

JOLLIBEE FOODS CORPORATION,
Opposer,

-versus-

SPLASH FOODS CORPORATION,
Respondent- Applicant.

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}
} **IPC No. 14-2012-00291**
} Opposition to:
} Appln. Serial No. 4-2012-002822
} Date Filed: 07 March 2012
} **TM: "CRISPY JOY"**
}
}
}
}

NOTICE OF DECISION

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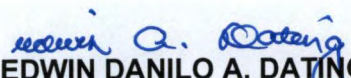
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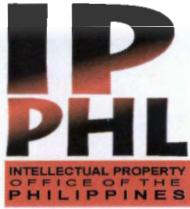
GREETINGS:

Please be informed that Decision No. 2016 - 103 dated April 01, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 01, 2016.

For the Director:


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



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SPLASH FOODS CORPORATION, <i>Respondent-Applicant.</i>	}	Title: CRISPY JOY
x-----x	}	Decision No. 2016- <u>103</u>

DECISION

JOLLIBEE FOODS CORPORATION,¹ (“Opposer”) filed a Verified Opposition to Trademark Application Serial No. 4-2012-002822. The application, filed by SPLASH FOODS CORPORATION² (“Respondent-Applicant”) covers the mark **CRISPY JOY** for use on “*breeding mixes for pork, chicken, fish and seafoods*” under Class 30 of the International Classification of goods³.

The Opposer alleges the following grounds:

"1. Opposer has been in existence for nearly four (4) decades and operates the very popular chain of quick-service restaurants called JOLLIBEE that is found all over the Philippines and abroad. Throughout the years, Opposer has continuously used the JOLLIBEE name and marks in each Jollibee outlet and in almost all product packaging, advertising, promotional materials. Opposer and its JOLLIBEE brand are recognized as one of the country's greatest success stories and is an undeniable symbol of Filipino pride worldwide.

"2. Opposer's fried chicken which are patronized by the consuming public due to its unique and distinct taste - perfectly seasoned, crispy on the outside, tender and juicy on the inside - is known as CHICKEN JOY, and the same is usually described as CRISPYLICIOUS. On the other hand, Opposer's french fries are usually referred to as JOLLY CRISPY FRIES. CHICKEN JOY, CRISPYLICIOUS and JOLLY CRISPY FRIES are all registered marks owned by the Opposer and/or have earlier filing dates than Respondent-Applicant's mark.

"3. Opposer respectfully comes before the Honorable Office to ask for the rejection of the application for the mark CRISPY JOY sought to be registered by Respondent-Applicant for being confusingly similar to Opposer's mark CHICKEN JOY as well as other trademarks CRISPYLICIOUS and JOLLY CRISPY FRIES.

x x x

¹ A domestic corporation with address at 7th Floor, Jollibee Plaza Building, Emerald Avenue, Ortigas Center, Pasig City
² A domestic corporation with office address at 5W Bldg., Bonifacio Global City, Taguig City.
³ 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.

"4. The registration of the mark CRISPY JOY is contrary to the provisions of Sections 123.1 (d), (e) and (f) of the Republic Act No. 8293, as amended, otherwise known as the Intellectual Property Code of the Philippines xxx."

The Opposer's evidence consists of the following:

1. Exhibit "B" - Affidavit of Atty. Gonzalo D.V. Go III with Annexes;
2. Exhibit "C" - various Philippine registrations and pending applications for the marks CHICKENJOY, CRISPYLICIOUS, JOLLY CRISPY FRIES and other Jollibee trademarks;
3. Exhibit "D" - representative samples of food packaging and containers bearing the marks CHICKENJOY, CRISPYLICIOUS, JOLLY CRISPY FRIES and other Jollibee trademarks;
4. Exhibits "E" - screenshots of Opposer's website, www.jollibee.com.ph;
5. Exhibit "F" - representative samples of promotional materials and advertisements;
6. Exhibit "G" - registrations and applications for the mark CHICKENJOY from Indonesia, Italy, South Korea, Kuwait, Malaysia, Oman, Qatar, Saudi Arabia, Singapore, Spain, Turkey, UAE, USA and Vietnam;
7. Exhibit "H" - sample photographs of Jollibee Restaurants/branches;
8. Exhibit "I" - Special Power of Attorney; and
9. Exhibits "J" - Secretary's Certificate.

