



JOLLIBEE FOODS CORPORATION,  
Opposer,

-versus-

DIANNE BEVERLY SIO,  
Respondent-Applicant.

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}  
} IPC No. 14-2010-00315  
} Opposition to:  
} Appln. Serial No. 4-2009-011895  
} Date filed: 20 November 2009  
} TM: "SUPER JOLLY INSIDE  
} AN OVAL"

**NOTICE OF DECISION**

**QUISUMBING TORRES**  
Counsel for Opposer  
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26 Street corner 3<sup>rd</sup> Avenue  
Crescent Park West, Bonifacio Global City  
Taguig City

**DIANNE BEVERLY SIO**  
Respondent-Applicant  
22-A 4<sup>th</sup> Street, New Manila Rolling Hills  
Quezon City

**GREETINGS:**

Please be informed that Decision No. 2014 - 173, dated June 30, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 30, 2014.

For the Director:

*Edwin D. Danilo A. Dating*  
**Atty. EDWIN DANILO A. DATING**  
Director III  
Bureau of Legal Affairs



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IPC No. 14-2010-00315  
Opposition to:  
Application No. 4-2009-011895  
Date Filed: 20 November 2009  
Trademark: SUPER JOLLY INSIDE  
AN OVAL  
Decision No. 2014 - 173

## DECISION

JOLLIBEE FOODS CORPORATION<sup>1</sup> ("Opposer") filed on 16 December 2010 a Notice of Opposition to Trademark Application No. 4-2009-011895. The contested application filed on 20 November 2009 by DIANNE BEVERLY SIO<sup>2</sup> ("Respondent-Applicant"), covers the mark SUPER JOLLY INSIDE AN OVAL for use on "*spaghetti, pasta*" under Class 30 of the International Classification of goods.<sup>3</sup>

The Opposer alleges the following:

"1. The registration of the mark SUPER JOLLY 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 mark and related JOLLIBEE and JOLLY marks (hereafter collectively referred to as the "JOLLIBEE MARKS") which have been registered and/or applied for registration with the Philippine Intellectual Property Office ("IPO") for various food and food products such as but not limited to spaghetti and pasta in class 30 and related classes. The details of these marks appear below:

Registrations:

Mark	Registration No.	Date Issued	Class
JOLLIBEE	4-2000-004772	03/10/06	29, 30, 32, 42
JOLLIBEE CHAMP	4-2009-006900	11/12/09	29, 35
JOLLIBEE GREAT BURGERS, GREAT CHICKEN	4-1995-100403	05/15/00	29
JOLLIBEE YUMBURGER	4-2003-008178	12/18/06	29, 43

- 1 A company organized under the laws of the Philippines with address at the 7<sup>th</sup> Floor Jollibee Plaza Building, #10 Emerald Avenue, Ortigas Center, Pasig City, Philippines.
- 2 With address on record at 22-A 4<sup>th</sup> Street, New Manila Rolling Hills, Quezon City.
- 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.



AND DEVICE			
JOLLY SHAKES (STYLIZED)	4-2003-001019	11/20/06	29, 30
JOLLY KRUNCHY TWIRL	4-2005-001998	09/18/06	29, 30
JOLLY CRISPY FRIES	4-2004-006392	02/09/09	29
JOLLY CHEEZY FRIES	4-2005-006933	11/05/07	29
JOLLY 'ZERTS	4-2005-003292	06/08/06	30

**Applications:**

Mark	Application No.	Date Filed	Class
JOLLIBEE LOGO AND DEVICE	4-2010-002055	02/24/10	29, 30, 43
JOLLY HOTDOG	4-2009-006903	07/13/09	29, 35
JOLLIBEE BREAKFAST JOYS	4-2009-006901	07/13/09	29, 35

"3. Since 1978, the JOLLIBEE MARKS have been used in the Philippines and worldwide by the Company, and its franchisees and licensees in connection with a wide variety of food and food products such as but not limited burgers, spaghetti, chicken and some local Filipino dishes;

"4. In the Philippines, the use of the Company's mark JOLLIBEE, in particular, commenced on January 26, 1978. Since, then, goods and services bearing the mark have been sold, distributed and offered in the Philippines continuously up to the present;

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

"6. 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;

"7. 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;

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

"9. The Respondent-Applicant's use of the mark SUPER JOLLY on "spaghetti, pasta" 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 SUPER JOLLY; and

"10. 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."

In support of the opposition, the Opposer submitted the following pieces of evidence:

