

SUYEN CORPORATION,
Opposer,

-versus-

SCIPIO CORPORATION,
Respondent-Applicant.

X-----X

}
} **IPC No. 14-2011-00366**
} Opposition to:
} Appln. Serial No. 4-2010-990263
} Date Filed: 24 December 2008
} **TM: "COFFEECAT & DESIGN"**
}

NOTICE OF DECISION

MIGALLOS & LUNA LAW OFFICES

Counsel for the Opposer
7th Floor, The Phinma Plaza
39 Plaza Drive, Rockwell Center
Makati City

ALVIZO LAW OFFICE

Counsel for Respondent-Applicant
Unit 206-Cm, Bajada Plaza Building
J.P. Laurel Avenue, Davao City

GREETINGS:

Please be informed that Decision No. 2016 - 33 dated January 28, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 28, 2016.

For the Director:


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

SUYEN CORPORATION,
Opposer,

- versus -

SCIPIO CORPORATION,
Respondent-Applicant.
X-----X

IPC No. 14-2011-00366
Opposition to:

Appln. Serial No. 4-2010-990263
Date filed: 24 December 2008
Trademark: **"COFFEECAT &
DESIGN"**

Decision No. 2016 - 33 -

DECISION

SUYEN CORPORATION ("Opposer"),¹ filed a verified opposition to Trademark Application Serial No. 4-2010-990263. The application, filed by SCIPIO CORPORATION ("Respondent-Applicant"),² covers the mark "COFFEECAT & DESIGN" for use on goods under class 43³, namely: "coffee shop".

The Opposer alleges the following grounds for opposition:

"Opposer Suyen will be damaged by the registration of the mark covered by Respondent-Applicant's application. The said mark is identical to and confusingly similar with Opposer's duly registered trademarks. The said mark will also mislead the public into believing that the products bearing the said mark are the same products marketed and sold by Opposer or that the goods originated from the same source.

"In its totality, the 'COFFEECAT & DESIGN' mark of respondent-applicant is practically identical and confusingly similar with Suyen's CAT Device trademarks.

"Likelihood of confusion is further highlighted by the known fact that Suyen directly or through its sister company, is engaged in the coffee and internet cafe businesses.

"The use of respondent-applicant's mark even on goods not covered by the CAT DEVICE of Suyen will create confusion. Suyen will also be prevented from expanding its CAT DEVICE to its coffee and internet cafe businesses."

The Opposer's evidence consists of the following:

1. Affidavit of Suyen's Group Brand Manager;
2. Photographs of various BENCH products;
3. Trademark Application No. 4-2001-004438 for KAPE LATTE mark;
4. Certificate of Registration No. 4-2001-004440 for >BE CONNECTED mark;

¹ A corporation duly organized and existing under the laws of the Republic of the Philippines, with principal address at 12th Floor, Centerpoint Condominium, Garnet Road corner Julia Vargas Avenue, Ortigas Center, Pasig City.

² A corporation duly organized and existing under the laws of the Republic of the Philippines, with address at 1052 EDSA, Magallanes Village, Makati City.

³ The Nice Classification of goods and services is for registering trademark and service marks, based on a multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

5. Certificate of Registration No. 059967 for HERBENCH;
6. Photographs of Suyen's HERBENCH stores in the Philippines;
7. Certificate of Registration Nos. 4-2006-001706 and 4-2010-002854 for HERBENCH & CAT DEVICE and CAT DEVICE marks, respectively;
8. Photographs of HERBENCH products bearing the CAT DEVICE;
9. Samples of HERBENCH advertising materials featuring the CAT DEVICE;
10. Photographs of models wearing clothes featuring the CAT DEVICE.

On 20 December 2011, Respondent-Applicant filed its Verified Answer alleging the following:

"6. Opposer would not be damaged by the registration of the 'COFFEE CAT & DESIGN' and related trademarks since Respondent-Applicant is the owner, first adopter and user of the 'COFFEECAT & DESIGN' and related marks. Thus, Opposer's notice of opposition must likewise fail for lack of a ground/cause of action.

"7. To protect its ownership over the trademark 'COFFEECAT & DESIGN' considering that it is the first to adopt and use the said trademark/tradename, Respondent-Applicant applied with the IPOPHIL for its registration under Serial No. 42010990263 for 'coffee shop' under Class 43.

"8. Respondent-Applicant's 'COFFEECAT & DESIGN' and related marks were conceptualized in early 2007 for the purpose of opening a coffee shop to offer an improved quality of cafe experience in Davao City.

The name 'COFFEECAT' in Respondent-Applicant's 'COFFEECAT & DESIGN' and related marks were derived from an intriguing play of words coupled by a serendipitous association to a small cat-sized mammal known as the Asian Palm Civet that consumes coffee berries - the product of which is one of the most-highly prized coffees in the world today. xxx

"9. Respondent-Applicant has been openly and continuously using the 'COFFEECAT & DESIGN' and related marks for several years. It also maintains a website, www.yourcoffecat.com, to promote its stores and products.

