

JOLLIBEE FOODS CORPORATION,
Opposer,

-versus-

FLY ACE CORPORATION,
Respondent-Applicant.

X-----X

IPC No. 14-2011-00475

Opposition to:

Appln. Serial No. 4-2010-011213

Date Filed: 12 October 2010

TM: JOLLY FRESH

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 396 dated 04 November 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 04 November 2016.

MARILYN F. RETUAL

IPRS IV

Bureau of Legal Affairs

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

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IPC No. 14-2011-00475

Opposition to:
 Application No. 4-2010-011213
 Date Filed: 12 October 2010
 Trademark: "JOLLY FRESH"

Decision No. 2016- 396

DECISION

JOLLIBEE FOODS CORPORATION¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2010-011213. The application, filed by Fly Ace Corporation² ("Respondent-Applicant"), covers the mark "JOLLY FRESH" for use on "fruit juices" under Class 32 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"1. The grounds for opposition are as follows:

"1. The registration of the mark JOLLY FRESH is contrary to the provisions of Sections 123.1 (d), (e) and (f) of Republic Act No. 8293, as amended, otherwise known as the Intellectual Property Code of the Philippines ('IP Code') which prohibit the registration of a mark that:

x x x

"2. Opposer is the owner and first user of the internationally well-known JOLLIBEE mark and other related JOLLIBEE and JOLLY marks (hereafter collectively referred to as the 'JOLLIBEE Trademarks'), which have been registered and/or applied for registration with the Philippine Intellectual Property Office ('IPO') for food products in class 32, as well as for a wide range of food products and related services in various classes. The details of some of these marks appear below:

x x x

"3. A cursory examination of the conflicting marks show that JOLLY FRESH, on the one hand, and the JOLLIBEE Trademarks, on the other, are confusingly similar:

¹A domestic corporation duly organized and existing under the laws of the Republic of the Philippines, with address at the 7th Floor, Jollibee Plaza Building, Emerald Avenue, Ortigas Center, Pasig City, Philippines.

²A domestic corporation with address at 2796 Daan Hari Street, United Hills Subdivision, Paranaque City, Metro Manila, Philippines.

³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.



x x x

"3.1. The component 'JOLLY' of Respondent's mark JOLLY FRESH is identical in appearance, spelling and phonetics with the dominant component 'JOLLY' of Opposer's well-known and registered marks JOLLY SHAKES, JOLLY CRISPY FRIES, JOLLY CHEEZY FRIES, JOLLY 'ZERTS, JOLLY KRUNCHY TWIRL and JOLLY HOTDOG (hereinafter the 'JOLLY Trademarks').

"3.2. In particular, the mark JOLLY FRESH is patently similar to Opposer's registered mark JOLLY CRISPY FRIES covered by Trademark Registration No. 4-2009-006965 issued on 15 April 2010, as can be readily ascertained by a side-by-side comparison of the two marks, thus:

x x x

"3.3. The dominant component 'JOLLY' of Respondent's mark JOLLY FRESH is substantially similar in appearance, spelling and phonetics with the dominant component 'JOLLI' of Opposer's well-known and registered JOLLIBEE Trademarks. Except for the last letter, the dominant words in the marks, i.e., 'JOLLY' and 'JOLLI', look and sound exactly the same. The first two syllables of JOLLIBEE and JOLLY FRESH are phonetically indistinguishable. JOLLY FRESH, pronounced as 'jo-li-bee'. Both words have three (3) syllables. This confusing similarity is bolstered by the fact that Respondent's mark is intended for use in connection with the sale of products in class 32, under which the JOLLIBEE Trademarks are also used and registered.

"3.4. The term JOLLY FRESH is a combination of the words 'JOLLY' and 'FRESH', and closely resembles JOLLIBEE, which combines the words 'JOLLI' and 'BEE'.

"3.5. Respondent seeks to register the mark JOLLY FRESH for 'fruit juices' in class 32, under which the JOLLIBEE Trademarks are also used and registered.

"The foregoing support a finding of sufficient similarity between the competing marks, if not identity with the JOLLIBEE Trademarks.

