

JOLLIBEE FOODS CORPORATION,
Opposer,

-versus-

YUM! BRANDS, INC.,
Respondent- Applicant.

IPC No. 14-2011-00526
Opposition to:
Appln. Serial No. 4-2011-007616
Date Filed: 29 June 2011
TM: "YUM LOGO"

x-----x

NOTICE OF DECISION

BETITA CABILAO CASUELA SARMIENTO
Counsel for Opposer
Suite 1104, Page One Building
1215 Acacia Avenue, Madrigal Business Park
Ayala Alabang, Muntinlupa City

SANTOS PILAPIL & ASSOCIATES
Counsel for Respondent- Applicant
Suite 1209, Prestige Tower
Emerald Avenue, Ortigas Center
Pasig City

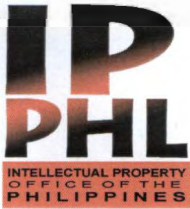
GREETINGS:

Please be informed that Decision No. 2016 - 129 dated May 03, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 03, 2016.

For the Director:

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




JOLLIBEE FOODS CORPORATION, Opposer,	}	IPC No. 14-2011-00526
	}	
	}	Opposition to:
	}	Appl. Ser. No. 4-2011-007616
-versus-	}	Date Filed: 29 June 2011
	}	
YUM! BRANDS, INC., Respondent-Applicant.	}	Title: YUM LOGO
x-----x	x	Decision No. 2016- <u>129</u>

DECISION

JOLLIBEE FOODS CORPORATION,¹ ("Opposer") filed on 19 January 2012 a Verified Opposition to Trademark Application No. 4-2011-007616. The application, filed by YUM! BRANDS, INC.² ("Respondent-Applicant") covers the mark YUM LOGO for use on "restaurants, snack bars, cafes, canteens and fastfood outlets; services connected with the sale and distribution of foodstuffs and refreshments; catering services; and the provision of food ordering services through an online computer network" under Class 43 of the International Classification of goods³.



The Opposer alleges the following grounds:

"1. The registration of the mark  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 mark YUM, which is registered with the Philippine Intellectual Property Office ('IPO') for various food and food products in class 29 and restaurant services in class 43. The details of the registration for the mark YUM and related marks appear below:


x x x

"3. Respondent-Applicant's mark  is visually and phonetically identical with the Opposer's registered mark YUM as to be likely to deceive or cause confusion. Respondent-Applicant's mark YUM LOGO appropriates the word element 'YUM' as its dominant feature and has exactly the same spelling same as the Opposer's registered mark YUM. Furthermore, the use of the Respondent-Applicant's mark  on any of the following services in class 43, to wit:


x x x


¹ A domestic corporation with address at 7th Floor, Jollibee Plaza Building, Emerald Avenue, Ortigas Center, Pasig City
² A foreign corporation organized and existing under the laws of Kentucky USA with address at 1441 Gardiner Lane, Louisville, Kentucky, U.S.A
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.

the same kind and class of services on which the Opposer's mark YUM is 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 registered mark YUM.

"4. The confusing similarity between the opposed mark and the Opposer's mark YUM is confirmed by the examiner's opinion during the examination of the Opposer's Application No. 4-2003-008177 for the mark YUM to the effect that the Respondent-Applicant's mark  subject of this opposition, is IDENTICAL to the Opposer's mark YUM. xxx


"5. Hence, the registration of the Respondent-Applicant's mark  will be contrary to Section 123.1 (d) of Republic Act No. 8293.



"6. The Respondent-Applicant's use of the mark  will mislead consumers into believing that the Respondent-Applicant's services are rendered by, originate from, or are under the sponsorship of the Opposer.


"7. The Opposer's mark YUM is well-known and world famous. Hence, the registration of the Respondent-Applicant's mark  will constitute a violation of Sections 123.1 (e) and 123.1 (f) of Republic Act No. 8293.


"8. Opposer has used the mark YUM in the Philippines and elsewhere prior to the filing date of the application subject of this opposition. The Opposer continues to use the mark YUM in the Philippines and abroad.

"9. The Opposer has also extensively promoted the mark YUM in the Philippines and abroad. Over the years, the Opposer has obtained significant exposure for the products and services upon which the mark YUM is used in various media, including television commercials, outdoor advertisements, internationally well-known print publications and other promotional events.

"10. Opposer has not consented to the Respondent-Applicant's use and registration of the mark  or any other mark identical or similar to the Opposer's mark YUM.

"11. The Respondent-Applicant's use of the mark  on the proposed services in class 43 will mislead the purchasing public into believing that the Respondent-Applicant's services are rendered 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 and services put on the market by the Respondent-Applicant under the mark .

"12. The use by the Respondent-Applicant of the mark  in relation to the restaurant service in class 43 which are identical, similar and/or closely related to the Opposer's services on which the mark YUM is used and registered will take unfair advantage of, dilute and diminish the distinctive character of the Opposer's mark YUM.

"13. The Respondent-Applicant has never used its mark  in the Philippines on services in class 43 and has no serious intention to do so. In fact, its previous registrations under Registrations Nos. 4-2002-009603, 4-2005-007030 and 4-2008-008448 for substantially the same mark have been cancelled on account of non-use. xxx

"14. The denial of the Respondent-Applicant's application for the mark  subject of this opposition is authorized under other provisions of Republic Act No. 8293."

