

JOLLIBEE FOODS CORPORATION,  
Opposer,

IPC No. 14-2007-00033  
Case Filed: 02 February 2007  
Opposition to:  
Appln. Serial No. 4-2000-005814  
Date Filed: 13 July 2000  
Trademark: JELLYBEE

- versus -

HEALTHY & YOUNG MULTI-FOOD  
CORPORATION,  
Respondent-Applicant.  
x-----x

Decision No. 2008-165

## DECISION

For decision is the Opposition filed by Jollibee Foods Corporation (the "Opposer") against Application No. 4-2000-005814 filed by Healthy & Young Multi-Food Corporation (the Respondent-Applicant") on 13 July 2000 for the registration of the mark JELLYBEE covering goods under Class 30, specifically for jelly and gelatin candies (in different flavors) candies, chiz curls and cracker nuts snack upon the grounds that the mark JELLYBEE 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 10<sup>th</sup> Floor, Jollibee Plaza Building, #10 Emerald Avenue, Ortigas Center, Pasig City, Philippines.

Respondent-Applicant, HEALTHY & YOUNG MULTI-FOOD CORPORATION, is a corporation organized and existing under the laws of Republic of the Philippines, with business address at Km. 15 MacArthur Hi-way, Dalandan, Valenzuela City, Metro Manila.

On 02 February 2007, Opposer filed the instant Opposition against Respondent-Applicant's Application for registration of the trademark JELLYBEE for goods under Class 30, specifically for jelly and gelatin candies (in different flavors) candies, chiz curlz and cracker nuts snack.

On 01 June 2007, this Bureau issued an Alias Notice to Answer. The Notice to Answer required Respondent-applicant to submit its Verified Answer within thirty (30) days from receipt thereof.

On 01 February 2008, 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 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 JELLYBEE 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 JELLYBEE 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 JELLYBEE mark will take unfair advantage of, dilute and diminish the distinctive character or reputation of the JOLLIBEE mark.

6.1 The Opposer's use of the JOLLIBEE mark has begun as early as 1978 in the Philippines and has been continuous and uninterrupted ever since then.

7. "The Opposer has not abandoned the JOLLIBEE mark and continues to use it in trade and commerce in the Philippines and in locations outside the Philippines.

8. "By virtue of the prior and continuous use by the Opposer of the JOLLIBEE mark in the Philippines, the JOLLIBEE mark 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 good on which the JOLLIBEE mark is used.

9. "Over the years, the Opposer has obtained significant exposure for its goods on which the JOLLIBEE mark is used, in various media including television, the internet, commercials, outdoor advertisements, and other promotional materials. The JOLLIBEE mark is also promoted at the domain [www.jollibee.com.ph](http://www.jollibee.com.ph), which can be readily accessed by internet users.

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

#### ADMISSIONS

1. "The allegations in the prefatory paragraph of the Notice of Opposition as to the existence of the JELLYBEE trademark application of the respondent and its publication in the Trademark e-Gazette including the corporate existence and address of opposer Jollibee Foods Corporation;
2. "The allegations in paragraph 2 of the grounds for opposition and paragraph 1 of the facts relied upon by the Opposer;
3. "The allegations in paragraph 3 of the facts relied upon by the Opposer but only in so far as the JELLYBEE trademark is concerned;
4. "The allegations in paragraphs 6 and 7 of the facts relied upon by the Opposer in so far as the alleged long, continues and unabandoned commercial use of the JOLLIBEE trademark in the Philippines is concerned.

## DENIALS

5. "The claim of the Opposer in the prefatory statement of the Notice of Oppositions that it will be damaged by the registration of the Respondent's JELLYBEE trademark application;
6. "Paragraph 1, 3, 4, 5, 6 and 7 of the grounds for opposition;
7. "Paragraphs 2, 4, 5, 6.1, 8 and 9 of the facts relied upon by the Opposer.

and by way of special and Affirmative Defenses in support of the foregoing specific denials, pleaded stating thus:

8. "Opposer has no valid cause of action against the Respondent;
9. "Contrary to Opposer's claim, the trademark JELLYBEE of the herein Respondent is visually and phonetically different from the JOLLIBEE trademark of the Opposer. Respondent's trademark was coined from the words "jelly" and "bee" while Opposer's trademark is derived from the words "jolly" and "bee". Emphasis must be given to the fact that the term jelly in Respondent's trademark is a dictionary word which means "a food, soft when hot, but somewhat firm and partly transparent when cold" (The World Book Dictionary, 1994 edition). On the other hand, the term jolly in Opposer's trademark means "very cheerful, full of fun, merry" (The World Book Dictionary, 1994 edition). This whole of difference in the meaning of jelly and jolly, alone, is more than sufficient to make the contending trademarks distinctive from each other.

