

JOLLIBEE FOODS CORPORATION
Opposer,
- versus -

IPC 14-2006-00165

Opposition to:
TM Application No. 4-2005-003283
(Filing Date: 12 April 2005)

HAMBLES FOOD, INC.,
Respondent-Applicant.

TM: "JOLLYDAY & DEVICE"

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Decision No. 2007 – 143

DECISION

For resolution is the Opposition filed by Jollibee Foods Corporation (the "Opposer") against Application No. 4-2005-003283 filed by Hambels Food, Inc. (the "Respondent-Applicant") on 12 April 2005 for the registration of the mark JOLLYDAY & DEVICE covering goods in Class 29, specifically but not limited to hotdogs, ham, patties & meatloaf upon the ground that the mark JOLLYDAY & DEVICE resembles the JOLLIBEE mark of Opposer.

Opposer, JOLLIBEE FOODS CORPORATION (hereafter the "Opposer") is a corporation duly organized and existing under the laws of the Republic of the Philippines, with principal place of business at 10th Floor, Jollibee Plaza Building, #10 Emerald Avenue, Ortigas Center, Pasig City, Philippines.

Respondent-Applicant, HAMBELS FOOD, INC., is a corporation organized and existing under the laws of Republic of the Philippines, with business address at No. 12 Brgy. Banay-Banay, Cabuyao, Laguna.

On 14 November 2006, Opposer filed the instant Opposition against Respondent-Applicant's Application for registration of the trademark JOLLYDAY & DEVICE for goods under Class 29, specifically but not limited to hotdogs, hams, patties, and meatloaf.

On 21 November 2006, this Bureau issued a Notice to Answer, copy of which together with the Opposition was received by Respondent-Applicant on 11 December 2006. The Notice to Answer required Respondent-Applicant to submit its Verified Answer within thirty (30) days from receipt thereof.

On 10 January 2007, Respondent-Applicant filed its Verified Answer to the Opposition after successive motions for extension of time to file the same were granted.

Grounds for Opposition

Opposer filed the instant Opposition based on the following grounds:

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

(d) Is identical with a registered mark belonging to a different proprietor or a 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 and first user of the JOLLIBEE mark which has been used and registered in the Philippines and in other countries.
3. "The Respondent-Applicant's mark resembles the JOLLIBEE mark 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 JOLLIBEE mark.
4. "The Respondent-Applicant's use of the JOLLYDAY mark will mislead consumers into believing that the Respondent-Applicant's goods are produced by, originate from, or are under the sponsorship of the Opposer.
5. "The Respondent-Applicant's use of the JOLLYDAY mark will mislead the public into believing that the Respondent-Applicant's goods are associated with the Opposer. Therefore, potential damage to the Opposer will be caused as a result of 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 JOLLYDAY mark will take unfair advantage of, dilute and diminish the distinctive character or reputation of the JOLLIBEE mark.
7. "The denial of the application subject of this opposition is authorized under other provisions of Republic Act No. 8293.

Opposer relied on the following facts to support its opposition: (1) The Opposer owns the trademark JOLLIBEE with date of registration and use in the Philippines and abroad prior to the filing date of the subject mark (see pars. 1, 6 & 7, Opposition), (2) Respondent-Applicant's mark JOLLYDAY & DEVICE is visually and phonetically similar to Opposer's JOLLIBEE mark (see par. 2, Opposition), (3) Opposer did not consent to Respondent's use and application for the registration of the mark in issue (see 3, Opposition); (4) That use of Respondent-Applicant's JOLLYDAY mark is likely to deceive or cause confusion and will dilute the distinctiveness of Opposer's JOLLIBEE mark (see pars. 4&5, Opposition). (5) That due to continuous use, promotion and advertisement of Opposer's JOLLIBEE mark, said mark have become popular and well-known (see pars. 8&9, Opposition).

