



SUYEN CORPORATION,
Opposer,

-versus-

SUN AND SKIN CARE RESEARCH, INC.,
Respondent-Applicant.

X-----X

}
} IPC No. 14-2011-00155
} Opposition to:
} Appln. Serial No. 4-2010-5000322
} Filing Date: 12 Jan. 2010
} Trademark: "OCEAN POTION"

NOTICE OF DECISION

MIGALLOS & LUNA LAW OFFICES

Counsel for Opposer
7th Floor, The Phinma Plaza
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Makati City

JDF LAW


Counsel for Respondent-Applicant
1502 One Global Place
5th Avenue cor. 25th Street
Bonifacio Global City
Taguig City

GREETINGS:

Please be informed that Decision No. 2012 – 153 dated August 28, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 28, 2012.

For the Director:


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

CERTIFIED TRUE COPY


MARILYN F. RETURAL



SUYEN CORPORATION,	}	IPC NO. 14-2011-00155
<i>Opposer,</i>	}	Case Filed: 19 Apr. 2011
	}	Opposition of:
-versus-	}	
	}	Appln. No. 4-2010-5000322
SUN AND SKIN CARE RESEARCH,	}	Date filed: 12 Jan 2010
INC.,	}	
<i>Respondent-Applicant.</i>	}	TM : "OCEAN POTION"
	}	
x-----x	x	Decision No. 2012- 153

**DECISION BASED ON
COMPROMISE AGREEMENT**

SUYEN CORPORATION ("Opposer"), filed on 19 April 2011 an opposition to Trademark Application Serial No. 4-2010-5000322. The application filed by SUN AND SKIN CARE RESEARCH, INC. ("Respondent-Applicant"), covers the mark "OCEAN POTION" for use on goods under Class 03. The opposition is anchored on Sections 123.1 (d) and 155.1 of R.A. 8293 otherwise known as the Intellectual Property Code of the Philippines.

This Bureau issued a Notice to Answer dated 20 May 2011 and served upon a copy thereof to Respondent-Applicant on 26 May 2011. The Respondent-Applicant filed its Answer on 26 September 2011.

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*"), this Bureau issued on 07 October 2011 Order No. 2011-296 referring the case to mediation.

On 07 June 2012 the ADR services of this Bureau submitted a Mediation Report indicating a settlement by the parties' of the case. Attached to the report is the parties' COMPROMISE & COEXISTENCE AGREEMENT. The pertinent portions of the Agreement read, as follows;

- "1. SSCRI hereby agrees and undertakes as follows:
 - 1.1. SSCRI shall use the mark 'OCEAN POTION (DESIGN)' only in the manner and form depicted in the Design Application, a copy of which is attached hereto and made an integral part hereof as Annex 'A' (hereinafter the 'Permitted Design Mark');
 - 1.2. SSCRI shall not, by itself or through other persons or entities, use the Permitted Design Mark, or the words 'OCEAN POTION', which forms part of the permitted Design Mark, as a word mark, or in any other manner confusingly similar with SUYEN's Registered Mark;
 - 1.3. SSCRI shall not, by itself or through other persons or entities, use, register or seek registration of the Registered Mark, or any other

mark containing the word 'POTION' other than the Permitted Design mark;

1.4. SSCRI shall not use the permitted Design mark in connection with the Body Spays, such as or in the form of, Eau de Cologne, Eau de Toilette, Eau de Parfum, Deo Cologne and Deo Body Spray;

1.5. SSCRI shall not seek the cancellation of the Registered Mark of SUYEN.

"2. SUYEN hereby agrees and undertakes as follows:

2.1. SUYEN hereby permits SSCRI to use the Permitted Design Mark in accordance with this Agreement and to proceed with its Design Application. Suyen hereby agrees to withdraw its Opposition case against the Design Application;

2.2. SUYEN shall not, by itself or through other persons or entities, use its Registered Mark in any manner confusingly similar to the Permitted Design Mark of SSCRI;

2.3. SUYEN shall not, by itself or through other persons or entities, use, register or seek registration of the mark covered by the Design Application of SSCRI, or any other mark containing the words 'OCEAN POTION';

2.4. SUYEN shall not use its Registered Mark in connection with the following goods:

'Sunblock oils, sunscreen oils, self-tanning oils, sunblock lotions, sunscreen lotions, self-tanning lotions, after sun lotions'

It is hereby agreed by the parties that the limitation in paragraph 2.4 hereof shall not apply to lotions, sprays, creams or other products under class 3 which are not primarily sunblock products but has SPF or sunscreen component that SUYEN may manufacture or produce in the future.

