



JOLLIBEE FOODS CORPORATION,
Opposer,

-versus-

BESTCHOICE PACKAGING INC.,
Respondent-Applicant.

X-----X

}
} IPC No. 14-2010-00195
} Opposition to:
} Appln. Serial No. 4-2009-009144
} Date filed: 11 Sept. 2009
} TM: "HAPPYBEE/ BESTCHOICE
} INC. AND DEVICE"
}

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2012 – 215 dated October 30, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 30, 2012.

For the Director:



Atty. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs



JOLLIBEE FOODS CORPORATION,
Opposer,

- versus -

BESTCHOICE PACKAGING, INC.,
Respondent-Applicant.

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IPC No. 14-2010-00195

Opposition to:

Appln. Ser. No. 4-2009-009144

Date Filed: 11 September 2009

Trademark: **HAPPYBEE/
BESTCHOICE INC. AND DEVICE**

Decision No. 2012 - 215

DECISION

JOLLIBEE FOODS CORPORATION¹ ("Opposer") filed on 01 September 2010 a Notice of Opposition to Trademark Application No. 4-2009-009144. The application, filed by BESTCHOICE PACKAGING, INC.² ("Respondent-Applicant"), covers the mark HAPPYBEE/BESTCHOICE INC. AND DEVICE used for goods under Class 21³, particularly, "*domestic plastic utensils – spoon, fork and toothpick*".

The Opposer alleges the following:

"1. The registration of the mark HAPPYBEE is contrary to the provisions of Sections 123.1 (d), (e) and (f) of Republic Act No. 8293, as amended, which prohibit the registration of a mark that:

x x x

"2. The Opposer is the owner and first user of the internationally well-known JOLLIBEE marks and related marks (hereafter the "JOLLIBEE MARKS") which have been registered and/or applied for registration with the Philippine Intellectual Property Office in class 21, among other classes. The details of these marks appear below.

Registrations:

Mark	Registration No.	Date Issued	Classes
JOLLIBEE	4-2005-007558	19 February 2007	9, 18, 20, 21, 24, 25

¹ A company organized under the laws of the Philippines with address at 7th Floor, Jollibee Plaza Building, #10 Emerald Avenue, Ortigas Center, Pasig City, Philippines.

² With address on record at No. 8 Arellano Street, Brgy. Bagong Barrio, Caloocan City, Metro Manila.

³ Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

 JOLLIBEE MASCOT	4-2008-007562	23 July 2009	16, 18, 20, 21, 24, 25, 27, 28, 41
 BEE HEAD DEVICE	4-2005-007557	19 February 2007	9, 16, 18, 20, 21, 24, 25, 28

“3. The JOLLIBEE MARKS have also been registered and/or applied for registration in the name of the Opposer with the Philippine Intellectual Property Office for food and food-related products and services in various classes, to wit:

Registrations:

Mark	Registration No.	Date Issued	Classes
JOLLIBEE	4-2000-004772	10 March 2006	29, 30, 32, 42
 BEE HEAD DEVICE	4-2004-006570	6 January 2006	43
 MASCOT DEVICE	4-1995-105714	12 July 2000	42

Applications:

Mark	Application No.	Date Filed	Classes
 Jollibee JOLLIBEE LOGO AND DEVICE	4-2010-002055	24 February 2010	29, 30, 43
 BEE DEVICE	4-2010-002056	24 February 2010	29, 30, 43

"4. Respondent-Applicant's mark HAPPYBEE is confusingly similar to the Opposer's JOLLIBEE marks.

"4.1. The term HAPPYBEE, which appears prominently in the Respondent-Applicant's mark, is a combination of "HAPPY" and "BEE", and closely resembles JOLLIBEE which combines "JOLLY" and "BEE". Both HAPPYBEE and JOLLIBEE have identical suffixes, i.e., "BEE". The component "HAPPY" in HAPPYBEE is also identical in meaning and concept to "JOLLY" in JOLLIBEE in that they both describe a feeling of joy, well-being and elation.

"4.2. HAPPYBEE is phonetically indistinguishable from JOLLIBEE. Both words have three (3) syllables. The second and third syllables of HAPPYBEE, i.e., "PI" and "BEE", which figure prominently in its pronunciation, sound exactly like the second and third syllables of JOLLIBEE, pronounced as "LI-BEE", thereby making it extremely difficult to distinguish the marks apart from each other. Under the *idem sonans* rule, marks that sound the same are deemed confusingly similar even though they may be spelled differently.

