



SCENTRAL LABORATORIES, INC.,
Opposer,

-versus-

GOLDEN ABC, INC.,
Respondent- Applicant.

}
} IPC No. 14-2012-00186
} Opposition to:
} Appln. Serial No. 4-2011-011092
} Date Filed: 15 September 2011
} TM: "ACQUA BENE BY
} PENSHPPE"
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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2014 - 182 dated July 14, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 14, 2014.

For the Director:

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



SCENTRAL LABORATORIES INC.,	}	IPC NO. 14-2012-00186
Opposer,	}	Opposition to:
	}	Application Serial No. 4-2011-011092
- versus -	}	Date Filed: 15 Sept 2011
	}	Trademark: ACQUA BENE BY PENSHOPPE
GOLDEN ABC, INC.,	}	
Respondent-Applicant.	}	
x-----x		Decision No. 2014 - <u>182</u>

DECISION BASED ON COMPROMISE AGREEMENT

SCENTRAL LABORATORIES INC., (“Opposer”) filed on 11 June 2012 an opposition to Trademark Application Serial No. 4-2011-011092. The application filed by GOLDEN ABC, INC. (“Respondent-Applicant”) covers the mark **ACQUA BENE BY PENSHOPPE** for use on goods under Class 03. The opposition is anchored on Section 123.1 (d) of R.A. 8293 also known as the Intellectual Property Code of the Philippines (“IP Code”).

Pursuant to the Regulations on Inter Partes Proceedings, this Bureau issued a Notice to Answer and served a copy thereof to Respondent-Applicant on 20 June 2012. The Respondent-Applicant filed its Answer on 17 September 2012.


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 28 September 2012 Order No. 2012-197 referring the case to mediation.

On 09 July 2014, the ADR Services of this Bureau submitted a Mediation Report indicating a settlement by the parties. Attached to the report is the parties' COMPROMISE & CO-EXISTENCE AGREEMENT, the pertinent portion of which reads:

“NOW THEREFORE, for and in consideration of the foregoing premises and of the terms and conditions hereinafter set forth, the Parties hereby agree as follows:

“1. GOLDEN ABC hereby agrees and undertakes as follows:

1.1 Notwithstanding the existence of trademarks registered before the IPOPHL in the name of GOLDEN ABC containing 'ACQUA', GOLDEN ABC shall at all times use the mark 'ACQUA' only with or accompanied by the word 'BENE' or 'BELLA', with equal prominence as 'ACQUA, or with the words 'ENE' OR 'BELLA' in bigger font or presented more prominently than 'ACQUA' (hereinafter the 'Permitted Mark'), including on all products, labels, advertising and promotional materials (collectively 'Products and Materials').

For the avoidance of doubt, the use of 'ACQUA' in the following manner  or as currently used by GOLDEN ABC shall be deemed non-compliant with the foregoing paragraph.

GOLDEN ABC hereby agrees that immediately upon issuance of judgment granting and/or approving the Joint Motion for Judgment based on Compromise Agreement *in toto* under Section 6 hereof, GOLDEN ABC shall amend the Application to adjust the representation of word 'ACQUA' to equal its prominence with that of the word 'BENE' or make 'BENE' larger or more prominent than 'ACQUA'.

1.2 GOLDEN ABC may use the word 'ACQUA' with the words 'BENE' or 'BELLA' as it is currently used and understood to be non-compliant with this Agreement. Including use on all its Products and Materials only until June 17, 2015 (the 'Selloff Period').

1.3 GOLDEN ABC shall not, by itself or through other persons or entities, use the word 'ACQUA' alone or 'AQUA' alone, but always in combination with the words 'BENE' or 'BELLA'.

1.4 GOLDEN ABC shall not, by itself or through other persons or entities, use the Permitted Mark in any manner confusingly similar with SCENTRAL's Registered Mark.

1.5 GOLDEN ABC 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 'ACQUA' or 'AQUA' other than the Permitted Mark, or seek the cancellation of the Registered Mark.

"2. SUYEN and SCENTRAL hereby agree and undertake as follows:

2.1 SUYEN and SCENTRAL agree that GOLDEN ABC may use the Permitted Mark in accordance with this Agreement and hereby permit GOLDEN ABC to proceed with its Application as amended in accordance with Section 1.1 hereof.

2.2 SUYEN and SCENTRAL shall not, by itself or through other persons or entities, use, register or seek registration of the Permitted Mark, or any other mark containing the words 'ACQUA BENE' or 'ACQUA BELLA' or use its Registered Mark in any manner confusingly similar to the Permitted Mark.

"3. The Parties hereby agree that breach by GOLDEN ABC of this Agreement shall constitute full and sufficient ground and basis for the IPOPHL to deny the Application or cancel any registration of the Permitted Mark or any other registered mark of GOLDEN ABC with the word 'ACQUA'



or 'AQUA', on the basis of GOLDEN ABC's deemed admission of SUYEN and SCENTRAL's position that the Permitted Mark and the said other registered marks are confusingly similar to the Registered Mark.

"4. The Parties further agree that breach by SUYEN and SCENTRAL of this Agreement shall constitute full and sufficient ground and basis for the IPOPHL to dismiss the Opposition and grant registration of the Permitted Mark based on SUYEN and SCENTRAL's deemed admission of the position of GOLDEN ABC that the Permitted Mark is not confusingly similar to the Registered Mark.

"5. For and in consideration of the foregoing agreements and undertakings of GOLDEN ABC, SCENTRAL hereby agrees to withdraw the Opposition subject to this Agreement.

"6. The Parties shall upon execution hereof file a Joint Motion for Judgment Based on Compromise Agreement praying for the issuance of the IPOPHL of a judgment in the Opposition based on this Agreement, including the dismissal of the Opposition under the terms and conditions hereof.

"7. The Parties hereby acknowledge that they have entered into similar Compromise and Coexistence Agreements ('the other Agreements') in connection with the following marks: i) 'ACQUABENE' covered by GOLDEN ABC's pending Trademark Application No. 4-2010-013892 which was opposed by SUYEN, for and on behalf of SCENTRAL, in Inter Partes Case No. 14-2012-00449; ii) 'ACQUA BELLA' covered by GOLDEN ABC's pending Trademark Application No. 4-2010-012741 which was opposed by SCENTRAL in Inter Partes Case No. 14-2011-00364; and iii) 'ACQUACLEAR' covered by GOLDEN ABC's pending Trademark Application No. 4-2011-014486 which was opposed by SCENTRAL in Inter Partes Case No. 14-2012-00187 ('the Other Oppositions'). This Agreement shall be effective upon issuance by IPOPHL in the present Opposition of its judgment based on the said Other Agreements, whichever is later.

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

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.¹

¹ Office Order No. 154 Series of 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. 4-2011-011092 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 14 July 2014.


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

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