



JOLLIBEE FOODS CORPORATION,
Opposer,

-versus-

JOLLIVILLE HOLDINGS CORPORATION,
Respondent-Applicant.

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}
} IPC No. 14-2013-00076
} Opposition to:
} Appln. Serial No. 4-2012-010131
} Date Filed: 17 August 2012
} TM: "JOLLIVILLE HOLDING
} CORPORATION"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2014 - 226 dated September 16, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 16, 2014.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



JOLLIBEE FOODS CORPORATION,

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IPC No. 14-2013-00076

Opposition to Trademark

Application No. 4-2012-010131

Date Filed: 17 August 2012

Trademark: **"JOLLIVILLE HOLDINGS CORPORATION"**

Decision No. 2014- 226

DECISION

Jollibee Foods Corporation¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-01-131. The contested application, filed by Jolliville Holdings Corporation² ("Respondent-Applicant"), covers the mark "JOLLIVILLE HOLDINGS CORPORATION" for use on "*real estate affairs – leasing of realty*" under Class 36 of the International Classification of Goods³.

The Opposer anchors its claims on the provisions of paragraphs (d) and (f) of Section 123 of the Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). It insists that its trademark is well-known based on the criteria set forth in Rule 102 of the Implementing Rules and Regulations on Trademarks, Service Marks, Tradenames and Marked or Stamped Containers. According to Opposer, the company now has seven hundred eighty (780) restaurants in the Philippines alone and ninety-two (92) restaurants abroad since it first introduced its mark on 26 January 1978. It avers that it is a dynamic and continually expanding operations that now has its name attached to various projects and developments, both food and non-food related, such as the Jollibee Plaza in Pasig City and the television show "JOLLITOWN".

With the extensive use and advertising of the mark, Opposer claims that a mere look or mention of "Jollibee" or "Jolly" would immediately make the consuming public associate the terms with its products and services regardless of the goods and services involved. Aside from citing the articles and blog sites all over the world to sustain its assertion that its mark is well-known, Opposer states that it has seventy six (76) registrations and seven pending applications in the Philippines and two hundred fifteen (215) registrations and one hundred thirty (130) pending applications abroad. Likewise, it contends that the Intellectual Property Office of the Philippines (IPOP) has already

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

² A corporation organized and existing under the laws of the Republic of the Philippines with business address at 4F Lansbergh Place Bldg., 170 Tomas Morato, Quezon City, Metro Manila, Philippines.

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

recognized the well-known status of Jollibee trademarks as contained in the decision in IPC Case No. 14-2006-00113 entitled "Jollibee Foods Corporation vs. Atlas Publishing Inc."

In support of its Opposition, the Opposer submitted the following:

1. original notarized affidavit of Atty. Gonzalo D.V. Go III;
2. representative samples of Philippine registrations for the "JOLLIBEE" marks and other related "JOLLIBEE" marks;
3. representative samples of food packaging and containers bearing the "JOLLIBEE" trademarks;
4. representative samples of promotional materials and advertisements in television programs, the internet, well-known print publications, in-store promotions, and outdoor promotions for products and services bearing the "JOLLIBEE" trademarks;
5. screen shots of its websites, www.jollibee.com.ph and www.jollitown.com.ph;
6. table showing the details of the Opposer's applications and registrations for the "JOLLIBEE" trademarks;
7. various articles and blogs from different parts of the world attesting to the renown and well-known status of the Opposer and its marks;
8. the Opposer's coffeetable book entitled "A 25-Year Love Story with the Pinoy";
9. the Opposer's Annual Reports from 2002 to 2011; and
10. list of awards received by the Opposer.⁴

In its defense, the Respondent-Applicant states that before going into the real estate business, its chairman, Mr. Jolly L. Ting, opened several successful businesses in the Manila area specifically Quiapo Lunch, Manchu Noodle House (later Sandiwa Mami House), Minim's House and Marilag Restaurant & Soda Fountain. According to the Respondent-Applicant, recognizing the goodwill he had in his name, Mr. Ting started using his initials in one of his restaurants, Jay Tee Fas Food, wherein "Jay" stands for "J" in his first name, Jolly, and "Tee" for the letter "T" in his last name "Ting". Thereafter, he got into the entertainment industry catering solely to male adult entertainment through the establishment of Discovery, Paraluman Entertainment and more recently, Pharaoh KTV, Pegasus Club, Lexus, Genie, Heartbeat Megadisco and Loveboat. These newer establishments were allegedly owned by Jollibeat Entertainment Corporation, whose majority stockholder is Mr. Ting.

