



SUYEN CORPORATION,
Opposer,

-versus-

SOLSKYN PERSONAL CARE LLC,
Respondent-Applicant.

X-----X

IPC No. 14-2016-00351

Opposition to:

Appln. Serial No. 4-2016-500973

Date Filed: 17 February 2016

TM: OCEAN POTION

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

MIGALLOS & LUNA LAW OFFICES

Counsel for Opposer
7th Floor, The Phinma Plaza
39 Plaza Drive, Rockwell Center,
Makati City 1210


BARANDA & ASSOCIATES

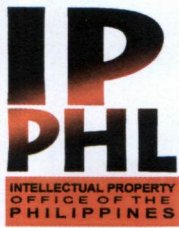
Counsel for Respondent- Applicant
Suite 1002-B Fort Legend Towers
3rd Avenue corner 31st Street,
Bonifacio Global City, Taguig

GREETINGS:

Please be informed that Decision No. 2017 - 317 dated 23 August 2017 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 24 August 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



SUYEN CORPORATION,
Opposer,

-versus-

SOLSKYN PERSONAL CARE LLC,
Respondent-Applicant.

x-----x

} IPC No. 14-2016-00351

} Opposition to:

} Appln. Serial No. 4-2016-500973

} Date Filed: 17 February 2016

} Trademark: OCEAN POTION

} Decision No. 2017 - 317

DECISION BASED ON COMPROMISE AGREEMENT

SUYEN CORPORATION, ("Opposer") filed a verified Notice of Opposition to Trademark Application No. 4-2016-500973. The application, filed by SOLSKYN PERSONAL CARE LLC ("Respondent-Applicant"), covers the mark OCEAN POTION for goods in Class 3 of International Classification of Goods.

The Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 29 September 2016. The Respondent-Applicant filed a Verified Answer on 03 January 2017.

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 17 January 2017 Order No. 2017-015 referring the case to mediation.

On 02 August 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 read, as follows:

"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. SOLSKYN hereby agrees and undertakes as follows:

1.1 SOLSKYN shall not, except as permitted herein, by itself or through other persons or entities, use the words 'OCEAN POTION' other than in stylized form and as part of specially designed marks, images of which are attached as Annex 'A' (collectively, the 'OP Design Mark'), and shall not use the word 'POTION' other than as part of 'OCEAN POTION' in the OP Design Mark.

1.2 SOLSKYN shall amend the goods description in the SolSkyn Application to state the following:

Self-tanning gels and sprays; after sun sprays; bath and body wash, gels, lotions, sprays and oils all for accelerating, enhancing, extending and protecting the skin and tan (the 'SOLSKYN Tanning Goods').

1.3 SOLSKYN shall not, directly or indirectly, use the OP Design Mark on the following goods:

Body Sprays, such as or in the form of, Eau de Cologne, Eau de Toilette, Eau de Parfum, Deo Cologne and Deo Body Spray (the 'SUYEN Fragrance Goods').

1.4 SOLSKYN shall within five (5) days from receipt of approval of this Agreement by the IPOPHL, ensure that the SolSkyn Application is requested to be amended pursuant to Section 1.2 above.

1.5 SOLSKYN shall not, directly or indirectly, seek the registration or cancellation of the Registered Mark or oppose the registration by SUYEN of any mark containing the word 'POTION' unless such mark is confusingly similar to the OP Design Mark or otherwise in violation of Section 2 below.

2. SUYEN hereby agrees and undertakes as follows:

2.1 SUYEN hereby consents to the use and registration of the mark 'OCEAN POTION' by SOLSKYN, but only as part of the OP Design Mark and only in accordance with this Agreement, and not for the SUYEN Fragrance Goods. Suyen also consents to SOLSKYN'S continued ownership and maintenance of the Existing OCEAN POTION Registrations; provided, however, SOLSKYN acknowledges that such consent does not operate to modify any of SOLSKYN'S obligations under this Agreement.

2.2 SUYEN shall not, by itself or through other persons or entities, use, register or seek registration of the OP Design Mark or any mark that is confusingly similar thereto or any mark containing the words 'OCEAN POTION.'

2.3 SUYEN shall not, directly or indirectly, oppose any application of SOLSKYN for registration of the OP Design Mark or seek the cancellation of any registration thereof.

2.4 SUYEN shall not use the Registered Mark in connection with the SOLSKYN Tanning Goods or any sunscreen or sunblock goods; provided that this prohibition shall not apply to lotions, sprays, creams or other products of SUYEN under Class 3 which are not primarily sunblock products but has SPF or sunscreen component/s.

2.5 SUYEN hereby allows SOLSKYN to modify the OP Design Mark or any other element thereof provided that such modifications or changes are neither material nor substantial so as to affect the general appearance or orientation of the OP Design Mark; provided further, that the use of the word 'POTION' with any word other than 'OCEAN' under any circumstances shall amount to a violation by SOLSKYN of this Agreement.

3. SUYEN hereby agrees and acknowledges that in the instances provided in Sections 3.1, 3.2 and 3.3 below, the words 'OCEAN POTION' relating to SOLSKYN may appear in word form:

3.1 Third party write-ups and news articles about SOLSKYN and its products;

3.2 Write-ups found in the website of SOLSKYN as long as the OP Design Mark is prominently displayed on such website and on the webpage where such write-ups appear;

3.3 Online web store product listings, or write-ups or product information found in brochures, flyers or other advertising materials, provided that the web store and materials on which said write-ups or product information are contained includes and prominently displays the OP Design Mark; and

3.4 On items not available for sale, distributed to consumers in limited quantities, solely in connection with the promotion of SOLSKYN Tanning Goods, sunscreen, or sunblock goods.

4. Material breach by SOLSKYN of this Agreement shall constitute full and sufficient ground to prevent the grant of the SolSkyn Application or any application for registration of any mark of SOLSKYN containing the words 'OCEAN POTION' and/or 'POTION' or to cancel any registration of any mark of SOLSKYN with the words 'OCEAN POTION' and/or 'POTION.'

5. This Agreement is entered into by the Parties without prejudice to and shall not be deemed an amendment of the SSCRI Compromise Agreements and the obligations of SSCRI thereunder. Violation by SSCRI of the SSCRI Compromise Agreements shall not be imputed against SOLSKYN or be deemed a violation of this Agreement.

6. The Parties shall upon execution hereof file a Joint Motion for Judgment Based On Compromise Agreement praying for the issuance by 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. This Agreement shall be effective upon issuance by the IPOPHL of such judgment approving this Agreement without modification and based on this Agreement.
8. This Agreement may be signed in any number of counterparts. Any single counterpart executed by SUYEN and SOLSKYN shall together constitute a full and original Agreement for purposes hereof.
9. Rights of the Parties not expressly addressed herein are reserved."

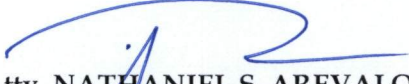
This Bureau evaluated the COMPROMISE AGREEMENT and finds that the same have been duly entered into by the parties with the terms and conditions thereof not contrary to law, morals, good customs, public order or public policy.

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**. Let the filewrapper of Trademark Application No. 4-2016-500973 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, **23 AUG 2017**


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

¹

Office Order No. 154 Series of 2010