



STARBUCKS CORPORATION,
Opposer,

-versus-

FERDINAND A. FLOIRENDO,
Respondent- Applicant.

X-----X

} IPC No. 14-2011-00437
} Opposition to:
} Appln. Serial No. 4-2011-004289
} Date filed: 13 April 2011
} TM: "STARBUKOL"
}
}
}
}

NOTICE OF DECISION

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FERDINAND A. FLOIRENDO
Respondent-Applicant
Zone 8, Lower Bulua
Cagayan de Oro City

GREETINGS:

Please be informed that Decision No. 2013 - 113 dated June 20, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 20, 2013.

For the Director:

Atty. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs



STARBUCKS CORPORATION,	}	IPC No. 14-2011-00437
<i>Opposer,</i>	}	Opposition to:
	}	
	}	Appln. Serial No.: 4-2011-004289
- versus -	}	Date Filed: 13 April 2011
	}	
	}	Trademark: STARBUKOL
FERDINAND A. FLOIRENDO,	}	
<i>Respondent-Applicant.</i>	}	Decision No. 2013 - <u>113</u>
x-----x		

DECISION

STARBUCKS CORPORATION, ("Opposer")¹ filed on 17 November 2011 an opposition to Trademark Application Serial No. 4-2011-004289. The application, filed by FERDINAND A. FLOIRENDO ("Respondent-applicant")², covers the mark **STARBUKOL** for use on "*coffee, tea, bread, sandwiches, siopao, cakes, pasties; fruit drinks, juices and shakes*" under Classes 30 and 32 of the International Classification of Goods and Services.³

The Opposer alleges, among other things, the following:

- "1. The registration of the mark subject of this opposition is contrary to the provisions of Sections 123.1 (d), (e) and (f) of R.A. 8293; and
- "2. The opposer is the owner of the **STARBUCKS** mark, which has been registered in the opposer's name with the Philippine Intellectual Property Office in various classes."

The Opposer's evidence consists of the following:

1. Exhibit "A" - Original notarized and legalized Verified Notice of Opposition;
2. Exhibit "B" - Original notarized and legalized Affidavit of Lucy Lee Helm;
3. Exhibit "B-1" - List of **STARBUCKS** stores in the Philippines;
4. Exhibit "B-2" - Copies of computer printouts of search results generated through Google, evidencing the notoriety of the term **STARBUCKS** as a trademark;

1 Doing business as Starbucks Coffee Company, a corporation organized under the laws of the State of Washington U.S.A., with business address at 2401 Utah Avenue South, Seattle, Washington 98134 U.S.A.
2 With address at Zone 8, Lower Bulua, Cagayan de Oro City, Philippines.
3 The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement concerning the International Classification of goods and services for the purpose of the Registration of marks concluded in 1957.

5. Exhibit "B-3" - Copies of articles and advertisements featuring the **STARBUCKS** product;
6. Exhibit "B-4" - Representative sample of the trademark registrations for the **STARBUCKS** mark in the various countries;
7. Exhibit "C" - Computer printout of the trademark details report for **STARBUCKS** under Registration No. 4-1995-103604 register on 14 December 1999 downloaded from the Intellectual Property Office website;
8. Exhibit "D" - Computer printout of the trademark details report for **STARBUCKS** under Registration No. 4-1997-118330 registered on 30 October 2004 downloaded from the Intellectual Property Office website;
9. Exhibit "E" - Computer printout of the trademark details report for **STARBUCKS** under Registration No. 4-2000-004294 registered on 11 March 2004 downloaded from the Intellectual Property Office website;
10. Exhibit "F" - Computer printout of the trademark details report for **STARBUCKS** under Registration No. 4-2001-006887 registered on 5 December 2004 downloaded from the Intellectual Property Office website;
11. Exhibit "G"- Computer printout of the trademark details report for **STARBUCKS** under Registration No. 4-2003-007501 registered on 1 July 2005 downloaded from the Intellectual Property Office website;
12. Exhibit "H" - Computer printout of the trademark details report for **STARBUCKS** under Registration No. 4-2010-000130 registered on 14 October 2010 downloaded from the Intellectual Property Office website;
13. Exhibit "I" - Computer printout of the trademark details report for **STARBUCKS** under Registration No. 4-2010-009029 registered on 31 December 2010 downloaded from the Intellectual Property Office website;
14. Exhibit "J" - Computer printout of the trademark details report for **STARBUCKS** (STYLIZED BLOCK LETTERS IN COLOR) under Registration No. 4-2006-008358 registered on 01 December 2008 downloaded from the Intellectual Property Office website;
15. Exhibit "K" - Computer printout of the trademark details report for **STARBUCKS** under Registration No. 4-2001-006889 registered on 6 January 2006 downloaded from the Intellectual Property Office website;
16. Exhibit "L" - Computer printout of the trademark details report for **STARBUCKS** (STYLIZED BLOCK LETTERS) under Registration No. 4-2004-012147 registered on 6 January 2006 downloaded from the Intellectual Property Office website;
17. Exhibit "M" - Computer printout of the trademark details report for **STARBUCKS BARISTA** under Registration No. 4-2000-003547 registered on 10 March 2006 downloaded from the Intellectual Property Office website;
18. Exhibit "N" - Computer printout of the trademark details report for **STARBUCKS COFFEE** under Registration No. 4-2001-006890 registered on 28 November 2005 downloaded from the Intellectual Property Office

