



SOFFT SHOE COMPANY, INC.,
Petitioner,

-versus-

ALEXANDER UY,
Respondent-Registrant.

X-----X

}
} IPC No. 14-2009-00206
} Cancellation of:
} Registration No. 4-2003-001038
} Date Issued: 16 March 2006
} TM: "NURSE MATES &
} HEART DEVICE"

NOTICE OF DECISION

ORTEGA, BACORRO ODULIO, CALMA & CARBONELL

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ATTY. SHEM A. YAP

Counsel for Respondent
1851 Eureka St.
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GREETINGS:

Please be informed that Decision No. 2013 - 188 dated October 07, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 07, 2013.

For the Director:

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



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IPC No. 14-2009-000206
Cancellation of:
Registration No.: 4-2003-001038
Date Issued: 16 March 2006
Trademark: NURSE MATES &
HEART DEVICE
Decision No. 2013- 188

**DECISION BASED ON
COMPROMISE AGREEMENT**

SOFFT SHOE COMPANY (“Petitioner”) filed on 13 August 2009 a petition for cancellation of Trademark Registration No. 4-2003-001038. The registration issued on 16 March 2006 in favor of ALEXANDER UY (“Respondent-Registrant”) covers the mark **NURSE MATES & HEART DEVICE** for use on shoes under Class 25.

This Bureau issued a Notice to Answer dated 09 September 2009 and served upon a copy thereof to Respondent-Registrant on 16 September 2009. The Respondent-Registrant filed his Answer on 08 January 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 02 February 2011 Order No. 2011-61 referring the case for mediation.

On 01 June 2011, the ADR Services of this Bureau submitted a Mediation Report indicating the unsuccessful mediation of the instant case.

On 01 December 2011, however, the parties filed a Joint Motion to Approve Compromise Agreement. The pertinent portions of the COMPROMISE AGREEMENT read, as follows:

NOW, THEREFORE, for and in consideration of the foregoing premises and of the mutual covenants hereinafter set forth, the **PARTIES** agree as follows:

“I. **THE MARKS**: This Agreement shall cover the ownership and use of the registered marks NURSE MATES & DEVICE with Philippine Registration Nos. 061390 and 42003001038 in the Philippines (“Marks”).

“II. UNDERTAKINGS OF THE SECOND PARTY:

- (1) **ASSIGNMENT**: The **SECOND PARTY** does hereby irrevocably assign to the **FIRST PARTY** all rights, title and interest in and to the Marks and any other pending applications for identical or confusingly similar marks, including but not limited to, all rights to the registration, all rights to create and use derivative marks, and all rights to use the Marks in different classes of goods.
- (2) The **SECOND PARTY** undertakes not to file an application for the registration of the Marks, or any of its derivatives with any government agency or use the Marks in trade except under the circumstances described in clause IV below. The **SECOND PARTY** further undertakes not to be

involved with any third party that files an application for the registration of any mark identical or confusingly similar to the Marks or otherwise uses the Marks in trade.

- (3) The **SECOND PARTY** undertakes to never contest the validity of the Marks or the rights and interests of the **FIRST PARTY** over the same.

“III. CONSIDERATION: In consideration for the assignment set forth in clause II above, the **FIRST PARTY** shall pay the **SECOND PARTY** the sum of **TWELVE THOUSAND US DOLLARS (US\$12,000)** or its equivalent in Philippine Pesos at the time of the signing of this Agreement.

“IV. DISPOSAL OF INVENTORY: The **SECOND PARTY** shall be given a period of two (2) years from the signing of this Agreement within which to dispose of all of its remaining inventory of products that bear the **NURSE MATES & DEVICE** trademarks.

“V. REPRESENTATIONS AND WARRANTIES: Each of the **PARTIES** represents that:

- (1) **FIRST PARTY** is a duly incorporated, validly existing and in good standing under the laws of the United States of America, whereas the **SECOND PARTY** is of legal age and a citizen of the Philippines.
- (2) The **PARTIES** have their principal offices at the addresses indicated herein, and are registered or qualified to do business in the jurisdiction where such registration or qualification is necessary;
- (3) The **PARTIES** have full legal right, power and authority to carry on their present business, to own properties and assets, to incur the obligations provided for in this Agreement, to execute and deliver this Agreement, and to perform and observe the terms and conditions hereof and thereof.
- (4) All appropriate and necessary corporate and legal action has been taken by the **PARTIES** to authorize the execution, delivery and performance of this Agreement;
- (5) The signatories to this Agreement are fully authorized to sign the Agreement.
- (6) This Agreement constituted the **PARTIES'** legal, valid and binding obligations;
- (7) There is no provision in the Articles of Incorporation, By-Laws, or any other constitutive documents of the **FIRST PARTY** or any laws in the country of the **SECOND PARTY** which would be contravened by the execution and delivery of this Agreement, or by the performance of any provision, condition, covenant or other term hereof; and
- (8) The **PARTIES** have obtained all consents, licenses, approvals and authorizations and have effected all declarations, filings and registrations necessary for the due execution and delivery of this Agreement. All consents, licenses, approvals and authorizations and all declarations, filings and registrations necessary for the performance, validity or enforceability of the Agreement shall be obtained and effected and shall be in full force and effect prior to the date of the initial signing of this Agreement.

