



B.S.A. JOINT STOCK CO.
WITH BOARD OF DIRECTORS
AND SUPERVISION BOARD,
Opposer,

-versus-

SAN MIGUEL PURE FOODS CO., INC.,
Respondent-Applicant.

x-----x

}
} IPC No. 14-2011-00522
} Opposition to:
} Appln. Serial No. 4-2011-500452
} Date filed: 22 March 2011
} TM: "PRESIDENT'S TUB"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 - 41 dated February 12, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 12, 2013.

For the Director:


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



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IPC NO. 14-2011-00522
 Case Filed: 20 January 2012

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Decision No. 2013- 41

DECISION BASED ON AGREEMENT

B.S.A. JOINT STOCK COMPANY WITH BOARD OF DIRECTORS AND SUPERVISION BOARD, ("Opposer") filed on 20 January 2012 an Opposition to Application No. 4-2011-500452. This Bureau issued a Notice to Answer dated 02 February 2012 and served upon a copy thereof to SAN MIGUEL PURE FOODS CO., INC. ("Respondent-Applicant"), on 09 February 2012. The Respondent-Applicant timely filed its Answer on 10 April 2012.

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 18 April 2012 Order No. 2012-91 referring the case to mediation.

On 04 February 2013 the ADR Services of this Bureau submitted a Mediation Report indicating a settlement by the parties' of the case. Attached to the report is the parties' AGREEMENT the pertinent portions of which read, as follows;

- "1. SMPFC represents that the SMPFC Application is currently the only active application owned by SMPFC in the Philippines and anywhere else in the world for marks that contain or comprise the term PRESIDENT, and further represents that SMPFC owns no other active trademark filings, including registrations, in the Philippines and anywhere else in the world for marks that comprise or contain the term PRESIDENT.
- "2. Within ten (10) business days of the execution of this Agreement, SMPFC will file with the BOT-IPOPHIL., with copy furnished the BLA, a request to amend the SMPFC Application to reflect the mark **PRESIDENT'S TUB appearing together/alongside each other or in one line, all the words being in the same size of characters and not one of said terms on top of the other** (the "Amendment"), in roughly the same manner as shown in the figure below:

PRESIDENT'S TUB

"3. In the event the Amendment pursuant to Paragraph 2 is not approved and made effective by the BOT-IPOPHIL, SMPFC will withdraw the SMPFC Application immediately upon notice of the ineffective amendment and, if SMPFC wishes, file a new application for the SMPFC Mark only for the "Ice Cream" which is in accordance with the requirements of Paragraph 2 of this Agreement and is otherwise consistent with the terms of this Agreement (the "SMPFC's New Application")

"4. SMPFC will withdraw within one (1) year from the signing of this Agreement from all markets/places where products bearing its mark using/featuring/displaying its current label/s, packagings, promotional materials and the like, are being sold/offered for sale/marketed/distributed/otherwise used or disposed of, and replace these with labels, product packagings, promotional materials all showing the Amendment in accordance with Paragraph 2 above, or the SMPFC New Application, and always use the SMPFC mark accompanied by the house brand "Magnolia" or any other house brand that may be developed by SMPFC for its ice cream or frozen dessert products, which house brand shall not be confusingly similar to the PRESIDENT Mark, and will not use or authorize others to use the SMPFC Mark in its current format/presentation.

"5. Only in relation to SMPFC's Application and/or SMPFC's Mark, SMPFC will not react, attempt to react, cancel, attempt to cancel, or otherwise interfere with B.S.A.'s use and/or registration of the PRESIDENT Mark and consents to the use of the PRESIDENT Mark.

"6. Upon submission to B.S.A.'s above-identified Philippine Legal Counsel of proof of filing of the Amendment with the BOT/BLA-IPOPHIL and the latter Bureau's acceptance of said Amendment, and in consideration of the actions and forbearances of SMPFC, B.S.A., through its said Philippine Legal Counsel, will withdraw its Opposition to the SMPFC Application. Only in relation to PRESIDENT Mark, B.S.A. will not react, attempt to react, cancel, attempt to cancel, or otherwise interfere with SMPFC's use and registration of the SMPFC amended Mark or the SMPFC New Application for as long as the SMPFC amended Mark or the SMPFC New Application is consistent with, or SMPFC is otherwise in compliance with, the terms of this Agreement.

"7. The Parties agree to execute with good faith the Agreement. Apart from the consents granted in this Agreement, the Parties reserve all other rights.

"8. The Parties agree that, at the time of the execution of this Agreement, they are not aware of any actual confusion arising from the concurrent use of their respective Marks in the Philippines.

"9. The Parties agree to bear their own costs in connection with this Agreement and with respect to any consents granted by either Party pursuant to and referred to in Paragraphs 4, 5 and 6 of this Agreement.

"10. This Agreement sets forth the entire agreement between the Parties, there being no other oral or written terms hereof. No agreement amending, suspending or terminating this Agreement or any provisions hereof shall be valid

unless in writing and signed by both Parties. No waiver of any 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.

"11. This Agreement shall inure to the benefit of and shall be binding upon the Parties, their officers, directors, shareholders, partners, members, agents, representatives, servants, employees, licencees, franchisees, attorneys, parent companies, subsidiaries, related and affiliated companies, successors and assigns and all entities operated and/or controlled by any of them or in active concert or participation with any of them.

"12. The undersigned individuals hereby warrant and represent they have full authority to execute this Agreement on behalf of the Party for which they are assigned.

"13. This Agreement may be executed in counterparts, each of which shall be deemed to be 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 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.

Accordingly, an approved 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.¹

WHEREFORE, premises considered, the parties' AGREEMENT is hereby **APPROVED**. Let the filewrapper of trademark Application Serial No. 4-2011-500452 be returned, together with a copy of this Decision to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 12 February 2013.


ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs 

¹ Office Order No. 154 Series of 2010