The Respondent-Applicant avers that after the success in the night entertainment industry, Mr. Ting diversified into other business, particularly the real estate industry. It maintains that Jolliville Realty Development Company was Mr. Ting's first venture in this industry established in 1986. It also claims that Mr. Ting extended the practice of using his first name in other businesses he owned - like Jolli-Build in

⁴ Marked as Exhibits "B" to "W", inclusive.

1998, which was engaged in manufacturing goods, and Jolli-Deal in 1989 engaged in the business of trading goods – and in identifying other companies affiliated to him. Additionally, it avows Mr. Ting's use of his name in his other businesses such as the Jollideal Marketing Corporation, Jollibeat Entertainment Corporation, Jolliville Group Management and Jolliville Leisure and Resort Corporation.

The Respondent-Applicant further claims that on 15 April 1999, Jolliville Realty and Development Company, Inc, underwent transformation into a holding company, consequently changing its name to Jolliville Holdings Corporation. When the Respondent-Applicant company was established, it acquired the entire capital stock of its affiliates, which include the other "JOLLI" companies – Jollideal Marketing Corporation, Jollideal Entertainment Corporation, Jolliville Group Management, Inc. and Jolliville Leisure and Resort Corporation. It contends that since the coining of "JOLLIVILLE" in 1986, the Respondent-Applicant and its predecessor have continuously, consistently and exclusively used the said mark in its documents and communications. It recall to have been initially granted Certificate of Registration No. 4-2001-007412 on 18 September 2004 although the same lapsed for its inadvertence to file the 5th year Declaration of Actual Use (DAU). Hence, it re-filed the present application.

The Respondent-Applicant's evidences consist of the following:

1. certified true copy of its Articles of Incorporation;
2. certified true copy of the Respondent-Applicant's 2012 General Information Sheet (GIS);
3. copy of the Articles of Incorporation of Jollibeat Entertainment Corporation;
4. certified true copy of the Articles of Incorporation of Jolliville Realty and Development Company;
5. certified true copy of the Articles of Incorporation of Jollideal Marketing Corporation;
6. certified true copy of the Articles of Incorporation of Jolliville Group Management, Inc.;
7. certified true copy of the Articles of Incorporation of Jolliville Lesiure and Resort Corporation;
8. copy of the Securities and Exchange Commission (SEC) approval of he change of name of Jolliville Realty and Development Company, Inc. to Jolliville Holdings Corporation, as well as the change of its primary purpose;
9. copies of the 201 GIS of the Respondent-Applicant's companies;
10. print-outs of the Respondent-Applicant's company profile;
11. newspaper articles announcing its initial public offering;
12. original notarized affidavits of Petrocelie B. Dolorican, Joephine A. Tiu, Lolita A. Cunanan and Gloria Gapoy;
13. letter of appointment of Gina U. Ting dated 05 April 1989;
14. print-out of the contents of its website;
15. copy of the filewrapper of its mark;

16. certified true copy of the Certificate of Registration No. 4-2001-007412;
17. original notarized affidavit of Maria Joy Ting; and
18. certified true copy of Trademark Application No. 4-2012-010131.⁵

The issue to be resolved is whether the trademark application of Respondent-Applicant should be granted.

The records reveal that the Opposer has a valid and existing registration of its trademark "JOLLIBEE", which certificate was issued as early as 24 September 2005. The latter has several other registrations under its name including but not limited to: "JOLLITOWN", "JOLLIBEE LOGO AND DEVICE", "JOLLY ZERTS", "JOLLY SHAKES", "JOLLY KRUNCHY TWIRL", "JOLLY CRISPY FRIES", "JOLLY CHEEZY FRIES", "JOLLY CRISPY FRIES, BESTFRIEND FRIES", "JOLLY HOTDOG" and "JOLLY HOTDOG, SARAP ON-THE-MOVE" (hereafter collectively referred to as "Jollibee trademarks"). On the other hand, the Respondent-Applicant is the previous holder of Certificate of Registration No. 4-2001-007412 issued on 18 September 2004 covering the mark "JOLLIVILLE HOLDINGS CORPORATION & LOGO". This registration, however, lapsed for failure to file the required DAU. Hence, the Respondent-Applicant filed the subject trademark application.

