

WINTRADE SALES CORPORATION
Opposer,

Versus

FLOWIL INTERNATIONAL LIGHTING,
HOLDING) B.V.

Respondent-Applicant.

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IPC No. 14-2010-00145

Opposition to:

Appln. Serial No. 4-2007-00318

Date Filed: 10 January 2007

Trademark: SYLVANIA

Decision No. 2011-94

DECISION
BASED ON COMPROMISE AGREEMENT

WINTRADE INDUSTRIAL, SALES CORP. ("Opposer") filed on 16 July 2010 an opposition to Trademark Application Serial No. 4-2007-000318. The application filed by FLOWIL INTERNATIONAL LIGHTING (HOLDING) B.V., ("Respondent Applicant") covers the mark SYLVANIA for use on goods under Class 09. The opposition is anchored on the following grounds:

1. Approval of Respondent's Applications SN 4-2007-000318 is prescribed by Section 123, 1 (d) of the IP Code.
2. Approval of Respondent application SN 4-2007 -000318 is barred by prior judgment.
3. Respondent filed application SN04-2007-000318 in bad faith.

The Respondent Applicant filed each answer on 02 December 2010 refuting the material allegations of the Opposer.

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 14 February 2011 Oder No, 2011-125 referring the case to mediation.

On 23 November 2011, this Bureau received a "MEDIATOR's REPORT" indicating the successful mediation of the instant case. Attached to the report is the parties' "COMPROMISE AGREEMENT" submitted to this Bureau for approval. The Agreement states, among other things.

NOW THEREFORE, the Parties agreed by way of amicable settlement as follows:

1. For good and valuable consideration, receipt of which is hereby acknowledged, Opposer hereby assigns in favor of the Respondent all registrations for any SYLVANIA marks, including the following registrations, including the goodwill associated therewith and symbolized thereby.
 - a. Registration No. 65433 issued on December 17, 1997 for the trademark "SYLVANIA" for use on radio, TV, disc player, telephone and communications equipment, socket,. Electric wiring devices falling under Class 9; and
 - b. Registration No. 4-2003-0001322 issued on February 25, 2009 for the trademark "SYLVANIA" for use on electric bulbs, fluorescent tubes. Starter, ballast, lighting fixtures, floodlight, spotlight, par 38. dichroic halogen, pl tubes falling under Class 11.

2. For good and valuable consideration, receipt of which is hereby acknowledged, Opposer likewise abandons and waives in favor of the Respondent all rights and interests over all applications for any SYLVANIA marks, including the following application and including the goodwill associated therewith and symbolized thereby.
 - a. Application No. 4-2001-002796 filed on April 21, 2001 for the trademark "SYLVNIA" for use on bulbs and batteries falling under Class 09; and
 - b. Application No. 41999007376 filed on September 28, 1999 for the trademark "SYLVANNIA" for use on electric bulbs, fluorescent tubes, starter, ballast, lighting fixtures, floodlight, spotlight, par 38. dichroic halogen, pl tubes falling under Class 11.
3. Respondent hereby accepts the foregoing assignment and the parties undertake to have them duly recorded with the Bureau of Trademarks.
4. Other than these trademark registrations, Opposer undertakes that there are no other trademark registrations or application for registration of the mark SYLVANNIA or any similar mark, in respect of goods or services in any classes, in its name or in the name of any other entity associated with it, its licensee, successors, in-title or any person deriving rights from Opposer. Should it learn later of any such trademark registrations and/or applications, Opposer undertakes to immediately disclose and assign any such relevant registration of application to the Respondent.
5. Opposer Wintrade (as well as any of its associated entities, licenses, successors, in title or any person deriving any rights from it) undertakes that it will not hereinafter use or apply for the registration of marks therefrom and further undertakes to immediately discontinue all use and promotion of "SYLVANIA" and any similar trademarks on its website or any other website, as well in all advertising or other promotional avenues.
6. Opposer Wintrade (as well as any of its associated entities, licensees, successors in title, or any person deriving any rights from it) undertakes not to adopt, use, register or apply for any trademark or domain name consisting of or incorporating the term SYLVANIA (or any confusingly similar marks) on any and all kinds of goods and/or services hereinafter in the Philippines or in any other jurisdiction. Opposer Wintrade additionally not to authorize, encourage or assist the use or application for registration of the mark SYLVANIA by any third party.
7. Opposer Wintrade (as well as any of its associated entities, licensees, successors in title, or any other person deriving any rights from it) undertakes not to oppose, sue or otherwise challenge, proceed in any manner, in agency or other proceedings to authorize, encourage or assist, solicit other to oppose, institute any such actions or proceedings or otherwise challenge the use, registration, consent to be complainant in any action or application for registration of any mark consisting proceeding against Respondent (as well as any of its associated entities, licensees, successors in title. Or any person deriving any rights therefrom) because of or incorporating the word SYLVANIA (in any form) in the Philippines or in any other jurisdictions, but with consent arising out of the respondent applicant FLOWIL or any of its assigns or licensee.
8. Opposer undertakes to destroy all materials or goods bearing the mark SYLVANIA and/or any other similar marks that are in its possession or control and agrees to remove any such marks from its goods, websites, advertisements and promotional materials within 10 days from the execution of this Agreement. Opposer warrants full compliance with these particular undertakings.
9. Respondent-Applicant hereby accepts the foregoing assignment and each Party agrees that this Compromise Agreement will be worldwide in effect.

10. The Agreement may be pleaded as a full and complete defense to, and may be used as the basis for an injunction against, any action, suit or other proceeding which may be instituted, prosecuted or attempted in breach of this agreement. Further, each of the Parties will indemnify and hold each other harmless against all damages, losses, costs and expenses, resulting from breach of any provision contained in this Agreement
11. This Compromise Agreement constitutes the entire agreement between the Parties pertaining to the subject matter thereof. Accordingly, this Compromise Agreement supersedes and replaces all prior negotiations, agreements, understandings, between the Parties whether written or oral, on the subject matter hereof.
12. If any provision of this Agreement or the application thereof is held invalid, the invalidity shall not affect other provisions and applications of this Agreement which can be given effect without the invalid provisions or applications.
13. Each Party hereto shall be solely responsible for its own legal expenses and costs in connection with this Compromise Agreement.
14. In entering into this Agreement, the Parties represent that they have read this Compromise Agreement in full and that the terms of Compromise Agreement and their consequences are fully understood and voluntarily accepted and agreed to by them.
15. This Compromise Agreement may be modified only by the mutual written of both the Parties,
16. This Compromise Agreement shall be binding upon. And insure to the benefit of the affiliates , successors, and assigns of the Parties hereto,
17. As a consequence of the foregoing Opposer hereby withdraws its opposition to Respondent's Application SN 4-2007-000318 and has no more objection to its final approval.

This Bureau finds that the Agreement has been duly entered into by the Parties with the terms and conditions thereof not contrary to law. Morals good custom, public order or public policy/

In this regard, an approved Compromise Agreement shall give 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 submitted Compromise Agreement is hereby APPROVED. Accordingly the instant opposition case is hereby DISMISSED. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision to the Bureau of Trademarks for information appropriate action.

SO ORDERED.

Taguig City, 05 December 2011