In term of appearance, Respondent's trademark is presented artistically in wave-like motion which is not the case in the Opposer's trademark;

10. "Opposer cannot deprive Respondent from appropriating the term BEE as part of Respondent's trademark since BEE is not a trademark of the Opposer. Opposer's mark is JOLLIBEE as a whole. And since JELLY is far from being similar in sound, spelling appearance and meaning from JOLLI, Respondent entitled to use and register the trademark JELLYBEE for jelly or gelatin products;
11. "Respondent adopted the term JELLY as part of its trademark to describe the business and products of the Respondent which are jelly or gelatin food products and that the term "BEE" was purposely adopted to describe the sweet taste of its jelly or gelatin products as "bee" is known to produce *honey* symbolizing sweet taste;
12. "Respondent and Opposer are engaged in different kinds of business and deals with different types of products. Respondent is engaged in the manufacture and sale of jellies produced and packed in various forms in a jelly or gelatin factory for distribution and sale to groceries and sari-sari stores. Opposer, on the other hand, is engaged in fastfood and restaurant business where foods are prepared and offered only at Jollibee outlets. As a matter of fact, Opposer from the time it started in 1978 never produced, served or offered jellies or gelatins in its Jollibee outlets. In brief, no confusion or likelihood of confusion would arise from the use of the parties' contending trademarks since the respective products of the parties are different and flow through a different channel of trade;
13. "Respondent has been using the trademark JELLYBEE openly, extensively, and continuously from January 2001 up to the present. Through out the said period, Respondent had not received not heard even a single complain or comment from

the buying public of any incident of actual or possible confusion with the Jollibee trademarks due to Respondent's use of the JELLYBEE trademark. Thus, Opposer's claim that Respondent's use of the trademark JELLYBEE is likely to deceive or cause confusion is more imaginary than real;

14. "Respondent adopted in good faith the trademark JELLYBEE for its jelly products without any reference to the JOLLIBEE trademarks of the Opposer nor does Respondent had the slightest intention to ride on the goodwill or popularity of the Opposer's mark when it decided to adopt JELLYBEE as its trademark;
15. "Respondent truly believes that an honest and unbiased mind will consider its JELLYBEE trademark not confusingly similar with the JOLLIBE trademark;
16. "With all the foregoing, it can be said the filing of the instant Notice of Opposition is an abuse in the exercise of intellectual property rights on the part of Opposer to the extreme prejudice of the Respondent.

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. Secretary's Certificate proving Luis Enrico Salvador's authority to verify the notice of opposition and execute the certificate of non-forum shopping and the undersigned's authority to represent Opposer in these proceedings - *Exhibit "C"*
4. Copy of Certificate of Registration No. 4-1995-100404
5. Copy of Certificate of Registration No. 4-1995-100403 - *Exhibit "D"*
6. Copy of Certificate of Registration No. 4-1995-102456 - *Exhibit "E"*
7. Copy of Certificate of Registration No. 4-2000-007421 - *Exhibit "F"*
8. Copy of Certificate of Registration No. 4-2000-004772 - *Exhibit "G"*
- *Exhibit "H"*

