



MERCK KgaA,
Opposer,

-versus-

ENVIRON SKIN CARE (PROPRIETARY), LIMITED,
Respondent- Applicant.

X-----X

MERCK KgaA,
Opposer,

-versus-

ENVIRON SKIN CARE (PROPRIETARY), LIMITED,
Respondent- Applicant.

X-----X

}
} **IPC No. 14-2011-00311**
} Opposition to:
} Appln. Serial No. 4-2010-501157
} Date Filed: 06 August 2010
} TM: "ENVIRON"

}
} **IPC No. 14-2011-00312**
} Opposition to:
} Appln. Serial No. 4-2010-501158
} Date Filed: 06 August 2010
} TM: "ENVIRON LOGO"

NOTICE OF DECISION

BUCOY POBLADOR & ASSOCIATES

Counsel for the Opposer
21st Floor, Chatham House
116 Valero cor. V.A. Rufino Streets
Salcedo Village, Makati City

ORTEGA BACORRO ODULIO CALMA & CARBONELL

Counsel for Respondent-Applicant
5th & 6th Floors, ALPAP I Bldg.
140 L.P. Leviste Street
Salcedo Village, Makati City

GREETINGS:

Please be informed that Decision No. 2013 - 110 dated June 20, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 20, 2013.

For the Director:


ATTY. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs



MERCK KgaA,	}	IPC No. 14-2011-00311
<i>Opposer,</i>	}	Opposition to:
	}	
- versus -	}	Appln. No. 4-2010-501157
	}	Date Filed: 06 August 2010
ENVIRON SKIN CARE (PROPRIETARY),	}	Trademark: ENVIRON
LIMITED,	}	
<i>Respondent-Applicant.</i>	}	
x-----x		
	}	
MERCK KgaA,	}	IPC No. 14-2011-00312
<i>Opposer,</i>	}	Opposition to:
	}	
- versus -	}	Appln. No. 4-2010-501158
	}	Date Filed: 06 August 2010
ENVIRON SKIN CARE (PROPRIETARY),	}	Trademark: ENVIRON LOGO
LIMITED,	}	
<i>Respondent-Applicant.</i>	}	
x-----x		
	}	Decision No. 2013- 110

**DECISION BASED ON
COMPROMISE AGREEMENT**

MERCK KgaA ("Opposer"), filed on 26 July 2011 an opposition to Trademark Application Serial Nos. 4-2010-501157 and 42010-501158. The applications filed by ENVIRON SKIN CARE (PROPRIETARY) LIMITED ("Respondent-Applicant") covers the marks ENVIRON and ENVIRON LOGO for use on goods under Classes 03,05 and 10. The opposition is anchored on Sections 123.1 (d) of Republic Act No. 8293 otherwise known as The Intellectual Property Code of the Philippines.

This Bureau issued a Notice to Answer and served upon a copy thereof to Respondent-Applicant on 25 August 2011. The Respondent-Applicant filed its Answer on 23 December 2011.

Meanwhile, on 15 November 2011, the Opposer filed a "Motion to Consolidate Opposition Proceedings" praying for the consolidation of the instant opposition case and another opposition case docketed as IPC No. 14-2011-00312.

Pending the resolution by the Hearing Officer of the motion to consolidate, this Bureau in compliance to Office Order No. 154, s. 2010 ("Rules of Procedure for IPO Mediation Proceedings") and Office Order No. 197, s. 2010 ("Mechanics for IPO Mediation Settlement Period"), issued on 12 January 2012 Order No. 2012-12 referring the case to mediation. On 30 March 2012, however, the ADR Services of this Bureau submitted a Mediation Report

indicating a refusal of the parties to mediate the case. However, on 07 June 2013, the parties filed a Joint Motion for Approval of Co-Existence Agreement (with Prayer for Resolution of Motion to Consolidate Opposition Proceedings). Attached to the joint motion is the parties' CO-EXISTENCE AGREEMENT, the pertinent portions of which read, as follows:

"NOW THEREFORE, the parties agree as follows:

"1. ENVIRON shall:

1.1 never use its ENVIRON mark in relation to supplements for the treatment of Vitamin E deficiencies, and , to this end, hereby undertakes to amend its description of goods in trade mark application Nos. 4-2010-501157 and 4-2010-501158 to specifically exclude said supplements or the treatment of Vitamin E deficiencies. ENVIRON shall then provide MERCK's Philippine counsels a duplicate original copy of the formal communication lodged with the Intellectual Property Office (IPO) amending said description of goods, bearing the IPO's official stamp of receipt and acknowledgment of payment.

1.2 always use its ENVIRON word mark together with its distinctive ENVIRON device.

1.3 ENVIRON shall provide MERCK's Philippine counsels with the document mentioned in par. 1.1 above, simultaneously with the transmittal of two (2) original signed and duly authenticated/legalized copies of this Co-Existence Agreement to said Philippine counsels.

"2. Merck shall never interfere with the use and registration of ENVIRON's trademarks as reflected in Schedule "A", in relation to any goods or services which are not restricted as indicated in paragraph 1 above, inclusive.

"3. The parties shall be entitled to use and apply for the registration of marks incorporating ENVIRON and EVION respectively in accordance with the provisions of paragraphs 1 and 2 above, inclusive.

"4. Each party will make the terms of this agreement binding and effective upon its successors in title and assignees and the terms of this agreement will inure to the benefit of each party's successors in title, assignees, Licensees, registered users, associate and subsidiary companies and business.

"5. Each party will make the terms of this agreement binding and effective in the Philippines only."

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.

With respect to the motion to consolidate, the records show that both opposition cases have the same parties; that the subject matter of both opposition cases involved the mark ENVIRON; that the issues in both opposition cases would involve similar and/or related questions of fact and/or law and; that both opposition cases are assigned to the same Hearing Officer. Therefore, both opposition cases are proper subject of consolidation pursuant to Rule 31, Section 1 of the Rules of Court¹, which Rules have supplementary effect in the absence of a specific procedural rule in the rules and regulations governing *inter partes* cases. Be that as it may, the motion is deemed moot with the settlement by the parties of their disputes. The Compromise Agreement covers not only the instant case but also IPC No. 14-2011-00312.

WHEREFORE, premises considered, the COEXISTENCE AGREEMENT is hereby **APPROVED**. With the approved COEXISTENCE AGREEMENT having the force and effect of a decision or judgment, the parties are enjoined to faithfully comply with the terms set forth therein. Accordingly, the opposition cases docketed as IPC Nos. 14-2011-00311 and 14-2011-00312 are hereby **DISMISSED**.

Let the filewrapper of Trademark Application Serial Nos. 4-2010-501157 and 42010-501158, together with a copy of this Order, be returned to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Taguig City, 20 June 2013.


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



/vanj

¹ Section 1. *Consolidation*. - When actions involving a common question of law or fact are pending before the court, it may order a joint hearing or trial of any or all the matters in issue in the actions; it may order all the actions consolidated; and it may make such orders concerning proceedings therein as may tend to avoid unnecessary costs or delay.