



**JOLLIBEE FOODS CORPORATION,**  
Opposer,

**-versus-**

**JOEL CHENG NG,**  
Respondent-Applicant.

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}  
} **IPC No. 14-2014-00470**  
} Opposition to:  
} Appln. Serial No.4-2013-00008179  
} (Filing Date: 12 July 2013)  
} **TM: "YUMMLY"**

**NOTICE OF DECISION**

**BETITA CABILAO CASUELA SARMIENTO**  
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**JOEL CHENG NG**  
Respondent-Applicant  
19 D. Muñoz Avenue Carmel V Subdivision  
Brgy. Tandang Sora, Quezon City

**GREETINGS:**

Please be informed that Decision No. 2015 - 98 dated May 20, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 20, 2015.

For the Director:

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



**JOLLIBEE FOODS CORPORATION,**  
*Opposer,*

**IPC No. 14-2014-00470**  
Opposition to:

-versus -

Application Serial No: 4-2013-00008179  
(Filing Date: 12 July 2013)  
Trademark: "YUMMLY"

**JOEL CHENG NG,**  
*Respondent-Applicant.*

X-----X

Decision No. 2015- 98

## DECISION

**JOLLIBEE FOODS CORPORATION** ("Opposer")<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2013-00008179. The application, filed by **JOEL CHENG NG** ("Respondent-Applicant")<sup>2</sup>, covers the mark "YUMMLY" for use on "foodcart/kiosk to sell hotdog, sandwiches and hamburger sandwiches to customer" under Class 35 of the International Classification of goods.<sup>3</sup>

The Opposer alleges that "YUMMLY" is confusingly similar to its registered mark "YUM". According to the Opposer the registration of "YUMMLY" in favour of the Respondent-Applicant will violate Sec. 123.1, paragraphs (d) to (f) of Rep. Act No. 8293, as amended, also known as the Intellectual Property Code of the Philippines ("IP Code"). In support of its opposition, the Opposer submitted in evidence the original notarized Notice of Opposition, original notarized Affidavit of Atty. Sheilah Marie P. Tomarong-Canabano with annexes, original notarized Certificate and Special Power of Attorney and original notarized Secretary's Certificate executed by William Tan Untiong<sup>4</sup>.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 27 January 2015 requiring him to file a verified answer within thirty (30) days from receipt thereof. However, the Respondent-Applicant did not file an answer. Accordingly, this Bureau issued on 21 April 2015 Order No. 2015-600 declaring the Respondent-Applicant in default and the case deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark YUMMLY?

Sec. 123.1 (d) of the IP Code provides that a mark cannot be registered if it:

<sup>1</sup> A corporation duly organized and existing under the laws of the Philippines, with business address at 10<sup>th</sup> Floor, Jollibee Plaza Building, #10 Emerald Avenue, Ortigas Center, Pasig City.

<sup>2</sup> With address at 19 D. Munoz Avenue, Carmel V Subdivision, Brgy. Tandang Sora, Quezon City.

<sup>3</sup> 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.

<sup>4</sup> Marked as Exhibits "A" to "D" with annexes.

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- (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;

In this regard, records and evidence show that at the time the Respondent-Applicant filed his trademark application on 12 July 2013, the Opposer has already the following trademark registrations in the Philippines:

<u>Mark</u>	<u>Registration No.</u>	<u>Date Issued</u>	<u>Classes</u>
YUM	4-2003-008177	11 November 2010	29, 43
YUM MASCOT DESIGN	4-2008-007565	23 July 2009	16, 18, 20, 21, 24, 25, 27, 28, 41
YUM MASCOT HOUSE AND DEVICE (IN COLOR)	4-2010-005371	14 October 2010	16, 18, 25, 28, 41
YUM MASCOT HOUSE AND DEVICE (IN BLACK AND WHITE)	4-2010-005362	6 January 2011	16, 18, 25, 28, 41

In addition, the Opposer's "YUM" mark is also registered or pending registration in various countries, including Bahrain, Brunei Darussalam, Canada, Cambodia, India, Indonesia, Italy, Japan, Korea (South), Kuwait, Malaysia, Oman, Qatar, Saudi Arabia, Singapore, United Arab Emirates, Vietnam, and United States of America.

But, is the mark "YUMMLY" confusingly similar to the Opposer's "YUM" marks?

The Respondent-Applicant appropriated the word "YUM", which comprises the registered mark of the Opposer. The Respondent-Applicant may have added the letters "M", "L" and "Y", but this is of no moment. It is underscored that the Respondent-Applicant's trademark application indicates goods and services ("*foodcart/kiosk to sell hotdog, sandwiches and hamburger sandwiches*") dealt in by the Opposer under the mark "YUM".

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 purchaser as to cause him to purchase the one supposing it to be the other<sup>5</sup>. Corollarily, colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or trade name with that of the other mark or trade name in their

<sup>5</sup> *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 April 2001, 356 SCRA 207, 217.

over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article<sup>6</sup>.

The determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.<sup>7</sup> There is the likelihood that consumers in encountering the Respondent-Applicant's mark will be reminded of and relate it to the Opposer's mark and its goods and services. The likelihood of confusion would subsist not only on the purchaser's perception of the goods but on the origins thereof as held by the Supreme Court.<sup>8</sup>

It is emphasized that 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 inferior and different article as his product.<sup>9</sup> Thus, the field from which a person may select a trademark is practically unlimited. As in all cases of colourable imitation, the unanswered riddle is why, of the millions of terms and combination of letters are available, the Respondent-Applicant had to come up with a mark identical or so closely similar to take advantage of the goodwill generated by the other mark.

The intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services. It is stressed that the Law on Trademarks and Tradenames is based on the principle of business integrity and common justice. This law, both in letter and spirit is laid upon the premise that, while it encourages fair trade in every way and aims to foster, and not to hamper competition, no one especially a trader, is justified in damaging or jeopardizing other business by fraud, deceit, trickery or unfair methods of any sort. This necessarily precludes the trading by one dealer upon the good name and reputation built by another. In *Societe Des Produits Nestle v. Martin T. Dy, Jr.*<sup>10</sup>, the Supreme Court reiterated:

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<sup>6</sup> *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.

<sup>7</sup> *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.

<sup>8</sup> *Converse Rubber Corp. v. Universal Rubber Products, Inc. et al.* G.R. No. L-27906, 08 Jan. 1987.

<sup>9</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. 114508, 19 Nov. 1999.


<sup>10</sup> G.R. No. 172276, 08 August 2010.

Modern law recognizes that the protection to which the owner of a trademark is entitled is not limited to guarding his goods or business from actual market competition with identical or similar products of the parties, but extends to all cases in which the use by a junior appropriator of a trademark or trade-name is likely to lead to a confusion of source, as where prospective purchasers would be misled into thinking that the complaining party has extended his business into the field (see 148 ALR 56 *et seq.*; 53 Am. Jur. 576) or is in any way connected with the activities of the infringer; or when it forestalls the normal potential expansion of his business (v. 148 ALR, 77, 84; 52 Am. Jur. 576, 577).

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of the Trademark Application Serial No. 4-2013-00008179 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 20 May 2015.



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