"4. It must be emphasized that Opposer's JOLLIBEE Trademarks - including the mark JOLLY which is registered in Opposer's name - are arbitrary trademarks when used on its goods in Class 32 as well as on related goods and services. It is therefore surprising that notwithstanding a boundless choice of words, phrases and symbols, Respondent has chosen a mark that closely resembles Opposer's mark for use on exactly identical or related goods. In the absence of a plausible explanation from Respondent as to how this happened, it is not far-fetched to conclude that Respondent is aware of the existence, prior use, and registration in the Philippines, the international renown, and goodwill of Opposer's JOLLIBEE Trademarks prior to Respondent's appropriation, and application for registration, of the mark JOLLY FRESH. When an applicant, without a reasonable explanation, uses the same elements which are dominant

features in another person's mark, though the field of its selection was so broad, the inevitable conclusion is that it was done deliberately to deceive (x x x)

"5. Opposer enjoys the exclusive right to prevent all third parties not having its consent from using in the course of trade identical or similar signs for goods which are identical or similar to those in respect of which its trademarks are registered, where such use would result in a likelihood of confusion.

"Opposer has not consented to the Respondent's use and registration of the mark JOLLY FRESH, or any other mark identical or similar to the Opposer's JOLLIBEE Trademarks.

"6. Opposer has used the JOLLIBEE Trademarks in the Philippines and elsewhere prior to the filing date of the application subject of this opposition. In the Philippines, Opposer has used the JOLLIBEE mark as early as 1978. The Opposer continues to use the JOLLIBEE Trademarks in the Philippines and in numerous other countries worldwide.

"7. The confusing similarity between Respondent's mark JOLLY FRESH with Opposer's JOLLIBEE Trademarks will deceive consumers by suggesting a connection, association or affiliation with the Opposer when none exists, thereby causing substantial damage to the goodwill and reputation associated with the JOLLIBEE Trademarks. Hence, the registration of the Respondent's mark will be contrary to Section 123.1 (d) of Republic Act No. 8293.

"8. The Opposer has extensively promoted the JOLLIBEE Trademarks 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 Trademarks are used in various media, including television commercials, outdoor advertisements, internationally well-known print publications, and other promotional events.

"Opposer's JOLLIBEE Trademarks are well-known and world-famous. Hence, the registration of the Respondent's mark JOLLY FRESH will constitute a violation of Section 123.1 (e), and 123.1 (f) of Republic Act No. 8293.

"9. Opposer is entitled to protection for its JOLLIBEE Trademarks against marks that are liable to create confusion in the minds of the public or used in bad faith under Article 6bis of the Paris Convention, thus:

x x x

"10. As owner of a mark that is well-known and registered in the Philippines, Opposer is entitled to protect its JOLLIBEE Trademarks against marks that are liable to create confusion in the minds of the public, whether such marks are used on similar or dissimilar goods or services.

"11. Respondent's use of the mark JOLLY FRESH on 'fruit juices' in class 32, under which the Opposer's JOLLIBEE Trademarks are also used and registered, will mislead the purchasing public into believing that the Respondent'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 services put on the market by the Respondent under the mark JOLLY FRESH.

"12. Moreover, the use by Respondent of the mark JOLLY FRESH in relation to 'fruit juices' in class 32 which are identical, similar and/or closely related to the Opposer's goods for which the JOLLIBEE Trademarks are used will take unfair advantage of, dilute and diminish the distinctive character or reputation of Opposer's JOLLIBEE Trademarks.

"The Supreme Court, in *Levi Strauss & Co. vs. Clinton Apparelle, Inc.*, has defined trademark dilution as follows:

x x x

"Opposer's use of the JOLLIBEE Trademarks in relation to Class 32 goods, as well as on related goods and services is unique and distinctive. Respondent's use of JOLLY FRESH indubitably detracts from this uniqueness and, ultimately, the ability of the JOLLIBEE Trademarks to distinguish Opposer's goods and services from that of other business entities.

"13. Opposer's goodwill on its JOLLIBEE Trademarks is a property right separately protected under Philippine law, and a violation thereof amounts to unfair competition proscribed under Article 10bis of the Paris Convention, Article 28 of the Civil Code and Section 168 of the IP Code. Article 10bis of the Paris Convention provides:

x x x

"14. Moreover, the registration of Respondent's JOLLY FRESH mark will work to impede the natural expansion of Opposer's use of its JOLLIBEE Trademarks in the Philippines.

