



JOLLIBEE FOODS CORPORATION,
Opposer,

-versus-

YUMMIX ASIA AB,
Respondent- Applicant.

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}
} **IPC No. 14-2015-00254**
} Opposition to:
} Appln. Serial No. 4-2014-505005
} Date Filed: 22 October 2014
} **TM: "YUMMIX MILK RICE"**
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}
}
}

NOTICE OF DECISION

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

VIRGILAW
(Virgilio M. Del Rosario & Partners)
Counsel for Respondent-Applicant
The Peak, Unit 602, 107 L.P. Leviste Street
Salcedo Village, Makati City

GREETINGS:

Please be informed that Decision No. 2016 - 241 dated July 12, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 12, 2016.

For the Director:

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

JOLLIBEE FOODS CORPORATION,

Opposer,

-versus-

YUMMIX ASIA AB,

Respondent-Applicant.

IPC No. 14-2015-00254

Opposition to Trademark

Application No. 4-2014-505005

Date Filed: 22 October 2014

Trademark: **"YUMMIX MILK RICE"**

x ----- x Decision No. 2016- 241

DECISION

Jollibee Foods Corporation¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2014-505005. The contested application, filed by Yummix Asia AB² ("Respondent-Applicant"), covers the mark "YUMMIX MILK RICE" for use on "*puddings; rice puddings; puddings made of milk and rice*" under Class 30 of the International Classification of Goods³.

The Opposer anchors its opposition on Section 123.1 subparagraphs (d), (e) and (f) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines "IP Code". It alleges, among others, that it is the owner and first user of the "YUM" mark, which in it registered for various food and food products in Class 29 and restaurant services in Class 43. It avers that the said mark is also registered and/or pending registration in various countries. It asserts that the Respondent-Applicant's mark "YUMMIX" is confusingly similar to its "YUM" mark as to be likely to deceive or cause confusion. In support of the Opposition, the Opposer submitted the affidavit of Atty. Sheilah Marie P. Tomarong-Cañabano, with annexes.⁴

A Notice to Answer was issued and served upon the Respondent-Applicant on 12 August 2015. The latter, however, did not file an Answer. Thus, on 11 March 2016, the Hearing Officer issued Order No. 2016-424 declaring the Respondent-Applicant in default and the case submitted for decision.

The issue to be resolved is whether the Respondent-Applicant's mark "YUMMIX MILK RICE" should be allowed registration.

Section 123.1 (d), (e) and (f) of the IP Code provides that:

¹ A domestic corporation with business address at 10th Floor, Jollibee Plaza Building, #10 Emerald Avenue, Ortigas Center, Pasig City.

² With known address at Santessonbrahegatan 23, 114 37 Stockholm, Sweden.

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.

⁴ Marked as Exhibits "B" to "B-29".

"123.1. A mark cannot be registered if it:

(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;

(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

(f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, That the interests of the owner of the registered mark are likely to be damaged by such use;

xxx"

Records reveal that at the time the Respondent-Applicant filed an application for registration of the contested mark on 22 October 2014, the Opposer already has valid and existing registration of the marks "YUM", which was issued on 11 November 2010, "YUM MASCOT DESIGN" issued on 23 July 2009 and "YUM MASCOT HOUSE" issued on 06 January 2011 and 14 October 2010.

To determine whether the competing marks are indeed confusingly similar, the same are reproduced hereafter:

Opposers' marks:

YUM



Respondent-Applicant's mark

Yummix
MILK RICE

Vis-à-vis the Opposer's "YUM MASCOT HOUSE" mark, it is obvious that there are no similar features on the said mark that is incorporated in the Respondent-Applicant's mark. As to the Opposer's "YUM" and "YUM MASCOT DESIGN" marks, the common element is the word "YUM". The said word, however, is synonymous to "delicious" and therefore, suggests that the goods involved are food products. Entities dealing in anything connected to food and/or restaurants naturally tend to use the said word to give away the idea of the products and/or services they deal with.

Succinctly, the Trademark Registry shows that there are other registered marks belonging to different proprietors that use the same word. These marks include "YUM YUM AND DEVICE", "YUM YUM DONUTS AND DEVICE" and "GOLDEN YUM AND DEVICE", under Certificates of Registration Nos. 4-2010-012401, 4-2003-001758 and 4-2009-012659, respectively, all of which cover goods under Class 30. This shows that the Opposer does not exclusively use the word "YUM" in its trademarks. In fact, some of the aforementioned marks were registered before that of the Opposer's.

Therefore, what will determine confusing similarity are the words and/or device that accompany the same. In this case, the Opposer's mark "YUM", whether alone or accompanied by a drawing of a mascot is easily distinguishable from the Respondent-Applicant's "YUMMIX MILK RICE". It is noteworthy that the Respondent-Applicant does not separate "YUM" from "MIX" and therefore, the mark should be



appreciated in its entirety. Even in respect of aural and conceptual projection, mistake is remote to occur.

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.⁵ In this case, the Respondent-Applicant's mark sufficiently met this function.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2014-505005 is hereby **DISMISSED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 12 JUL 2016


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

⁵ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.