



FUTURE STATE INC.,
Opposer,

-versus-

JD SPORTS FASHION PLC.,
Respondent-Applicant.

X-----X

}
} IPC No. 14-2012-00578
} Opposition to:
} Appln No. 4-2012-009387
} Date filed: 31 July 2012
} TM: "FLY53"
}

NOTICE OF DECISION

MIGALLOS & LUNA LAW OFFICES

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Makati City

SYCIP SALAZAR HERNANDEZ & GATMAITAN

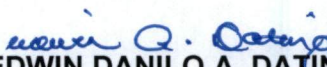
Counsel for Respondent-Applicant
SyCipLaw Center
105 Paseo de Roxas, Makati City

GREETINGS:

Please be informed that Decision No. 2015 - 01 dated January 06, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 06, 2015.

For the Director:


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



FUTURE STATE INC.,	}	IPC No. 14-2012-00578
Opposer,	}	Opposition to:
	}	
-versus -	}	Application Serial No. 4-2012-009387
	}	Date Filed: 31 July 2012
JD SPORTS FASHION PLC.,	}	Trademark: FLY53
Respondent-Applicant.	}	
X-----X		Decision No. 2015 - <u>01</u>

**DECISION
BASED ON COMPROMISE AGREEMENT**

FUTURE STATE INC. ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-009387 on the ground that the Respondent-Applicant's mark is confusingly similar to the Opposer's registered trademark "FLY53" which is applied for under Class 25.

This Bureau issued a Notice to Answer and served a copy thereof to the Respondent-Applicant on 14 March 2013. The Respondent-Applicant did not file its Answer. The parties, however, manifested their intention to amicably settle the case and requested for additional period within which to submit the Coexistence Agreement.

On 10 December 2014, the parties filed a Joint Motion for Judgment Based on Compromise Agreement. Attached to the Motion is the parties' Coexistence Agreement, the pertinent portion of which reads:

"NOW THEREFORE, in consideration of the mutual covenants herein contained, the Parties hereto agree as follows:

1. **JD SPORTS** hereby undertakes:
 - a. To always use, in the Philippines, mark "FLY" with "53" and only in such a manner where "53" shall appear more prominently or with equal prominence as "FLY" (hereafter the "Permitted Mark");
 - b. To use the Permitted Mark only in relation to the following goods in the Philippines:

Class 18: Bags; trunks and travelling bags; holdalls, back packs and rucksacks; wallets, key cases; purses and pouches; credit card cases; record bags; book bags; handbags; sports bags; shopping bags; luggage and suitcases, weekend bags
Class 25: Anoraks, athletic uniforms, t-shirts, bathing costumes for women, bathing suits, bathing trunks, beachwear,

belts, Bermuda shorts, bikinis, blazers, blouses, blousons, board shorts, bottoms, boxer briefs, boxer shorts, briefs, camp shirts, capes, Capri pants, capris, cardigans, cargo pants, coats, denim pants, dress shirts, dress suits, dresses, dungarees, fleece pullovers, fleece shorts, frocks, gloves, halter tops, jackets, jeans, jerseys, jumpers, knit shirts, lounge pants, loungewear, trousers, vests, men's socks, overcoats, parkas, pique shirts, polo shirts, pullovers, quilted vests, rain jackets, raincoats, rainproof jackets, rugby tops, shirts, short trousers, shorts, short-sleeved and long-sleeved t-shirt, snowboarding suits, snow pants, snow suits, snowboard gloves, snowboard pants, suede jackets, surf wear, sweatpants, sweatshirts, sweat shorts, sweat suits, sweaters, sweatsocks, swim trunks, swimwear, track pants, tracksuits, trench coats, waterproof jackets and pants, wind resistant jackets, windcheaters, windjammers, wind jackets, women's underwear, headgear, namely, bandanas, beanies, berets, caps, headwear, hats, hooded sweatshirts, hoods, sweatbands, belts and footwear, namely, men's, women's and children's boots and shoes, hiking boots, slippers, training shoes, boat shoes work shoes and boots, moccasins, sandals, wellington boot:

- c. Not to sell goods in class 3 (i.e., Fragrances) under the FLY53 mark in the Philippines; and
 - d. That it 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 "FLY" other than the Permitted Mark, and that it shall not question, whether through a cancellation action or opposition proceeding, the ownership and use by FUTURE STATE of the Registered Mark or the mark "FLY", which Future State may in the future register or seek registration of for goods other than Class 3.
2. **FUTURE STATE, INC.** hereby undertakes to:
- a. Withdraw its opposition to the Trademark Application;
 - b. Not object to the use by JD SPORTS of the Permitted Mark, in any form whatsoever, in relation to goods in classes 18 and 25 in the Philippines as provided for in paragraph 1(b) of this Agreement, as long as said use and registration is in accordance with this Agreement; and
 - c. It shall not by itself, or through other persons or entities, use, register, or seek registration of the Permitted Mark, and that it shall not question, whether through a cancellation or opposition proceeding, the ownership by

JD SPORTS of the Permitted Mark in the Philippines in relation to goods in classes 18 and 25 as provided for in paragraph 1(b) of this Agreement.

3. The Parties undertake to use reasonable commercial efforts to ensure that there will be no likelihood of confusion or deception between the Registered Mark and the Permitted Mark, and should either Party become aware of any actual confusion or deception in the market, such Party will review the matter with the other Party in good faith so as to promptly minimize or put a stop to the confusion or deception;
4. The Parties undertake not to imitate or copy the trade dress or packaging used by the other in respect of the respective goods covered by the Registered Mark and the Permitted Mark;
5. This Agreement shall be limited to the Philippines and shall be binding, valid and enforceable against, and the benefits thereof shall inure not only to be Parties hereto but also to the subsidiaries, successors, licensees, assigns, and parties in privity with them, as well as other parties validly exploiting the trademarks and designated as such;
6. Each Party represents and warrants that it has full authority and legal capacity to enter this Agreement and has the capacity to carry out all obligations and requirements herein;
7. Each Party represents and warrants that entry into this Agreement does not violate any other agreements executed or entered into by the Party or on its behalf;
8. Each Party shall bear its own costs in connection with Inter Partes Case No. 12-2012-00578 and the preparation, execution of and compliance with this Agreement;
9. The terms and conditions of this Agreement may be amended, waived or modified only by an agreement in writing signed by the Parties or their respective assigns or successors in interest;
10. The Parties acknowledge that they have read and understood the contents of this Agreement and that they have signed the same willingly, voluntarily and with full knowledge of their rights and obligations; and


11. This Agreement embodies the entire agreement between the Parties with respect to the subject matter and supersedes all prior correspondence and agreements.
12. This Agreement may be signed in any number of counterparts. Any single counterpart executed by FUTURE STATE and JD SPORTS shall together constitute a full and original Agreement for purposes thereof."

This Bureau evaluated the Co-existence Agreement and finds that the same have 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.

WHEREFORE, premises considered, the parties' Joint Motion for Judgment Based on 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. 4-2012-009387 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 06 January 2015.


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

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