1. Original notarized Verified Notice of Opposition;
2. Original notarized Affidavit of Atty. Gonzalo D. V. Go III and its attachments consisting of a screenshot of the company's website [www.jollibee.com.ph](http://www.jollibee.com.ph) and table showing the details of the applications and registrations for the JOLLIBEE marks worldwide;
3. Certified true copy of Philippine Trademark Registration No. 4-2000-004772 for JOLLIBEE;
4. Certified true copy of Philippine Trademark Registration No. 4-2003-008178 for JOLLIBEE YUMBURGER AND DEVICE;
5. Certified true copy of Philippine Trademark Registration No. 4-2009-006900 for JOLLIBEE CHAMP;
6. Certified true copy of Philippine Trademark Registration No. 4-1995-100403 for JOLLIBEE GREAT BURGERS GREAT CHICKEN & DEVICE;
7. Certified true copy of Philippine Trademark Registration No. 4-2003-001019 for JOLLIBEE SHAKES WRITTEN IN COLORS RED AND ORANGE ENCLOSED BY A RECTANGULAR SHADED IN BLUE;
8. Certified true copy of Philippine Trademark Registration No. 4-2005-001998 for JOLLY KRUNCH TWIRL;
9. Certified true copy of Philippine Trademark Registration No. 4-2004-006392 for JOLLY CRISPY FRIES;
10. Certified true copy of Philippine Trademark Registration No. 4-2005-006933 for JOLLY CHEEZY FRIES;
11. Certified true copy of Philippine Trademark Registration No. 4-2005-003292 for JOLLY 'ZERTS
12. Certified true copy of Philippine Trademark Registration No. 4-2010-002055 for JOLLIBEE LOGO AND DEVICE;
13. Certified true copy of Philippine Trademark Registration No. 4-2009-006903 for JOLLY HOTDOG;
14. Certified true copy of Philippine Trademark Registration No. 4-2009-006901 for JOLLIBEE BREAKFAST JOYS;
15. Screenshots taken from the television commercial for JOLLIBEE spaghetti;
16. Advertisement poster for JOLLIBEE spaghetti;
17. Advertisement page for JOLLIBEE spaghetti taken from the November 2010 issue of YES! Magazine;



18. Styrofoam box for JOLLIBEE Spaghetti;
19. Original notarized Certificate executed by William Tan Untiong; and
20. Original notarized Secretary's Certificate executed by William Tan Untiong regarding the execution of the Certificate/Power of Attorney.<sup>4</sup>

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 04 March 2011. The Respondent-Applicant, however, did not file her Answer.

Should the Respondent-Applicant be allowed to register the trademark SUPER JOLLY INSIDE AN OVAL?

Section 123.1 (d) of R. A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") 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 or services, or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

In this regard, the records and evidence show that at the time the Respondent-Applicant applied for registration of her trademark, the Opposer has a valid and existing registrations for JOLLIBEE, JOLLIBEE CHAMP, JOLLIBEE GREAT BURGER, GREAT CHICKEN, JOLLIBEE YUMBURGER AND DEVICE, JOLLY SHAKES (STYLIZED), JOLLY KRUNCHY TWIRL, JOLLY CRISPY FRIES, JOLLY CHEEZY FRIES, and JOLLY 'ZERTS (collectively referred to as "JOLLIBEE MARKS"). It is undisputed that the Opposer's JOLLIBEE MARKS were registered earlier than the filing of Respondent-Applicant's trademark application. With respect to the goods carried by the contending marks, it is apparent that they are similar or closely related to each other. One of the registrations issued to the Opposer shows that its mark is being used for "*hamburger, sandwiches, spaghetti, french fries, chicken sandwiches and fried chicken for consumption on or off the premises*"<sup>5</sup> which is similar to Respondent-Applicant's "*spaghetti, pasta*".

But do the competing marks resemble each other such that confusion, mistake or even deception is likely to occur?

In the case of *McDonald's Corporation v. Macjoy Fastfood Corporation*<sup>6</sup>, the Supreme Court held, to wit:

"For sure, it is the prefix "Mc," an abbreviation of "Mac," which visually and aurally catches the attention of the consuming public. Verily, the word "MACJOY" attracts attention the same way as did "McDonalds," "MacFries," "McSpaghetti," "McDo," "Big Mac" and the rest of the MCDONALD'S marks which all use the prefixes Mc and/or Mac.

Besides and most importantly, both trademarks are used in the sale of fastfood products. Indisputably, the respondent's trademark application for the "MACJOY & DEVICE" trademark covers goods under Classes 29 and 30 of the International Classification of Goods, namely, fried chicken, chicken barbeque,

4 Marked as Exhibits "A" to "T".

5 Exhibit "D".

6 G. R. No. 166115, 2 February 2007.

burgers, fries, spaghetti, etc. Likewise, the petitioner's trademark registration for the MCDONALD'S marks in the Philippines covers goods which are similar if not identical to those covered by the respondent's application."

Corollarily, in the instant case, the word JOLLY is the distinguishing feature of the competing marks. Verily, the word JOLLY in the Respondent-Applicant's is the one that immediately catches the attention of the consumers. The Respondent-Applicant's SUPER JOLLY attracts the attention the way as did Opposer's JOLLY SHAKES, JOLLY KRUNCHY TWIRL, JOLLY CRISPY FRIES, JOLLY CHEEZY FRIES, JOLLY 'ZERTS and JOLLY HOTDOG such that an ordinary would-be customer would conclude an association or relation between the contending marks.

Moreover, the fact that the marks are both used for food products under Classes 29 and 30 all the more create the possibility or likelihood of confusion. As held by the Supreme Court in the case of *Converse Rubber Corporation v. Universal Rubber Products, Inc., et. al.*<sup>7</sup>, the likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof, to wit:

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.

Accordingly, this Bureau finds that 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. 4-2009-011895 be returned, together with a copy of this Decision, to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 30 June 2014.

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