



**NUMATIC INTERNATIONAL LIMITED,** }  
*Opposer,* }  
 }  
 -versus- }  
 }  
**YANG HUA HUANG,** }  
*Respondent-Applicant.* }  
 x-----x

**IPC No. 14-2012-00109**  
 Case Filed: 04 May 2012  
 Opposition to:  
 Appln. Serial No. : 4-2011-008657  
 Date Filed: 25 July 2011  
 TM: **"HENRY & DEVICE"**  
 Decision No. 2013- 114

**Decision Based on  
 Compromise Agreement**

**NUMATIC INTERNATIONAL LIMITED** ("Opposer") filed on 04 May 2012 an opposition to Trademark Application Serial No. 4-2011-008657. The application filed by **YANG HUA HUANG** ("Respondent-Applicant") covers the mark **"HENRY & DEVICE"** for use on goods under Classes 07 and 08.

This Bureau issued a Notice to Answer dated 10 May 2012 and served a copy thereof upon the Respondent-Applicant on 21 May 2012. The Respondent-Applicant filed his Answer on 22 June 2012.

On 13 June 2013 a Joint Motion for Approval of Co-Existence Agreement duly signed by the parties was submitted for the approval of this Bureau. The pertinent portion of the COMPROMISE AGREEMENT reads, as follows:

- "1. YH shall within 14 days of this Agreement:
  - 1.1 withdraw the Philippine Trademark Application No. 14-2011-008657;
  - 1.2 file a request at the Australian Trademarks Registry to partially limit or surrender the specifications of Australian Trademark Applications in Nos. 1479426 and 1479428 as follows: *Class 8 of the Nice Classifications: "Hand tools; none of the aforementioned being for polishing, scrubbing, shampooing, sanding, sweeping, cleaning, carpet cleaning, floor mopping, vacuuming or shampooers or scrubbers or used in relation to and/or substitutable for polishing machines, scrubbing machines, shampooing machines, sanding machines, sweeping machines, cleaning machines, carpet cleaning machines, floor mopping machines, vacuum cleaners, vacuum cleaner bags, shampooers or scrubbers; or parts and fittings for all the aforesaid goods; and*
  - 1.3 file a request at the Hong Kong Trademarks Registry to partially limit or surrender the specifications at Hong Kong Trademark Applications Nos. 302185614, 302185623 and 302189836 as

follows: *Class 8 of the Nice Classifications: "Hand tools (hand operated); none of the aforementioned being for polishing, scrubbing, shampooing, sanding, sweeping, cleaning, carpet cleaning, floor mopping, vacuuming or shampooers or scrubbers or used in relation to and/or substitutable for polishing machines, scrubbing machines, shampooing machines, sanding machines, sweeping machines, cleaning machines, carpet cleaning machines, floor mopping machines, vacuum cleaners, vacuum cleaner bags, shampooers or scrubbers or parts and fittings for all the aforesaid goods.*

"2. The Yatai Parties whether acting jointly or severally agree:

2.1 not to:

2.1.1 register or use in Australia, Hong Kong or the Philippines any mark containing and/or comprising HENRY in any form or style now or at any time in the future for or in relation to: *"any goods in Classes 7 or 8 for polishing, scrubbing, shampooing, sanding, sweeping, cleaning, carpet cleaning, floor mopping, vacuuming or shampooers or scrubbers, or used in relation to and/or substitutable for polishing machines, scrubbing machines, shampooing machines, sanding machines, sweeping machines, cleaning machines, carpet cleaning machines, floor mopping machines, vacuum cleaners, vacuum cleaner bags, shampooers or scrubbers; or parts and fittings for all the aforesaid goods".*

2.1.2 use anywhere else in the world any mark containing and/or comprising HENRY in any form or style now or at any time in the future for or in relation to the goods set in Clause 2.1.1 of this Agreement.

2.2 without prejudice and limitation to Clause 2.1.1 of this Agreement, to expressly exclude the goods specified in Clause 2.1.1 from any existing or future trademark application or registration for any mark containing and/or comprising HENRY in any form or style filed in the name of any of the Yatai Parties and/or in the name of any of their Associated Company (as defined in Clause 10 of this Agreement) in Australia, Hong Kong or the Philippines not expressly referred to in Clause 1 of this Agreement by filing a notice to partially surrender such goods at the relevant Registry.

"3. In the event that the partial surrender of any of the trademark applications or registrations set out in Clauses 1.2, 1.3, 2.1.1 or 2.2 of this Agreement is not accepted by any of the relevant Trademarks Registries, the Yatai Parties shall use their best endeavours to agree to an alternative amendment or restriction to the specification of such trademark application(s) or

registration(s) with Numatic, which the Yatai Parties shall forthwith file at the relevant Trademarks Registries. In the event that the relevant Trademark Registries refuse such further amendments to the specifications, the Yatai Parties shall forthwith withdraw or surrender the said trademark applications or registrations in Classes 7 and/or 8, without prejudice to the right to file new trademark applications for the same mark provided such applications accord with Clause 2.1.1 and Clause 2.2. of this Agreement.

"4. The Yatai Parties jointly and severally acknowledge Numatic's prior rights to the Numatic Marks and its use for the goods covered by Numatic's Marks and undertake not to derive any rights from the Yatai Parties use or registration of any of its trademark marks containing and/or comprising HENRY against the Numatic Marks or to contest Numatic's use or registration of the Numatic Marks or any mark containing or comprising HENRY in any form or style in respect of any goods in Class 7 of the Nice Classification anywhere in the world, save in respect of non-use. The Yatai Parties, shall, if requested by the relevant Registries, at Numatic's costs and expense, expressly grant consent and execute all such necessary documents to allow the registration of the Numatic Marks or any mark containing or comprising HENRY in any form or style in respect of any goods in Class 7 of the Nice Classification anywhere in the world.