Filed as evidence likewise for Respondent-Applicant were the following: Secretary's Certificate of Board Resolution authorizing: the defense of the JELLYBEE trademark application, authorizing Mr. Chua to execute the verification and certification of non-forum shopping and appointing Atty. Clarence Lee Evangelista to act as counsel for the corporation in Inter-Partes Case No. 14-2007-00033 (*Exhibit "1", Applicant*); Affidavit of Francis Dennis Chua (*Exhibit "2", Applicant*); Certified true copy of Certificate of Incorporation of Healthy & Young Multi-Food Corporation (*Exhibit "3", Applicant*); Certified true copy of By-Laws of Healthy & Young Multi-Food Corporation (*Exhibit "3-A", Applicant*); Certified true copy of License to Operate as a Manufacturer of Healthy & Young Multi-Food Corporation (*Exhibit "4", Applicant*); Certified true copy of License to Operate as a Food Distributor/Importer of Healthy & Young Multi-food Corporation (*Exhibit "4-A", Applicant*); Samples of actual products bearing the trademark JELLYBEE (*Exhibits "5", "5-A" to "5-D", applicant*); Sales Invoices showing sales of JELLYBEE jelly products (*Exhibit "6", "6-A" to "6-MM", applicant*); Lists of customers of Healthy & Young Multi-Food Corporation distributing/selling JELLYBEE jelly products (*Exhibits "7", "7-A" to "7-F", Applicant*); and Promotional/Advertisement materials (*Exhibits "8", "8-A", "8-B", Applicant*).

## Issues

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

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

A Preliminary Conference of the instant suit was held on 18 March 2008 and on the same date, the parties agreed to terminate the said conference. 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 28 July 2008 while Respondent-Applicant filed theirs on same date.

Opposer filed its application for its trademark JOLLIBEE for Class 29 in the Philippines on 09 February 1995 and was granted registration on 15 May 2000 under a duly issued Certificate of Registration No. 4-1995-100403. Respondent applied for the registration of the mark JELLYBEE on 13 July 2000, or more than five (5) years after Opposer filed its trademark JOLLIBEE for goods falling under Class 29. Although Opposer has shown prior registration thereof, were the evidence sufficient to prove confusing similarity in both trademarks?

On the basis of the evidence presented, there is a shown clear and convincing proof that the two (2) competing trademarks, JOLLIBEE of Opposer and Respondent-Applicant's JELLYBEE are confusingly similar. Below is a side-by-side comparison between Opposer's registered mark JOLLIBEE and Respondent JELLYBEE mark, subject of this instant suit and/or opposition:

**JOLLIBEE**

Opposer's mark

**Jellybee**

Applicant's mark

*as shown in TM registration no. 42000004772*

*as shown in Appl. Serial No. 42000005814*

The marks JOLLIBEE and JELLYBEE are both one-word marks that are made up of the letters J, L, B and E. Both contain three (3) syllables and bear the first letter "J" with the same, of identical sounds with almost similar consonant and vowel content. Respondent-Applicant's insertion of the letters "E" and "Y" in JELLYBEE in place of the letters "O" and "I" of Opposer's registered JOLLIBEE trademark did not significantly or effectively change the mark nor how the mark will be pronounced, the sound effect or pronunciation is still the same. Applying the doctrine, this Bureau considers the subject mark JELLYBEE to be *idem sonans* to be registered trademark JOLLIBEE (Sapolin Co. vs. Balmaceda, 67 Phil. 795), JOLLIBEE and JELLYBEE sound alike when spoken.

For purposes of illustration, this Bureau has adopted the declaration of the Court in the case of Celanes Corporation of America vs. E.I. Du Pont de Nemours & Co. (1946), 154F. 2d 146 148 which held that "the following words have the same significance or have the same appearance and meaning:

*"CELDURA" and "CORDURA" – That both marks considered as a whole are similar in meaning and appearance cannot be doubted. When spoken as written they sound very much alike. Similarity of*

*sound alone, under such circumstances, is sufficient to cause the marks to be regarded as confusingly similar when applied to merchandise of the same descriptive properties.”*

This Bureau likewise compared and contrasted the details of the two trademarks and considered such other factors as: *appearance, form, style, size, spelling, and pronunciation*, and concludes that they are indeed confusingly similar. In one case, *Amigo Manufacturing vs. Cluett Peabody Co.*, G.R. No. 139300, March 14, 2001, which presented the same antecedent facts of circumstances for resolution, the Supreme Court ruled that:

