



STARBUCKS CORPORATION D/B/A  
STARBUCKS COFFEE COMPANY,  
Opposer,

-versus-

MORINAGA NYUGYO KABUSHIKI  
KAISHA (MORINAGA MILK  
INDUSTRY CO., LTD.),  
Respondent -Applicant.

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IPC No. 14-2014-00114  
Opposition to:  
Appln. Serial No. 4-2013-502401  
Date Filed: 28 August 2013  
TM: "MT. RAINIER THE  
MOUNTAIN OF SEATTLE  
ESPRESSO & MILK"

X-----X

**NOTICE OF DECISION**

**QUISUMBING TORRES**  
Counsel for the Opposer  
12<sup>th</sup> Floor, Net One Center  
26 Street corner 3<sup>rd</sup> Avenue  
Crescent Park West, Bonifacio Global City  
Taguig City

**SAPALO VELEZ BUNDANG & BULILAN**  
Counsel for Respondent-Applicant  
11<sup>th</sup> Floor, Security Bank Centre  
6776 Ayala Avenue, Makati City

**GREETINGS:**

Please be informed that Decision No. 2016 - 156 dated May 31, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 31, 2016.

For the Director:

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

**STARBUCKS CORPORATION D/B/A  
STARBUCKS COFFEE COMPANY,**

Opposer,

-versus-

**MORINAGA NYUGYO KABUSHIKI  
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**IPC No. 14-2014-00114**

Opposition to Trademark  
Application No. 4-2013-502401  
Date Filed: 28 August 2013

Trademark: **"MT. RAINIER THE  
MOUNTAIN OF SEATTLE  
ESPRESSO & MILK"**

Decision No. 2016- 156

### DECISION

Starbucks Corporation D/B/A Starbucks Coffee Company<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-502401. The contested application, filed by Morinaga Nyugu Kabushiki Kaisha (Morinaga Milk Industry Co., Ltd.)<sup>2</sup> ("Respondent-Applicant"), covers the mark "MT. RAINIER THE MOUNTAIN OF SEATTLE ESPRESSO & MILK" for use on "*milk; milk products; milk beverages*" and "*coffee; unroasted coffee; coffee beverages with milk; coffee-based beverages; artificial coffee; sugar; ice cream; ice candies; sherbets; cones of icecream*" under Classes 29 and 30, respectively, of the International Classification of Goods<sup>3</sup>.

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 and in other countries and territories throughout the world. It asserts that the applied mark is confusingly similar to its "STARBUCKS" marks as both use concentric circles and color scheme. It points out that both marks cover goods in Classes 29 and 30. In support of its opposition, the Opposer submitted the original notarized and legalized affidavit of Atty. Laxmi J. Rosell, with annexes.<sup>4</sup>

The Respondent-Applicant filed its Answer on 10 September 2014 alleging, among others, that its registration of "MT. RAINIER THE MOUNTAIN OF SEATTLE

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

<sup>2</sup>With known address at 33-1, Shiba 5-Chome Minato-Ku, Tokyo (Jp).

<sup>3</sup> 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.

<sup>4</sup> Marked as Exhibits C" to "M", inclusive.

Republic of the Philippines

INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center # 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio, 1

Taguig City 1634 Philippines • [www.ipophil.gov.ph](http://www.ipophil.gov.ph)

T: +632-2386300 • F: +632-5539480 • [mail@ipophil.gov.ph](mailto:mail@ipophil.gov.ph)

ESPRESSO & MILK" is not made for the purpose of capitalizing upon or riding the goodwill of the Opposer. It maintains that the involved trademarks are distinguishable in spelling, sound, meaning, style and connotation. The Respondent-Applicant's evidence consists of the affidavit of Atty. Michael Andrew G. Malvar, with annexes.<sup>5</sup>

Pursuant to Office Order No. 154, s. 2010, the Hearing Officer referred the case to mediation. This Bureau's Alternative Dispute Resolution Services submitted a report that the parties refused to mediate. Accordingly, the Hearing Officer conducted and terminated the preliminary conference on 26 January 2016 wherein the parties were directed to submit their respective position papers. After which, the case is deemed submitted for decision.

The issue to be resolved is whether the trademark application of Respondent-Applicant for "MT. RAINIER THE MOUNTAIN OF SEATTLE ESPRESSO & MILK" should be allowed.

Section 123.1 subparagraphs (d), (e) and (f) of the IP Code provides that a mark cannot be registered if it:

***"(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:***

***(i) The same goods or services, or***

***(ii) Closely related goods or services, or***

***(iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;***

***(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;***

***(f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, That the interests of***

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<sup>5</sup> Marked as Exhibits "2" to "13", inclusive.



*the owner of the registered mark are likely to be damaged by such use;  
xxx"*

Records reveal that at the time Respondent-Applicant applied for registration of its mark on 29 August 2013, the Opposer has valid and existing registrations of its trademark "STARBUCKS", one of which is Certificate of Registration No. 4-1995-103604 issued on 14 December 1999 under.

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



**STARBUCKS**

*Opposer's marks*



*Respondent-Applicant's mark*

Looking at the Opposer's marks, what is impressed in the eyes and mind are either the word "STARBUCKS" and/or the mermaid figure. On the other hand, the prevalent features of the Respondent-Applicant's mark are the words "MT. RAINIER" and the picture of the mountain. As such, it is highly unlikely that the consumers will be confused, mistaken or deceived that the products of one is sponsored by or affiliated to the other. The only similarity between the competing marks is that both appropriate concentric circles. However, the same pales in significance in view of the obvious and unquestionable differences of the competing marks.

Also, the Trademark Registry of this Office reveals several other trademarks involving coffee products that likewise employ concentric circles in their trademarks, and which belong to different proprietors, including:



*Registration No. 4-2012-012918*



*Registration No. 4-2012-501901*



*Registration No. 4-2003-007867*



*Registration No. 4-2013-004151*

Finding no confusing similarity between the marks, there is no need to determine whether the Opposer's mark is well-known and is protected under Section 123.1 (e) and (f) of the IP Code.

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.<sup>6</sup> Based on the above discussion, Respondent-Applicant's trademark sufficiently met this function.

<sup>6</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

**WHEREFORE**, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2013-502401 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, **31 MAY 2016**

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