"5. Numatic undertakes:

5.1 to withdraw all pending Oppositions within 14 days of receipt of the withdrawal and acceptance by the relevant Trademarks Registries of the partial surrender of the trademark applications referred to in Clause 1.2 and 1.3 of this Agreement;

5.2 not to contest the Yatai Parties:

5.2.1 use or, save in respect of non-use, registrations in Australia, Hong Kong or the Philippines of any mark containing or comprising HENRY in any form or style in relation to any goods in Class 7 or Class 8 of the Nice Classification, insofar as such use and registration by the Yatai Parties is consistent with Clauses 1 and 2.1.1 of this Agreement; and

5.2.2 use anywhere else in the world of any mark containing or comprising HENRY in any form or style in relation to any goods in Class 7 or Class 8 of the Nice Classification, insofar as such use by the Yatai Parties is consistent with Clause 2.1.1 of this Agreement; and

5.2.3 if requested by the relevant Registries in Australia, Hong Kong and the Philippines, at the Yatai Parties' costs and expense, to expressly grant consent and execute all such necessary documents to allow the Yatai Parties registration of the marks set

out in Clause 5.2.1 above insofar as such registration is consistent with Clause 1 and 2.1.1 of this Agreement.

"6. The Parties shall at the request and reasonable expense of the other, assist each and execute any documents to fulfill the spirit and terms of this Agreement and to effect the compromise reached in this Agreement and to use reasonable endeavours to take such action as necessary to avoid or limit confusion without being required to stop using their trademarks.

"7. The Yatai Parties represent and warrant that as the date of this Agreement, there are no trademark registrations or applications that contain and/or comprise HENRY in any form or style in Classes 7 or 8 of the Nice Classification anywhere in the world other than those set out in Annex B.

"8. Subject to Clauses 4, 5.3 and 6 of this Agreement, the Parties agree to bear their own costs in respect of the dispute referred to in the Agreement and the settlement thereof.

"9. The Yatai Parties shall send Numatic copies of all requests filed at the relevant Trademark Registries to withdraw or surrender any trademark application referred to in this Agreement at the same time as filing such requests, and within 3 days of receipt, send Numatic copies of all response including refusals and/or acceptance received by the relevant Trademarks Registries in respect thereto. All such notices shall be sent to Numatic's UK Trademark Attorneys Cleveland, 10 Fetter Lane, London EC4A 1BR, fax number 00 44 207 583 9575 under reference YH/57774 Any notices or communications Numatic sends to the Yatai Parties shall be sent to Yatai International Corporation, 2673-CR Alunan St., Malate, Manila, Philippines.

"10. This Agreement shall be binding on and benefit the Parties, their "Associated Companies" (that is their wholly owned subsidiaries, ultimate holding company and all subsidiaries of such ultimate holding company) licensees, all successors in title and assigns. Notwithstanding the foregoing, the Parties shall remain responsible for the complete discharge of their obligations under this Agreement and shall ensure their Associated Companies, licensees and all successors in title are made aware of and observe the terms of this Agreement.

"11. Should one or any of the provisions of this Agreement be, or become, invalid in whole or in part, or if there is an omission in the Agreement, the validity of the remaining provisions shall not be affected. In place of the invalid provision or to fill an omission, an appropriate provision shall be effective which, to the extent legally possible, most closely reflects the intention of the contractual Parties if they had considered this point.

"12. This Agreement constitutes the entire agreement between the Parties in settlement of all disputes regarding the marks the subject of this Agreement and any variations of this Agreement must be in writing signed by the Parties.

"13. This Agreement shall be governed by Philippine law and subject to the non-exclusive jurisdiction of the Philippine courts. In the event of a dispute in relation to the present Agreement, the Parties shall follow the dispute resolution set out below before commencing a Court Action:

- 13.1 the Party shall write to the offending Party as appropriate to put them on notice of any breach of this Agreement, and providing 21 days to remedy such breach if the breach is capable of remedy;
- 13.2 in the event that the dispute cannot be resolved as referred in Clause 14.1 any Party may refer the dispute to determination in accordance with the mediation procedure administered by the World Intellectual Property Organization (WIPO) Mediation Rules. The place of mediation shall be the Intellectual Property Office Philippines and the language to be used in the mediation shall be English, the costs of the mediator being split equally between the Parties, who shall otherwise bear their own costs of the reference.

This Bureau finds that the Joint Motion for Approval of Co-Existence Agreement has been duly entered into by the parties with the terms and conditions thereof not contrary to law, morals, good custom, public order or public policy.

In this regard, an approved Joint Motion for Approval of Co-Existence Agreement shall have the effect of a decision or judgment on the case.

**WHEREFORE**, premises considered, the parties' JOINT MOTION FOR APPROVAL OF CO-EXISTENCE AGREEMENT is hereby **APPROVED**. Accordingly, with the approved JOINT MOTION FOR APPROVAL OF CO-EXISTENCE AGREEMENT having the force and effect of a decision or judgment, the parties are enjoined to faithfully comply with the terms set forth therein.

**SO ORDERED.**

Taguig City, 19 June 2013.

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