

VALMONT, INC.,  
Opposer,

INTER PANES CASE NO. 3514

OPPOSITION TO:  
Application Serial No. 63409  
Filed: December 9, 1987  
Applicant: Farmitalia Carlo  
ErbaS.p.A.  
Trademark: LISERDOL  
Used on: Chemical preparations for  
hygienical use; pharmaceutical and  
veterinary preparations

- versus -

FARMITALIA CARLO ERBA  
S.p.A.,  
Respondent-Applicant.

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DECISION NO. 90-34 (TM)  
August 31, 1990

### DECISION

This is an opposition filed by Valmont, Inc., a corporation duly organized under the laws of the State of Delaware, United States of America, with principal office at 90 Park Avenue, New York, New York, U.S.A., against the application for registration of the trademark "LISERDOL" for chemical preparations filed on December 9, 1987 under Serial No. 63409 in the name of Farmitalia Carlo Erba S.p.A. and which was published on Page 14, Volume II, No. 10, October 31, 1989 issue of the Official Gazette officially released for circulation on November 7, 1989.

The grounds for opposition are as follows:

"1. The trademark 'LISERDOL' so resembles Opposer's registered trademark 'LYSOL', which has been previously used in commerce in the Philippines and other parts of the world and not abandoned, as to be likely, when applied to or used in connection with the goods of Applicant, to cause confusion, mistake and deception on the part of the purchasing public.

2. The registration of the trademark 'LISERDOL' in the name of the Applicant will violate Section 37 of Republic Act No. 166, as amended, and Section 6bis and other provisions of the Paris Convention for the Protection of Industrial Property to which the Philippines and the United States of America are parties.

3. The registration and use by Applicant of the trademark 'LISERDOL' will diminish the distinctiveness and dilute the goodwill of Opposer's trademark 'LYSOL'.

4. The registration of the trademark 'LISERDOL' in the name of the Applicant is contrary to other provisions of the Trademark Law."

On July 3, 1990, while this case was still at the pretrial stage, the parties, through their respective counsels, submitted a Compromise Agreement embodying the following terms and conditions:

"1. Respondent-Applicant has agreed, as it hereby agrees, to amend its Application Serial No. 63409 by substituting the following specification of goods in lieu or the former description, to wit:

'Anti-serotonin preparation, prolactin inhibitor, preventive agent against vascular hemicrania and cephalogy.'

2. Respondent-Applicant shall execute any and all documents necessary to effect the above amendment to Application Serial No. 63409.

3. Respondent-Applicant has undertaken, as it hereby undertakes, to restrict its use of the trademark, 'Liserdol' to the goods specified in number (1) above.

4. Conditioned upon Respondent-Applicant's undertaken, under the above paragraphs, Opposer has agreed to withdraw, as it hereby withdraws, its Notice of Opposition to Respondent-Applicant's Application Serial No. 63409, as amended for the trademark 'Liserdol'.

5. The parties herein have agreed to submit the Compromise Agreement to this Honorable Bureau for approval and for a judgment on its terms."

Finding the terms and conditions of said Compromise Agreement to be not contrary to law, order, morals, good customs and public policy, the same is hereby APPROVED.

WHEREFORE, this Opposition is DISMISSED subject to the terms and conditions of the Compromise Agreement.

Let Application Serial No. 63409 for the trademark "LISERDOL" be transmitted to the Trademark Examining Division for amendment of the specification of goods, after which said application may be given due course.

SO ORDERED.

IGNACIO S. SAPALO  
Director