*“With respect to the issue of confusing similarity between the marks of the petitioner and that of the respondent-registrant applying the tests of idem sonans, the mark ‘GOLD TOP & DEVICE’ is confusingly similar with the mark ‘GOLD TOE’. The difference in sound occurs only in the final letter at the end of the marks. For the same reason, hardly is there any variance in their appearance. ‘GOLD TOE’ and ‘GOLD TOP’ are printed in identical lettering. Both show [a] representation of a man’s foot wearing a sock. ‘GOLD TOP’ blatantly incorporates petitioner’s ‘LINENIZED’ which by itself is a registered mark.”*

Comparing both marks in plain view, there certainly is obvious similarity. Anyone is likely to be misled by the adoption of the same spelling and almost the same sound or pronunciation of JELLYBEE mark vis-à-vis Opposer’s registered JOLLIBEE trademark. Hence, Respondents’ JELLBEE mark lacks the element of originality to be sufficiently distinctive. The court observed in *Philippine Refining Co, Inc., vs. Dir. Of Patents and Sparklets Corp. vs. Walter Kidde Sales Co.*, 104 F. 2d 396, that “a trademark is designed to identify the user. But it should be so distinctive and sufficiently original as to enable those who come in contact with it to recognize instantly the identity of the user. It must be affirmative and definite, significant and distinctive, capable to indicate the origin.” Likewise, our trademark law does not require identity. Confusion is likely if the resemblance is so close between two trademarks. Bolstering this observation is the pronouncement by the court in the case of *Forbes, Munn & Co. (Ltd.) vs. Ang San To*, 40 Phil. 272, 275 where it stated that *the test was similarity of “resemblance between the two (trademarks) such as would be likely to cause the one mark to be mistaken for the other. . . . [But] this is not such similitude as amounts to identity.”*

More importantly, the JOLLIBEE as word mark is not generic. The word is a combination of two generic terms “JOLLY” and “BEE”, the combination of which is Opposer’s original concept or creation which entitles Opposer to prevent Applicant from using the same word combination. The word JOLLIBEE as used by Opposer is not a descriptive trademark, it is arbitrary. It does not describe the nature of identity of the product or service for which it is used. Such word-combination of Opposer’s JOLLINEE trademark, “JOLLI” combined with another word “BEE”, is not that would naturally occur to Respondent-Applicant or any other trader for that matter to use and/or conceptualize, thus, arriving at a combination of “JELLY” and “BEE” for goods under Class 30 specifically for jelly and gelatin candies (in different flavors) candies, chiz curls and cracker nuts snack, if there is no existing JOLLIBEE in the market for that matter.

Having shown and proven resemblance of the two marks at issue, we now delve on the matter of priority in use and registration which certainly has decisive effect in the adjudication of the case. Culled from IPP’s website [www.ipophil.gov.ph](http://www.ipophil.gov.ph) are documents showing that Opposer is the registered owner in the Philippines of the JOLLIBEE family of marks, as follows:

<i>Trademark</i>	<i>Registration Number</i>	<i>Nice Classification</i>	<i>Date Filed</i>	<i>Date Registered</i>
JOLLIBEE	4-2000-004772	29, 30, 32, 42	6/8/2000	03/10/2006
JOLLIBEE	4-2000-007421	16, 28	8/31/2000	9/24/2005
JOLLIBEE	4-2005-007558	9, 18, 20, 21, 24, 25	8/5/2005	2/19/2007

JOLLIBEE AND MASCOT DEVICE	4-1995-102456	29	5/23/1995	1/20/2003
JOLLIBEE GREATBURGERS GREAT CHICKEN & DEVICE-A FANCIFUL REPRESENTATION OF A BEE'S HEAD WITH A CAP WITHIN A SQUARE	4-1995-100403	29	2/9/1995	5/15/2000
JOLLIBEE GREATBURGERS GREAT CHICKEN & DEVICE-A FANCIFUL REPRESENTATION OF A BEE'S HEAD WITH A CAP WITHIN A SQUARE	4-1995-100404	42	2/9/1995	3/23/2000
JOLLIBEE SUPERMEALS	4-2005-002450	43	3/15/2005	12/18/2006
JOLLIBEE YAMBURGER AND DEVICE	4-2003-008178	29 and 43	9/4/2003	12/18/2006

Opposer's JOLLIBEE trademarks were applied for trademark registration with the Intellectual Property Office as early as 2 February 1995 for goods and services under Classes 29 and 42, while Respondent-Applicant's JELLYBEE was only applied for registration last 13 July 2000.