"4.3. The BEE DEVICE in the mark HAPPYBEE imitates the Opposer's marks JOLLIBEE MASCOT, BEE HEAD DEVICE and BEE DEVICE as to be likely to cause

public confusion. The design of the eyes, bow tie, white gloves and antennae of the BEE DEVICE of the mark HAPPYBEE are conspicuously similar to the eyes, bow tie, white gloves and antennae which are distinctive of the Opposer's marks JOLLIBEE MASCOT, BEE HEAD DEVICE and BEE DEVICE.

"4.4. The use of the Respondent-Applicant's mark HAPPYBEE on "domestic plastic utensils – spoon, fork and toothpick" in class 21 under which the Opposer's JOLLIBEE MARKS are used and registered will deceive consumers by suggesting a connection, association or affiliation with the Opposer, thereby causing substantial damage to the goodwill and reputation associated with the JOLLIBEE MARKS. 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 MARKS.

"5. The Respondent-Applicant's use of the mark HAPPYBEE will mislead consumers into believing that the Respondent-Applicant's goods are produced by, originate from, or are under the sponsorship of the Opposer.

"6. The Opposer's JOLLIBEE MARKS are well-known and world famous trademarks. Hence, the registration of the Respondent-Applicant's mark HAPPYBEE will constitute a violation of Sections 123.1 (e) and 123.1 (f) of Republic Act No. 8293.

"7. Opposer has used the JOLLIBEE MARKS in the Philippines and elsewhere prior to the filing date of the application subject of this opposition. The Opposer continues to use the JOLLIBEE MARKS in the Philippines and in numerous other countries worldwide.

"8. The Opposer has also extensively promoted the JOLLIBEE MARKS in the Philippines and in other countries around the world. Over the years, the Opposer has obtained significant exposure for the products and services upon which the JOLLIBEE MARKS are used in various media, including television commercials, outdoor advertisements, internationally well-known print publications, and other promotional events.

"9. Opposer has not consented to the Respondent-Applicant's use and registration of the mark HAPPYBEE, or any other mark identical or similar to the Opposer's JOLLIBEE MARKS.

"10. The Respondent-Applicant's use of the mark HAPPYBEE on "domestic plastic utensils – spoon, fork and toothpick" will mislead the purchasing public into believing that the Respondent-Applicant's goods are produced by, originate from, or are under the sponsorship of 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 HAPPYBEE.

"11. The use by the Respondent-Applicant of the mark subject of this opposition in relation to its goods which are identical, similar and/or closely related to the Opposer's goods will take unfair advantage of, dilute and diminish the distinctive character or reputation of the Opposer's JOLLIBEE MARKS.

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

The Opposer's evidence consists of the following:

1. Exhibit "A" - Original notarized Verified Notice of Opposition;
2. Exhibit "B" - Original notarized Affidavit of Atty. Gonzalo D. V. Go III;
3. Exhibit "B-1" - Screen shot of the company's website www.jollibee.com.ph featuring the JOLLIBEE mascot;
4. Exhibit "B-2" - Table showing the details of the applications and registrations for the JOLLIBEE marks worldwide;
5. Exhibit "C" - Certified true copy of Philippine Trademark Registration No. 4-1995-105714 for MASCOT DEVICE (A FANCIFUL REPRESENTATION OF A BEE);
6. Exhibit "D" - Certified true copy of Philippine Trademark Registration No. 4-2000-004772 for JOLLIBEE;
7. Exhibit "E" - Certified true copy of Philippine Trademark Registration No. 4-2005-007557 for BEE HEAD DEVICE;
8. Exhibit "F" - Certified true copy of Philippine Trademark Registration No. 4-2005-007558 for JOLLIBEE;
9. Exhibit "G" - Certified true copy of Philippine Trademark Registration No. 4-2008-007562 for JOLLIBEE MASCOT DESIGN;
10. Exhibit "H" - Certified true copy of Philippine Trademark Application No. 4-2010-002055 for JOLLIBEE LOGO AND DEVICE;
11. Exhibit "I" - Certified true copy of Philippine Trademark Application No. 4-2010-002056 for BEE DEVICE;
12. Exhibit "J" - Sample of eating utensils with Jollibee Bee Head;
13. Exhibit "K" - Original notarized Certificate executed by William Tan Untiong ; and
14. Exhibit "L" - Original notarized Secretary's Certificate executed by William Tan Untiong.