Respondent, through Counsel, filed its Answer and interposed the following defenses, to wit:

1. "The mark JOLLYDAY as applied for registration by Hambels Food, Inc. per Application No. 4-2005-003283 on 12 April 2005 (Exhibit 1) is not identical with the registered mark JOLLIBEE as claimed by the Opposer to be contrary to the provision of Section 123.1 (d) of the Republic Act No. 8293, as amended, on the following reasons:
 - a. The mark JOLLYDAY has a very different meaning with the mark JOLLIBEE

Jollyday – means joyful day, while
Jollibee – means joyful bee
 - b. The mark JOLLYDAY is different in spelling and pronunciation with the mark JOLLIBEE.

- c. The mark and device of JOLLYDAY as filed to this office is different and does not resemble the mark JOLLIBEE. The device of JOLLYDAY mark is “a sunshine with happy face in yellow and red peep behind the word JOLLYDAY” (Exhibit 2) while the devices of JOLLIBEE mark, as registered and approved by this honorable office per various Certificate of Registrations are represented by a word “Jollibee” alone (Exhibit 3), “Jollibee and Mascot Bee device” (Exhibit 3A) and a fanciful representation of a bee’s head with a cup within a square” (Exhibit 3B).
2. “The Applicant has filed the mark JOLLYDAY in good faith and has no intention whatsoever to deceive or cause confusion with any other existing and registered mark.
3. “The Applicant denied the allegation of the Opposer that the applicant has intended to exploit the goodwill associated with JOLLIBEE mark. It is a well-known fact that the Opposer is a fast food-chain commissary servicing directly its customers on a dine-in service similar to other fast food restaurants while Applicant is a registered manufacturer of processed food products and cater its dealers in wet market and supermarket.
4. “ The Applicant believes that the JOLLYDAY mark as applied to this Honorable Office will not mislead consumers into believing that the products are produced by, originate from, or are under the sponsorship of the Opposer since the packaging label of the Applicant’s products bearing the mark and device JOLLYDAY clearly bears the name of the manufacturer HAMBELS FOOD, INC. which is duly registered in Securities and Exchange Commission per Reg. # A200016458 dated October 24, 2000 under the laws of the Republic of the Philippines as a separate, distinct and juridical person. (Exhibit 4). Respondent Hambels Food, Inc. has a different address with that of the Opposer, Jollibee Food Corp.
5. “The Applicant denied the allegation of the Opposer that JOLLYDAY mark will mislead the public into believing that the Applicant’s goods are associated with the Opposer. Applicant’s rebuttal and justifiable reasons were already explained in item 4 above. Furthermore, the Opposer claimed of potential damage as a result of the Applicant’s inability to control the quality of the goods produced by the Applicant as separate, distinct and juridical personality is approved and licensed to operate by Bureau of Food and Drugs (Exhibit 5) and other government agencies and has its own organizational set-up with systems, policies and procedures in place to ensure that the quality of applicant’s products released in the market has met the standards set not only by the governing agencies but with the applicant’s internal pre-defined and established product specifications.
6. “The Applicant refutes Opposer’s allegation that applicant’s use of the mark JOLLYDAY as applied to this Honorable Office will dilute and diminish the distinctive character or reputation of JOLLIBEE mark. This is malicious, contemptuous and baseless since the JOLLYDAY mark is very much different from JOLLIBEE mark. On the contrary the Applicant, Hambels Food, Inc., will take all measure and step to protect its integrity, credibility and reputation as a separate, distinct and juridical person recognized under the existing laws of the Republic of the Philippines.
7. “The denial of Applicant’s application for the approval of the mark JOLLYDAY will apparently distort the authenticity of the provision of Republic Act No. 8293 particularly Section 123.1 (d).

and further stated the following:

