

STARBUCKS CORPORATION,
Opposer,

-versus-

ISRAEL C. ROMANO,
Respondent-Applicant.

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}
} **IPC No. 14-2012-00389**
} Opposition to:
} Appln. Serial No. 4-2012-001501
} Date Filed: 08 February 2012
} **TM: "REDBUCK'S COFFEE**
} **SHAKES LOGO"**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 24 dated January 25, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 25, 2016.

For the Director:


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

STARBUCKS CORPORATION,
Opposer,

-versus-

ISRAEL C. ROMANO,
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X ----- X

IPC No. 14-2012-00389

Opposition to Trademark
Application No. 4-2012-001501
Date Filed: 08 February 2012

Trademark: **"REDBUCK'S COFFEE
SHAKES LOGO"**

Decision No. 2016- 24

DECISION

Starbucks Corporation¹ (Opposer) filed an opposition to Application No. 4-2012-001501. The contested application, filed by Israel C. Romano² (Respondent-Applicant), covers the mark "REDBUCK'S COFFEE SHAKES LOGO" for use on "food cart/kiosk" under Class 35 of the International Classification of Goods³.

The Opposer anchors its opposition on the provisions of paragraphs (d), (e) and (f) of Section 123 of the Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). It claims to be the owner of the "STARBUCKS" mark and logo, in various variants, which it applied and/or registered in the Philippines for various classes, including Class 35. It avers that it has used its marks and promoted the same in the country and elsewhere prior to the Respondent-Applicant's filing of its application. It asserts that the mark "REDBUCK'S COFFEE SHAKES LOGO" consisting of two concentric circles, the use and position of the word "BUCK'S", the position of the word "COFFEE" in the outer circle and the two dots on the opposite sides between the concentric circles, used in connection with Class 35, will mislead the purchasing public into believing that the Respondent-Applicant's services originate from or are under its sponsorship. In support of its opposition, the Opposer submitted the original notarized and legalized affidavit of Paul F. Mutty, with attachments and details of its trademark applications/registrations in the Philippines.⁴

A Notice to Answer was issued and served upon the Respondent-Applicant on 25 October 2012. The latter, however, filed its Answer only on 14 December 2012. The Hearing Officer then issued Order No. 2014-183 on 12 February 2014 denying

¹A corporation organized under the laws of the State of Washington with address at 2401 Utah Avenue South, Seattle, Washington 98134, USA.

²With known address at #57 A. Ceng-Cris Compound, #4 Tangos Baliuag Bulacan, Philippines.

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.

⁴ Marked as Exhibits "B" and "C", inclusive.

its Motion to Admit Attached Verified Answer and thus, the case is deemed submitted for resolution.

The issue to be resolved is whether the trademark application of Respondent-Applicant for "REDBUCK'S COFFEE SHAKES LOGO" should be allowed.

Records reveal that at the time Respondent-Applicant applied for registration of its mark on 08 February 2012, the Opposer has valid and existing registrations of its trademark "STARBUCKS", issued as early as 14 December 1999 under Certificate of Registration No. 4-1995-103604.

To determine whether the competing marks are confusingly similar, the same are reproduced below for comparison:



Opposer's mark



Respondent-Applicant's mark

The competing marks differ in color, in their respective beginning words "STAR" and "RED" and the figures inside the circles. These notwithstanding, the competing marks, based on their configuration of the components or features or presentations, are confusingly similar. Both incorporate a logo consisting of a ring inside a bigger circle. The positioning of the words "STARBUCKS" and "REDBUCK'S" is the same as well as the words "COFFEE" and "COFFEE SHAKES". Also, the positioning of the two dots that separate "REDBUCK'S" from "COFFEE SHAKES" is exactly the same as the two stars that separate "STARBUCKS" and "COFFEE". It appears that the Respondent-Applicant merely replaced the word "RED" for "STAR" and the mermaid logo for a buck figure in attempt to justify the use of "BUCK'S." Noteworthy, the common word "BUCKS" or "BUCK'S" is distinctive to coffee kiosks and/or establishments. Therefore, the Respondent-Applicant's applied mark closely resembles the pattern and presentation of the Opposer's mark. After all, Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the

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original as to deceive ordinary purchased as to cause him to purchase the one supposing it to be the other.⁵

Succinctly, since the Respondent-Applicant will use or uses the mark "REDBUCK'S COFFEE SHAKES LOGO" to services that are similar and/or closely related to that of Opposer's registered mark "STARBUCKS" marks, the differences will not diminish the likelihood of the occurrence of confusion, mistake and/or deception. It is highly probable that the purchasers will, at the very least, be reminded of the Opposer's marks when they encounter the Respondent-Applicant's. Withal, the protection of trademarks as intellectual property is intended not only to preserve the goodwill and reputation of the business established on the goods bearing the mark through actual use over a period of time, but also to safeguard the public as consumers against confusion on these goods.⁶

Moreover, it is settled that the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. Callman notes two types of confusion. The first is the *confusion of goods* "in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other." In which case, "defendant's goods are then bought as the plaintiff's, and the poorer quality of the former reflects adversely on the plaintiff's reputation." The other is the *confusion of business*: "Here though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff, and the public would then be deceived either into that belief or into the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."⁷

Finally, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. 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 product.⁸ Based on the above discussion, Respondent-Applicant's trademark fell short in meeting this function. The latter was given ample opportunity to defend its trademark application but Respondent-Applicant failed to do so.

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

⁵ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

⁶ Skechers, USA, Inc. vs. Inter Pacific Industrial Trading Corp., G.R. No. 164321, 23 March 2011.

⁷ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.

⁸ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-001501 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 25 January 2016.



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