This Bureau served a Notice to Answer upon the Respondent-Applicant's counsel on 31 May 2012. The said party, however, despite the grant of its motion for extension, did not file the Answer. Thus, Order No. 2012-1301 dated 27 September 2012 was issued declaring the Respondent-Applicant in default and submitting the case for decision on the basis of the opposition, affidavit of witness and documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the trademark HAPPYBEE/BESTCHOICE INC. AND DEVICE?

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 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.⁴ Thus, Sec. 123.1 (d) of the Intellectual Property Code ("IP Code") provides that 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 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;

The records and evidence show that at the time the Respondent-Applicant filed its trademark application in 2009, the Opposer already has an existing trademark registrations for JOLLIBEE marks specifically for Class 21⁵, to wit:

1. Registration No. 4-2005-007558, issued on 19 February 2007, for the mark JOLLIBEE;
2. Registration No. 4-2008-007562, issued on 23 July 2009, for the mark JOLLIBEE MASCOT DESIGN; and
3. Registration No. 4-2005-007557, issued on 19 February 2007, for the mark BEE HEAD DEVICE.

Evidently, the Opposer's household or kitchen utensils and containers and Respondent-Applicant's domestic plastic utensils such as spoon, fork and toothpick are closely related. Goods are related when they belong to the same class or have the same attributes or essential characteristics with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or are sold in grocery stores".⁶ The Opposer being engaged in food products and services obviously utilizes the goods covered by the Respondent-Applicant's mark in the conduct of its business.

But are the competing marks, as shown below, resemble each other such that confusion or deception is likely to occur?

⁴ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999.

⁵ Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

⁶ *ESSO Standard Eastern, Inc. v. Court of Appeals, et. al.*, 201 Phil 803.

JOLLIBEE



JOLLIBEE MASCOT
DESIGN



BEE HEAD DEVICE

Opposer's marks (under Class 21)



Respondent-Applicant's mark

The contending marks reveal the same idea or concept and presents the same details in their visual presentation. Examining the Respondent-Applicant's mark, it is obvious that the word HAPPYBEE and the bee device are the features that immediately draw the eyes and ears of the consumers. Respondent-Applicant's HAPPYBEE is a combination of the words HAPPY and BEE while Opposer's JOLLIBEE composed of the words JOLLY and BEE. The words HAPPY and JOLLY connote the same meaning and concept characterized by or indicative of pleasure, contentment or joy. The suffix "BEE" in the Opposer's mark is likewise incorporated in the Respondent-Applicant's printed in the same manner as that of the Opposer's JOLLIBEE.

The BEE DEVICE in the Respondent-Applicant's mark is obviously a colorable imitation of the Opposer's JOLLIBEE MASCOT DESIGN and BEE HEAD DEVICE. Colorable imitation does not mean such similitude as amounts to identity. Nor does it require that all the details be literally copied. Colorable imitation refers to such similarity in form, content, words, sound, meaning, special arrangement, or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all presentation or in their essential, substantive and distinctive parts as would likely mislead or confuse persons in the ordinary course of purchasing the genuine article.⁷ The design of the eyes, the bow tie, white gloves and antennae which are distinctive of the Opposer's JOLLIBEE MASCOT and BEE HEAD DEVICE were conspicuously similar with the Respondent-Applicant's bee device such that confusion and deception is likely to occur. It is also likely that consumers would assume that HAPPYBEE is just a "relative" or variation of JOLLIBEE.

⁷ *Emerald Garment Mfg. Corp. v. Court of Appeals, et. al.*, G. R. No. 100098, 29 December 1995.

If Respondent-Applicant's mark is allowed for registration, the Opposer would likely be damaged. Since the competing marks are used on related goods, there would be confusion or deception as to the source or origin of the goods with the Respondent-Applicant riding on in the reputation and goodwill generated by the advertisement and promotion of the Opposer's mark. Children, who are unsuspecting, would be drawn to the HAPPYBEE figure as much as they would in case of JOLLIBEE. As held by the Supreme Court⁸:

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

It is highly improbable for another person to come up with an identical or nearly identical mark for use on the same or related goods purely by coincidence. The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of letters available, the Respondent-Applicant had come up with a mark identical or so clearly similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.⁹

The Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code, and therefore, should not be allowed.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application No. 4-2009-009144, together with a copy of this Decision, be returned to the Bureau of Trademarks for appropriate action.

SO ORDERED.

Taguig City, 30 October 2012.


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

⁸ See *Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

⁹ See *American Wire and Cable Co. v. Director of Patents, et. al.*, G. R. No. L-26557, 18 February 1970.