JOLLIBEE FOODS CORPORATION, *Opposer* -versus- FAR EAST MED CARE INC., *Respondent-Applicant.*	} } } } } } } } }	Inter Partes Case No. 14-2006-00112 Opposition to: Appl'n Serial No.: 4-2005-004331 Date Filed : 12 May 2005 Trademark : "BEE CLEAN PLUS with SLOGAN and DEVICE"
x----------x		Decision No. 2007-46

DECISION

This is an opposition to the registration of the mark "BEE CLEAN PLUS with SLOGAN and DEVICE" bearing Application No. 4-2005-004331 filed on May 13, 2005 covering the goods "detergent bar, detergent powder" falling under class 3 of the International Classification of goods which published in Intellectual Property Philippines (IPP) Electronic Gazette (E-Gazette) and released for circulation on April 25, 2006.

The Opposer in the instant opposition is "JOLLIBEE FOODS CORPORATION" a company organized and existing under the laws of the Philippines with address at 10th Floor, Jollibee Plaza Building, No. 10 Emerald Avenue, Ortigas Center, Pasig City, Philippines.

The Respondent-Applicant on the other hand is "FAR EAST MED CARE, INC.," with address at c/o AD Tuazon Street, Sta. Mesa heights, Quezon City.

Grounds for the opposition are as follows:

"1. The registration of the mark subject of this opposition is contrary to the provisions of Section 123.1 (d), (e) and (f) of Republic Act No. 8293, which prohibit the registration of a mark that:

"(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.

"2. The Opposer is the owner of the bee mascot device (shown below) which is registered under Registration No. 4-1995-105714 issued on 12 July 2000 and Registration No. 4-1998-102456 issued on 20 January 2003.

"3. The bee device forming part of Respondent-Applicant's mark resembles the Opposer's bee mascot device as to be likely to deceive or cause

confusion. Hence, the registration of the Respondent-Applicant's mark will be contrary to Section 123.1 (d) of Republic Act No. 8293. Clearly, the Respondent-Applicant intends to exploit the goodwill associated with the bee mascot device.

"4. The Respondent-Applicant's use of the bee device forming part of its mark mislead consumers into believing that the Respondent-Applicant's goods are pronounced by, originated from, or are under the sponsorship of the Opposer.

"5. The Respondent-Applicant's use of the bee device forming part of its mark will mislead the public into believing that the Respondent-Applicant's goods are associated with the Opposer's inability to control the quality of the goods put on the market by the Respondent-Applicant under the mark subject of this opposition.

"6. The Respondent-Applicant's use of the bee device forming part of its mark will take unfair advantage of, dilute and diminish the distinctive character or reputation of the Opposer's bee mascot device and will encroach on the zone of the natural expansion of the Opposer's business on which the bee mascot device is used.

"7. The denial of the application subject of this opposition is authorized under provisions of Republic Act No. 8293.

The Opposer relied in the following facts to support its opposition:

"1. The Opposer is the owner of the bee mascot device, which has been applied for registration and registered in the name of the Opposer in the Philippines and in other countries prior to the filing date of the opposed application.

"2. The bee device forming part of the mark subject of the opposed application is visually identical to the Opposer's registered bee mascot device.

"3. The Opposer has not consented to the Respondent-Applicant's use and registration of the bee device forming part of the Respondent-Applicant's mark, or any other mark identical to Opposer's bee mascot device.

"4. The Respondent-Applicant's use of a bee device as a trademark is likely to deceive or cause confusion and will dilute the distinctiveness of the Opposer's registered bee mascot device.

"5. The Opposer's bee mascot device has been in commercial use in the Philippines and in other countries and territories prior to the filing date of the application subject of this opposition. Opposer's use of the bee mascot device began in the Philippines as early as 1975 and has been continuous and uninterrupted ever since then.

"6. The Opposer has not abandoned the bee mascot device and continued to use the bee mascot device in trade and commerce in the Philippines and in other countries and territories.

"7. By virtue of the prior and continuous use by the Opposer of the bee mascot device in the Philippines and in other countries and territories, the bee mascot device has become popular and well-known and has

established for the Opposer valuable goodwill with the public which has identified the Opposer as the source of goods on which the bee mascot device is used.

