



McDONALD'S CORPORATION,
Opposer,

-versus-

ASIA PRIME PHILIPPINES CORPORATION,
Respondent-Applicant.

x-----x

}
} IPC No. 14-2011-00359
} Opposition to:
} Appl. Serial No. 4-2010-005950
} Date Filed: June 02, 2010
} TM: "MaCoffee"
}

NOTICE OF DECISION

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No. 1 Don Jesus cor. West Service Road
Alabang Hills, Muntinlupa City

GREETINGS:

Please be informed that Decision No. 2012 – 174 dated September 17, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 17, 2012.

For the Director:


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



McDONALD'S CORPORATION,	}	IPC No. 14-2011-00359
Opposer,	}	Opposition to:
	}	
- versus -	}	Appln. Serial No. 4-2010-005950
	}	Date Filed: 02 June 2010
ASIA PRIME PHILIPPINES CORPORATION,	}	Trademark: MACOFFEE
Respondent-Applicant.	}	
x-----x	x	Decision No. 2012 - <u>174</u>

**DECISION
BASED ON COMPROMISE AGREEMENT**

McDONALD'S CORPORATION ("Opposer") filed on 03 October 2011 an opposition to Trademark Application Serial No. 4-2010-005950. The application filed by **ASIA PRIME PHILIPPINES CORPORATION** ("Respondent-Applicant") covers the mark **MACOFFEE** for use on goods under Class 30. The opposition is anchored on Sections 123.1 (f) of R.A. 8293 otherwise known as The Intellectual Property Code of the Philippines.

On 29 March 2012, the Respondent-Applicant filed its Answer 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 18 April 2012 Order No. 2012-87 referring the case to mediation.

On 30 August 2012, the parties filed a Compromise Agreement. The pertinent portions of the document read:

"NOW, THEREFORE, the parties hereby freely agree to the following terms of a compromise agreement with full knowledge of the consequences thereof:

- "1. APPC shall withdraw its application for registration of the trademark 'MaCoffee' (Application Serial No. 4-2010-005950) and shall not file any application for registration of trademarks identical to or confusingly similar with any trademark of McDonald's;
- "2. Subject to Section 4 hereof, APPC shall cease and desist from producing, manufacturing, packaging, marketing, promoting or selling 'MaCoffee' mark or any marks identical or confusingly similar with any trademark of McDonalds;
- "3. APPC shall submit a complete list of the remaining existing inventory of 'MaCoffee' packaging materials used for the production of 'MaCoffee' products, a copy of which is attached hereto as Annex 'A' and made an integral part of this Compromise Agreement;

"4. Solely to enable APPC to use its remaining inventory of packaging materials, APPC may manufacture 'MaCoffe' coffee mix in such quantity as may be necessary to finish, package, market, promote, sell or dispose APPC's on-hand remaining existing packaging inventory subject to the following conditions:

"i. such inventory is included in the complete list of the remaining existing inventory as contained in Annex 'A';

"ii. APPC must notify the public that 'MaCoffee' products do not originate from McDonald's and that APPC is selling the products subject to the terms and conditions of this Compromise Agreement, in the following manner:

a. APPC shall put a noticeable sign saying that 'This is a product of Asiaprime Philippines Corporation' or 'Product of Asiaprime Philippines Corporation' or 'Product of APPC' on the lid of, or as an insert in, any and all of the box packaging of the 'MaCoffee' products; and

b. APPC shall post on its website (facebook.com/asiaprime.philscorp) the entirety of the following notice: 'Disclaimer: MACOFFEE products do not originate from McDonald's; and

"iii. All such inventory must be sold or disposed of within a reasonable period of time.

"5. This Compromise Agreement shall not preclude each party from further availing of any other available legal remedies to protect and/or enforce its rights.

"6. This Compromise Agreement shall be the basis of a Judgmental/Decision based on Compromise Agreement to be issued by the Intellectual Property Office.

"7. Each Party represents and warrants that:

i. It has duly secured and obtained all corporate authorizations necessary in connection with the execution and delivery of this Agreement.

ii. The execution of this Agreement is a valid and legal act and that the transaction does not violate any existing law or regulation applicable to each Party.

"8. APPC agrees to keep the terms, conditions and obligations of the Compromise Agreement strictly and shall not disclose the same to the public or any third party except the notice permitted under Section 4 (ii) (b) of this Compromise Agreement.

"9. This Compromise Agreement and any and all of its terms, conditions and obligations shall be binding against each party, its officers, directors as well as its

successors, assigns, subsidiaries and other affiliated companies. Breach of any of the foregoing terms shall be cause for the breaching party to be cited in contempt by the Intellectual Property Office, after proper charge and hearing, without prejudice to the non-breaching party's right to avail of any other available legal remedies for such breach.

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

In this regard, 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 (Sec. 5, Office Order No. 154, s. 2010).

WHEREFORE, premises considered, the submitted Compromise Agreement is hereby **APPROVED**. Let the filewrapper of Trademark Application Serial No. 4-2010-005950 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 17 September 2012.


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