- website;
19. Exhibit "O" - Computer printout of the trademark details report for **STARBUCKS COFFEE** under Registration No. 4-2004-012151 registered on 19 February 2007 downloaded from the Intellectual Property Office website;
 20. Exhibit "P" - Computer printout of the trademark details report for **STARBUCKS COFFEE & DESIGN** under Registration No. 4-1995-101400 registered on 20 November 2005 downloaded from the Intellectual Property Office website;
 21. Exhibit "Q" - Computer printout of the trademark details report for **STARBUCKS COFFEE & DESIGN** under Registration No. 4-1994-103607 registered on 26 March 2001 downloaded from the Intellectual Property Office website;
 22. Exhibit "R" - Computer printout of the trademark details report for **STARBUCKS COFFEE** under Registration No. 4-1997-118324 registered on 23 July 2001 downloaded from the Intellectual Property Office website;
 23. Exhibit "S" - Computer printout of the trademark details report for **STARBUCKS COFFEE & DESIGN** under Registration No. 4-1997-118326 registered on 23 July 2001 downloaded from the Intellectual Property Office website;
 24. Exhibit "T" - Computer printout of the trademark details report for **STARBUCKS COFFEE (AND DESIGN)** under Registration No. 4-1997-118329 registered on 23 July 2001 downloaded from the Intellectual Property Office website;
 25. Exhibit "U" - Computer printout of the trademark details report for **STARBUCKS COFFEE (AND DESIGN)** under Registration No. 4-1997-118328 registered on 23 July 2001 downloaded from the Intellectual Property Office website;
 26. Exhibit "V" - Computer printout of the trademark details report for **STARBUCKS COFFEE (DESIGN W/ COLOR)** under Registration No. 4-2007-001521 registered on 24 September 2007 downloaded from the Intellectual Property Office website;
 27. Exhibit "W" - Computer printout of the trademark details report for **STARBUCKS COFFEE (DESIGN)** under Registration No. 4-2000-004293 registered on 11 August 2005 downloaded from the Intellectual Property Office website;
 28. Exhibit "X" - Computer printout of the trademark details report for **STARBUCKS COFFEE (DESIGN)** under Registration No. 4-2001-006888 registered on 16 April 2004 downloaded from the Intellectual Property Office website;
 29. Exhibit "Y" - Computer printout of the trademark details report for **STARBUCKS COFFEE (DESIGN)** under Registration No. 4-2003-003506 registered on 9 April 2007 downloaded from the Intellectual Property Office website;
 30. Exhibit "Z" - Computer printout of the trademark details report for **STARBUCKS COFFEE (DESIGN)** under Registration No. 4-2003-007503