"15. Furthermore, considering the substantial investment incurred by Opposer in promoting its goods and identifying itself throughout the world through the JOLLIBEE Trademarks, it is clear that Respondent's deceitful conduct in securing the registration of a mark similar to Opposer's and in exploiting the same is aimed towards unduly enriching itself at the expense of Opposer.

"16. The denial of the application subject of this opposition is authorized under other provisions of the IP Code.

The Opposer's evidence consists of the Notice of Opposition; the Affidavit of Atty. Gonzalo D.V. Go III; screenshots of Opposer's website, www.jollibee.com.ph featuring the various JOLLIBEE food and food products as well as JOLLIBEE restaurant locations in the Philippines and overseas; table showing the details of Opposer's applications and registrations for the JOLLIBEE MARKS worldwide; copies of representative samples of the registration certificates for Opposer's trademark registrations for the JOLLIBEE MARKS worldwide (Bahrain, Canada, Hongkong, India, Indonesia, South Korea, Oman, Singapore, Saudi Arabia, United Arab Emirates, United States of America and Vietnam); representative samples of promotional materials and advertisements for the JOLLIBEE trademarks and products; copy of Philippine

Trademark Registration No. 4-2000-004772 for the mark JOLLIBEE; copy of Philippine Trademark Registration No. 4-2005-007558 for the mark JOLLIBEE; copy of Philippine Trademark Registration No. 4-2000-007421 for the mark JOLLIBEE; copy of Philippine Trademark Registration No. 4-2004-006570 for the mark BEE HEAD DEVICE; copy of Philippine Trademark Registration No. 4-2005-007557 for the mark BEE HEAD DEVICE; copy of Philippine Trademark Registration No. 4-2010-002056 for the mark BEE DEVICE; copy of Philippine Trademark Registration No. 4-2008-007562 for the mark JOLLIBEE MASCOT DESIGN; copy of Philippine Trademark Registration No. 4-2009-006901 for the mark JOLLIBEE BREAKFAST JOYS; copy of Philippine Trademark Registration No. 4-2009-006900 for the mark JOLLIBEE CHAMP; copy of Philippine Trademark Registration No. 4-2009-006905 for the mark JOLLIBEE CHAMP. BIG BURGER GOODNESS LIKE NO OTHER; copy of Philippine Trademark Registration No. 4-2010-004204 for the mark JOLLIBEE CHICKEN BARBEQUE INSIDE A RECTANGULAR DEVICE; copy of Philippine Trademark Registration No. 4-2010-004233 for the mark JOLLIBEE CHICKEN BARBEQUE DELICIOUS INSIDE AND OUT INSIDE A RECTANGULAR DEVICE (IN COLOR); copy of Philippine Trademark Registration No. 4-2010-004234 for the mark JOLLIBEE CHICKEN BARBEQUE INSIDE A RECTANGULAR DEVICE (IN COLOR); copy of Philippine Trademark Registration No. 4-2008-001694 for the mark JOLLIBEE FOUNDATION; copy of Philippine Trademark Registration No. 4-2003-008178 for the mark JOLLIBEE YUMBURGER AND DEVICE; copy of Philippine Trademark Registration No. 4-2005-002450 for the mark JOLLIBEE SUPER MEALS; copy of Philippine Trademark Registration No. 4-2010-002055 for the mark JOLLIBEE LOGO & DEVICE; copy of Philippine Trademark Registration No. 4-2010-005306 for the mark JOLLIBEE KIDS TV INSIDE A SQUARE DEVICE (IN COLOUR); copy of Philippine Trademark Registration No. 4-2010-005305 for the mark JOLLIBEE KIDS TV AND DEVICE WITH JOLLIBEE CHARACTER ON THE LEFT SIDE (IN COLOUR); copy of Philippine Trademark Registration No. 4-2010-005307 for the mark JOLLIBEE KIDS MEAL INSIDE A CIRCLE DEVICE WITH A GRAPHIC DESIGN OF A FORK ON THE LEFT SIDE AND A SPOON ON THE RIGHT SIDE (IN COLOUR); copy of Philippine Trademark Registration No. 4-2010-005304 for the mark JOLLIBEE KIDS MEAL INSIDE A CIRCLE DEVICE WITH A GRAPHIC DESIGN OF A FORK ON THE LEFT SIDE AND A SPOON ON THE RIGHT SIDE AND A JOLLIBEE CHARACTER ON THE UPPER LEFT SIDE (IN COLOUR); copy of Philippine Trademark Registration No. 4-2010-005302 for the mark JOLLIBEE KIDS CLUB INSIDE A CIRCLE DEVICE WITH A GRAPHIC DESIGN OF FACES OF KIDS AND A JOLLIBEE CHARACTER ON TE UPPER LEFT SIDE (IN COLOUR); copy of Philippine Trademark Registration No. 4-2010-005303 for the mark JOLLIBEE KIDS CLUB INSIDE A CIRCLE DEVICE WITH A GRAPHIC DESIGN OF FACES OF KIDS (IN COLOUR); copy of Philippine Trademark Registration No. 4-2010-005367 for the mark JOLLIBEE MASCOT HOUSE AND DEVICE (IN COLOR); copy of Philippine Trademark Registration No. 4-2010-005366 for the mark JOLLIBEE MASCOT HOUSE AND DEVICE (IN BLACK & WHITE); copy of Philippine Trademark Registration No. 4-2010-005152 for the mark JOLLIBEE KIDS TV

