



DD IP HOLDER LLC,  
Opposer,

IPC No. 14-2012-00459  
Opposition to:  
Appln. Serial No. 4-2012-001457  
Date filed: 07 February 2012  
TM: "DUNKCOCTIONS"

-versus-

GOLDEN DONUTS, INC.,  
Respondent -Applicant.

X-----X

**NOTICE OF DECISION**

**BUCOY POBLADOR AND ASSOCIATES**

Counsel for the Opposer  
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Salcedo Village, Makati City

**MR. ANGEL O. OLANDRES**

For the Respondent-Applicant  
No. 26 Libya Street  
Betterliving Subdivision  
Don Bosco, Paranaque City

**GREETINGS:**

Please be informed that Decision No. 2014 - 40 dated February 12, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 12, 2014.

For the Director:

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



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*Opposer,*

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Decision No. 2014- 40

## DECISION

DD IP HOLDER LLC ("Opposer")<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2012-001457. The application, filed by GOLDEN DONUTS, INC. ("Respondent-Applicant")<sup>2</sup>, covers the mark "DUNKCOCTIONS" for use on beverages, namely: "café Americano, latte, cappuccino, espresso, white mocha, caramel cookie frio, cookies and crème frio, iced coffee float, café mocha frio, caramel frio, mocha frio and almond frio" under Class 30; and "strawberry mocha frio, strawberry froothie, mango froothie" under Class 32, of the International Classification of Goods and Services<sup>3</sup>.

The Opposer alleges, among other things, that DUNKCOCTIONS resembles the dominant components of its mark "DUNKIN' DONUTS", in respect of the use of the same stylized lettering and colour scheme, which when applied to or used in connection with the goods covered by the application under opposition, will likely cause confusion, mistake and deception on the part of the purchasing public. Thus, the Opposer argues that the registration of the mark DUNKCOCTIONS in favour of the Respondent-Applicant violates Sec.123.1, pars. (d) and (e) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). Moreover, the Opposer imputes bad faith on the part of the Respondent-Applicant, pointing out that the latter is its local licensee since 1985 up to the present. According to the Opposer, the Respondent-Applicant should have desisted from filing the contested trademark application pursuant to the License Agreement between them.

To support its opposition, the Opposer submitted/presented as evidence the Affidavit executed by one Ms. Theresa C. Ursino including the annexes thereto, certified true copy of Trademark Reg. No. 4-2012-003383, for the mark DUNKIN' DONUTS and No. 4-2011-501305, for the mark DUNKIN' DONUTS COFFEE & MORE & DD CUP LOGO, certified copy of the Respondent-Applicant's trademark application, and samples of actual use of the Opposer's marks.<sup>4</sup>

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 23 January 2013. However, the Respondent-Applicant did not file the Answer. Thus, the Hearing Officer issued on 14 May 2013 Order No. 2013-0731 declaring the Respondent-Applicant in default and the instant opposition deemed submitted for decision.

<sup>1</sup> A Delaware limited liability company with principal address at 130 Royal Street, Canton, Massachusetts, 02021, United States of America.

<sup>2</sup> A Philippine corporation with address at GOI Building, Reliance corner Sheridan Streets, Mandaluyong City, Metro Manila.

<sup>3</sup> The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

<sup>4</sup> Marked as Exhibits "A" to "E".



Should the Respondent-Applicant be allowed to register the mark DUNKCOCTIONS?

The essence of the trademark registration is to give protection to the owners of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is applied; to secure to him who has been instrumental in bringing into the market a superior article of merchandise; the fruit of his industry and skill; to assure the public that they are procuring the genuine article, to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product<sup>5</sup>.

Records show that at the time the Respondent-Applicant filed the contested application on 07 February 2012, the Opposer already has trademark registrations, to wit:

1. Reg. No. 4-2004-007554 issued on 25 June 2007 for the mark "DUNKIN' DONUTS (NEW IMAGE CP & WORDS IN BLACK AND WHITE)";
2. Reg. No. 4-2005-001931 issued on 16 July 2006 for the mark "DUNKIN' DONUTS"; and
3. Reg. No. 4-2011-501305 issued on 08 March 2012 for the mark "DUNKIN' DONUTS COFFEE & MORE (NEW IMAGE IN COLOR) & DD CUP LOGO".

These registrations cover goods that are similar to those indicated in the Respondent-Applicant's application, particularly, coffee and coffee-based beverages, and closely related goods like doughnuts and pastries,

A close scrutiny of the mark applied for registration by the Respondent-Applicant as compared to the Opposer's, as shown below:

*Opposer's marks*

DUNKIN' DONUTS



*Respondent-Applicant's applied mark*

**DUNKCOCTIONS**

shows that confusion, or even deception, is likely to occur. The first syllable of the Respondent-Applicant's mark, which is actually the word "DUNK" is practically identical to the word "DUNKIN". Moreover, the word "DUNK" in the Respondent-Applicant's mark, like "DUNKIN" in the Opposer's mark covered by Reg. No. 4-2011-501305 is of the same font style and color (orange). That the syllables "COCTIONS" in the Respondent-Applicant's mark do not appear in or are not parts of any of the Opposer's marks is of no moment. "COCTIONS" is presented in font-style and color (magenta) similar to those

<sup>5</sup> Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.

of the other parts of the Opposer's mark under Reg. No. 4-2011-501305 (the word "DONUTS").

There is no doubt that the mark will be associated by the public to the Opposer. This is so because of the goods involved (coffee and coffee based beverages) and of the fact that the Respondent-Applicant is a licensee of the Opposer. The consumers would assume that any product or services available in the Respondent-Applicant's establishment originates or is connected with the Opposer.

Notwithstanding the business relationship between the parties, the fact remains however that the Respondent-Applicant coined a mark that is confusingly similar to the Opposer's marks. The Opposer, as the owner, registrant and licensor of the DUNKIN' DONUTS marks, has the right under Sec.147.1 of the IP Code, to wit:

The owner of a registered mark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs or containers for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

Corollarily, Sec. 134 of the IP Code provides:

Sec. 134. Opposition. – Any person who believes that he would be damaged by the registration of a mark may, upon payment of the required fee and within thirty (30) days after the publication referred to in Subsection 133.2, file with the Office an opposition to the application. x x x

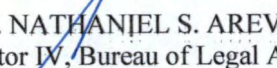
Certainly, even if there is an existing licensing agreement between the parties, the Opposer qualifies as a person who may be damaged by the registration of the mark DUNKCOCTIONS. An issue regarding the quality of the goods and services under the mark DUNKCOCTIONS is likely to be imputed, associated or connected to the Opposer. Succinctly, there is no evidence that the Opposer consented, tacitly or impliedly, to the use by the Respondent-Applicant of the mark DUNKCOCTIONS. This Bureau has given the Respondent-Applicant opportunity to air its side and defend its application. However, it chose not to.

In conclusion, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby SUSTAINED. Let the filewrapper of Trademark Application Serial No. 4-2012-001457 be returned, together with a copy of this Decision, to the Bureau of Trademark for information and appropriate action.

SO ORDERED.

Taguig City, 12 February 2014.

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