This Bureau issued on 13 August 2012 a Notice to Answer and served to the Respondent-Applicant on 24 August 2012. After two motions for extension to file answer, Respondent-Applicant filed the Answer on 21 November 2012, alleging the following Special and Affirmative Defenses:

"22. Opposer has no valid cause of action against respondent.

"23. Either or both of the words 'CRISPY' and/or 'JOY' for which respondent's CRISPY JOY trademark was derived are not registered trademarks of the opposer.

"24. The registrability of the respondent's CRISPY JOY has been determined and resolved by no less than the Intellectual Property Office (IPO) when the latter, through the Bureau of Trademarks, allowed the registration of the said trademark despite the existing CHICKENJOY, JOLLY CRISPY FRIES and CRISPYLICIOUS prior trademark registrations/applications of the opposer. As a matter of fact, none of the aforesaid trademark registrations/applications of the opposer was cited by the Bureau of Trademarks during the substantive/merit examination of the CRISPY JOY trademark application of the respondent.

"25. Contrary to Opposer's claim, the CRISPY JOY trademark of the respondent is **visually, aurally and conceptually different** from any of the CHICKENJOY, JOLLY CRISPY FRIES and CRISPYLICIOUS trademark of the opposer.

"26. The trademark CHICKENJOY is undeniably a single word mark, coined from the words CHICKEN and JOY. As coined mark, CHICKENJOY is distinctive as a whole. The distinctiveness of CHICKENJOY as a single word mark confirmed by the fact that the CHICKEN in the CHICKENJOY trademark is not disclaimed in the certificate of registration of the said

trademark. On the other hand, respondent's CRISPY JOY trademark is clearly a combination of two distinct words: CRISPY and JOY, each having a definite dictionary meaning.

"27. The registration of the CHICKENJOY trademark does not vest in favor of the opposer the right to prevent others from using JOY as a trademark or part of a trademark. Since JOY is not used by the opposer as a trademark for fried chicken or for any goods under Class 30, respondent can freely use JOY in combination with the word CRISPY as its trademark for all purpose breeding mix, a goods different from fried chicken.

"28. In like manner, opposer cannot question the use by respondent of the word CRISPY as part of the CRISPY JOY trademark since CRISPY is not a registered trademark of the opposer and its incapable of exclusive use for being a descriptive mark as admitted by the opposer.

"29. The trademark CRISPY JOY was conceptualized and adopted in consideration of the kind or characteristics of the **all purpose breeding mix** product that respondent will manufacture and sell and the perception or feeling that respondent wants to impress upon to the consumers. Thus, the trademark CRISPY JOY was adopted because respondent wants its all purpose breeding mix when used will give the breaded food a crispy texture and taste making the customers/users feel the joy of frying and/or eating food breaded with CRISPY JOY all purpose breeding mix.

"30. It is therefore untrue and far from the mind of the respondent the allegation of the opposer that the mark CRISPY JOY was adopted by the respondent to ride on the alleged popularity and goodwill generated by the opposer's CHICKENJOY trademark.

"31. Opposer is engaged in the fastfood restaurant business for almost 4 decades. Throughout the said period JOLLIBEE food products including CHICKENJOY fried chicken and JOLLY CRISPY FRIES, have been sold only at JOLLIBEE fastfood restaurants. For the same period of time, opposer never engaged in the manufacture and sale of other processed or packed food items for sale in groceries and retail outlets. On the other hand, the goods of the respondent bearing the CRISPY JOY trademark is a food ingredient prepared and processed differently to be sold in different channels of trade. These facts alone belie opposer's claim that the purchasing public will be mislead into believing that the respondent goods originate from or are under the sponsorship of the opposer and that the registration of the CRISPY JOY trademark will cause substantial damage to the goodwill and reputation associated with its CHICKENJOY, CRISPYLICIOUS and JOLLY CRISPY FRIES trademarks.