“VI. SURVIVAL OF WARRANTIES AND REPRESENTATIONS: All representations and warranties made by each of the **PARTIES** to this Agreement shall survive the execution hereof. Each of the **PARTIES** agrees to indemnify and hold the other **PARTY** harmless against and in respect of any damage or deficiency resulting from their respective misrepresentations.

“VII. REGISTRATION OF AGREEMENT AND OF DEED OF ASSIGNMENT: After the Agreement has been executed, the **PARTIES** shall file a Joint Motion for Judgment on Compromise Agreement with the Bureau of Legal Affairs to end the aforesaid petition for cancellation. Further, a copy of a separate notarized Assignment document shall also be submitted to the Bureau of Trademarks for the recordal of the assignment of the ownership of Marks from the **SECOND PARTY** to the **FIRST PARTY**.



"VIII. TERM AND TERMINATION: Should one **PARTY** unreasonably violate the terms of this Agreement by failing or refusing to perform to perform its commitments in accordance with this Agreement, or to comply strictly with any terms of this Agreement, for any reason whatsoever, the other **PARTY** shall have the right to rescind this Agreement with immediate effect upon giving the violating **PARTY** written notice.

"IX. VENUE: The **PARTIES** irrevocable agree that any action, suit or proceeding arising out of or relating to this Agreement shall be instituted in any court of competent jurisdiction in the City of Makati, Philippines, to the exclusion of other courts.

"X. SEVERABILITY OF PROVISIONS: If any provision of this Agreement or part thereof is rendered void, illegal or unenforceable by any legislation to which it is subject, or by a valid judgment rendered by a court of competent jurisdiction, the enforceability of the remaining provisions not otherwise affected shall in no way be affected or prejudiced. The invalidity, illegality or unenforceability of any provision in this Agreement under the laws of any one jurisdiction shall not in itself affect the validity, legality and enforceability of such provision under the laws of other jurisdiction.

"XI. ATTORNEY'S FEES AND COSTS OF LITIGATION: In case of any legal action or proceeding arising out of or connected with this Agreement, the aggrieved **PARTY**, in addition to any award granted by the Court, shall be entitled to recover: (1) attorney's fees in an amount equivalent to ten percent (10%) of all amounts recovered; and (2) expenses and costs of suit, all with interest at the legal rate, computed from the time the suit was commenced until fully paid.

"XII. AMENDMENTS OR SUPPLEMENTS: No amendment, modification waiver, change or addition hereto shall be effective or binding on any of the **PARTIES** unless the same is made in writing and signed by the **PARTIES** hereto.

"XIII. WAIVERS: Any waiver by any of the **PARTIES** hereto of any right hereunder, or that arising from the Agreement must be made in writing, it being agreed that the rights of any of the **PARTIES** shall not be prejudiced or restricted by any indulgence or forbearance.

"XIV. EXECUTION IN PARTS: This Agreement may be executed in any number of counterparts, each of which shall be an original, but all of which together shall constitute one instrument having full binding legal effect.

"XV. MISCELLANEOUS PROVISIONS: In the event that the terms of this Agreement shall be deemed to be in violation of their Articles of Incorporation and By-Laws (or any amendment thereof), or in violation of existing law or that may be exacted in the future, the **PARTIES** shall take such steps as are necessary to remedy the error in order to reflect the terms of Agreement, so far as permitted by the relevant government agencies within sixty (60) days from the execution of this Agreement. If such amendments are deemed not permitted, the **PARTIES** shall immediately endeavor to rectify the same whether by amendment to this Agreement or to enter into such Agreement as may be deemed appropriate under the premises.

"All the terms of this Agreement shall be binding upon and inure to the benefit of the **PARTIES**, their permitted assigns and successors-in-interest. Except as otherwise provided herein, no **PARTY** shall assign its right and obligations hereunder without the prior written consent of the other **PARTY**.

"This Agreement supersedes oral or verbal representations made by the **PARTIES** to each other with respect to the subject matter thereof.


"Each of the **PARTIES** agrees that any other enabling document needed to proceed with this Agreement shall be produced by the **PARTY** concerned."

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.

WHEREFORE, premises considered, the parties' Compromise Agreement is hereby APPROVED. The 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. Accordingly, the instant cancellation case is hereby DISMISSED. Let the filewrapper of Trademark Registration No. 4-2003-001038 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 07 October 2013.



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

Copy furnished:

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ODULIO, CALMA & CARBONELL**

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