



HUGO BOSS TRADEMARK MANAGEMENT
GMBH & CO., KG.,

Opposer,

-versus-

TALLYHOE MANUFACTURING CO., INC.,
Respondent-Applicant.

X-----X

IPC No. 14-2011-00197

Opposition to:

Appln. Serial No. 4-2009-500935

Date filed: 2 December 2009

TM: "BOSS SUPER KINGS LABEL
MARK"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2012 – 225 dated November 20, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 20, 2012.

For the Director:


Atty. EDWIN DANILO A. DATING

Director III

Bureau of Legal Affairs



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Decision No. 2012 - 225

DECISION BASED ON COMPROMISE AGREEMENT

HUGO BOSS TRADEMARK MANAGEMENT GMBH & CO., KG. ("Opposer") filed on 12 May 2011 an opposition to Trademark Application Serial No. 4-2009-500935. The application filed by TALLYHOE MANUFACTURING CO., INC. ("Respondent-Applicant") covers the mark **BOSS SUPER KINGS LABEL MARK** for use on goods under Class 34 particularly "cigarettes". The opposition is anchored on Section 123.1, paragraphs (d), (e) and (f) of Republic Act 8293 otherwise known as the Intellectual Property Code of the Philippines.

On 20 September 2011, the Respondent-Applicant filed its Answer refuting the material allegations of the Opposer.

Then after, 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 and Settlement Period"*), this Bureau issued on 10 April 2012 Order No. 2012-81 referring the case to mediation.

On 18 October 2012, the parties filed a Joint Motion to Approve Compromise Agreement submitting a document entitled "SETTLEMENT AGREEMENT", the pertinent portions of which read:

"NOW THEREFORE, in consideration of the foregoing premises, the parties hereby undertake and obligate themselves as follows:

"1. PMFTC will continue its use of BOSS as a trademark, alone or with other words and without being restricted as to a particular stylized form or design; Provided, however, that such use will only be in connection with tobacco and tobacco related products (including lighters, matches and associated smokers articles) under Class 34, and shall not be used for the following goods:

a. Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing scouring and abrasive preparations; soap; perfumery, essential oils, cosmetics, hair lotions; dentrifices.

b. Class 9: Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images;

magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.

c. Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.

d. Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

e. Class 24: Textiles and textile goods, not included in other classes; bed and table covers.

f. Class 25: Clothing, footwear, headgear.

g. Class 26: Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.

h. Class 28: Games and playthings; gymnastics and sporting articles not included in other classes; decorations for Christmas trees.

i. Class 35: Advertising; business management; business administration; office functions.

j. Class 42: Providing of food and drink; temporary accommodation; medical, hygienic and beauty care; veterinary and agricultural services; legal services; scientific and industrial research; computer programming; services that cannot be placed in other classes.

"2. Accordingly, PMFTC can secure trademark registration for the same but under Class 34 only, for which purpose, it shall prosecute without objection or opposition from Hugo Boss, the pending trademark applications for its BOSS, BOSS FILTER KINGS LABEL MARK and BOSS SUPER KINGS LABEL MARK.

"3. In consideration for the foregoing agreement of PMFTC, Hugo Boss shall:

a. Dismiss or withdraw with prejudice all its opposition suits, namely, Inter Partes Cases Nos. 14-2011-00075, 14-2011-00196 and 14-2011-00197;

b. Desist, now and in the future, from opposing or canceling applications and registrations of PMFTC using the BOSS trademark and variation thereof, for use in connection with goods under Class 34;

"4. Both parties shall jointly move for the approval of this Settlement Agreement by the Bureau of Legal Affairs of the Intellectual Property Office.

"5. Each party shall bear their own costs and expenses, including attorney's fees, incurred in connection with the filing of and defending against the oppositions.

"6. This Settlement Agreement is effective only within the territorial jurisdiction of the Philippines and effects only the parties' respective rights in the Philippines.

"7. Further, this Settlement Agreement shall constitute the entire agreement between the parties, and supersedes all prior communications and understanding relating to the subject matter, whether oral or written.

"8. 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."

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.

In this regard, 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 (Sec. 5, Office Order No. 154, s. 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. 4-2009-500935 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 20 November 2012.


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