



FERRERO S.P.A.,  
Opposer,

-versus-

YONG CHIP, PHOA,  
Respondent-Applicant.

X-----X

}  
} IPC No. 14-2013-00429  
} Opposition to:  
} Appln. Serial No. 4-2013-00004601  
} Date Filed: 22 April 2013  
} TM: "TIC TAC"

### NOTICE OF DECISION

#### CRUZ MARCELO & TENEFRANCIA

Counsel for Opposer  
6<sup>th</sup>, 7<sup>th</sup>, and 8<sup>th</sup> Floors, CVCLAW Center  
11<sup>th</sup> Avenue corner 39<sup>th</sup> Street  
Bonifacio Triangle, Bonifacio Global City  
Taguig City

YONG CHIP, PHOA  
Respondent-Applicant  
# 15 Pawai Street  
Quezon City

#### GREETINGS:

Please be informed that Decision No. 2014 - 288 dated November 05, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 05, 2014.

For the Director:

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



FERRERO S.P.A.,	}	IPC No. 14-2013-00429
Opposer,	}	Opposition to:
	}	
- versus -	}	Application No. 4-2013-00004601
	}	Date Filed: 22 April 2013
YONG CHIP, PHOA,	}	
Respondent-Applicant.	}	Trademark: TIC TAC
x-----x	x	Decision No. 2014 - <u>288</u>

### DECISION BASED ON COMPROMISE AGREEMENT

FERRERO S.P.A. ("Opposer") filed on 02 January 2014 a Verified Notice of Opposition to Trademark Application No. 4-2013-00004601. The application, filed by YONG CHIP, PHOA ("Respondent-Applicant"), covers the mark TIC TAC for use on "polo, panties, briefs, pants, jumpers, sando, tie side, shorts" under Class 25 of the International Classification of goods.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 17 February 2014. The Respondent-Applicant filed his Verified Answer on 06 March 2014.

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 12 March 2014 Order No. 2014-044 referring the case to mediation.

On 03 November 2014, the ADR Services of this Bureau submitted a Mediation Report indicating a settlement by the parties. Attached to the report is a copy of the parties' Compromise Agreement, the pertinent portions of which reads, as follows:

"NOW, THEREFORE, for and in consideration of the Parties' respective concessions herein below enumerated, FERRERO and MR. PHOA, by way of compromise, mutually agree as follows:

"1. Within ten (10) days from the execution of this Agreement, MR. PHOA shall file his voluntary withdrawal of his Trademark Application No. 4-2013-004601 with the Bureau of Trademarks of the IPO and furnish a copy thereof to FERRERO, through its counsel and attorney-in-fact, CRUZ MARCELO & TENEFRANCIA, by e-mail and at the following address:

CRUZ MARCELO & TENEFRANCIA  
6<sup>th</sup>, 7<sup>th</sup> 8<sup>th</sup> and 10<sup>th</sup> Floors  
CVCLAW CENTER  
11<sup>th</sup> Avenue corner 39<sup>th</sup> Street  
Bonifacio Triangle, Bonifacio Global City  
1634 Taguig, Metro Manila  
E-mail: [ip@cruzmarcelo.com](mailto:ip@cruzmarcelo.com)

"2. MR. PHOA hereby confirms that, with the exception of Philippine Trademark Registration No. 4-2001-004093 which has already been cancelled and Application No. 4-2013-004601, he does not own any registered trademark or trademark application that is identical or confusingly similar with "TIC TAC" in the Philippines or any jurisdiction.

"3. MR. PHOA hereby undertakes to never apply for a trademark that is identical or confusingly similar with "TIC TAC" in the Philippines or any jurisdiction.

"4. FERRERO agrees to reimburse MR. PHOA the amount of Fifty Five United States Dollar (US\$55.00) representing the filing fees incurred in connection with Trademark Application No. 4-2013-004601 to be paid upon submission of this notarized Agreement before the Alternative Dispute Resolution Services (Mediation Office) of the IPO.

"5. Effective on the date of this Agreement, MR. PHOA shall cease production of all goods using the mark "TIC TAC" whether as a label or as printed on any good/item.

"6. MR. PHOA shall be allowed to continue to sell and distribute his goods bearing the mark "TIC TAC" on the label at his retail store located at Sta. Lucia Mall in Marikina City only until 30 September 2014. By 02 October 2014, MR. PHOA shall send Ferrero through its counsel, a notarized affidavit stating that:

- a. MR. PHOA has ceased the marketing, sale and distribution of his goods using the "TIC TAC" mark; and
- b. Any inventory remaining of MR. PHOA's goods bearing the "TIC TAC" mark at the end of the sell-off period have been recalled from the market with all the "TIC TAC" labels removed.

"7. Each party shall bear its own costs and expenses in connection with IPC No. 14-2013-00429, the Agreement, including implementation thereof, and the transactions contemplated thereby.

"8. Violation of any of the terms and provisions of this Agreement shall constitute material breach, and MR. PHOA shall be liable to Ferrero for liquidated damages in the following amounts:

First Violation	-	P400,000.00
Second Violation	-	P700,000.00
Third and Subsequent Violations	-	P1,000,000.00/violation

"9. This Agreement shall also apply to and be binding upon the parties' related or associated companies and/or heirs, including the parties' subsidiaries or affiliates, their legal successors or assigns, and their

respective licensees in the Philippines.

"10. This Agreement shall be governed by the law of the Philippines.

"11. This Agreement may be executed in counterparts, each of which when executed and delivered shall constitute an original of this Agreement, but all the counterparts shall together constitute the same agreement."

This Bureau evaluated the COMPROMISE AGREEMENT and finds that the same have 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>

**WHEREFORE**, premises considered, the parties' Compromise Agreement is hereby **APPROVED**. Accordingly, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application No. 4-2013-00004601 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 05 November 2014.

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

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