

SUNKIST GROWERS, INC.,  
Opposer,

IPC No. 14-2011-00074  
Opposition to:

-versus-

Appln. No. 4-2010-000252  
Date Filed: 08 January 2010

ROBINSON'S INC.,  
Respondent-Applicant.

Trademark: SUN KISSED

X-----X

Decision No. 2011-28

DECISION  
BASED ON COMPROMISE AGREEMENT













SUNKIST GROWERS, INC., (“Opposer”) filed on 02 March 2011 an opposition to Trademark Application Serial No. 4-2010-000252. The application filed by ROBINSON’S INC. (“Respondent-Applicant”) covers the mark “SUN KISSED” for use on goods under Class 25. The Opposer alleges, among other things, that it is the owner of the “SUNKIST” marks and that the Respondent-Applicant’s proposed mark “SUN KISSED” is confusingly similar to Opposer’s “SUNKIST” trademarks.



The Respondent-Applicant filed its Answer on 09 June 2011, refuting the material allegations of the Opposers.

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 and Settlement Period”). This Bureau issued on 29 June 2011 Order No. 2011-198 referring the case to Mediation.

On 11 August 2011, the 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:

1. The Respondent-Applicant Robinsons Inc. has filed Trademark Application No. 4-2010-000252 for the mark SUN KISSED covered under Class 25 for the following specific goods: maxi dress, short dress, pants, capris, shorts, tank tops, jumpsuits, tunics, caftans, sarongs, and cover ups. In the Trademark Application filed on 08 January 2010, Respondent-Applicant described the Trademark as consisting of the word SUN KISSED rendered in orange with turquoise background. Respondent-Applicant further identified the font used is ‘kissmekissme’.
2. Respondent-Applicant does not intend to, and will not use the trademark ‘SUN KISSED’ on any other product other than resort wear, namely: maxi dress, short dress, pants, capris, shorts, tank tops, jumpsuit, tunics, caftans, sarongs, and cover ups.
3. Respondent-Applicant does not intend to, and will not use the trademark SUN KISSED in relation to its business in any style or manner apart from the appearance of the mark below:
4. Opposer is an agricultural Marketing Cooperative and has used the trademark SUNKIST in the Philippines since 02 March 1928. In the Philippines, Opposer has obtained the following registration for the mark SUNKIST:

Representation of Mark	Mark	Date of Filing of Application/ Renewal	Reg. No.	Registered on:	Class/es
	SUNKIST	14 November 2008	4-2008-013987	09 March 2009	24, 25, 30
	SUNKIST	21 January 2008	002206	27 July 1958	32
	SUNKIST	19 June 2008	002243	15 December 1958	31, 32
	SUNKIST	29 May 1990	051754	05 November 1991	32
	SUNKIST	08 April 1994	064861	25 June 1997	05
	SUNKIST	28 March 1996	4-1996-107064	13 November 2003	29
	SUNKIST (FANCIFUL) & DESIGN	26 November 1998	4-1998-008717	05 August 2004	32
	SUNKIST	26 November 1998	4-1998-008718	26 July 2002	32
	SUNKIST (IN AN OVAL DESIGN)	23 June 2003	4-2003-005528	10 February 2005	32
	SUNKIST (IN AN OVAL DESIGN)	23 June 2003	4-2003-005529	10 February 2005	32
	SUNKIST AND DESIGN (ORANGES W/ INSERTED STRAW)	18 September 2003	4-2003-008680	30 July 2006	32
	SUNKIST AND DESIGN (APPLES W/	18 September 2003	4-2003-008682	30 July 2006	32

	INSERTED STRAW)				
	SUNKIST AND DESIGN (GRAPES W/ INSERTED STRAW)	18 September 2003	4-2003-008684	30 July 2006	32
<b>SUNKIST</b>	SUNKIST	05 January 2004	4-2004-000052	20 March 2005	30
	IN AN OVAL SUNKIST DEVICE	13 November 2009	4-2009-011694	05 May 2010	30, 31

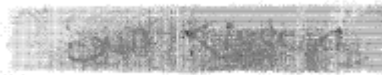
5. While Opposer uses the mark primarily on agricultural products, food and beverages, Opposer has also registered the same in Class 25 for hats, caps, headbands made of clothing, neckties, neckerchiefs, dresses, blouse, jackets, blazers, coats, t shirts, polo shirts, pants, sweaters, shorts, leggings, gloves, socks, sandals, shoes, and belts made of clothing, jogging attire, sweatshirts, panties, underwears, undershirts, sandos, bathing suits, costumes, suspenders, sportswear, and athletic wear (Registration No. 4-2008-013987).

6. In consideration of Opposer's withdrawal of the instant Opposition:

6.1. Respondent-Applicant undertakes that its registration and use of the mark SUN KISSED will be limited to the manufacture, production, sale, and marketing of resort wear namely; maxi dress, short dress, pants, capris, shorts, tank tops, jumpsuit, tunics, caftans, sarongs, and cover ups. In this regard, Respondent-Applicant hereby agrees to the amendment of the list of goods and Trademark Application No. 4-2010-000252 in this wise:

'Resort wears namely: maxi dress, short dress, pants, capris, shorts, tank tops, jumpsuit, tunics, caftans, sarongs, and cover ups.'

6.2 Respondent-Applicant undertakes that it will use the mark SUN KISSED only in the following manner and appearance:



6.3 Respondent-Applicant undertakes that it will not expand the use of the mark SUN KISSED outside of the Philippines.

6.4 Respondent-Applicant recognizes the exclusive ownership of the Opposer of the well-known mark SUNKIST and will not make any move to challenge the validity of Opposer's right to its existing and future application

and registration for, as well as the use of the mark SUNKIST in the Philippines.

7. In consideration of the foregoing undertakings need by Respondent-Applicant, Opposer hereby withdraws its Opposition to the Registration of the Trademark Application No.4-2010-000252 for the mark SUN KISSED in Class 25.

8. The Parties, in good faith undertakes to honor the respective commitments under this Compromise Agreement.

This Bureau finds that the Agreement has been duly entered by the Parties with the terms and conditions thereof not contrary to law, morals, good customs, public order and public policy.

In this regard, 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 Intellectual Property Office and the Rules of Court, (Section 5, Office Order No, 154 section 2010).

WHEREFORE, premises considered, the submitted COMPROMISE AGREEMENT is hereby APPROVED. Accordingly, the instance Opposition is hereby DISMISSED and with the APPROVED AGREEMENT having the force and effects of a decision or judgment, the parties are hereby enjoined to comply with the terms and conditions set forth therein. Let the filewrapper of the Trademark be returned together with a copy of this Decision to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 01 September 2011.