8. "The Applicant respectfully recognized that the Opposer is the registered owner of JOLLIBEE mark.
9. "The Applicant denied that JOLLYDAY mark is visually and phonetically similar to JOLLIBEE mark as it has different meaning, spelling and resembling sounds.
10. "The Applicant, Hambels Foods, Inc. has a separate and distinct personality of its own and authorize to operate under the existing laws of the Republic of the Philippines, is not required to ask consent from Opposer, Jollibee Foods, Corp. in applying to this honorable office of the mark "Jollyday" as applicant does not violate any provision of Republic Act No. 8293.
11. "The Applicant's use of its own trademark JOLLYDAY is not intended to deceive or cause confusion to any party or whatsoever nature.
12. "The Applicant's use of the mark JOLLYDAY will not dilute distinctiveness of the JOLLIBEE mark as it is clearly and obviously different from each other.
13. "The Applicant recognized the long existence of JOLLIBEE mark and its use in the Philippines and in other countries but opposed any allegation that applicant's JOLLDAY mark violates any provision of its registration.
14. "The Applicant recognized that Opposer did not abandon its use of JOLLOBEE mark but the applicant's mark JOLLDAY is not the same as JOLLIBEE mark.
15. "The Applicant recognized that Opposer JOLLIBEE mark had become popular and well-known and has established valuable goodwill but not the JOLLYDAY mark as being applied by the applicant to this honorable office.
16. "The Applicant recognized the promotions and advertisement continuously undertake by the Opposer of its own trademark JOLLIBEE, but not of the JOLLYDAY mark.

Filed as evidence for the Opposer, based on the records, are the following:

1. Verified Notice of Opposition - Exhibit "A"
2. Affidavit of Luis Enrico Salvador - Exhibit "B"
3. Certification on authority of Luis Enrico Salvador to verify the notice of opposition And execute the certificate of non-forum Shopping - Exhibit "C"
4. Certified true copy of Philippine application No. 4-2000-004772 - Exhibit "D"
5. Certified true copy of Philippine registration No. 4-2000-007421 - Exhibit "E"
6. Certified true copy of Philippine application No. 4-2005-007558 - Exhibit "F"
7. Certified true copy of Philippine registration No. 4-1995-102456 - Exhibit "G"

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| 8. | Certified true copy of Philippine registration
No. 4-1995-100403 | - | Exhibit "H" |
| 9. | Certified true copy of Philippine registration
No. 4-1995-100404 | - | Exhibit "I" |
| 10. | Certified true copy of Philippine application
No. 4-2005-002450 | - | Exhibit "J" |
| 11. | Certified true copy of Philippine application
No. 4-2003-008178 | - | Exhibit "K" |

Filed as evidence likewise for Respondent-Applicant were the following: TM Application No. 4-2004-003283 (Exhibit "1", Applicant); Registrability Report for JOLLYDAY & DEVICE ((Exhibit "2", Applicant); Certificate of Registration No. 42000007421 for the mark JOLLIBEE (Exhibit "3", Applicant); Certificate of Registration No. 41995102456 for the mark JOLLIBEE AND MASCOT DEVICE (Exhibit "3A". Applicant); Certificate of Registration No. 41995100404 for the mark JOLIBEE GREAT BURGERS GREAT CHICKEN & DEVICE (Exhibit "3B", Applicant).

Issues

The issues to be solved in the instant Opposition case are:

- (a) Whether or not Respondent-Applicant' trademark JOLLYDAY & DEVICE is confusingly similar to Opposer's JOLLIBEE trademark such that Opposer will be damaged by registration of JOLLYDAY & DEVICE mark in the name of Respondent-Applicant; and
- (b) Whether or not Respondent-Applicant's trademark application for JOLLYDAY & DEVICE should be granted registration.

