

WESTMONT PHARMACEUTICALS, INC.,
Opposer,

-versus-

TAIHO PHARMACEUTICALS CO, LTD.,
Respondent-Applicant.

}	IPC No. 14-2016-00116
}	Opposition to:
}	
}	Appln. Serial No. 4-2015-014273
}	Date Filed: 16 December 2015
}	
}	TM: SOLMACK

X-----X

**NOTICE OF DECISION
(DECISION BASED ON COMPROMISE AGREEMENT)**


OCHAVE & ESCALONA
Counsel for Opposer
No. 66 United Street,
Mandaluyong City

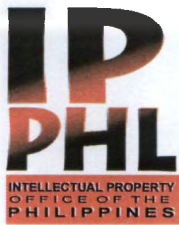
E.B. ASTUDILLO & ASSOCIATES
Counsel for Respondent- Applicant
10th Floor, Citibank Center
8741 Paseo de Roxas, Makati City

GREETINGS:

Please be informed that Decision No. 2017 - 71 dated 14 March 2017 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 15 March 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



WESTMONT PHARMACEUTICALS, INC }
Opposer, }

-versus- }

TAIHO PHARMACEUTICAL CO, LTD., }
Respondent-Applicant. }

x-----x

IPC No. 14-2016-00116

Opposition to:

Appln. Serial No. 4-2015-014273

Date Filed: 16 December 2015

Trademark: SOLMACK

Decision No. 2017 - 71

DECISION BASED ON COMPROMISE AGREEMENT

WESTMONT PHARMACEUTICALS, INC (“Opposer”) filed a verified Notice of Opposition to Trademark Application No. 4-2015-014273. The application, filed by TAIHO PHARMACEUTICAL CO, LTD., (“Respondent-Applicant”), covers the mark SOLMACK for goods in Class 5 of International Classification of Goods.

The Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 8 April 2016. The Respondent-Applicant filed a Verified Answer on 7 July 2016.

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 July 2016 Order No. 2016-073 referring the case to mediation.

On 13 March 2017, the Alternative Dispute Resolution Services (“ADRS”) of this Bureau submitted a Mediation Report indicating a settlement by the parties. Attached to the report is a copy of the parties Compromise Agreement, the pertinent portions of which reads, as follows:

“NOW, THEREFORE, the parties, desirous of putting an expeditious end to the Opposition proceeding, have agreed by way of amicable settlement as follows:

1. TAIHO hereby undertakes, in respect to pharmaceutical and veterinary preparations of Class 5, to:

(a) Limit the 014273 Trademark Application to the following goods under Class 5 of the International Classification of Goods:

“GASTROINTESTINAL DRUGS”

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center # 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio,
Taguig City 1634 Philippines • www.ipophil.gov.ph
T: +632-2386300 • F: +632-5539480 • mail@ipophil.gov.ph

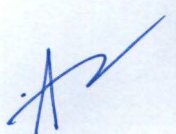
- (b) File an amendment with the Bureau of Trademarks of the IPOPHL to amend the covered goods in the 014273 Trademark Application to "CLASS 5: GASTROINTESTINAL DRUGS" within fourteen (14) calendar days from the Effective Date (as defined hereinafter), and provide a copy thereof, stamped received by the IPOPHL, to WESTMONT within seven (7) calendar days from receipt of said copy.
- (c) NOT apply in the future for registration of the mark "solmack" for goods under Class 5 of International Classification of Goods as " Mucosolvent preparation for tracheobronchial secretions" with the IPOPHL or as otherwise indicated in Section 1(a) above;
- (d) NOT put any restraint on WESTWONT's use of the trademark "SOLMUX" in the Philippines, as long as such trademark is registered for goods within a scope of pharmaceutical and veterinary preparations of Class 5, other than for Gastrointestinal Drugs; and
- (e) NOT commence any opposition or cancellation against any trademark application or registration with WESTMONT (i) has filed, may decide to file, to the extent that said file or decision is within scope of pharmaceutical and veterinary preparations of Class 5, other than the Gastrointestinal Drugs for the trademark "SOLMUX" in the Philippines, or (ii) has obtained for the trademark "SOLMUX" in the Philippines as of Effective Date; provided, that TAIHO complies with the terms of this Agreement.