The Opposer's evidence consists of the following:

1. Exhibit "A-1" - certified true copy of the decision of the Director of Bureau of Trademarks dated 29 March 2010;
2. Exhibit "A-2" to "A-4" - certified true copies of the trademark registrations of Respondent-Applicant's mark YUM which were cancelled;
3. Exhibit "B" Affidavit of Atty. Gonzalo D.V. Go III with Annexes;
4. Exhibit "B-1" - certified true copy of the Trademark Registration No. 4-2003-008177 for the mark YUM of Opposer;
5. Exhibits "B-2" to "B-4" - computer printouts of the trademark details report for YUM related marks;
6. Exhibit "B-5" to "B-7" - copy of trademark registrations for YUM and YUM related marks in the U.S.A.;
7. Exhibits "B-8" - list of Jollibee restaurants in the Philippines and abroad;
8. Exhibit "B-9" - screenshots of television commercials for YUM;
9. Exhibit "B-10" - CD collection of the various television commercials for YUM;
10. Exhibit "B-11" - restaurant menu item showing the mark YUM;
11. Exhibits "B-12" - screenshots of Opposer's website, www.jollibee.com.ph;
12. Exhibit "B-13" - various articles and write-ups on Yumbassadors, endorsers of YUM;
13. Exhibit "B-14" - table showing the details of Opposer's applications and registrations for the mark YUM;
14. Exhibit "C" to "E" - original wrappers for YUM!, YUM with cheese and YUM! with TLC;
15. Exhibit "F" - Officer's Certificate and Power of Attorney; and
16. Exhibits "G" - Secretary's Certificate.

This Bureau issued on 27 January 2012 a Notice to Answer and served to the Respondent-Applicant on 03 February 2012. After a motion for extension to file answer, Respondent-Applicant filed the Answer on 27 March 2012. Respondent-Applicant alleges that it is the first adopter, registrant, owner and user of marks bearing the word 'YUM' and not Opposer. Respondent-Applicant also claims that there is no confusing similarity or colorable imitation between respondent's and Opposer's marks and that Opposer's mark is not internationally well-known.

Respondent-Applicant's evidence consists of the following:

1. Exhibits "1" - Sworn Statement of Eliane Seton;
2. Exhibit "2" - Certification;
3. Exhibit "3" - trademark listing of Respondent-Applicant's registration of its mark;
4. Exhibit "4" - Certificate of Registration No. 2772281 issued in the U.S.A. for the mark YUM! BRANDS; and
6. Exhibit "5" - Certificate of Registration No. 3192988 issued in the U.S.A. for the mark YUM! LOGO.

On 18 April 2012, Opposer filed a Reply. Pursuant to Office Order No. 154, s. 2010, the case was referred to the Alternative Dispute Resolution ("ADR") for mediation. On 22 June 2012, the Bureau's ADR Services submitted a report that the parties failed to settle the dispute. During the preliminary conference on 03 September 2012, the preliminary conference was

terminated and the parties were directed to submit position papers. On 12 September 2012, Respondent-Applicant filed its Position Paper while Respondent did so on 13 September 2012.

Should the Respondent-Applicant be allowed to register the mark YUM LOGO?

A perusal of the records of this case show that Opposer has existing and valid registered marks for YUM, YUM MASCOT DESIGN and YUM MASCOT HOUSE AND DEVICE which were issued prior to the application of Respondent-Applicant's mark YUM LOGO. Opposer's YUM marks are also used on goods and/or services under classes 29 and 43 which also covers Respondent-Applicant's goods also classified under class 43.

But are the marks confusingly similar as to likely cause confusion, mistake or deception on the part of the public? The marks of the parties are reproduced below:

YUM



Opposer's Marks



Respondent-Applicant's Mark

A scrutiny of the marks of the parties would show that both Opposer's and Respondent-Applicant's marks YUM and YUM LOGO, respectively. However, the adoption by Respondent-Applicant of the word "yum" as its mark does not automatically makes it confusingly similar with that of Opposer's. Aside from the word "yum", other distinguishing features of Respondent-Applicant's mark is visually perceivable. Respondent-Applicant's "YUM" mark which consists of a stylized "Yum" with an exclamation point is written inside a bubble quote. Opposer's YUM mark on the other hand is plainly written in uppercase letters. Furthermore, based on the Trademark Database of this Office, Opposer has not solely appropriated the word "yum" to the exclusion of others. Aside from Opposer's YUM mark, other marks with the word "yum" has been registered by this Office for same goods/services and related goods/services. Among these trademarks are YUM YUM TREE DINER, YUM SAAP for class 43; GOLDEN YUM and DESIGN, BUBBLE YUM, YUM-YUM HOTDOG LABEL and DARI CREME YUM LABEL & DESIGN for class 29; and other trademarks combined with the word 'yum' for other classes. As such, the mere presence of the word "yum" in Respondent-Applicant's mark is insufficient to establish a finding of confusing similarity between the competing marks to sustain the opposition.

Handwritten signature or initials in blue ink.


Furthermore, the word "YUM" is a commonly used interjection to express enjoyment or satisfaction, especially in the taste of food.⁴ Thus, when the word "YUM" is used as a trademark in relation to food and food-related goods/services, it is considered a weak mark. A weak trademark has no capacity to identify strongly a single original or source of goods or services. In this case, when we hear the word YUM it does not exclusively suggest that it comes from Opposer or it refers only to Opposer's products only. Rather, the word "yum" suggests that the goods or services to which that mark is used refers to a food or food-related product or services.

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.⁵ 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. 4-2011-007616, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. 03 MAY 2016.


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

⁴"yum". *Dictionary.com Unabridged. Random House, Inc. 02 May. 2016.* <Dictionary.com <http://www.dictionary.com/browse/yum>>
⁵ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.