



SUYEN CORPORATION,
Opposer,

-versus-

COFFECAT CORPORATION (formerly
SCIPIO CORPORATION),
Respondent-Applicant.

X-----X

}
} IPC No. 14-2011-00367
} Opposition to:
} Appln. Serial No. 4-2010-0990262
} Date Filed: 24 December 2008
} Trademark: "COFFEE-CAT &
} DEVICE"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2012 – 177 dated September 19, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 19, 2012.

For the Director:

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



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**COFFECAT CORPORATION (formerly
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TM : "COFFEE-CAT & DEVICE"

Decision No. 2012- 177

DECISION

SUYEN CORPORATION ("Opposer")¹ filed on 3 August 2011 an opposition to Trademark Application Serial No. 4-2010-990262. The application, filed by **COFFEECAT CORPORATION (formerly SCIPPIO CORPORATION)** ("Respondent-Applicant")², covers the mark "**COFFEE-CAT & DEVICE**" for use on "coffee shop" under class 43 of the International Classification of Goods³.

The Opposer alleges, among other things, that the mark applied for registration by the Respondent-Applicant is identical to and confusingly similar with the Opposer's duly registered trademarks. Further, the mark of the Respondent-Applicant will also mislead the public into believing that the products bearing the said marks are the same products marketed and sold by the Opposer or that the goods originated from the same source.

In support of its opposition, the Opposer submitted the following:

1. Exh. "A": affidavit of Dale Gerald G. Dela Cruz;
2. Exh. "B" to "B-14": photographs of the various Bench products;
3. Exh. "C": photocopy of Suyen's Trademark Application No. 4-2001-004438 for the mark "KAPE LATTE";
4. Exh. "D": photocopy of the Cert. of Reg. No. 4-2001-004440 for the mark "> BE CONNECTED";
5. Exh. "E": photocopy of Cert. of Reg. No. 059967 for the mark "HERBENCH";

¹ Is a corporation duly organized and existing under and by virtue of the laws of the Republic of the Philippines with office located at 2214 Tolentino Street, Pasay City.

² Is a corporation organized under the Philippine law, with business address at B12 De Luisa Plaza, Magsaysay Avenue, Davao City.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services 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.

6. Exh. "F" to "F-3": photographs of some of SUYEN's HERBENCH stores in the Philippines;
7. Exh. "G" to "G-1": certified true copies of Cert. of Reg. Nos. 4-2006-001706 and 4-2010-002854 for the marks HERBENCH & CAT DEVICE and CAT DEVICE;
8. Exh. "H" to "H-33": photographs of HERBENCH products bearing the CAT DEVICE;
9. Exh. "I" to "I-1": sample of HERBENCH advertising materials featuring the CAT DEVICE; and
10. Exh. "J" to "J-1": photographs of models wearing clothes bearing the CAT DEVICE.

On 20 December 2011, the Respondent-Applicant filed its Verified Answer denying all the material allegations thereof, arguing that the Opposer would not be damaged by the registration of the mark COFFE-CAT & DEVICE. According to the Respondent-Applicant, it is the owner, first adopter and user of the mark COFFEE-CAT & DEVICE. It also contends that its mark is not confusingly similar to the Opposer, pointing out that the goods/services indicated in its trademark application differ from those covered by the Opposer's trademark registration.

The Respondent-Applicant's evidence consists of the following:

1. Exh. "1" series: copies of Respondent-Applicant's pertinent Cert. of Reg. and Article of Inc. issued by the Securities and Exchange Commission;
2. Exh. "2" and "3": evidence of use such as signage's, marketing, promotional materials and in-store merchandise;
3. Exh. "4" series: print out of the website and domain name registration; and
4. Exh. "5" series: print outs from IPO website containing the pertinent trademark database.

Should the Respondent-Applicant's trademark application be allowed?

The Opposer anchors its opposition on Sec. 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") which 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 and services, or if it is nearly resembles such a mark as to be likely to deceive or cause confusion. The Opposer also cites Sec. 147.1 of the IP Code⁴.

In this regards, the records show that at the time the Respondent-Applicant filed its trademark application on 24 December 2008, the Opposer has existing trademark registrations for the mark "HERBENCH & CAT DEVICE" under Reg. No. 4-2006-001706 and Reg. No. 4-2010-002854. The Respondent-Applicant's marks, a silhouette of a cat bears resemblance to the Opposer's, as shown below:

⁴ Section 147. *Rights Conferred.* - 147.1. 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.



herbench/

Opposer's Mark



Respondent-Applicant's Mark

This Bureau noticed, however, that the goods covered by the abovementioned trademark registrations:

1. Reg. Nos. 4-2006-001706: “*ladies clothing, footwear and headgear, namely dresses, blouses, skirts, long sleeves, pants, jogging pants, slacks, jeans, shorts, shirts, cardigans, undershirts, under wears, namely brassieres, panties, blazers, costumes, pajamas, half slips, sweat shirts, jackets, bath robes, belts, gloves, swimwear, socks, stockings, shoes, slippers, sandals, boots, hats, caps, shawls and raincoats*”, under class 25; and

2. Reg. No. 4-2010-002854: “*body spray, deo body spray, pressed powder, foundation, lip gloss, lipstick, eye shadow*” under Class 3; “*bags, key chains*” under Class 18; and, “*knitted shirts, woven shirts, flat knits, pants, shorts, skirts, undergarments, caps, visors, shoes, sandals, slippers*” under class 25,

are not similar or closely related to the service (coffee shop under class 43) indicated in the Respondent-Applicant’s trademark application.

It is unlikely therefore that a customer who chances upon a coffee shop with a signage bearing the Respondent-Applicant’s mark would assume that the establishment belongs to or is associated with the Opposer. Much less is the probability that such customer would be swayed to enter and patronize the Respondent-Applicant’s coffee shop because the customer thinks that it is connected with the Opposer.

In *Canon Kabushiki Kaisha v. Court of Appeals and NSR Rubber Corporation*, the Supreme Court ruled that:

“The Trademark “CANON” as used by Petitioner for its paints, chemical products, toner and dyestuff, can be used by private respondent for its sandals because the products of these two parties are dissimilar⁵”.

And in *ESSO Standard Eastern, Inc. v. Court of Appeals*:

“The Petroleum Products on which the Petitioner wherein uses the trademark ESSO, and the product of Respondent, cigarettes are so foreign to each other as to make it unlikely that purchasers would think that the Petitioner is the manufacturer of Respondent’s goods⁶”.

⁵ G.R. No. 120900, 20 July 2000.

⁶ 116 SCRA 336.

The Opposer may have a trademark registration for use on “*coffee beans, coffee drink, internet café and bar*”, but the registered mark does not bear any similarity or resemblance to the Respondent-Applicant’s. The trademark registration, No. 4-2001-004440⁷, covers the mark “> be connected”.

It is emphasized that the essence of trademark registration is to give protection to the owner of the trademarks. The function of a trademark is to point out distinctly the origin of 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 manufacture against and sale of an inferior and different article of his products.⁸ This Bureau finds and concludes that the Respondent-Applicant’s mark fulfill this function.

WHEREFORE, premises considered, the opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2010-990262 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 19 September 2012.


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

⁷ Date of registration was 07 Feb. 2004.

⁸ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114509, 19 Nov.1999.