



WILLIE KOA,
Petitioner,

-versus-

NEW ERA CAP CO., INC.,
Respondent-Registrant.

X-----X

} **IPC No. 14-2012-00434**
}
} Cancellation of:
} Reg. No. 4-2006-004925
} Date Issued: 19 March 2007
} **TM: "NE AND DESIGN"**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2014 - 324 dated December 19, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, December 19, 2014.

For the Director:


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



WILLIE KOA,	}	IPC No. 14-2012-00434
<i>Petitioner,</i>	}	Cancellation of:
	}	
- versus -	}	Reg. No. 4-2006-004925
	}	Date Issued: 19 March 2007
NEW ERA CAP CO., INC.,	}	Trademark: NE AND DESIGN
<i>Respondent-Registrant.</i>	}	
x-----x		Decision No. 2014- 324

**DECISION BASED ON
COMPROMISE AGREEMENT**

WILLIE KOA ("Petitioner") filed on 27 September 2012 a petition for cancellation of Trademark Registration No. 4-2006-004925. The registration issued on 19 March 2007 in favor of NEW ERA CAP CO. INC. ("Respondent-Registrant"), covers the mark **NE AND DESIGN** for use on caps, pants, t-shirts, shoes, polo shirts, slippers, and socks under Class 25.

This Bureau issued a Notice to Answer and served a copy thereof to Respondent-Registrant on 09 November 2012. The Respondent-Registrant filed its Answer on 12 February 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 Settlement Period*"), this Bureau issued on 26 February 2013 Order No. 2013-054 referring the case to mediation.


On 05 December 2014, the ADR Services of this Bureau submitted a Mediation Report submitting a copy of the parties' Manifestation. Attached to the Manifestation is the parties' MEMORANDUM AGREEMENT and AMICABLE SETTLEMENT, the pertinent portions of which read, as follows:

NOW THE PARTIES AGREE AS FOLLOWS:

"1. **THE PARTIES** shall immediately, and in any event within three (3) days of the date of this Agreement, withdraw the petition for cancellation they filed against each other's marks. Specifically, the FIRST PARTY shall withdraw the Petition for Cancellation against Willie Koa's mark

new era cap

under registration number 4-2005-008836, docketed as IPC No. 14-2013-00124 and Willie Koa shall withdraw the Petition for

Cancellation against the FIRST PARTY'S mark  under registration number 4-2006-004925, docketed as IPC No. 14-2012-00434.

"2. The SECOND PARTY shall immediately, and in any event within three (3) days of the date of this Agreement, assign the mark

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under registration number 4-2005-008836 to the FIRST PARTY, at no cost, by executing a notarized Deed of Assignment to be recorded with the Bureau of Trademarks and such other documents as necessary in order to effect the assignment.

"3. The FIRST PARTY shall immediately, and in any event within three (3) days of the date of this Agreement, withdraw the criminal case against MARILYN KOA-CHAN pending before the Regional Trial Court, Branch 46 of Manila and its duly authorized representative shall execute an Affidavit of Desistance in standard form. The withdrawal and the desistance shall be with the conformity of the Public Prosecutor and executed by the duly authorized representative of the FIRST PARTY, with instructions to the handling counsel in the criminal case to facilitate the dismissal of the criminal case against Marilyn Koa-Chan. The withdrawal of the criminal case against MARILYN KOA-CHAN shall be without prejudice the FIRST PARTY'S rights to pursue any action against EFREN G. LATOCAN.

"4. The SECOND PARTY shall immediately, and in any event within three (3) days of the date of this Agreement:

a.) transmit and deliver to the FIRST PARTY or its appointed agent any products, work-in-progress, marketing and promotional materials, tags, labelling, packaging, or other goods bearing the New Era Marks (or any part thereof or their translations) within the possession, power custody or control of the SECOND PARTY or its Related Persons;

b.) provide to the FIRST PARTY a complete list (with details including quantity and description) of the products, work-in-progress, marketing and promotional materials, tags, labelling, packaging, or other goods bearing the New Era Marks (or any part thereof their translations), within the possession, power, custody or control of the SECOND PARTY or its Related Persons;

c.) cease the sale and will not in the future manufacture, deliver, distribute, promote or sell any goods bearing the New Era Marks (or any part thereof or their translations);

d.) disclose to the FIRST PARTY the identity of any third party to whom the SECOND PARTY has previously supplied goods bearing the New Era Marks (or any part thereof or their translations;) and

e.) disclose to the FIRST PARTY the identity of the supplier or provider and their contact details from whom the SECOND PARTY has previously sourced or obtained goods bearing the New Era Marks (or any part thereof or their translations).

"5. The SECOND PARTY acknowledges that this Agreement is




binding upon any of their heirs, employees, agents, spouses, parents, sons, and daughters, and spouses thereof, parents and spouses thereof, brothers and sisters and spouses thereof, grandparents, and grandchildren and spouses thereof, domestic partner and parents thereof, including domestic partners of the foregoing individuals, and any individual related by blood or affinity whose close association with the parties is the equivalent of a family relationship (the "Related Persons"). Provided further that the SECOND PARTY shall be liable only for the acts of the Related Persons that are within their control or knowledge or knowledge which the SECOND PARTY ought to have. Without limiting the scope of the foregoing, if the FIRST PARTY finds on its own any violation committed by a Related Person, then the FIRST PARTY may notify the SECOND PARTY so that the SECOND PARTY can prove that they have no knowledge and control of such acts. The SECOND PARTY shall provide the FIRST PARTY all assistance at the cost of the FIRST PART for the prosecution of such Related Persons.

