



SOCIETE DES PRODUITS NESTLE S. A.,
Opposer,

-versus-

DOXO INGREDIENTS INC.,
Respondent –Applicant.

X-----X

IPC No. 14-2014-00021
Opposition to:
Appln. Serial No. 4-2013-00009515
Date Filed: 08 August 2013
TM: “INJOY CONCENTRATED
CAMEL MACCHIATO
POWDER DRINK MIX”

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2014 - 78 dated March 20, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 20, 2014.

For the Director:


Atty. PAUSI U. SAPAK
Bureau of Legal Affairs



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NESTLE S. A.,	}	Opposition to:
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	}	TM: INJOY CONCENTRATED
DOXO INGREDIENTS INC.,	}	CARAMEL MACCHIATO
Respondent-Applicant.	}	POWDER DRINK MIX
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DECISION BASED ON COMPROMISE AGREEMENT

SOCIETE DES PRODUITS NESTLE S. A. ("Opposer") filed on 17 March 2014 a Joint Motion for Approval of Compromise Agreement. The Joint Motion states that the parties, pursuant to their mutual desire to settle amicably, entered into a Compromise Agreement.

The pertinent portions of the Compromise Agreement reads:

"NOW, THEREFORE, for and in consideration of the foregoing premises and mutual covenants contained in this Agreement, the Parties hereby agree as follows:

"1. DOXO hereby acknowledges SPN's earlier rights over the trademark 'RED MUG DEVICE' in the Philippines and worldwide. DOXO further acknowledges that SPN and/or its predecessor/s-in-interest, agents, affiliated or related entities, individually and through their licensees, have long used and are using throughout the world, including but not limited to in the Philippines, various trademarks and service marks which consist of or incorporate the 'RED MUG DEVICE', alone or with other word or design elements, on or in connection with coffee and any related products.

"2. DOXO hereby voluntarily undertakes to cease and desist from reproducing and using, in the Philippines and/or anywhere in the world, the INJOY CONCENTRATED CARAMEL MACCHIATO POWDER MIX labels containing any red mug or logo or any device which might be identical or confusingly similar to the RED MUG DEVICE including in particular the original label subject of Trademark Applications Nos.42013009515 subject to provisions of paragraph 4 and 42013009156. DOXO also hereby undertakes to submit an inventory of all such labels currently in the market and dispose of these labels within a period of three (3) months from the signing of this agreement.

"3. DOXO further undertakes never to use and/or register or attempt to register, in the Philippines and/or anywhere in the world, a mark which is identical, akin, or confusingly similar to or comprises any identical or similar element to SPN's 'RED MUG DEVICE'. Accordingly, SPN shall have the

right to oppose, attempt to oppose, cancel, attempt to cancel, object to, challenge, or otherwise interfere with DOXO's use and/or application for registration of any mark which SPN believes to be in violation of this provision, whether through judicial, administrative/quasi-judicial or other legal means, including but not limited to action for breach of contract, and always with right to injunction and/or damages in appropriate actions.

"4. DOXO undertakes to file before the BOT-IPOPHL, with the BLA-IPOPHL copied, a request for voluntary amendment of the Trademark Application No. 42013009515 to reflect the revised label mark attached hereto as Annex "D" no later than 14 March 2014. The color of the mug appearing on the revised label is "light brown, brown or tan", and shall be described as such on the amended trademark application.

"5. In the event that the Amendment pursuant to paragraph 4 is not approved and made effective, DOXO undertakes to withdraw Trademark Application No. 42013009515 immediately upon notice of the ineffective amendment and, if DOXO wishes, file a new application reflecting the revised label as mentioned in paragraph 4 and as attached hereto as Annexes "D".

"6. DOXO also undertakes to withdraw Trademark Application No. 42013009156 no later than 14 March 2014.

"7. So long as DOXO complies with the terms of this Agreement, SPN releases, discharges, acquits, and waives any and all claims, causes of action and demands against DOXO and its stockholders, directors, officers, agents, assigns and successors-in-interest with respect to the matters noted herein, and agrees not to commence any legal action against DOXO for DOXO's past use of a red mug and coffee beans device confusingly similar to the 'RED MUG DEVICE' in the market in the Philippines in its INJOY CONCENTRATED CARAMEL MACCHIATO POWDER MIX mark for coffee powder drink mix falling under International Class 30 which was filed on 08 August 2013 and bearing Trademark Application No. 42013009515.

"8. So long as DOXO complies with the terms of this Agreement, SPN releases, discharges, acquits, and waives any and all claims, causes of action and demands against DOXO and its stockholders, directors, officers, agents, assigns and successors-in-interest with respect to the matters noted herein, and agrees not to commence any legal action against DOXO in relation with its mark for coffee powder drink mix falling under International Class 30 and bearing Trademark Application No. 42013009516.

"9. 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.

"10. The Parties shall not divulge or disclose any facts relating to this Agreement, including its existence and its specific terms and conditions, to

any third parties without the written consent of the other Party. Notwithstanding the foregoing, the Parties are allowed:

"10.1 to inform their employees, officers, stockholders, affiliates, agents, affiliates' agents, and the like who have a need to know, and their respective legal counsels, regarding the existence and terms of the Agreement;

"10.2 to divulge this Agreement only to the extent necessary to enforce its terms; or

"10.3 to divulge this Agreement pursuant to law or to a court order.

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

"12. 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 that the Parties have the authority to comply with the promises, obligations, undertaking and acknowledgments 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.

"13. On or before 17 March 2014, the Parties shall jointly submit a copy of this Agreement before the Bureau of Legal Affairs (BLA) of the IPOPHL. The BOT-IPOPHL shall be copied in the same.

"14. This Agreement shall be binding upon and inure to the benefit of the Parties, their employees, officers, affiliates, successors and assigns locally and/or worldwide.

"15. This Agreement sets forth the entire agreement between the Parties, there being no other oral or written terms hereof. 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 in interest. If any provision of this Agreement is determined to be invalid or unenforceable, it shall not affect the validity or enforceability of the other provisions.

"16. This Agreement shall be interpreted and construed exclusively under Philippine laws. Any dispute arising out of or in connection with this Agreement shall be referred to and finally resolved by arbitration in accordance with the Arbitration Law of the Philippines by one arbitrator appointed in accordance with the implementing rules. The language of the arbitration shall be English, and unless otherwise agreed, the arbitration shall be conducted in Metro Manila."

In compliance with Clause 4 of the Agreement, the Respondent-Applicant filed with the Bureau of Trademarks on 12 March 2014 a request for the amendment of Trademark Application No. 42013009515. A copy of said request is attached thereto as Annex "B".


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, goods 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.

WHEREFORE, premises considered, the parties' Compromise Agreement is hereby **APPROVED**. Accordingly, the instant opposition case is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2013-00009515 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 20 March 2014.


Atty. **NATHANIEL S. AREVALO**
Director IV, Bureau of Legal Affairs