"32. With all the foregoing, it can be said that the filing of the instant Notice of Opposition is an abuse in the exercise of intellectual property rights on the part of the opposer to the prejudice and damage of the respondent."

Respondent-Applicant's evidence consists of the following:

1. Exhibits "2" and "2-A" - Secretary's Certificate of Board Resolution of Respondent-Applicant and Special Power of Attorney;
2. Exhibit "3" - Affidavit of Ms. Teresita Panganiban;
3. Exhibits "4" and "4-A" - Certificate of Incorporation with Articles of Incorporation and Amended By Laws of Respondent-Applicant;
4. Exhibit "5" - Certificate of License to Operate as Food Distributor/Wholesaler issued by the FDA;
6. Exhibit "6" - representation of the proposed product label of the CRISPY JOY all purpose breeding mix; and

7. Exhibit "7" - Certificate of Product Registration of the CRISPY JOY all purpose breading mix issued by FDA.

Pursuant to Office Order No. 154, s. 2010, the case was referred to the Alternative Dispute Resolution ("ADR") for mediation on 15 January 2013. On 29 May 2012, the Bureau's ADR Services submitted a report that the parties failed to settle the dispute. During the preliminary conference on 22 May 2013, the preliminary conference was terminated and the parties were directed to submit position papers. On 31 May 2013, Opposer filed its Position Paper while Respondent did so on 11 June 2013.

Should the Respondent-Applicant be allowed to register the mark "CRISPY JOY"?

The records show that Opposer has existing and valid registered marks and pending applications of its various marks which include, among others, CHICKENJOY, CRISPYLICIOUS and JOLLY CRISPY FRIES which were registered and/or applied prior to Respondent-Applicant's application for registration of its mark CRISPY JOY which was filed only on 07 March 2012.

The marks are reproduced below for comparison:

CHICKENJOY CRISPYLICIOUS JOLLY CRISPY FRIES

Opposer's Marks

CRISPY JOY

Respondent-Applicant's Mark

This Bureau do not agree with Opposer that the Respondent-Applicant's mark CRISPY JOY is confusingly similar to its marks CHICKENJOY, CRISPYLICIOUS and JOLLY CRISPY FRIES. While the words "CRISPY" and "JOY" which forms part of the trademark of Respondent-Applicant appears in the marks of the Opposer, these words are common English words that Opposer cannot exclusively appropriate. This fact is bolstered by the various application and registration of marks which uses "CRISPY" in combination with other words such as "CRISPY PATATA", "CRISPY FRY" and "GOLDEN CRISPY" among others . The same is true for the word "JOY" which is also used as a stand-alone mark or in combination with other words such as "KINDER JOY", "JOY SJ" and "JOY STICK", among others. As such, the mere presence of the words "CRISPY" and "JOY" in Respondent-Applicant's marks is insufficient to establish a finding of confusing similarity between the competing marks to sustain the opposition. Further, Opposer was not able to show that it has used the combination of CRISPY and JOY as its mark in its various food products available in its fast-food restaurant.

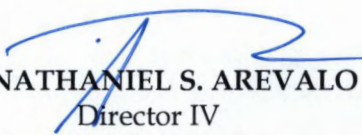
Moreover, the goods upon which the competing marks are used are also different. Respondent-Applicant's mark is used on all-purpose breading mix which Opposer does not deal with. Also, the products of the parties are sold in different channels of trade, that is, Opposer's food products are sold in-house 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 or is manufactured by Opposer.

Finally, 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. 4-2012-002822, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 01 April 2016.


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