INSIDE A SQUARE DEVICE; copy of Philippine Trademark Registration No. 4-2010-005151 for the mark JOLLIBEE KIDS TV AND DEVICE WITH JOLLIBEE CHARACTER ON THE LEFT SIDE; copy of Philippine Trademark Registration No. 4-2010-005153 for the mark JOLLIBEE KIDS MEAL INSIDE A CIRCLE DEVICE WITH A GRAPHIC DESIGN OF A FORK ON THE LEFT SIDE AND A SPOON ON THE RIGHT SIDE; copy of Philippine Trademark Registration No. 4-2010-005154 for the mark JOLLIBEE KIDS MEAL INSIDE A CIRCLE DEVICE WITH A GRAPHIC DESIGN OF A FORK ON THE LEFT SIDE AND A SPOON ON THE RIGHT SIDE AND A JOLLIBEE CHARACTER ON THE UPPER LEFT SIDE; copy of Philippine Trademark Registration No. 4-2010-005155 for the mark JOLLIBEE KIDS CLUB INSIDE A CIRCLE DEVICE WITH A GRAPHIC DESIGN OF FACES OF KIDS; copy of Philippine Trademark Registration No. 4-2010-005156 for the mark JOLLIBEE KIDS CLUB INSIDE A CIRCLE DEVICE WITH A GRAPHIC DESIGN OF FACES OF KIDS AND JOLLIBEE CHARACTER ON THE UPPER LEFT SIDE; copy of Philippine Trademark Registration No. 4-2009-006965 for the mark JOLLY CRISPY FRIES; copy of Philippine Trademark Registration No. 4-2004-006392 for the mark JOLLY CRISPY FRIES; copy of Philippine Trademark Registration No. 4-2005-006933 for the mark JOLLY CHEEZY FRIES; copy of Philippine Trademark Registration No. 4-2003-001019 for the mark JOLLY SHAKES; copy of Philippine Trademark Registration No. 4-2009-006903 for the mark JOLLY HOTDOG; copy of Philippine Trademark Registration No. 4-2009-006906 for the mark JOLLY HOTDOG. SARAP ON-THE-MOVE; copy of Philippine Trademark Registration No. 4-2009-006907 for the mark JOLLY CRISPY FRIES. BEST FRIENDS FRIES.; copy of Philippine Trademark Registration No. 4-2005-003292 for the mark JOLLY 'ZERTS; copy of Philippine Trademark Registration No. 4-2005-001998 for the mark JOLLY KRUNCHY TWIRL; Opposer's sample food container using the JOLLIBEE & BEE HEAD DEVICE; sample photographs of JOLLIBEE restaurants/branches; copy of Certificate executed by William Tan regarding the authority of Atty. Gonzalo D.V. Go III to verify the notice of opposition and execute the certificate of non-forum shopping and the authority of Quisumbing Torres to represent Opposer in IPC No. 14-2011-00475; and the Secretary's Certificate executed by William Tan Untiong regarding the execution of the Certificate/Power of Attorney.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 31 January 2012. The Respondent-Applicant filed their Answer on 14 May 2012 and avers the following:

x x x

"SPECIAL AND AFFIRMATIVE DEFENSE

"4. By way of special and affirmative allegations and defenses and in support of the aforementioned specific denials, herein respondent-applicant incorporates by way of reference all the material, pertinent, and relevant