2. For and in consideration of the foregoing undertakings and subject to the faithful performance by TAIHO of its undertakings set forth above, WESTMONT hereby undertakes, to:

- 2.1 Withdraw its opposition in the Case within fourteen (14) days from receipt of the copy of the amendment by Taiho pursuant to Section 1(b) above;
- 2.2 NOT object (i) to the registration by TAIHO of, and (ii) put any restraint on TAIHO's or its licensees' use of, the mark "solmack" used for "GASTROINTESTINAL DRUGS"; and
- 2.3 NOT commence any opposition, cancellation action or take any action against any trademark application or registration with 014273 Trademark Application; provided, that WESTMONT complies with the terms of this Agreement.

3. Immediately upon the execution of this Agreement, the Parties shall submit the signed Agreement to the assigned mediator in the Case for the approval by the Bureau of Legal Affairs.

4. The Parties agree that each Party shall not be obliged to pay to the other Party any compensation, fee or charge in connection with the



subject matter under this Agreement. Each Party shall bear its own costs and expenses incurred in carrying out each of their respective undertakings and obligations required under this Agreement, including but not limited to, attorney's fees and filing fees, incurred in relation to this Case.

5. The Parties undertake to observe the terms and conditions of this Agreement in utmost good faith.

6. The Parties hereby agree that their respective addresses as set forth below shall be their respective addresses for purposes of notice, communication and demand, if any be required under this Agreement until and unless another address shall be formally communicated to the other Party in writing.

If to WESTMONT:

OCHAVE & ESCALONA
No. 66 United Street
Mandaluyong City

If to TAIHO:

E.B. ASTUDILLO & ASOCIATES
Citibank Center, 10th Floor
8741 Paseo de Roxas, Makati City

7. Unless otherwise expressly stated herein, each Party shall maintain in confidence the existence and the terms and conditions of this Agreement and shall not disclose or divulge those to a third party without the prior written consent of the other Party.

8. The Parties acknowledge that their respective signatories have full authority and/or have secured the necessary approvals to execute, and do execute, this Agreement on behalf of their principals and that the Parties have the authority to comply with the undertakings, obligations and acknowledgements made in this Agreement. The Parties hereto further acknowledge that they have executed this Agreement voluntarily with full knowledge of its consequences under the law.

9. This Agreement shall bind and inure to the benefit of each Party and its directors, officers, employees, parent corporations, subsidiaries, affiliates, predecessors, successors, licensees, agents and assigns. Further, the Parties also undertake to impose the undertakings, obligations and requirements under this Agreement upon any of their legal successors or assigns.

10. The Parties acknowledge and agree that the terms and conditions of this Agreement entered into by the Parties are reasonable and that the restraints agreed upon are not more onerous than what is required to protect that interests of each of the Parties and are, therefore, not contrary to law, morals, good customs, public order or public policy.

11. In the event of breach of any of the terms and conditions of this Agreement, the non-breaching Party shall be entitled to recover its reasonable attorney's fees in addition to any other damages and remedies it may have at law or in equity.

12. Whenever possible, each provision of this Agreement shall be interpreted in such a manner as to be effective and valid under applicable laws, but if any provision of this Agreement should be held invalid or unenforceable under applicable laws, such provision shall be ineffective to the extent of such prohibition or invalidity without invalidating the remainder of such provision or the remaining provisions of this Agreement.

13. This Agreement is the entire agreement between the Parties and constitutes complete, final and exclusive embodiment of their agreement with respect to the subject matter hereof. This Agreement may not be amended except by written agreement executed by both parties.

14. 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.

15. This Agreement shall become effective and enforceable upon the last date of execution hereof.

16. This Agreement may be signed in any number of counterparts. Any single counterpart executed by the Parties shall together constitute a full and original agreement for purposes hereof.

This Bureau evaluated the COMPROMISE 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.

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 Rules of Court.¹

WHEREFORE, premises considered, the parties' Compromise Agreement is hereby **APPROVED**. Accordingly, the instant opposition is hereby **DISMISSED**. Let

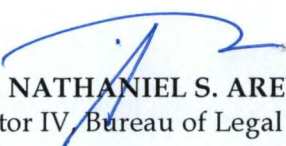
¹

Office Order No. 154 Series of 2010

the filewrapper of Trademark Application No. 4-2015-014273 be returned, together with a copy of this Decision, to the Bureau of Trademarks for appropriate action subject to the Respondent-Applicant's filing of an amendment to the application pursuant to the Compromise Agreement and payment of the required fees.

SO ORDERED.

Taguig City, **14 MAR 2017**


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