



CLINIQUE LABORATORIES,  
Opposer,

-versus-

LECLINIQUE INC.,  
Respondent- Applicant.

X-----X

}  
} IPC No. 14-2012-00470  
} Opposition to:  
} Appln. Serial No. 4-2012-000013  
} Date Filed: 02 January 2012  
} TM: "LECLINIQUE DEVICE"  
}  
}  
}  
}  
}

**NOTICE OF DECISION**

**ANGARA ABELLO CONCEPCION  
REGALA & CRUZ**  
Counsel for Opposer  
22/F ACCRALAW Tower  
Crescent Park West, Bonifacio Global City  
Taguig City

**PARAS AND MANLAPAZ LAWYERS**  
Counsel for Respondent-Applicant  
1402 Equitable Bank Tower  
8751 Paseo de Roxas, Makati City

**GREETINGS:**

Please be informed that Decision No. 2014 - II dated January 14, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 14, 2014.

For the Director:

  
**Atty. EDWIN DANILO A. DATING**  
Director III  
Bureau of Legal Affairs



CLINIQUE LABORATORIES,	}	IPC No. 14-2012-00470
Opposer,	}	Opposition to:
	}	
- versus -	}	Application Serial No. 4-2012-000013
	}	Date Filed: 02 January 2012
LECLINIQUE INC.,	}	Trademark: LECLINIQUE DEVICE
Respondent-Applicant.	}	
X-----X		Decision No. 2014 - <u>11</u>

### DECISION BASED ON COMPROMISE AGREEMENT

CLINIQUE LABORATORIES (“Opposer”) filed an opposition to Trademark Application Serial No. 4-2012-000013. The application filed by LECLINIQUE INC. (“Respondent-Applicant”) covers the mark LECLINIQUE DEVICE for use on goods under Class 44. The opposition is anchored on Sections 123.1 (d) of R.A. 8293 otherwise known as The Intellectual Property Code of the Philippines.

On 06 May 2013, the Respondent-Applicant filed its Answer refuting the material allegations of the Opposer.

In compliance to Office Order No. 154, s. 2012 (“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 27 May 2013 Order No. 2013-126 referring the case to mediation.

On 08 January 2014, the ADR Services of this Bureau submitted a Mediator's Report indicating a settlement by the parties. Attached to the report is the parties' COMPROMISE AGREEMENT, the pertinent portion of which reads:

“WHEREAS, after seriously considering that protracted litigation is not beneficial to their respective interests, the Parties have mutually decided to amicably settle, with finality, Inter Partes Case No. 14-2012-00470 entitled '*Clinique Laboratories, LLC v. Leclinique Inc.*' and to include in such settlement LECLINIQUE's pending application for the registration of its other mark '*Leclinique Dental and Medical Esthetiques*' bearing Application No. 4-2012-005342, under the terms and conditions hereinafter set forth:

“1. LECLINIQUE shall confine its use of the word '*Leclinique*' to the specific services covered by its application for registration of the mark '*LeClinique Device*' bearing Application No. 4-2012-000013, namely medical and dental services, and shall not use it for any other goods which may in the future be associated with the services of Leclinique;

"2. LECLINIQUE undertakes to use the word 'Leclinique' exclusively to dental and medical services and to refrain from using the word on any product, whether dental or aesthetic products, and especially skin products;

"3. LECLINIQUE shall refrain from using the word 'Clinique' or any other 'Clinique' mark that is identical or confusingly similar to any of the marks owned by CLINIQUE;

"4. LECLINIQUE undertakes to refrain from objecting to, disturbing, or challenging CLINIQUE's exclusive use of or ownership over the mark 'Clinique' or any of its variants;

"5. LECLINIQUE shall refrain from using the word 'Clinique', or any other mark that is identical or confusingly similar to any of the 'Clinique' marks owned by CLINIQUE, except for its use in 'Leclinique';

"6. LECLINIQUE shall refrain from filing, in the future, any application for registration of marks bearing the word 'Clinique' or any other mark that is identical or confusingly similar to any of the 'Clinique' marks owned by CLINIQUE;

"7. LECLINIQUE shall consistently use the word 'Leclinique' as part of the entire mark 'Leclinique Dental and Medical Esthetiques' with the word 'Leclinique' as such, i.e., as one word and with a lower case letter 'c', in all of Leclinique's materials. Its corporate name 'Leclinique' should always be depicted as one word;

"8. LECLINIQUE shall not apply for the registration of a mark composed of the word 'Leclinique' alone, but may apply for the registration of the entire mark 'Leclinique Dental and Medical Esthetiques'. As such, LECLINIQUE shall voluntarily withdraw its application for registration of the mark 'LeClinique Device' bearing Application No. 4-2012-000013, and shall request the amendment of the image of the mark for its application for the registration of 'Leclinique Dental and Medical Esthetiques' bearing Application No. 4-2012-005342 to the approved revised image attached hereto as Annex 'D';

"9. LECLINIQUE shall be allowed to use its existing company mark within seven (7) months from signing of this Agreement. Immediately thereafter, it shall undertake to use the amended mark, as contained in this Agreement.

"10. The Parties agree that each shall shoulder their respective expenses, attorney's fees, and costs incurred in relation to the opposition case and the completion of this Agreement;

"11. The Parties mutually acknowledge and agree that this Agreement does not in any manner constitute an admission of liability or fault whatsoever by either Party and is made solely for the purpose of amicably resolving Inter Partes Case No. 14-2012-00470 and application for the registration of the 'Leclinique Dental and Medical Esthetiques' bearing Application No. 4-2012-005342;

"12. In case either party, or any other person or entity authorized to act on behalf of any party, will violate or will not implement any term of this Agreement, the aggrieved party shall be entitled to the amount of One Hundred Thousand Pesos (PhP 100,000.00) from the other party. Furthermore, the aggrieved party shall be entitled to an immediate injunction from the courts to ensure compliance with the provisions of this Agreement without prejudice to other remedies available under the circumstances and to such damages as may be proven;

"13. This Agreement shall enter into force when the same has been executed by both Parties and shall continue in full force and effect until terminated by a subsequent agreement of the Parties;

"14. This Agreement shall be binding upon and inure to the benefit of the Parties, their related companies, and their respective successors and assigns;

"15. If any clause or part of a clause of this Agreement shall be, or is found by any authority or court of competent jurisdiction to be, invalid or illegal or unenforceable such invalidity, illegality, or unenforceability shall not affect other clauses or part of such clauses of this agreement, which shall remain in full force and effect;

"16. This Agreement embodies the entire agreement between the parties with respect to the subject matter hereof and may be amended, varied, or modified only by a written document executed by the Parties; and

"17. This Agreement shall be construed and enforced in accordance with the applicable laws of the Philippines.

This Bureau evaluated the COMPROMISE AGREEMENT and finds that the same has been duly entered into by the parties with the terms and conditions thereof not contrary to law, morals, good customs, public order or public policy.

Accordingly, 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 IPO and the Rules of Court (Sec. 5, Office Order No. 154, s. 2010).

**WHEREFORE**, premises considered, the parties' COMPROMISE AGREEMENT is hereby **APPROVED**. Accordingly, the Compromise Agreement having the force and effect of a



decision or judgment, the parties are hereby enjoined to comply with the terms and conditions set forth therein. Let the filewrapper of Trademark Application Serial No. 4-2012-000013 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 14 January 2014.



**ATTY. NATHANIEL S. AREVALO**  
Director IV  
Bureau of Legal Affairs

*cpb*