⁴Marked as Exhibits "A" to "M", inclusive.

allegations contained in the preceding paragraphs, and most respectfully alleges that:

"4.1 There exist no legal grounds for the Opposer to oppose respondent-applicant's trademark application Serial No. 4-2010-011213 for the grounds relied upon by the opposer are mere gratuitous conclusions of facts and law and for being false, misleading, malicious and self-serving allegations.

"4.2. Looking back as early as 1972, long before the alleged registration of Opposer's trademarks, the word 'JOLLY' was already in use by the respondent-applicant's incorporators as a trade name, to wit: 'The Jolly General Merchandise';

"4.3. This business name was later changed to respondent-applicant's current name following its incorporation but the word 'JOLLY' was adopted as part of its mark for the high quality products sourced from its partners all across the globe and distributed in Philippine supermarkets, hotels, groceries and restaurants;

"4.4. Respondent-applicant in using the trademark Jolly fresh for the goods/products it imported and distributed has no intention to mislead the public as to the source of origin of its goods or to confuse the buying public that the goods were originated from, or are licensed or sponsored by the Opposer and neither did it capitalize on the alleged renowned name of Opposer's trademark. The trademark JOLLY FRESH, where the word JOLLY came from respondent-applicant's former name, was adopted and applied by the respondent-applicant in Good Faith;

"4.5. This trademark application was filed under section 124 of the Intellectual Property Code of the Philippines, which is a legally recognized mode of filing an application. Thus, after a thorough and circumspect evaluation of the Trademark Examining Division and the Director of the Intellectual Property Office (IPO), application Serial No. 4-2010-011213 for Jolly Fresh was recommended for allowance.

"4.6. Respondent-applicant had spent considerable time, money, effort and resources in promoting its dominant mark Jolly and had in fact developed the local market and established the goodwill for the said trademark on its own, through various sales advertisements, mass media/television advertisements, promotions, demonstrations, had invested in the recruitment and training of its employees in the installation, operation and servicing of its products using the said trademark, thus, spending in the process substantial amount/investment, which is quantified into millions of pesos;

"4.7. Contrary to Opposer's incredulous, malicious and self-serving claim, deception, confusion, mistake on the part of the consuming public is highly remote with the granting of respondent-applicant's trademark as clearly, respondent-applicant's Jolly fresh mark is neither identical nor nearly resembles Opposer's Jollibee mark. Besides, it is a matter of public knowledge that the Opposer's goods where its alleged trademark was used are exclusively confined for its fast food services. Stated otherwise, Opposer's goods are not even distributed to other restaurants, hotels, supermarkets or groceries, but are

only confined for its fast-food chains' use. Thus, the alleged claim of confusion and deception on the part of the consuming public is simply baseless and a product of Opposer's wild imagination.

"4.8. While the goods where respondent-applicant's mark is used falls under class 32 of the nice classification of goods, however, they are not the same or closely related with the goods of the Opposer. The goods of the Opposer, which could be found only in its fast food chains are ready to eat/cooked food products. Whereas, the goods of the respondent-applicant where the trademark Jolly is being use are imported ingredients canned goods and bottled/tetra pack fruit juices. In sum, Opposer's claim that the goods where the mark is used are similar in their fundamental nature as food products under class 32 is simply self serving and mind boggling. Moreover, the product of opposer and herein respondent-applicant are not even sold to consumers through the same channel of trade;

"4.9. Based on the record, the trademark Jollibee with Certificate of Registration No. 38545, which presumably where the opposer's other marks were derived from, was already cancelled and revoked by the Honorable Office on October 2003. The same could not therefore be used as a legal justification for the Opposer to oppose instant application considering that any right conferred by such registration upon the Opposer herein was already terminated. Ergo, the alleged derivative marks, which were registered only in 2006, 2007, 2009 and 2010, acquire no right from such revoked or cancelled trademark.

