



KRAFT FOODS SCHWEIZ HOLDING GMBH,
Opposer,

-versus-

I-FERN CORPORATION,
Respondent- Applicant.

X-----X

}
} IPC No. 14-2013-00220
} Opposition to:
} Appln. Serial No. 4-2012-014079
} Date Filed: 19 November 2012
} TM: "MILKCA"
}
}
}
}

NOTICE OF DECISION

ORTEGA BACORRO ODULIO CALMA & CARBONELL

Counsel for Opposer
5th & 6th Floors ALPAP I Building
140 L.P. Leviste Street
Salcedo Village, Makati City

MICHELLE ANN A. TOLEDO-TOMAS

Counsel for Respondent-Applicant
3rd Floor Goldloop Tower A
J. Escriva Drive, Ortigas Center
Pasig City

GREETINGS:

Please be informed that Decision No. 2014 - 12 dated January 14, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 14, 2014.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



**KRAFT FOODS SCHWEIZ
HOLDING GMBH,**

Opposer,

-versus-

I-FERN CORPORATION,

Respondent-Applicant.

X-----X

IPC No. 14-2013-00220

Opposition to:

Appln. Serial No. 4-2012-014079

Date Filed: 19 November 2012

TM: **MILKCA**

Decision No. 2014- 12

**DECISION
BASED ON COMPROMISE AGREEMENT**

KRAFT FOODS SCHWEIZ HOLDING GMBH, ("Opposer") filed on 22 July 2013 an opposition to Trademark Application Serial No. 4-2012-014079. The application filed by **I-FERN CORPORATION**, ("Respondent-Applicant") covers the mark "**MILKCA**" for use on goods under Class 05.

This Bureau issued a Notice to Answer dated 02 August 2013 and served a copy thereof upon the Respondent-Applicant on 02 September 2013. The Respondent-Applicant filed its Answer on 25 September 2013.

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 04 October 2013 Order No. 2013-231 referring the case to mediation.

On 18 December 2013, this Bureau received a "MEDIATOR'S REPORT" indicating the successful mediation of the instant case. Attached to the report is the "UNDERTAKING" executed by both parties. The Undertaking states, among other things:

"I. WAIVER AND UNDERTAKING BY I-FERN

I-FERN hereby warrants and undertakes the following:

I.1. I-FERN shall never use a script similar to the font being used by KRAFT for its MILKA Trademark;

I.2. I-FERN shall never use the color lilac, purple, violet and/or any color of that shade in any of its MilkCa packaging, labels, and/or marketing implements;

I.3. I-FERN shall neither use nor apply for registration of the MilkCa Trademark for foodstuffs in Class 5 of the Nice Classification, with the exception of "calcium health supplement";

I.4. I-FERN shall neither use nor apply for registration of the MilkCa Trademark for foodstuffs in Class 29 of the Nice Classification, with the exception of "milk and milk products";

I.5. I-FERN shall neither use nor apply for registration of the MilkCa Trademark for foodstuffs in Class 30 of the Nice Classification, with the exception of "coffee";

I.6. I-FERN shall neither use nor apply for registration of the MilkCa Trademark for beverages in Class 32 of the Nice Classification; and

I.7. I-FERN shall neither use nor apply for registration of the MilkCa Trademark for any product that would contain chocolate or cocoa.

II. WAIVER AND UNDERTAKING BY KRAFT

KRAFT hereby warrants and undertakes the following:

II.1. KRAFT shall, upon execution of this Agreement, immediately withdraw its Opposition to I-FERN's application for registration of the MilkCa Trademark with the Bureau of Trademarks, Intellectual Property Office (IPO), bearing Philippine Trademark Application No. 4-2012-014079 which was published in the E-Gazette on April 22, 2013;

II.2. KRAFT hereby fully releases, discharges and waives any and all actions of whatever nature, real or apparent, which it may have had against I-FERN, or any of its corporate directors, officers, consultants and employees directly or indirectly relating to I-FERN's usage and application for registration of the MilkCa Trademark;

II.3. KRAFT hereby further waives any future claim, or right of action of whatsoever nature, against I-FERN, or any of its corporate directors, officers, consultants and employees directly or indirectly relating to I-FERN's usage and application for registration of the MilkCa Trademark, except in case of violation of any of I-FERN's undertakings in Section I hereof.

III. SEVERABILITY

The invalidity or unenforceability of any term, provision, or right of any party pursuant to this AGREEMENT shall not adversely affect the validity or enforceability of the remaining terms, provisions and rights.

IV. MISCELLANEOUS PROVISIONS

IV.1. Nothing expressed or implied in this agreement is intended, or shall be construed to, confer upon or give any person or entity other than the parties hereto, any rights or remedies under ir by reason of this AGREEMENT.

IV.2. This AGREEMENT constitutes the entire mutual agreement and understanding between the parties with respect to the subject matter hereof, and supersedes any prior discussion, negotiation, arrangement, and/or agreement between the parties, whether oral or in writing.

IV.3. No representation, undertaking or promise shall be taken to have been given or implied from anything said or written in negotiations between the parties prior to this AGREEMENT except as expressly stated herein."

This Bureau evaluated the UNDERTAKING 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 Undertaking 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 parties' UNDERTAKING is hereby **APPROVED**. Accordingly, the instant opposition case is hereby **DISMISSED**. Let the filewrapper of Trademark Application Ser. No. 4-2012-014079 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 14 January 2014.


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