

**SAN MIGUEL BREWERY INC.,  
ICONIC BEVERAGES, INC.,**  
Opposer,

**IPC No. 14-2013-00034**  
Opposition to:  
Appln. Serial No. 4-2012-011172  
Date Filed: 12 September 2012

-versus-

TM: 

**METRO VALUE VENTURES INC.,**  
Respondent- Applicant.

x-----x

**NOTICE OF DECISION  
[DECISION BASED ON COMPROMISE AGREEMENT]**


**BENZON NEGRE UNTALAN  
INTELLECTUAL PROPERTY ATTORNEYS**  
Counsel for Opposer  
Second Floor SEDCCO Building  
Rada corner Legaspi Streets  
Legaspi Village, Makati City


**SALUDO FERNANDEZ AQUINO & TALEON**  
Counsel for Respondent-Applicant  
5858 SAFA Building  
Alfonso corner Fermina Streets  
Poblacion, Makati City

**GREETINGS:**

Please be informed that Decision No. 2017 - 152 dated April 27, 2017 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 02, 2017.

  
**MARILYN F. RETUTAL**  
IPRS IV  
Bureau of Legal Affairs

<b>SAN MIGUEL BREWERY INC.,</b>	}	<b>IPC No. 14-2013-00034</b>
<b>ICONIC BEVERAGES, INC.,</b>	}	
Opposers,	}	Opposition to:
	}	Appln. Serial No. 4-2012-011172
- versus -	}	Date Filed: 12 September 2012
	}	Trademark:
<b>METRO VALUE VENTURES INC.,</b>	}	
Respondent-Applicant.	}	
x-----x		Decision No. 2017- <u>152</u>

**DECISION  
BASED ON COMPROMISE AGREEMENT**

**SAN MIGUEL BREWERY INC., ICONIC BEVERAGES, INC.,** (“Opposers”) filed an opposition to Trademark Application Serial No. 4-2012-011172. The application filed by **METRO VALUE VENTURES INC.,** (“Respondent-Applicant”), covers the mark **WEST COAST ICE AND DEVICE** for use on goods under Class 01 of the International Classification of Goods. The opposition is anchored on Section 123.1 (d) of R.A. 8293 also known as the Intellectual Property Code of the Philippines (“IP Code”).

Pursuant to the Regulations on Inter Partes Proceedings, this Bureau issued a Notice to Answer and served a copy thereof to the Respondent-Applicant on 19 April 2013. The Respondent-Applicant filed its Answer on 17 July 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 13 August 2013 Order No. 2013-194 referring the case to mediation. However, on 08 October 2013, the ADR Services of this Bureau submitted a Mediation Report indicating the failure of the parties to mediate, and as a consequence, the records were returned to the Bureau proper for the resumption of the adjudication proceedings. During the preliminary conference, parties manifested their intention to still negotiate for settlement.

On 07 March 2014, the parties filed a Joint Submission with the attached Compromise Agreement, the pertinent portion of which reads:

“NOW, THEREFORE, for and in consideration of the foregoing premises and mutual covenants contained in this Agreement, and other good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, the Parties hereby agree as follows:

"1. MVVI represents that the trademark application for the WEST COAST ICE Mark is the only application owned by MVVI in the Philippines and anywhere else in the world for marks that contain a combination of a mountain device, the term 'Ice,' and/or the color blue for goods under Class 1 or any other class covering beverages, whether alcoholic or non-alcoholic.

"2. Within ten (10) business days from the execution of this Agreement, MVVI will file with the BOT, with copy furnished to the BLA, SMB, and IBI, a request to amend Application No. 4/2012/011172 as follows –

- (a) by removing the mountain device;
- (b) by refraining from using the color blue if in combination WITH ICE AND/OR MOUNTAIN DEVICE since the color is highly associated with SMB & IBI's 'Blue Ice' and 'San Mig Strong Ice' brands;
- (c) by changing the font style for the word 'Ice' in the WEST COAST ICE Mark and employing a font style that is very dissimilar to the font style used in the BLUE ICE Mark; and
- (d) by reducing the size of the word 'Ice' in the WEST COAST ICE Mark such that it is at least the same size as the words 'West Coast' and no bigger.

For avoidance of doubt, the amended WST COAST ICE Mark shall be as follows:



(hereinafter, the 'Amended WEST COAST ICE Mark').

"3. Upon submission to SMB and IBI's legal counsel, Bengzon Negre Untalan Intellectual Property Attorneys, of proof of approval by the BOT of the Amended WEST COAST ICE Mark, SMB and IBI, through their legal counsel, shall withdraw the Opposition filed in IPC No. 14-2013-00034.

"4. In the event the amendment pursuant to Paragraph 2 is not approved and made effective by the BOT, MVVI will instead file with the BOT, with copy furnished to the BLA, SMB and IBI, a withdrawal of Application No. 4/2012/011172.

