

**JOLLIBEE FOODS CORPORATION,**  
Opposer,

**-versus-**

**HUAN SIEK SY,**  
Respondent- Applicant.

X-----X

}  
} **IPC No. 14-2011-00009**  
} **Opposition to:**  
} **Appln. Serial No. 4-2010-002983**  
} **Date Filed: 18 March 2010**  
} **TM: "JB JOLLY BEAR &**  
} **REPRESENTATION OF A BEAR"**  
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}

**NOTICE OF DECISION**

**QUISUMBING TORRES**  
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Taguig City

**HUAN SIEK SY**  
Respondent-Applicant  
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Pulilan, Bulacan

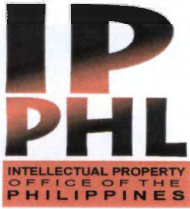
**GREETINGS:**

Please be informed that Decision No. 2016 - 148 dated May 16, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 16, 2016.

For the Director:

**MARILYN F. RETUAL**  
IPRS IV  
Bureau of Legal Affairs



JOLLIBEE FOODS CORPORATION,  
*Opposer,*

-versus-

HUAN SIEK SY,  
*Respondent-Applicant.*

x-----x

IPC No. 14-2011-00009

Opposition to:  
Appl. Ser. No.4-2010-002983  
Date Filed: 18March 2010

Title:JB JOLLY BEAR &  
REPRESENTATION OF A BEAR

Decision No. 2016- 148

**DECISION**

JOLLIBEE FOODS CORPORATION<sup>1</sup> (“Opposer”) filed on 11 January 2011 a Verified Opposition to Trademark Application Serial No. 4-2010-002983. The application, filed by HUAN SIEK SY <sup>2</sup> (“Respondent-Applicant”) covers the mark JB JOLLY BEAR AND REPRESENTATION OF A BEAR for use on “snack foods, namely, processed peanuts, processed corn, green peas, milk powder and jellies” under Class 29 and for use on “snack foods, namely, corn chips, cookies, biscuits, crackers, candies, wafer sticks, polvoron, chocolate powder” under Class 30 of the International Classification of goods<sup>3</sup>.

The Opposer alleges the following grounds:

"1. The registration of the mark JOLLY BEAR is contrary to the provisions of Section 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 ‘JOLLIBEE MARKS’) which have been registered and/or applied for registration with the Philippine Intellectual Property Office (‘IPO’) for various food and food products in classes 29 and 30, as well as in related classes.xxx

x x x

"3. Respondent-Applicant’s mark JOLLY BEAR is visually and phonetically identical with the Opposer’s JOLLIBEE MARKS as to be likely to deceive or cause confusion. Furthermore, the use of the Respondent-Applicant’s mark JOLLY BEAR on snack food products in classes 29 and 30, to wit:

<sup>1</sup>A domestic corporation with address at 7th Floor, Jollibee Plaza Building, Emerald Avenue, Ortigas Center, Pasig City

<sup>2</sup>A Filipino resident with address at 209 Laureano Avendaño Street, Sto. Cristo, Pulilan, Bulacan.

<sup>3</sup>The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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.

x x x

classes of goods 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.

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

"5. The Opposer's JOLLIBEE MARKS are well-known and world famous trademarks. Hence, the registration of the Respondent-Applicant's JOLLY BEAR will constitute a violation of Section 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 JOLLY BEAR, or any other mark identical or similar to the Opposer's JOLLIBEE MARKS.

"9. The Respondent-Applicant's use of the mark JOLLY BEAR on the snack food products in classes 29 and 30 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 JOLLY BEAR.

"10. The use by the Respondent-Applicant of the mark JOLLY BEAR in relation to snack food products 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.

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

The Opposer's evidence consists of the following:

1. Exhibit "B" - Affidavit of Atty. Gonzalo D.V. Go III with Annexes;
2. Exhibit "B-1" - screenshots of the company's website [www.jollibee.com.ph](http://www.jollibee.com.ph);

3. Exhibit "B-2" table showing the details of the applications and registrations for the JOLLIBEE mark worldwide;
4. Exhibits "C" to "R" - certified copies of various Philippine registrations and pending applications of the Opposer's JOLLIBEE Marks;
5. Exhibit "S"- screenshot taken from the television commercial for JOLLIBEE spaghetti;
6. Exhibits "T" to "V"- advertisement flyers for JOLLIBEE Delivery, Chickenjoy, Jolly Hotdog;
7. Exhibit "W"- food container for Jollibee Chickenjoy;
8. Exhibit "X" -page from Ugnayan, a bi-monthly publication of Opposer;
9. Exhibit "Y" - original notarized Certificate executed by William Tan Untiong; and
10. Exhibit "Z" - original notarized Secretary's Certificate.

This Bureau issued a Notice to Answer and served via DHL to the Respondent-Applicant on 29 January 2011. Despite the Notice, Respondent-Applicant failed to file the Answer. Thus, the case was deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended.

Should the Respondent-Applicant be allowed to register the mark "JB JOLLY BEAR"?

The records show that Opposer has existing and valid registered marks and pending applications of its various JOLLIBEE marks which include, among others, JOLLIBEE, JOLLY KRUNCH TWIRL and JOLLY CRISPY FRIES which were registered and/or applied prior to Respondent-Applicant's application for registration of its mark JB JOLLY BEAR on 18 March 2010.

But are the marks of Opposer and Respondent-Applicant identical or confusingly similar so as to prevent the registration of the latter's mark? The competing marks are reproduced below for comparison:



**JOLLY CRISPY FRIES**

Opposer's Marks



Respondent-Applicant's Mark

This Bureau does not agree with the Opposer's assertion that the Respondent-Applicant's mark JB JOLLY BEAR WITH A REPRESENTATION OF A BEAR is confusingly similar to its JOLLIBEE marks. While the word "JOLLY" which forms part of the various trademarks of Opposer appears in Respondent-Applicant's mark, this word is a common English word and widely used in various trademarks registered and pending application before the Bureau of Trademarks as shown by this Office's Trademark Database, which the Opposer cannot exclusively appropriate. Among these marks are "JOLLY", "JOLLY FRESH", "JOLLY RANCHER", "JOLLY LOLLY", "JOLLY SPREADS", "JOLLY COW FRESH MILK" and "REPRESENTATION OF A JOLLY CHEF", among others. Respondent-Applicant's mark also includes a "BEAR DEVICE" which is not a registered mark of Opposer.


Furthermore, the presentation of the mark of Respondent-Applicant is not in any way similar to any of Opposer's mark so as to likely create confusion, mistake or deception to the public nor does it suggest that Respondent-Applicant is riding on the popularity of Opposer's marks. While both parties use their marks on goods belonging to classes 29 and 30, the goods of the parties are different. Opposer's JOLLIBEE marks are used on products such as *spaghetti, fried chicken, hotdog, burger and fries* while Respondent-Applicant's JOLLY BEAR is used on *processed peanuts, processed corn, green peas, milk powder, jellies, corn chips, cookies, biscuits, crackers, candies, wafer sticks, polvoron and chocolate powder* which Opposer does not deal with. Their respective products are sold in different channels of trade, that is, Opposer's food products are sold in-house in its Jollibee restaurants while Respondent-Applicant's goods is sold in groceries and retail outlets. In view thereof, it is farfetched that consumers or the public in general will likely be confused or mistaken or be deceived that the product of Respondent-Applicant comes from, originated or sourced from or manufactured by Opposer.

It must be 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. It is found that Respondent-Applicant's mark sufficiently met the requirement of the law.

**WHEREFORE**, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2010-002983, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City,

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