"10. Respondent-Applicant's trademark 'COFFEECAT & DESIGN' and related marks are neither identical nor confusingly similar to Opposer's trademarks 'HERBENCH & CAT DEVICE' and 'CAT DEVICE'. Respondent-Applicant's trademark 'COFFEECAT & DESIGN' and related marks are arbitrary marks which differ in overall sound, spelling, meaning, style, configuration, presentation, style and appearance from the Opposer's trademarks 'HERBENCH & CAT DEVICE' and 'CAT DEVICE'. The dissimilarities between the trademarks are so distinct, thus, confusion is very unlikely. Respondent-Applicant's trademarks are distinctive and capable of identifying its services and distinguishing them from those offered for sale by others in the market, including the Opposer's goods.

x x x

"13. Even granting for the sake of argument that the presence of a common device/design of a 'cat' in both Respondent-Applicant's and Opposer's marks is to be considered, Opposer cannot exclusively appropriate device/design of a 'cat' since other marks, e.g., 'JUMPING CAT DEVICE', 'FORTUNE CAT WITH CAT DEVICE & CHINESE CHARACTER', '9 AND CAT DEVICE IN RECTANGLE', 'CAT DEVICE', 'PUMA WITH JUMPING CAT DEVICE', 'FELIX THE CAT (DESIGN)', 'FELIX THE CAT & CAT DESIGN', 'CAT DESIGN', etc., are all validly registered in the names of other parties and remain active.

"14. Again, Respondent-Applicant's 'COFFEECAT & DESIGN' and related marks cover coffee shop under class 42, while Opposer's 'HERBENCH & CAT DEVICE' and 'CAT DEVICE' marks cover goods under classes 3, 18 and 25. Hence, Respondent-Applicant serves upon which

the 'COFFEECAT & DESIGN' and related marks are used, obviously differ from Opposer's goods. For certain, confusion is not likely."

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

1. Certificates of Registration and Articles of Incorporation issued by the Securities and Exchange Commission;
2. History of Respondent-Applicant's COFFEECAT tradename/trademarks, and evidence of use;
3. Print-out of the website and domain name registration, www.yourcoffecat.com;
4. Print-out from IPO's website containing the pertinent trademark database.

The preliminary conference was held and terminated on 05 June 2012. The parties submitted their respective position on papers. Thus, this instant case is submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark COFFEECAT AND DEVICE?

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 out into the market a superior 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.⁴

The Opposer anchors its opposition on Sec. 123.1 (d) 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 a mark as to be likely to deceive or cause confusion. The Opposer also cites Sec. 147.1 of the Code.⁵

In this regard, the records show that at the time the Respondent-Applicant filed its trademark application on 24 December 2008, the Opposer has existing trademark registration for the mark "HERBENCH & CAT DEVICE" under Reg. No. 4-2006-001706 dated 30 April 2007⁶, and Reg. No. 4-2010-002854 dated 18 November 2010⁷. Under the law, a certificate of registration constitutes a prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.⁸

The competing marks are reproduced below for comparison and scrutiny:

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).

⁵ 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.

⁶ Exhibit "G" of Opposer.

⁷ Exhibit "G-1" of Opposer.

⁸ Sec. 138, IP Code.



Opposer's Trademarks



Respondent-Applicant's Trademark

It appears that there is similarity in the competing marks which refer to "a representation or silhouette of a cat sitting on all fours, with its tail raised and showing on the cat's right side". Opposer's mark is a distinct representation of a cat animal except for minor deviation on the body form of the cat device.

That the Respondent-Applicant is seeking the registration of COFFEECAT and DEVICE for services different from the good covered by the Opposer's certificates of registrations⁹ is not sufficient to sustain the contention of Respondent-Applicant. The allowance of the subject application would create an impression that the mark is owned by the Opposer and is just a variation of the Opposer's mark. The likelihood of confusion therefore, would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:¹⁰

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. Hence, 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 belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

In this regard, while the Opposer's goods are different from the goods/services covered by the Respondent-Applicant's trademark application, such may be assumed to originate with the Opposer and the public would then be deceived to believe that there is some connection between the Opposer and the Respondent-Applicant, which, in fact, does not exist. The likelihood of confusion would subsist not on the purchaser's perception of goods but on the origins thereof. Consequently, the registration of the Respondent-Applicant's mark would cause damage to the Opposer.

⁹ Reg. No. 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, Reg. No. 4-2010-002854: "body spray, deo body spray, pressed powder, foundation, lip gloss, lipstick, eyeshadow" under class 03; "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.

¹⁰ Sterling Products International, Inc. v. Farbenfabriken Bayer Aktiengesellschaft, G.R. No. L-19906, 30 April 1969.

Finally, this Bureau takes judicial notice of the Decision¹¹ rendered by the Office of the Director General¹², declaring the Opposer-Appellant Suyen Corporation (herein Opposer) as the rightful owner of the trademark "COFEECAT-CAT DEVICE" mark. Said Decision involves the same parties and virtually similar trademark, covering goods under Class 43. Pertinent portions of the said Decision reads, as follows:

"In this case, the Appellant has secured certificates of registration that illustrate the 'representation or silhouette of a cat sitting on all fours, with its tail raised and showing on the cat's right side'. While it is true that the representation of a cat is also found in several trademark registrations, the Appellant's trademarks are distinct representations that point out to the Appellant as source of the products covered by these marks. To allow, therefore, the Appellee to register a similar mark would defeat the rationale of trademark registration.

x x x

The Appellant's trademarks illustrated as 'Cat Devices' are highly distinctive marks that have been associated to it even prior to the Appellee's use of COFEECAT-CAT DEVICE. It is, thus, surprising and is unlikely a coincidence that the Appellee could come up with an identical or similar mark. To come up with an arguably highly distinctive and uncommon mark, which has been previously appropriated by another, for use on one's business, without any explanation is something mind-boggling. The field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitations, the unanswered riddle is why, of the millions of terms and combination of letters and designs available, the Appellee had to come up with a mark so closely similar to another's mark if there was no intent to take advantage of goodwill generated by the other mark."

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2010-0990263 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 28 January 2016.


Atty. **NATHANIEL S. AREVALO**
Director IV, Bureau of Legal Affairs

¹¹ Docketed as Appeal No. 14-2012-0054 in IPC No. 14-2011-00367, dated 18 November 2013.

¹² This Office (IPOPPhil).