4/2012/011172, immediately upon notice of the ineffective amendment and, if MVVI wishes, file a new application for the WEST COAST ICE Mark which is in accordance with the requirements of Paragraph 2 of this Agreement and is otherwise consistent with the terms of this Agreement (hereinafter, 'MVVI's New Application').

"5. MVVI hereby undertakes never to use and/or register or attempt to register a mark which is identical, akin, or confusingly similar to the disputed mark or to the BLUE ICE Mark. Accordingly, SMB and IBI shall have the right to oppose, attempt to oppose, cancel, attempt to cancel, object to, challenge, or otherwise interfere with MVVI's use and/or application for registration of any mark which SMB and IBI believes to be violative of this provision.

"6. SMB and IBI hereby agree, and accordingly, undertake not to oppose, attempt to oppose, cancel, attempt to cancel, object to, challenge, or otherwise interfere with MVVI's use, application for registration and/or registration of its Amended WEST COAST ICE Mark whether as amended under Paragraph 2 of this Agreement or filed as a new Application under Paragraph 4 hereof.

"7. Further, SMB and IBI hereby consents to grant MVVI the period of six (6) months from execution of this Agreement, or no later than 6 September 2014, within which to deplete, by way of sale, all existing stocks of West Coast Ice bottled water using the disputed mark. Existing stocks bearing the aforesaid mark upon termination of the aforesaid period shall be disposed or destroyed by MVVI in any manner except public distribution or repackaged to exclude the disputed mark.

"8. MVVI hereby consents to, and accordingly, undertakes not to oppose, attempt to oppose, cancel, attempt to cancel, object to, challenge, or otherwise interfere with SMB and IBI's use and/or registration of its BLUE ICE Mark, currently registered under Certificate of Registration No. 4-1994-096538.

"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 prior written consent of the other Party.

Notwithstanding the foregoing, the Parties are allowed to inform their employees and officers who have a need to know, and their respective legal counsels, regarding the existence and terms of Agreement.

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

"12. This Agreement sets forth the entire agreement between the Parties, there being no other oral or written terms hereof. No agreement amending, superseding or terminating this Agreement or any provisions hereof shall be valid unless in writing and signed by both Parties. No waiver or breach of this Agreement shall be construed as a continuing waiver or consent to any subsequent breach hereof. 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.

"13. The Parties warrant and represent 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.

"14. This Agreement shall be binding upon and inure to the benefit of the Parties, their affiliates, successors and assigns.

"15. This Agreement may be executed in counterparts, each of which shall be deemed to be an original but all of which taken together shall constitute one and the same Agreement, and shall become effective when one or more counterparts have been signed by each of the Parties and delivered to the other Party."

This Bureau evaluated the COMPROMISE AGREEMENT and finds that same have been duly entered by the parties with the terms and conditions thereof not contrary to law, morals, good customs, public order or public policy. Any part thereof hereinafter requiring action from the IPO shall be governed by the applicable Trademark Rules such as but not limited to Memorandum Circular No. 16-012 s2016 (IOPHL Revised Fee Structure 2017).

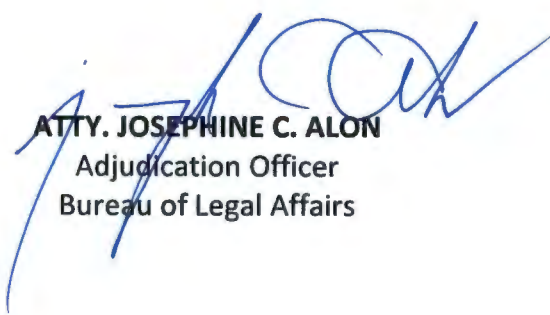
Accordingly, an approved COMPROMISE AGREEMENT shall have the effect of a decision or judgment on the case and shall be enforced accordingly in accordance with the

pertinent rules of IPO and the Rules of Court (Sec. 5, Office Order No. 154, s. 2010).

**WHEREFORE**, premises considered, the parties' Compromise Agreement is hereby **APPROVED**. Let the filewrapper of Trademark Application Serial No. 4-2012-011172 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 27 APR 2017.



**ATTY. JOSEPHINE C. ALON**  
Adjudication Officer  
Bureau of Legal Affairs

Copy furnished:

**BENGZON NEGRE UNTALAN**  
**INTELLECTUAL PROPERTY ATTORNEYS**  
Counsel for Opposers  
Second Floor SEDCCO Building  
Rada corner Legaspi Streets  
Legaspi Village, Makati City

**SALUDO FERNANDEZ AQUINO & TALEON**  
Counsel for Respondent-Applicant  
5858 SAFA Building  
Alfonso corner Fermina Streets  
Poblacion, Makati City

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