"8. Over the years, the Opposer has obtained significant exposure for its goods on which the bee mascot device is used, in various media including television, the internet, commercials, outdoor advertisements, and other promotional materials. The bee mascot device is also promoted at the domain www.jollibee.com.ph which can be readily accessed by internet users.

The Bureau of Legal Affairs issued Notice to Answer to the Respondent-Applicant dated January 30, 2007 requiring the said party to file its Answer within thirty (30) days from receipt.

Despite receipt of the Notice to Answer, Respondent-Applicant did not file the required answer, together with the affidavit of its witness and other documents in support of its application, hence the same is considered waived.

Section 11 of the Summary Rules (Office Order No. 79, Series of 2005) provides:

"Section 11. *Effect of failure to file an Answer*. – In case the Respondent-Applicant fails to file an answer, or if the answer is filed out of time, the case shall be decided on the basis of the Petitioner or Opposer."

Opposer submitted the following exhibits as its evidence:

Exhibit "A"	-	Notice of Opposition
Exhibit "B"	-	Affidavit of Luis Enrico E. Salvador.
Exhibit "C"	-	Certified true copy of Registration No. 4-1995-105714 for the trademark "MASCOT DEVICE" registered on June 12, 2000.
Exhibit "D"	-	Copy of Certificate of Registration No. 4-1995-102456 for the mark "JOLLIBEE AND MASCOT DEVICE" registered on January 20, 2003.

On the other hand, Respondent-Applicant failed to file the required Answer and so with the affidavit of its witness and the documents in support of its application subject of the instant opposition.

The only issue to be resolved in this case is:

WHETHER OR NOT RESPONDENT-APPLICANT IS ENTITLED TO THE REGISTRATION OF THE MARK "BEE CLEAN PLUS WITH SLOGAN AND DEVICE".

The applicable provision of the law is Sec. 123 (d) of Republic Act No. 8293, which provides:

Sec. 123. *Registrability* – 123.1. *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 of priority date, in respect of:

a. The same goods or services, or

b. Closely related goods or services, or

c. If it nearly resembles such a mark as to be likely to deceive or cause confusion;

Records will show that the Opposer's marks consists of the "MASCOT DEVICE" bearing Registration No. 4-1995-105714 registered on July 12, 2000 (Exhibit "C") and "JOLLIBEE AND MASCOT DEVICE" bearing Registration No. 4-1995-102456 registered on January 20, 2003 (Exhibit "D")

Below is the illustration of Opposer's marks:

Mascot Device
Registration No. 4-1995-105714

Jollibee Mascot & Device
Registration No. 4-1995-102456

On the other hand, the Respondent-Applicant's mark consists of "BEE CLEAN PLUS with SLOGAN and DEVICE".

Below is the illustration of Respondent-Applicant's mark:

In order to determine whether the two competing marks are identical or appears to be confusingly similar to each other, it is necessary to consider their components or compositions as both marks are composite because each of them is composed of more than one word.

In Emerald Garments Manufacturing Corporation vs. Court of Appeals [251 SCRA 600], the Supreme Court ruled that:

> "In the history of trademark cases in the Philippines, particularly in ascertaining whether one trademark is confusingly similar to or is a colorable imitation of another, no set rules can be deduced. Each case must be decided on its own merits."

Likewise in the case of Societe Des Produits Nestle, S.A. et. al. vs. Court of Appeals, et. Al., 356 SCRA 207, the Supreme Court re-iterated that:

> "The likelihood of confusion is a relative concept, to be determined only according to the particular and sometimes peculiar circumstances of each case. In trademark cases, even more than in any litigation, precedent must be studied in light of the facts of the particular case. The wisdom of the likelihood of confusion test lies in its recognition that each trademark infringement case presents its own unique set of facts. Indeed the complexities attendant to an accurate assessment consulting the relevant factual landscape be comprehensively examined."

