

UNITED BISCUITS (UK)
LIMITED,

Opposer,

INTER PARTES CASE NO. 3352

OPPOSITION TO:

- versus -

Application Serial No. 63526-A
Filed : December 28, 1987
Applicant : Island Biscuits, Inc.
Trademark : PENGUIN
Used on : Peanut butter sandwich

ISLAND BISCUIT, INC.,
Respondent-Applicant

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DECISION NO. 89-96 (TM)
December 12, 1989

DECISION

The United Biscuits (UK) Limited filed on March 29, 1989 an Unverified Notice of Opposition against the registration of the trademark "PENGUIN" used on peanut butter sandwich applied for by Island Biscuit, Inc. on December 28, 1987 under Application Serial No. 63526-A published on Page 33, Volume II, No. 2 of the BPTTT Official Gazette dated and released for circulation on February 28, 1989.

Opposer is a foreign corporation organized and existing under the laws of Scotland, with principal address at 12 Hope Street, Edinburgh, Scotland, while Respondent-Applicant is a domestic corporation doing business at 8th Street, 8th Avenue, Caloocan City, Philippines.

The grounds alleged in the Verified Notice of Opposition submitted on May 25, 1989 are:

"1. The Opposer is the owner of the trade mark 'PENGUIN' having been first to adopt and use the same in actual trade and commerce for goods under International Class 30.

2. The trademark 'PENGUIN' for goods falling under International Class 30 has been registered in many countries.

x x x

3. The trademark 'PENGUIN' which the Opposer has created and adopted is well known throughout the world for their good quality and high reputation."

In its Answer (Reply) filed on April 26, 1989, Respondent-Applicant denied the material allegations made by Opposer and alleged the following defenses:

1. That the Opposer has not registered in the Philippines its trademark "PENGUIN" nor are its products in use commerce or in circulation in the Philippines;
2. That there can be no confusion as to the source of Respondent's product because its trademark "PENGUIN PEANUT BUTTER SANDWICH" is clear and specific and carries on the front of the label the words "ISLAND BISCUIT INCORPORATED", Camarin Subdivision, Part I, Caloocan, Metro Manila"; and
3. That Respondent's trademark "PENGUIN PEANUT BUTTER SANDWICH" has been known and circulating commercially in the Philippines since October 15, 1986 while

Opposer's "PENGUIN" trademark has never been known in the Philippines at any time.

After receipt of the Answer, the case was set for pre-trial conference to June 21, 1989. At the continuation of the pre-trial conference on July 12, 1989, the parties manifested their joint desire to settle amicably the case. The terms and conditions were presented in a clean draft on October 27, 1989 for signature by the parties.

At the hearing of November 27, 1989, the parties' respective counsels submitted in open court a Compromise Agreement for the settlement of this case. Said Compromise Agreement provides:

- “1. For valuable consideration received, Respondent-Applicant hereby assigns its trademark Application Serial No. 63526-A for the trademark 'PENGUIN', subject matter of this Opposition in favor of the herein Opposer.
2. Respondent-Applicant hereby undertakes the premises to permanently cease and desist from manufacturing, selling or using in trade and commerce the trademark 'PENGUIN' including any other mark or marks which may be confusingly similar to or may be colorable imitation of the aforesaid trademark.
3. Respondent-Applicant likewise undertakes that it will not register or attempt to register in the future the trademark 'PENGUIN' or any colorable imitation thereof; that it relinquishes any right or title thereto and hereby acknowledges that the true and lawful owner of the mark is herein Opposer.
4. All existing 'PENGUIN' labels, hangtags and the like, in the possession of Respondent-Applicant, shall immediately be turned over herein Opposer through its counsels.
5. Respondent-Applicant likewise undertakes to immediately furnish a list and/or inventory of uncollected sales made before the turnover, through its counsel.
6. For a period of one (1) year from the date of this Agreement, Respondent-Applicant agrees to allow any duly authorized representative of Opposer to exercise the right of visitation at its business establishment during business days at any reasonable hour for purposes of verifying compliance with this Compromise Agreement.”

The Compromise Agreement was duly signed by the parties and the foregoing provisions being fair, equitable and not contrary to law and office policies, is hereby approved as basis for the settlement/ termination of the case.

WHEREFORE, subject to the provisions of their Compromise Agreement, this Opposition is DISMISSED for having become moot. Respondent's Application Serial No. 63526-A, having been assigned to herein Opposer, shall be given due filing of pertinent documents.

Let the records of the case be forwarded to the Application, Issuance and Publication Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director