

NORDSTROM, INC., AND NIHC, INC.,
Opposer,
- versus -

IPC 14-2003-00024

Opposition to:
TM Application No. 4-1996-110341
(Filing Date: 05 August 1996)

TRADEMARK SPECIALIST CORPORATION
OF THE PHILIPPINES,
Respondent-Applicant.

TM: "NORDSTROM"

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Decision No. 2007 – 149

JUDGEMENT BASED ON COMPROMISE AGREEMENT

For this Bureau's consideration is the Opposer's Motion to Dismiss filed on 22 October 2007 on the ground that the Opposers have settled and compromised the instant case with Respondents-Applicant to their mutual satisfaction.

The parties in their Compromise Agreement attached to the motion have agreed as follows:

"1. TRADEMARKS SPECIALIST recognizes/acknowledges the ownership of NORDSTROM, INC. over the "NORDSTROM" trademark in Classes 3, 9, 14, 18, 25, 26, 30 and 35, including for retail services; online retail services; mail order services; clothing, clothing accessories, and footwear; handbags and small leather goods; jewelry and watches; cosmetics, personal care products and fragrances; hair accessories; candy; and sunglasses; and hereby undertakes:

- (a) To assign Trademark Application No. 41996110341 and any rights TRADEMARKS SPECIALIST may have in the "NORDSTROM" mark or marks including or derived from "NORDSTROM", and to sign the Assignment attached to this Agreement as Annex "A";
- (b) Not to use or seek or maintain registrations for "NORDSTROM"; or marks or domain names including or derived from "NORDSTROM"; or marks confusingly similar thereto; or other trademarks owned by NORDSTROM, INC.;
- (c) Not to use or seek or maintain registrations for "NORDSTROM" as a trade/business name, corporate name, or use the same in signs; and
- (d) Not to oppose or object to NORDSTROM, INC.'s use or efforts to register or maintain registrations for "NORDSTROM" or marks including or derived from "NORDSTROM";"

"2. TRADEMARKS SPECIALIST agrees to sign such further documents as may be reasonably necessary to assign and transfer to NORDMSTROM, INC. its application and any and all rights it has or claims in "NORDSTROM" and to otherwise effect the terms of this Agreement."

"3. NORDSTROM, INC. in turn, agrees to pay the amount of USD 5,000 for and in consideration of the above-mentioned transfer of rights by TRADEMARKS SPECIALIST to NORDSTROM, INC.;"

"4. Upon assignment of TRADEMARK Application No. 4-1996-110341 to NORDSTROM, INC., NORDSTROM, INC. agrees to withdraw or move for the dismissal of its

aforesaid opposition to TRADEMARK Specialist's trademark application as filed before the Intellectual Property office."

"5. It is understood that the applicability of the instant Compromise Agreement shall be limited to the instant case only and that the said Compromise Agreement Shall in no way prevent NORDSTROM, INC. from undertaking, if need be, legal measures or initiating lawsuits in the Philippines or elsewhere in the world in case of any violation of the foregoing provisions by TRADEMARK SPECIALIST."

"6. The foregoing provisions shall take effect immediately upon approval by the Intellectual Property Office of the instant Compromise Agreement."

"7. The benefits and obligations of the Compromise Agreement shall be mutually binding upon, and inure the benefits of the respective parties, their assigns and/or representatives.

WHEREFORE, finding the parties' Compromise Agreement to have been duly executed and assigned by the parties and terms and conditions thereof to be in consonance with law, morals, good customs, public policy order, the same is hereby APPROVED. Application Serial No. 4-1996-110341 filed by Trademarks Specialist Corporation of the Philippines, now assigned to Nordstrom, Inc. and NIHC Inc. is hereby GIVEN DUE COURSE. Accordingly, the Opposer's Motion to Dismiss is GRANTED. Consequently, the parties are hereby enjoined to faithfully comply with the terms and conditions of the 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 "NORDSTROM" subject matter of this case together with this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 26 October 2007

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