



JOLLIBEE FOODS CORPORATION,
Opposer,

-versus-

HUHTAMAKI FINANCE B.V.,
Respondent-Applicant.

}
} **IPC No. 14-2013-00279**
} **Opposition to:**
} **Application No.4-2011-012601**
} **Date filed: 12 October 2012**
} **TM: "JOLLY RANCHER**
} **CRUNCH `N CHEW"**
}

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NOTICE OF DECISION

QUISUMBING TORRES

Counsel for Opposer
12th Floor Net One Center
26th Street corner 3rd Avenue
Crescent Park West, Bonifacio Global City
Taguig City

ANGARA ABELLO CONCEPCION REGALA & CRUZ

Counsel for Respondent-Applicant
22nd Floor, ACCRALAW Tower
Second Avenue corner 30th Street
Crescent Park West, Bonifacio Global City
0399 Taguig, Metro Manila

GREETINGS:

Please be informed that Decision No. 2015 - 91 dated May 18, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 18, 2015.

For the Director:

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



JOLLIBEE FOODS CORPORATION,
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IPC No. 14-2013-00279

Opposition to Trademark
Application No. 4-2011-012601
Date Filed: 12 October 2012
Trademark: **"JOLLY RANCHER
CRUNCH 'N CHEW"**
Decision No. 2015- 91

DECISION

Jollibee Foods Corporation¹ ("Opposer") filed an opposition to Application No. 4-2011-012601. The contested application, filed by Huhtamaki Finance B.V.² ("Respondent-Applicant"), covers the mark "JOLLY RANCHER CRUNCH 'N CHEW" for use on "*candy*" under Class 30 of the International Classification of Goods³.

The Opposer anchors its claims on the provisions of paragraphs (d), (e) 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 Respondent-Applicant's mark "JOLLY RANCHER CRUNCH 'N CHEW" is confusingly similar to its own "JOLLIBEE" and "JOLLY" marks. It explains that the first two syllables of the contending marks are identical. It also asserts that the dominant element in Respondent-Applicant's mark "JOLLY RANCHER CRUNCH 'N CHEW", is confusingly similar in sound and appearance of its prior and subsisting registrations.

According to Opposer, the company now has seven hundred eighty three (783) restaurants in the Philippines since it first introduced its mark on 26 January 1978. It claims, among others, that it has eight hundred forty (840) restaurants worldwide since it first branched out in Taiwan in 1986. In the Philippines, it maintains ownership over seventy-seven (77) trademark registrations and nine (9) pending trademark applications. The Opposer believes 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 and likewise cites the case of Jollibee Foods Corporation vs. Atlas Publishing Company Inc. (IPC No. 14-2006-00113).

In support of its opposition, the Opposer submitted the following:⁴

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

²With address at Jupiterstraat 102, 2132 HE Hoofddorp, Netherlands.

³The 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.

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

1. Decision of the IPO dated 25 February 2007 in Jollibee Foods Corporation vs. Atlas Publishing Company, Inc., IPC No. 14-2006-00113;
2. original notarized affidavit of Atty. Gonzalo D.V. Go III;
3. representative samples of Philippine registrations and application for the JOLLIBEE mark and other related JOLLIBEE and JOLLY TRADEMARKS;
4. representative samples of food packaging and containers bearing the JOLLIBEE Trademarks;
5. representative sample 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;
6. screenshots of Opposer's website, www.jollibee.com.ph, featuring various Jollibee items and food products, Jollibee restaurant locations on the Philippines and overseas, and other relevant information about Opposer;
7. table showing the details of Opposer's applications and registrations for the Jollibee trademarks worldwide;
8. representative samples of registrations and applications for the Jollibee Trademarks from different countries worldwide such as: Bahrain, Brazil, Canada, Hong Kong, India, Indonesia, Israel, Italy, Kuwait, Malaysia, Mexico, Oman, Saudi Arabia, Singapore, South Korea, Spain, United States of America and Vietnam;
9. various articles and blogs from different parts of the world attesting to the renown and the well-known status of Opposer and its Jollibee trademark worldwide;
10. the Opposer's coffee table book "a 25-Year Love Story with the Pinoy"
11. the Opposer's Power Point presentation shown to the participants of the Follow-up Session to the WIPO-Sweden Advanced Training Course on Industrial Property in the Global Economy;
12. the Opposer's Annual Reports from 2002 to 2010; and
13. list of awards received by the Opposer.