In ascertaining whether one trademark is confusingly similar to or is a colorable imitation of another, two kinds of test have been developed. The *"DominancyTest"* applied in Asia Brewery, Inc., vs. Court of Appeals, 224 SCRA 437; Co Tiong vs. Director of Patents, 95 Phil 1: Lim Hoa vs. Director of Patents, 100 Phil. 214; American Wire & Cable Co., vs. Director of Patents, 31 SCRA 544; Philippine Nut Industry, Inc., vs. Standard Brands, Inc., 65 SCRA 575; Converse Rubber Corporation vs. Universal Rubber Products, Inc., 147 SCRA 154 and the *"Holistic Test"* developed in Del Monte Corporation vs. Court of Appeals, 181 SCRA 410; Mead Johnson & Co. Vs. N.V.J. VSN Dorp., Ltd., 7 SCRA 771; Bristol Myers Co. vs. Director of Patents, 17 SCRA 128; Fruit of the Looms vs. Court of Appeals, 113 SCRA 405.

As its title implies, the *test of dominancy* focuses on the similarity of the prevalent essential or dominant features of the competing trademarks which might cause confusion or deception. On the other side of the spectrum, the *Holistic Test* mandates that the entirety of the mark in question must be considered in determining confusing similarity.

In the case at bar, the dominant feature of the Opposer's marks is the "MASCOT DEVICE" which is almost the same as the "device" incorporated in the Respondent-Applicant's mark subject of the instant opposition. It cannot be denied that the Bee device in Opposer's as well as that of Respondent's mark are almost the same.

As alleged by the Opposer, its "MASCOT DEVICE" has been commercially used in the Philippines and in other countries and territories prior to the filing date of the application subject of the instant opposition.

In one of the cases decided by the Supreme Court, it discussed the two types of confusion in trademark infringement. The first is "*confusion of goods*" when an otherwise prudent purchaser is induced to purchaser one product in the belief that he is purchasing another, in which case defendant's goods are then bought as the plaintiff's and its poor quality reflects badly on the plaintiff's reputation. The other is "*confusion of business*" wherein the goods of the parties are different but the defendant's product can be reasonably (though mistakenly) be assumed to originate from the plaintiff, thus deceiving the public into believing that there is some connection between the plaintiff and the defendant which in fact does not exist. (Mighty Corporation vs. E & J Gallo Winery Corporation, G.R. No. 154342, July 14, 2004).

It is very difficult to understand why the Respondent-Applicant incorporated as its trademark the "MASCOT DEVICE" which is a registered mark and commercially used in the Philippines and in other countries and territories by the Opposer for so many years if not with the intention of taking advantage of the reputation and goodwill of the Opposer's mark.

It is very difficult to understand why the Respondent-Applicant incorporated as its trademark the "MASCOT DEVICE" which is a registered mark and commercially used in the Philippines and in other countries and territories by the Opposer for so many years if not with the intention of taking advantage of the reputation and goodwill of the Opposer's mark.

Confusing similarity could have been avoided had Respondent-Applicant's mark not included the mascot device which has been appropriated and registered by the Opposer and which is continuously using it.

In the case (Philippine Nut Industry, Inc., vs. Standard Brands, Inc., 65 SCRA 575) the Supreme Court ruled that:

> "There is infringement of trademark when the use of the mark involved would be likely to cause confusion or mistake in the mind of the public or to deceive purchasers as to the origin or source of the commodity. Whether or not a trademark causes confusion and is likely to deceive the public is a question of fact which is to be resolved by applying the "*test of dominancy*" meaning, if the competing trademarks contain the main or essential or dominant features of another by reason of which confusion or deception are likely to result, the infringement takes place; the duplication or imitation is not necessary similarity in the dominant features of the trademark would be sufficient.

WHEREFORE, viewed in the light of the foregoing, this Bureau finds and so holds that Respondent-Applicant's mark is confusingly similar to Opposer's mark and as such the opposition is hereby SUSTAINED. Consequently, trademark application bearing Serial No. 4-2005-004331 filed on May 12, 2005 for the mark "BEE CLEAN PLUS with SLOGAN and DEVICE" is hereby REJECTED.

Let the filewrappers of the trademark "BEE CLEAN PLUS with SLOGAN and DEVICE" subject matter of this case together with a copy of this DECISION be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 24 April 2007.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office