- registered on 29 August 2005 downloaded from the Intellectual Property Office website;
31. Exhibit "AA" - Computer printout of the trademark details report for **STARBUCKS COFFEE** under Registration No. 4-2001-006891 registered on 28 August 2004 downloaded from the Intellectual Property Office website;
 32. Exhibit "BB" - Computer printout of the trademark details report for **STARBUCKS COFFEE** under Registration No. 4-2004-012146 registered on 27 November 2006 downloaded from the Intellectual Property Office website;
 33. Exhibit "CC" - Computer printout of the trademark details report for **STARBUCKS COFFEE (AND DESIGN)** under Registration No. 4-1997-118327 registered on 23 July 2001 downloaded from the Intellectual Property Office website;
 34. Exhibit "DD" - Computer printout of the trademark details report for **STARBUCKS COFFEE AND TEA (HERITAGE SIREN DESIGN)** under Registration No. 4-2010-003524 registered on 11 November 2010 downloaded from the Intellectual Property Office website;
 35. Exhibit "EE" - Computer printout of the trademark details report for **STARBUCKS VIA** under Registration No. 4-2009-000049 registered on 2 September 2010 downloaded from the Intellectual Property Office website;
 36. Exhibit "FF"- Computer printout of the trademark details report for **STARBUCKS VIA** under Registration No. 4-2010-009789 registered on 23 December 2010 downloaded from the Intellectual Property Office website;
 37. Exhibit "GG" - Computer printout of the trademark details report for **STARBUCKS VIA** under Registration No. 4-2010-009790 registered on 23 December 2010 downloaded from the Intellectual Property Office website;
 38. Exhibit "HH" - Original notarized and legalized Officer's Certificate signed by Sophie Hager Hume, Vice-President and Assistant General Counsel of the Opposer, on the authority of Lucy Lee Helm to sign the Verification and Certification of Non-Forum Shopping for the Opposer in the Notice of Opposition; and
 39. Exhibit "II"- Original notarized and legalized Special Power of Attorney signed by Paula Elaine Boggs, Executive Vice-President, General Counsel and Secretary of the Opposer appointing the undersigned counsel to represent Opposer in this case.

Should the Respondent-Applicant's trademark application be allowed or is the Respondent-Applicant's mark **STARBUKOL** confusingly similar to Opposer's mark **STARBUCKS**?

Sec. 123.1 (d) of the Intellectual Property Code provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a

mark with an earlier filing or priority date, in respect of the same goods or services, or closely related goods or services, or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

Jurisprudence says that a practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of the prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some factors such as sound; appearance; form; style, shape; size or format; color, idea connoted by the mark; the meaning, spelling and pronunciation of the words used; and the setting in which the words appear may be considered, for indeed, trademark infringement is a form of unfair competition.⁴

Thus, confusion is likely between marks only if their over-all presentation, as to appearance or meaning, would make it possible for the consumers to believe that the goods or the products, to which the marks are attached, emanated from the same source or are connected or associated with one another.

The competing trademarks are reproduced for comparison and scrutiny.

STARBUCKS

STARBUKOL

Opposer's mark

Respondent-Applicant's mark

This Bureau noticed that the competing marks are both composed of two (2) words. Their first component is the word "STAR" which is accompanied by another word which is entirely distinct and different from each other, in terms of spelling pronunciation as well as in meaning. The Opposer's mark is accompanied by the word "BUCKS" which mean Dollar or Money and "BUKOL" for the Respondent-Applicant's which means Lump or protruding or in other words a Filipino term or language, namamaga. In spelling, pronunciation or sound as well as in meaning, one can easily distinguish one from the other. Thus, the likelihood of the consumer being deceived or confused is remote. Neither is there a likelihood that the Respondent-Applicant's business is associated by consumers with the Opposer.

It has also been noticed that the word "star" has been used by many other entities already and as such it becomes a weak mark unless accompanied by another word or design. Some examples are as follows:



1. Star Drama
2. Star World
3. Star Apple
4. Star Gazer
5. Star Movies
6. Philippine Star

It is emphasized that the essence of trademark registration is to give protection to the owners of trademark. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; 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 product⁵.

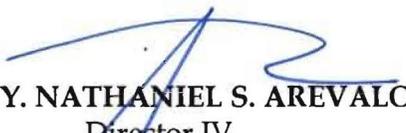
The Intellectual Property System was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individual who through their own innovation were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services. The Intellectual Property is not haven for people who take advantage of the intellectual creation of others, whether a local resident or a foreigner.

Accordingly, the Respondent-Applicant's trademark application is not proscribed by Sec. 123. 1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines.

WHEREFORE, premises considered, the opposition is hereby **DENIED**. Let the filewrapper of Trademark Application Serial No. 4-2011-004289, together with a copy of this Decision, be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 20 June 2013.


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

⁵ *Pribudas J. Mirpuri versus Court of Appeals*, G.R. No. 114508, 19 November 1999.