For its part, the Respondent-Applicant denies that its applied mark "JOLLY RANCHER CRUNCH 'N CHEW" is confusingly similar to the Opposer's "JOLLY" and "JOLLIBEE" marks reasoning that the latter merely focused on the first two syllables. It also contends that its mark is to be used on goods sold in retail stores while the Opposer's business is in quick service restaurants. It also points out that there are twenty six (26) other registrations belonging to other entities that appropriate the word "JOLLY" in their marks. It insists on its right to use and register "JOLLY RANCHER CRUNCH 'N CHEW" asserting that it has built its own goodwill thereto. It further states that if indeed there is conflict between the competing marks, the Opposer cannot claim prior right thereto since it has been using its mark way back 1949. It maintains that prior to the present application, it has obtained registrations over the mark "JOLLY RANCHER" under Certificates of Registration

Nos. 4-1996-107834, 4-2007-10168 and 4-2011-002067 issued respectively on 14 December 1999, 11 February 2008 and 04 August 2011. It thus finally posits that the opposition is barred by laches.

The Respondent-Applicant evidence consists of the following:⁵

1. copies of its trademark registrations issued by various jurisdictions;
2. picture of "JOLLY RANCHER" products as sold in stores; and,
3. print-out trademark registrations and pending applications in the Philippines.

The Preliminary Conference was conducted and terminated on 17 June 2014 wherein the parties were directed to file their respective Position Papers within ten days therefrom. After the submission thereof, the case is deemed submitted for resolution.

The issue to be resolved is whether the trademark "JOLLY RANCHER CRUNCH 'N CHEW" should be allowed.

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: "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". On the other hand, the Respondent-Applicant only filed the contested application on 12 October 2012.

Be that as it may, the Bureau does not agree with Opposer's contention that the mark "JOLLY RANCHER CRUNCH 'N CHEW" is confusingly similar to the Opposer's "JOLLIBEE" and other "JOLLY" trademarks. "JOLLY" is a common English word and hence, what will determine whether the marks are indeed confusingly similar are the words and/or device that accompany the same. In fact, the Trademark Registry shows many other registered marks belonging to different entities using the term for goods belonging to the same classes as the Opposer's. Apparently, the word "JOLLY" alone is not highly distinctive. In this case, the "JOLLY RANCHER CRUNCH 'N CHEW" is distinguishable from any of the Opposer's "JOLLY" and "JOLLIBEE" marks. The Opposer failed to show its right to exclusively use the word "JOLLY" as it has no registration over the said word standing alone. Hence, the marks should be scrutinized in their entirety.

⁵ Marked as Exhibits "1" to "31".

Moreover, the Opposer's goods and services can only be purchased and availed of in its restaurants and fast food chains while that of Respondent-Applicant in ordinary stores. In view thereof, it is highly improbable that the consumers will be deceived, or at least confused, that "JOLLY RANCHER CRUNCH 'N CHEW" products are the same or are sourced from the Opposer as they flow in different channels of trade.

Furthermore, records of this case reveal that the Respondent-Applicant has registered in the Philippines the "JOLLY RANCHER" mark as early as 14 December 1999, even before the registration of any of the Opposer's mark. In addition, both parties respectively registered its marks in Canada, Australia and Hong Kong, among other countries. Therefore, the two competing marks co-exist up to the present in commerce and no confusion and/or deception to the public was shown to have occurred. More importantly, it is underscored that the Respondent-Applicant's mark was registered in the Philippines even prior the Opposer.

Therefore, the mere use of "JOLLY" is insufficient to conclude that there is likelihood of confusion. It bears noting that some of these trademarks, as that of the Respondent-Applicant in this case, were applied for and/or used by their respective owners even prior the Opposer's application and/or use of its own "JOLLY" marks. To rule otherwise is tantamount to conferring upon the Opposer exclusive right over the common word "JOLLY". Doing so will have the unintended effect of opening doors for cancellation of valid and existing trademark registrations of parties using "JOLLY" as their trademark or a part thereof to the latter's damage and prejudice. The fact that the "JOLLY" marks co-exist in the market, each with its own distinctive presentation and coverage of goods or services, does not indicate a likelihood of confusion.

Consequent to the findings that there is no confusing similarity between "JOLLY RANCHER CRUNCH 'N CHEW" and the Opposer's trademarks, there is no reason to delve on the issue of whether "JOLLIBEE" and its other family of marks are well-known.

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.⁶ It is found that Respondent-Applicant sufficiently met the requirements of the law.

⁶ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application No. 4-2012-012601 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 18 May 2015.



ATTY. NATHANIEL S. AREVALO

Director IV

Bureau of Legal Affairs