To determine whether the competing marks are confusingly similar, they are reproduced below for comparison:

Opposer's marks include:



JOLLIBEE



⁵ Marked as Exhibits "1" to "22".



JOLLY CRISPY FRIES

Jolly 'Zerts Jolly Hotdog

Respondent-Applicant's mark



The competing marks are similar in the sense that they all use the word "JOLLY" or "JOLLI". Although the word "JOLLY" is a common word which is actually appropriated in many other marks owned by different registrants, the substitution of the letter "i" for the letter "y" makes the same a coined word which has been associated with the Opposer. Thus, the use of Respondent-Applicant of the same term "JOLLI" in exactly the same spelling as that coined by the Opposer may likely lead the consumers to believe that "JOLLIVILLE HOLDINGS CORPORATION" is in any way connected to the latter. It is almost impossible not to recall or be reminded of Opposer's "JOLLIBEE" trademarks when one looks at the Respondent-Applicant's mark even though the latter deals with unrelated goods. The addition of the word "VILLE" fails to lend it the distinctiveness as required by law.

Succinctly, confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such

resemblance to the original as to deceive ordinary purchased as to cause him to purchase the one supposing it to be the other.⁶ In fact, the addition of "VILLE" after "JOLLI" only makes the resemblance of the marks even more apparent it reverberates the same sound with "BEE" when pronounced. Aptly, in **Marvex Commercial Co. vs. Peter Hawpia**⁷ it was declared that:

"The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, Unfair Competition and Trade Marks, 1947, vol. 1, will reinforce our view that 'SALONPAS' and 'LIONPAS' are confusingly similar in sound: 'Gold Dust' and 'Gold Drop'; 'Jantzen' and 'Jazz-Sea'; 'Silver Flash' and 'Supper-Flash'; 'Cascarete' and 'Celborite'; 'Celluloid' and 'Cellonite'; 'Chartreuse' and 'Charseurs'; 'Cutex' and 'Cuticlean'; 'Hebe' and 'Meje'; 'Kotex' and 'Femetex'; 'Zuso' and 'Hoo Hoo'. Leon Amdur, in his book 'TradeMark Law and Practice', pp. 419-421, cites, as coming within the purview of the idem sonans rule, 'Yusea' and 'U-C-A', 'Steinway Pianos' and 'Steinberg Pianos', and 'Seven-Up' and 'Lemon-Up. In Co Tiong vs. Director of Patents, this Court unequivocally said that 'Celdura' and 'Cordura' are confusingly similar in sound; this Court held in Sapolin Co. vs. Balmaceda, 67 Phil. 795 that the name 'Lusolin' is an infringement of the trademark 'Sapolin', as the sound of the two names is almost the same.

In the case at bar, 'SALONPAS' and 'LIONPAS', when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties (see Celanese Corporation of America vs. E. I. Du Pont, 154 F. 2d. 146, 148)."

Moreover, it is settled that the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. 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 the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."⁸

That the Respondent-Applicant has been previously granted registration of the same mark is of no moment. After all, a certificate of registration is only a prima facie evidence of the validity of its registration, ownership and exclusive right to use the same, which can be debunked by evidence to the contrary. The Opposer has substantially proven that it has adopted and used its "JOLLIBEE" marks even before the

⁶ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

⁷ G.R. No. L-19297, 22 December 1966.

⁸ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 1772276, 08 August 2010.


filing of Respondent-Applicant's application then and now. Furthermore, while the Respondent-Applicant contends that the word "JOLLI" comes from Mr. Ting's first name "JOLLY", it failed to explain the use of the letter "i" instead of "y" consistent with the spelling of his name. Verily, the field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitations, the unanswered riddle is why, of the millions of terms and combination of letters and designs available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.⁹

Finally, it is emphasized that 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.¹⁰ It is found that Respondent-Applicant sufficiently met the requirements of the law.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application No. 4-2012-010131 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 16 September 2014.


ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs

⁹ American Wire & Cable Company v. Director of Patents, G.R. No. L-26557, 18 February 1970.

¹⁰ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.