



INTELLECTUAL PROPERTY  
OFFICE OF THE PHILIPPINES

**STARBUCKS CORPORATION,**  
*Opposer,*

**-versus-**

**ISRAEL C. ROMANO,**  
*Respondent-Applicant.*

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**IPC No. 14-2016-00063**

Opposition to:

Appln. Serial No. 4-2015-009938

Date Filed: 28 August 2015

**TM: REDBUCKS**

**NOTICE OF DECISION**

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**GREETINGS:**

Please be informed that Decision No. 2018 - 02 dated 18 January 2018(copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 25 January 2018.

**MARILYN F. RETUAL**  
IPRS IV  
Bureau of Legal Affairs

**STARBUCKS CORPORATION,**  
Opposer,

-versus-

**ISRAEL C. ROMANO,**  
Respondent-Applicant.

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IPC No. 14-2016-00063

Opposition to Trademark  
Application No. 4-2015-009938  
Date Filed: 28 August 2012  
Trademark: "**REDBUCK'S**"

Decision No. 2018- 02

### DECISION

Starbucks Corporation<sup>1</sup> (Opposer) filed an opposition to Application No. 4-2015-009938. The contested application, filed by Israel C. Romano<sup>2</sup> (Respondent-Applicant), covers the mark "REDBUCK'S" for use on "*food kiosk*" and "*services for providing food and drink; restaurant services*" under Classes 35 and 43, 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 for various classes, including Classes 35 and 43. It avers that it also registered its marks in other countries. It asserts that the mark "REDBUCK'S" closely resembles its "STARBUCKS" mark and logo as to be likely to deceive or cause confusion. In support of its opposition, the Opposer submitted the following:

1. original notarized and legalized affidavit of Michael Fink, with attachments;
2. details of its trademark applications/registrations in the Philippines; and,
3. certified true copy of the decision of the case "Starbucks Corporations vs. Israel C. Romano" promulgated in 25 January 2016.<sup>4</sup>

The Respondent-Applicant filed its Answer denying that confusion will result with the registration of its mark. Among other thing, it alleges that "REDBUCK'S" is a full-menu food stand that serves different set of products from that of the Opposer's. its company is branded and marketed as the "three-in-one coffee shop, pizza house, fast food" while the Opposer's business is a traditional coffee shop. Also, both sell

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

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

<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 "B" to "D", inclusive.

luxury food items, it caters to the lower segment of the market. In addition, it believes that the consumers can easily distinguish between the two brands as they do not sell basic food items but luxury food items, not easily considered affordable. The Respondent-Applicant's evidence consists of its advertisements and a comparison of the competing marks.<sup>5</sup>

Pursuant to Office Order No. 154, s. 2010 and Office Order No. 197, s. 2010, this case was referred to mediation. The case, however was not settled for the reason that there was "no consensus on key issues." On 30 May 2017, the preliminary conference was conducted and the parties were directed to file their respective position papers. Upon submission and/or the lapse of the said period, the case is deemed submitted for decision.

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

Records reveal that at the time Respondent-Applicant applied for registration of its mark on 28 August 2015, 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:

**STARBUCKS**



*Opposer's marks*



*Respondent-Applicant's mark*

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<sup>5</sup> Marked as Exhibits "1" to "5".

The competing marks differ in color, in their respective beginning words "STAR" and "RED" and their presentation. These notwithstanding, the competing marks, based on their configuration of the components or features or presentations, are confusingly similar. It appears that the Respondent-Applicant merely replaced the word "RED" for "STAR" and/or 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, it is highly possible for one who encounters "REDBUCKS" to confuse, mistake or at the very least, be reminded of the Opposer's "STARBUCKS" 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 original as to deceive ordinary purchased as to cause him to purchase the one supposing it to be the other.<sup>6</sup>

Succinctly, since the Respondent-Applicant will use or uses the mark "REDBUCK'S" 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. 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.<sup>7</sup>

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."<sup>8</sup>

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

<sup>6</sup> Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

<sup>7</sup> Skechers, USA, Inc. vs. Inter Pacific Industrial Trading Corp., G.R. No. 164321, 23 March 2011.

<sup>8</sup> Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.

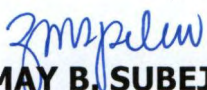
merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.<sup>9</sup> Based on the above discussion, Respondent-Applicant's trademark fell short in meeting this function.

Accordingly, this Bureau finds and concludes 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. 4-2015-009938 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 18 JAN 2018

  
**Atty. Z'SA MAY B. SUBEJANO-PE LIM**  
Adjudication Officer  
Bureau of Legal Affairs

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<sup>9</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.