From receipt of the Answer, a reply was subsequently filed by Opposer alleging, inter alia, that:

"THAT ANSWER IS NOT VERIFIED AND SHOULD THUS BE CONSIDERED S NOT HAVING BEEN FILED" before dwelling on issues about confusing similarity and priority in adoption and registration in the case at bar, this Bureau finds it imperative to delve on or first determine the verification issue. As to the alleged inconsistency in the date of execution of the Answer which was dated January 08, 2006 in relation to the date of the notarization of the verification and certification appearing as December 29, 2006, this Bureau is convinced that the same was the result of oversight or a typographical error in the light of attendant circumstances which does not materially alter or defeat the substance and merit of the assailed Answer of Respondent-Applicant. But if ever, what is controlling is the date when the verification/certification was made and notarized because the verification referred to the pleading itself, the Answer. And on December 29, 2006, it was signed before the notary public so the signing happened at the time it was notarized. This Bureau finds satisfactory the explanation given by Respondent-Applicant's representative, Mr. Abelardo Jimena, in the hearing on 15 February 2007 that the error was not on the year but on the date itself:

MR. JIMENA:

Your Honor, the question whether the date is a typographical error or not. The date in our reply was dated... apparently it was dated January 8, 2006. So, it was verified and notarized December 29, 2006. So, the question is, where the typo error lies, is it on the date or is it on the month? I manifest that the error was on the date and not on the year, your Honor.

This Bureau quotes the portion of the verification in Respondent-Applicant's Answer upon which opposer based its contention for considering the verification as undersigned pleading:

"That I have caused the preparation of this foregoing answer to Notice of Opposition and all allegations contained therein are true and correct of my own personal knowledge, information and belief and based on authentic documents."

Although Respondent stressed that matters in his Answer were obtained from information and belief, he made particular mention of the fact that these were sourced and based from authentic documents, and therefore are true and correct of his knowledge and not merely speculative. He cited like wise that other than information and belief, these matters were obtained from his own personal knowledge.

A Preliminary Conference of the instant suit was initially held on 15 February 2007 but due to Opposer's motion to resolve the above procedural issue, the scheduled conference was reset for 15 March 2007 and finally on 12 July 2007, after the subject procedural issue raised was resolved by virtue of Oder No. 2007-1166 and for failure of Respondent-Applicant to appear on the scheduled preliminary conference, the same was terminated.

Considering that the case was mandatorily covered by the Summary Rules under Office Order No. 79, this Bureau required Opposer through counsel to file its position paper. Opposer filed its position paper on 07 August 2007.

Opposer filed its application for its trade mark JOLLIBEE for Class 29 in the Philippines on 09 February 1995 and was granted registration on 15 May 2000 under duly issued Certificate of Registration No. 4-1995-100403 (Exhibit "H", Opposer). Respondent applied for the registration of the mark JOLLYDAY & on 12 April 2005, or more than a decade after Opposer filed its trademark JOLLIBEE for goods falling under Class 29. Although Opposer has shown prior registration thereof, were there evidence sufficient to prove confusing similarity in both trademarks?

This Bureau finds that the issue of confusing similarity can best be resolved by comparative examination or analysis of the marks in question. A comparison of Opposer's and Respondent-Applicant's marks will show that Respondent's JOLLYDAY & DEVICE is not confusingly similar to any of Opposer's registered JOLLIBEE family of marks.

This Bureau reproduced Opposer's as well as Respondent-Applicant's marks for purposes of Comparison.

Opposer's Mark

Applicant's mark

as shown in TM registration no. 42000007421 as shown in Appl. Serial No. 42005003283

The mark JOLLYDAY & DEVICE was printed and stylized in complete variation to the Opposer's JOLLIBEE family of marks. Although aurally, they may sound the same when uttered, JOLLI vis-à-vis JOLLY, the presentation of the labels are totally different. A mere examination and comparison of the competing marks reveal that the letters J, O, L, L are the letters appearing in both marks. The records disclose however that apart from the use of the word JOLLY/JOLLI, there are other essential features composing Applicant's JOLLYDAY mark which included the use of a device consisting of the image of sunshine with a happy face above the word JOLLYDAY. Underneath the sunshine device or design comprising Applicant's JOLLYDAY mark is written the word JOLLYDAY with only the first letter J in upper case letter and printed in blue

script Present in both trademarks is the word JOLLY/JOLLI, but the position of the word JOLLY for applicant is in blue color with the sunshine device in yellow background. Opposer's JOLLIBEE trademark is written in horizontal form with all the letters capitalized but wider in font as against Applicant's JOLLYDAY mark which is predominantly of the color blue/yellow and the letters in narrow print. Hence, both marks are similar only in the use and adoption of the word JOLLY/JOLLI with Applicant using the generic word JOLLY as against Opposers JOLLI, they vary substantially as well in the composition and integration of the other main and essential features, in the general design and their overall appearance. It is observed that an ordinary consumer's attention would not be drawn on the minute similarities that were noted but on the differences or dissimilarities of both service marks that are glaring and striking to the eye.

