

ILLINOIS TOOL, WORKS, INC.,
Opposer,

IPC 14-2006-00053

-versus -

Opposition to:
TM Application No. 4-1995-102003
(Filing Date: 14 August 2007)

ALEXANDER TANYA,
Respondent-Applicant.

TM: "OMEGA"

x-----x

Decision No. 07-67

JUDGEMENT BASED ON COMPROMISE AGREEMENT

Submitted for consideration is the parties' Joint Motion of Judgment based on Amended Compromise Agreement filed on 28 May 2007.

The Amended Compromise Agreement executed by and between Opposer ILLINOIS TOOL WORKS, INC., and Respondent-Applicant ALEXANDER TANYA provides for the following terms and conditions, to wit:

- "1.) Respondent undertakes to use mark OMEGA in the Philippines in connection only with brake fluids."
- "2.) Respondents undertakes not to use or file an application for the registration of the mark OMEGA in the Philippines in connection with any other goods ad/or services."
- "3.) Respondent undertakes not to license use of the mark OMEGA in the Philippines in connection with goods and/or services other than brake fluids".
- "4.) Opposer agrees not to commence any opposition or cancellation action against any trademark application or registration which Respondent has filed, may decide to file or has obtained in the Philippines for OMEGA in connection with brake fluids."
- "5.) Respondent agrees not to commence any opposition or cancellation action against any trademark application or registration which Opposer has filed, may decide to file or has obtained in the Philippines for OMEGA in connection with bearing and chassis lubricants, lubricants for industry generally, any other chemicals and additives for performance improvement and protection of automotive and other internal combustion engines and parts, in Class 1, 2, and 4, or any other related goods and/or services as well as sponsorship and promotional uses relating thereto."
- "6.) The Respondent's agrees, consents and does not object to Opposer's application for the registration of Opposer's OMEGA mark in the Philippines in Classes 1, 2, and 4 covered by Applicant Serial No. 4-1998-007110 filed on August 18, 1998."
- "7.) The parties mutually recognize their respective rights to the concurrent use of the OMEGA mark for the respective goods and business in the Philippines as mentioned above and accordingly waive any cause of action that either party may have against the other for the use of said mark in the Philippines."
- "8.) The Parties hereby fully and comprehensively release, forgive, quitclaim, and discharge each other, from any and all claims, demands, obligations, liabilities, indebtedness, causes of action and expenses, that each may have had against the other up to the date of this Joint Motion for Judgment based on Amended Compromise Agreement, relating to their respective rights to register, ownership, and use of the OMEGA mark in the Philippines."

“9.) This Amended Compromise Agreement shall not be constructed as to bind the parties to agree to the concurrent use of the OMEGA marks in other jurisdiction.”

“10.) Thus Amended Compromise Agreement shall be binding upon and inure to the benefit of the parties and their employees and officers and assigns or successors in interest of the parties. The terms and conditions of this Compromise Agreement may be amended, waived, or modified only by agreement in writing signed by the parties or their respective assigns or successors in interests.”

“11.) To show complete good faith and respect towards the implementation of this agreement, both parties have agreed that they will take all precautions and reasonable measures to prevent the public from being confused, not only as to the products themselves but also as to their source or origin, to the extent that as soon as the Certificate of Registrations are respectively issued to Respondent Alexander Tanya and Opposer Illinois Tool Works, Inc., following said issuance of certificate of registration of Respondent or Opposer as the case may be, it shall publish an announcement in a newspaper of general circulation in the Philippines once a week for three (3) consecutive weeks, to the effect that is products covered by its trademark as well as its source of origin pertaining to it, to the extent that the nature, origin or source of the product will not be mistaken for the other and that the public will be able to avoid any likelihood of confusion as to the products themselves, as well as the origin and source therefore.”

“12.) The Parties agree to file a Joint Motion for Judgment based on the foregoing Amended Compromise Agreement to effect the dismissal of Inter Partes Case No. 14-2006-00053.”

WHEREFORE, finding the parties' Amended Compromise Agreement to have been duly executed and signed by the parties and the terms and conditions thereof to be in consonance with law, morals, good customs, public policy or public order, the same is hereby APPROVED. Consequently, the parties are hereby enjoined to faithfully comply with the terms and conditions of the Amended Compromise Agreement, failure of which shall be cause for erring party to be cited for indirect contempt after proper charge and hearing.

Let the file wrapper of the trademark “OMEGA”, subject matter of this case together with this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 06 June 2007

ESTRELLITA BELTRAN – ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office