2.5. SUYEN shall allow SSCRI to modify the wave design logo or any other element of the Permitted Design Mark provided that such modifications or changes in the Permitted Design Mark are neither material nor substantial so as to affect the general appearance or orientation of the Permitted Design Mark, provided, further, that the use of the word 'POTION' in combination with any other word other than 'OCEAN' even if the wave design logo is not altered or modified shall amount to a violation by SSCRI of this Agreement.

"3. SUYEN agrees and acknowledges that in the instances provided in Sections 3.1, 3.2 and 3.3 below, it is difficult on the part of SSCRI to make reference to or cite the Permitted Design Mark in the form depicted in the Design Application or to control the manner in which it is presented. Thus, the Parties hereby agree that in the following cases, reference to or use of the mark 'OCEAN POTION' in word form shall be allowed and shall not constitute a violation by SSCRI of this Agreement:

3.1. Third-party write-ups and news articles;

3.2. Write-ups found in the website of SSCRI as long as the Permitted Design Mark is prominently displayed on such website or webpage where such write-ups appear;

3.3. Write-ups or product information found in brochures, flyers or other advertising materials, provided that the materials on which said write-ups or product information are included prominently displays the Permitted Design Mark.

"4. It is hereby agreed by the parties that SSCRI may use the mark 'OCEAN POTION' in a stylized form, as depicted in Annex 'B' hereof, and only in such form, provided that the use thereof shall be limited to its present use which is in the loading page of the flash site of SSCRI's website. It is further agreed that the stylized form of the 'OCEAN POTION' mark shall not appear in any other page of SSCRI's website including its homepage.

"5. The parties hereby agree that the violation by SSCRI of its commitment or agreement to use only the Permitted Design Mark and not to register or cause the registration of any other mark with the word 'POTION' shall constitute full and sufficient ground to cancel the Permitted Design Mark or to oppose and cancel the registration of the said other mark with the word 'POTION'

"6. It is hereby agreed that SSCRI may register or seek registration of the modified Permitted Design Mark provided that the conditions set forth under paragraph 2.5 hereof are complied with, and without prejudice the SUYEN's right to oppose or seek cancellation of, the application or registration, if the modified permitted Design Mark sought to be registered has substantially altered or changed the original orientation of the Permitted Design Mark.

"7. This Agreement is entered into by the parties without prejudice to the Compromise & Coexistence Agreement entered into by the parties in relation to Inter Partes Case No. 14-2011-00290 insofar as the terms and conditions therein are applicable.

"8. For and in consideration of the foregoing agreements and undertakings of SSCRI, SUYEN hereby agrees to withdraw and dismiss the Opposition. The Parties upon execution hereof file a Joint Motion for Judgment Based on Compromise Agreement praying for the issuance by IPOPHIL of a judgment in the Opposition based on this Agreement, including the dismissal of the Opposition under the terms and conditions hereof.

"9. This Agreement shall be effective upon issuance by IPOPHIL of such judgment based on this Agreement.

"10. This Agreement may be signed in any number of counterparts. Any single counterpart executed by SUYEN and SSCRI shall together constitute a full and original Agreement for purposes hereof."

This Bureau evaluated the COMPROMISE & COEXISTENCE 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.¹

WHEREFORE, premises considered, the parties' COMPROMISE & COEXISTENCE AGREEMENT is hereby **APPROVED**. Accordingly, the instant opposition case is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2010-5000322 be returned, together with a copy of this Order, to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 28 August 2012.


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

¹ Office Order No. 154 Series of 2010