From the evidence presented, the stand of Opposer as prior user and registrant was put forth with greater plausibility. As held in the case of Unno Commercial Enterprises, Inc. vs. General Milling Corporation "*prior use by one will controvert a claim of legal appropriation by subsequent users*". Hence, it may be concluded inevitably that Respondent-Applicant's use of substantially the same mark on the same or related goods will result in an unlawful appropriation of mark previously used by Opposer and not abandoned.

This present Opposition is anchored on Opposer's claim of ownership over the use of the trademark JOLLIBEE for goods and services under Classes 29, 30 and 42, among others, pursuant to Section 123.1 (d) of R.A. 8293, to wit:

*"Section 123. Registrability. – 123.1. A mark cannot be registered if it:*

xxx

- (e) *Is identical wit 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;"*

xxx

It may well be worthy to note that as early as the year 1995, Opposer already applied for trademark registration of JOLLIBEE trademarks in the Philippines and obtained registration in

2000 for products and services falling under classes 29 and 42. These registrations are subsisting and have not been abandoned. Hence, Respondent-Applicant, by any parity of reasoning, cannot be considered an originator, prior registrant nor a prior applicant of the subject or questioned trademark.

It is worth mentioning at this juncture, to bolster Opposer's exclusive right over its registered JOLLIBEE family marks and accord protection henceforth against any subsequent user is the established goodwill and reputation for its JOLLIBEE trademark that Opposer had earned over the years. Opposer's registered JOLLIBEE trademarks are widely and popularly used by Opposer especially on its food and restaurant business. Therefore, the use and adoption by applicant of substantially the same mark JELLYBEE as subsequent user can only mean that Applicant wishes to reap on the goodwill, benefit from the advertising value and reputation of Opposer's famous JOLLIBEE trademarks.

By appropriating a word which closely resembles that of a widely used and popularly known trademark, and taking into account the evidence submitted by Opposer, this Bureau holds that indeed, there was a deliberate intent by Respondent-Applicant to ride on the popularity and goodwill of the mark of the Opposer generated through extensive use and advertisement without the Respondent-Applicant having incurred any expense to gain such goodwill and/or reputation.

In the case of American Wire & Cable Co. vs. Director of Patents, 31 SCRA 544, it was observed that:

*"Why of the million of terms and combination of letters and designs available the appellee had to choose a mark so closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark"*

In like manner, the court in a long line of cases ruled thus:

*"Those who desire to distinguish their goods from the goods of another have a broad field from which to select a trademark for their wares and there is no such poverty in the English language or paucity of signs, symbols, numerals etc. as to justify one who really wishes to distinguish his product from the other entering the twilight zone of or field already appropriated by another (Weco Products Co., Milton Ray Co., 143 F. 2d. 985, 32 C.C.P.A. Patents 1214).*

*"xxx why, with all the birds in the air, and all the fishes in the sea, and all the animals on the face of the earth to choose from, the defendant company (Manila Candy Co.) elected two roosters as its trademark. Although its directors and managers must have been well aware of the long continued use of a rooster by the plaintiff with the same and achievement of its goods? x x x a cat, a dog, a carabao, a shark, or an eagle stamped upon the container in which candies are sold would serve as well as rooster for the product of defendants factory. Why did defendant select two roosters for the product of defendant's factory. Why did defendant select two roosters as its trademark? (Clarke vs. Manila Candy Co., 36 Phil 100)."*

As rightful owner and prior user of the JOLLIBEE trademark, Opposer should be given protection against entities that merely wish to take advantage of the goodwill its marks have generated.

WHEREFORE, premises considered, the Notice of Opposition is, as it is hereby SUSTAINED. Consequently, Application bearing Serial No. 4-2000-005814 filed by Healthy & Young Multi-Food Corporation on 13 July 2000 for the registration of the mark JELLYBEE specifically for jelly and gelatin candies (in different flavors) candies, chiz curls and cracker nuts snack is, as it is hereby REJECTED.

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

SO ORDERED.

Makati City, 12 September 2008.

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