In the case of Mead Johnson vs. N.V.J. Van Corp, Ltd., 7 SCRA 768, no less than the Supreme Court ruled that : while these are similarities in spelling, appearance and sound between "ALACTA" and "ALASKA" the trademarks in their entirety as they appear in their respective labels show glaring and striking differences or similarities such as in size of the containers, the colors of the labels, inasmuch as one uses light blue, pink and white, while Van Dorp containers uses two color bands, yellowish white and red; furthermore the mark "ALACTA" has only the first letter capitalized and is written in black while the mark "ALASKA" has all the letters capitalized written in white except that of the condensed full cream milk which is red.

Similarly, the Supreme Court recognized the following as registrable trademarks for medical products: BIOFERIN and BUFFERIN (Bristol Myers Company vs. The Director of Patents and United American Pharmaceuticals, Inc., 17 SCRA 128) ; and SULMET and SULMETINE (American Cyanamid Company vs. Director of Patents, et. al. G.R. No. L-23954, April 29, 1977);

The adoption of JOLLI in Opposer's JOLLIBEE family of marks does not create for or confer upon Opposer the right to exclusively appropriate the word JOLLY. JOLLY is an ordinary and generic word and no one has exclusive use to it. The use of JOLLY may constitute a valid trademark particularly in combination of words and syllables can be registered as trademarks for as long as it can individualize the goods of a trader from the goods of its competitors. Bolstering this observation is the pronouncement by the Court in the case of Etepha vs. the Director of Patents, Westmont Pharmaceutical, Inc., 16 SCRA 495, " that while the word by itself cannot be used exclusively to one's goods it may properly become a subject of a trademark by combination with another word or phrase; hence, Athena's "Pertussin" and Westmont's "Atussin"

Opposer further argues that JOLLIBEE family of marks are popular and/or well-known citing provision for the protection of well-known marks for goods or services which are either identical or similar as contained in Section 123.1 (e) of the Intellectual Property Code of the Philippines (R.A. 8293).

Before evidence showing well-knownness of the mark is assessed and evaluated, there must be shown or established confusing similarity of the trademarks in question. Inasmuch as this Bureau finds no confusing similarity between the subject trademarks in the light of discussions on the evidence adduced and/or presented to this Bureau, the issue of well-knownness of the mark has become unnecessary.

All told, confusion or deception to the purchasing public or the apprehension, if at all, that the public may be misled into believing that there is some connection or association between Opposer's goods and services using its JOLLIBEE family of marks and Applicant's JOLLYDAY & DEVICE, the likelihood that these goods may be mistaken as coming from the same origin, is far-fetched.

Based on the foregoing and despite allegation of prior use of Opposer in the Philippines of JOLLIBEE family of marks, this Bureau resolves to grant protection to Respondents-Applicant's mark JOLLYDAY & DEVICE, the two marks not being confusingly similar.

WHEREFORE, based on the foregoing facts and the evidence, the Notice of Opposition filed by herein Opposer is, as it is hereby, DENIED. Accordingly, application bearing Serial No. 4-2005-003283 for the mark "JOLLYDAY & DEVICE" filed on 12 April 2005 for use on goods under Class 29 is hereby GIVEM DUE COURSE.

Let filewrapper of JOLLYDAY & DEVICE, subject matter of this case together with a copy of this Decision be forwarded to Bureau of Trademarks for appropriate action.

SO ORDERED.

15 October 2007, Makati City.

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