"6. The SECOND PARTY shall draw this Agreement to the attention of and make it binding upon any Related Persons mentioned in the immediately preceding paragraph. The FIRST PARTY shall also make this agreement binding to its assigns, successors and related companies.

"7. The SECOND PARTY warrants that, apart from the Subject Mark, the SECOND PARTY and, to the extent that the SECOND PARTY has control or knowledge of or ought to have knowledge of, any of their Related Persons has not applied for or registered any intellectual property rights, including but not limited to trade marks, copyright, trade or business names, company names and domain names which incorporate or are identical or similar to any of the New Era Marks (or part thereof or their translations) anywhere in the world.


"8. (a) If, contrary to paragraph 7, the SECOND PARTY has applied for or registered any intellectual property rights which incorporate or are

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identical or similar to  or any of the New Era Marks (or part thereof or their translation), the SECOND PARTY shall immediately assign those rights to the FIRST PARTY irrevocably or withdraw/cancel (as directed and at the option of the FIRST PARTY), and will immediately, and in any event within 14 (fourteen) days of the date of this Agreement or upon request by the FIRST PARTY, execute any necessary documents or do such acts to effect such assignment to the FIRST PARTY (or another entity designated by assignment to the FIRST PARTY) or its withdrawal/cancellation as the case may be.


(b) If, contrary to paragraph 7, any Related Persons has applied for or registered any intellectual property rights which incorporate or are


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identical or similar to  or any of the New Era Marks (or part thereof or their translation), the SECOND PARTY shall use its best efforts to cause such Related Person to immediately assign those rights to the FIRST PARTY irrevocably or withdraw/cancel (as directed and at the option of the FIRST PARTY), and will immediately, and in any event within 14 (fourteen) days of the date of this Agreement or upon request by the FIRST PARTY, cause such Related Person to execute any necessary


documents or do such acts to effect such assignment to the FIRST PARTY (or another entity designated by the FIRST PARTY) or its withdrawal/cancellation as the case may be.

"9. The FIRST PARTY shall pay the SECOND PARTY a total sum of U \$5,000 as reimbursement for filing and maintaining the registration of the

mark  registration number 4-2005-008836) upon the

execution of the Deed of Assignment of the mark  in favor of the FIRST PARTY and submission to the FIRST PARTY all documents required under clauses 1,2 and 4 of this Agreement. As a consequence, the SECOND PARTY shall consent and execute all acts necessary and provide assistance to the FIRST PARTY until the assignment of the mark

 to the FIRST PARTY has been recorded with the Intellectual Property Office of the Philippines of the assignment of the mark to the FIRST PARTY. If the assignment of the mark

 (registration number 4-2005-008836) cannot be recorded on the official registered for any reason whatsoever, the SECOND PARTY will immediately, and in any event within three (3) days of notice of such inability to record the assignment, withdraw or surrender the registration of the Subject Mark so that Subject Mark will no longer be valid.

"10. The SECOND PARTY or any of their Related Persons within the SECOND PARTY'S control shall take all steps necessary, now and in the future, to avoid any confusion between their business and the FIRST PARTY (in relation to any goods or services), including among other things, not using and/or applying to register any words, signs, trademarks, service marks, trade or business names, logos, company names or domain names, which incorporate or are identical or similar to "New Era" or any of the New Era Marks (or part thereof or their translations).

"11. The SECOND PARTY or any of their Related Persons within the SECOND PARTY'S control shall never interfere or initiate actions to oppose, cancel or otherwise challenge trade mark applications or registrations of other intellectual property rights in the name of the FIRST PARTY or use by the FIRST PARTY of any of its intellectual property rights anywhere in the world. The SECOND PARTY shall render to the FIRST PARTY, at the FIRST PARTY'S cost and request, all such assistance as is necessary to maintain such applications or registrations or other intellectual property rights.

"12. The SECOND PARTY acknowledges that the FIRST PARTY has the rights to, in the future, lodge criminal complaints or initiate or bring any action against the SECOND PARTY (or either of WILLIE KOA or MARILYN KOA-CHAN) if the SECOND PARTY infringes any of the FIRST PARTY'S in any way howsoever.

"13. If any provision of the Agreement shall be held illegal, invalid or unenforceable, void, or contrary to law in any jurisdiction:

(a) the validity or enforceability of the other provisions of this Agreement shall not be affected in that jurisdiction; and

(b) the validity or enforceability of that or any other provision of this Agreement shall not be affected in other jurisdictions.

"14. This Agreement shall be governed by the laws of the Philippines.

"15. The parties declare that this Agreement and all other Agreement/Undertaking/Affidavits mentioned herein shall be enforceable worldwide.

"16. The parties further declare that they have read and understood this Agreement and such was made willingly and voluntarily with full knowledge of their rights under the law."

This Bureau evaluated the MEMORANDUM AGREEMENT and AMICABLE SETTLEMENT 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 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.

Corollarily, on 27 November 2014, the parties' filed a Manifestation stating that Petitioner is withdrawing its petition for cancellation of the registered mark NE AND DESIGN.

WHEREFORE, premises considered, the parties' Memorandum Agreement and Amicable Settlement is hereby **APPROVED**. Accordingly, the instant cancellation case is hereby **DISMISSED**. Let the filewrapper of Trademark Application No. 4-2006-004925 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 19 December 2014.


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