicant's amendment to its trademark application no. 4-2010-05538, by adding Class 37 described as follows:

Class 37: 'Installation of building automation fire alarm, detection and security system, other installations, except those involving and/or related to vehicle for land transportation.'

2.5 Respondent-Applicant, at its own expense, undertakes to amend the subject application to reflect the conditions stated herein, and ensure its republication by the proper Bureau of the IPPHL.

2.6 Any violations of the conditions herein set forth shall entitle any party to seek relief and damages as provided by law.

"3. In consideration of the foregoing undertakings made by Respondent-Applicant, Opposer hereby withdraws its opposition to the registration of Trademark Application No. 4-2010-005538 for the mark 'SMART ENERGY'.

"4. The parties, in good faith, undertake to honor their respective commitments under this Compromise 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.

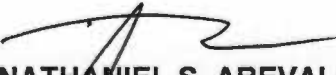

Accordingly, an approved Compromise Agreement shall have the effect of a decision or judgment on the case and shall be enforced accordingly in accordance with the pertinent rules of IPO and the Rules of Court.<sup>1</sup>


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

WHEREFORE, premises considered, the parties' COMPROMISE AGREEMENT is hereby APPROVED. Accordingly, the COMPROMISE AGREEMENT having the force and effect of a decision or judgment, the parties are hereby enjoined to comply with the terms and conditions set forth therein. Let the filewrapper of trademark Application Serial No. 4-2010-005538 be returned, together with a copy of this Order, to the Bureau of Trademarks (BOT) for information and appropriate action.

**SO ORDERED.**

Taguig City, 06 June 2012.

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

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