

SCOTCH WHISKY ASSOCIATION  
OF UNITED KINGDOM  
Opposer,

INTER PARTES CASE NO. 3169

OPPOSITION TO:

- versus -

Application Serial No.: 53377  
Filed: March 15, 1984  
Applicant: Consolidated Distillers of Far  
East Inc.  
Trademark: KEVIN BROTHERS  
Used On: Whisky, rum, gin and brandy

CONSOLIDATED DISTILLERS  
OF FAR EAST, INC.,  
Respondent-Applicant.

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DECISION NO. 90-17 (TM)  
March 21, 1990

### DECISION

In this Opposition filed on August 11, 198 by Opposer, Scotch Whisky Association of the United Kingdom, it is prayed that the application for file registration of the trademark "KEVIN BROTHERS" for whisky, rum, gin and brandy, with Serial No. 53377, filed on March 15, 1984 by Respondent-Applicant, Consolidated Distillers of Far East, Inc., and published on Page 90, Volume, 1, No. 4 of the Bureau of Patents, Trademarks & Technology Transfer's Official Gazette dated June 17, 1988, be denied.

Opposer is a trade association of Scotch Whisky distillers and blenders organized and existing under the laws of the United Kingdom with address at #20 Atholl Crescent, Edinburgh EH3 8HF, Scotland, United Kingdom; while Respondent-Applicant is a corporation duly organized and existing under the laws of the Philippines with office address at #10 Taft Street, Greenhills, San Juan, Metro Manila, Philippines.

The grounds of the Opposition are as follows:

"1. Respondent-applicant Consolidated Distillers of Far East, Inc. is not entitled to register the trademark 'KEVIN BROTHERS' because it has not had bona fide commercial use thereof before its application for its registration or thereafter.

2. Respondent-applicant has specifically agreed not to use the words which constitute the said mark and has therefore abandoned said mark.

3. Respondent-Applicant's mark constitute a direct or indirect use of a false indication of the source of its products which is an act contrary to honest practices in industrial or commercial matters or an act of unfair competition which the member countries of the Paris Union, including the Philippines, undertake to assure to nationals of the other countries of the Union appropriate legal remedies to repress effectively in accordance with the provisions of Articles 10, 10bis and 10ter of the said Paris Convention. x x x"

On August 15, 1988, Respondent-Applicant was sent through registered mail a copy of the notice of opposition with a notice to answer said opposition within fifteen (15) days from receipt thereof.

In its Answer filed on October 26, 1988, Respondent-Applicant denied the material allegations of the Opposer and made the following special and affirmative defenses:

1. The opposition should be CD forthright dismissed as, on its face, it was filed out of time and Opposer failed to allege its capacity to sue;
2. It is of public knowledge in the Philippines that Respondent-Applicant has been using the subject trademark since November 5, 1982;
3. Respondent-Applicant never abandoned the trademark "KEVIN BROTHERS" as alleged in par. 3 of the notice of opposition. What it voluntarily renounced was the reference to the "Kevin Brothers, Ltd. of London, England" in its Andy Player labels as it continued to use the trademark "KEVIN BROTHERS" after November 18, 1985;
4. Opposer failed to allege that it has the registered right (either in this country or in the United Kingdom) of the trademark "KEVIN BROTHERS"; and
5. Articles 10, 10bis and 10ter of the Paris Convention are not self-executory provisions and are merely expressive of intent -- or agreement in principle -- of the signatories to the Convention.

Issues having been joined, pre-trial conference was set on December 5, 1988 and notice thereof was sent to the parties and their respective counsels. From then on, trial on the merits was postponed for several times upon agreement of the parties in the hope of striking a compromise acceptable to all concerned.

Finally, on March 22, 1989, the parties jointly executed and filed with the Bureau a compromise agreement containing the following terms and conditions, to wit:

"1. Desirous of terminating this case in a conciliatory note, herein opposer and respondent-applicant hereby enters into a compromise agreement under the terms and conditions stated hereunder.

2. Respondent-applicant hereby commits itself to amend its application, for the registration of the trademark "KEVIN BROTHERS" by deleting 'whisky' from the present description of goods in the application and adding after the words 'rhum, gin, brandy,' the following 'except whisky and other drinks containing whisky'.

3. Opposer on the other hand is hereby committed to dismiss, as it hereby prays to dismiss, its Notice of Opposition dated 10 August 1988, with prejudice.

4. The amendment of the application for registration is not however a recognition of the truth or validity of the Notice of Opposition, as respondent-applicant hereby waives no right and admits no liability.

WHEREFORE, the parties hereby jointly pray that this Compromise Agreement be approved."

The Compromise Agreement not being contrary to law, morals, good customs, public order or public policy is, as it is hereby, APPROVED.

WHEREFORE, this opposition is DISMISSED subject to the terms of the Compromise Agreement. Let Respondent-Applicant's Application Serial No. 53377 for the, trademark "KEVIN BROTHERS" be amended in accordance with Paragraph 3 of the Compromise Agreement.

Let the records of this case be forwarded to the Patent/ Trademark Registry and EDP Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO  
Director