"4.10. In fact, respondent-applicant has a better and legal right to use the dominant mark 'JOLLY' over the Opposer, in as much as it is the first user since 1972 and registered owner in 2002 by virtue of the Certificate of Registration No. 4-199-04805 issued by the Honorable Office;

"4.11. Likewise, the trademark Jollibee could never be considered as a well-known mark within the meaning of the law and existing jurisprudence. To be considered as such, it should first pass the requirements of law to attain such status, after a full-blown trial, with a declaration to that effect by a competent authority;

"4.12. The Opposer in filing instant baseless and malicious Opposition did not act with justice, observe honesty and good faith. Records would show that Opposer had previously recognized the rights of the Respondent-Applicant over its mark, [JOLLY] as attested to by no other than the compromise agreement it entered into with the respondent-applicant before the Bureau of Legal Affairs, Intellectual Property Office, in cases captioned 'Jollibee Foods Corporation vs. Fly Ace Corporation', docketed as IPC Case No. 14-2007-00274 and 'Jollibee Foods Corporation vs. Fly Ace Corporation', docketed as IPC Case No. 14-2007-00275. In sum, Opposer is now estopped from questioning respondent-applicant application for the registration of the mark 'Jolly fresh'.

"4.13. In compliance with the rules, respondent-applicant is attaching the affidavit-direct testimony of its witnesses as Annexes '1' and '2' to form integral parts thereof; x x x

The Respondent-Applicant's evidence consists of the Affidavit of Jaime Ching; and, the Affidavit of Ellen L. Cochanco, Vice President for support services and one of the incorporators of Fly Ace Corporation.⁵

Should the Respondent-Applicant be allowed to register the trademark JOLLY FRESH?

The Opposer anchors its opposition on Sections 123.1, paragraphs (d), (e) and (f) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), to wit:

Sec. 123.Registrability. - 123.1. A mark cannot be registered if it:

x x x

- (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 service 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;

It must be emphasized, however, that the protection to a trademark under the afore-quoted provisions hinges on a factual finding of the existence of confusing similarity between the trademark sought to be protected and the other.

Hence, the question, does JOLLY FRESH resemble JOLLIBEE Trademarks such that confusion or deception is likely to occur? The marks are shown below:

⁵Marked as Annexes "1" and "2", inclusive.

JOLLIBEE



Opposer's trademarks



Respondent-Applicant's mark

This Bureau finds that confusion or deception is unlikely to occur at this instance. An examination and comparison of the competing marks shows that both marks start with the letters J, O, L, L or the word JOLLY. However, apart from the letters J, O, L, and L and the word JOLLY, there are other essential features in the Respondent-Applicant's mark consisting of the brand name "JOLLY FRESH" in white, bordered in black, green and orange outlines. The second word FRESH is reflected as all being in upper cases/capital letters. Also, all texts are white, with black, green and orange outlines. Both marks are similar only in the use of the letters J,O,L,L and the word JOLLY but they vary substantially in the composition and integration of the other main and essential features, in the general design and their overall appearance. It is observed that an ordinary consumer's attention would not be drawn on the minute similarities that were noted but on the differences or dissimilarities of both service marks that are glaring and striking to the eye and ring to the ears conferred on it visual and aural projection that would easily distinguish one from the other.

Moreover, in the Trademark Registry, the contents of which the Bureau can take cognizance of via judicial notice, there are several trademarks consisting of the word "JOLLY" or in pair with other word or device that are registered or applied for registration and these are the JOLLY trademarks generally under Classes 30 and 32, such as Jolly Ole Chef with Chef Illustration with Reg. No. 4-2009-10931, Jolly Rancher with Reg. No. 4-2007-10168, Jolly Shandy with Reg. No. 4-1987-414213, and Jolly-C with Reg. No. 4-1993-428975, which are owned by entities other than the Opposer. Further, the issue of whether or not the mark with the word JOLLY is confusingly similar to the JOLLIBEE Trademarks has already passed upon in IPC No. 14-2006-00165. This Bureau in the Decision on 15 October 2007⁶, held that the use of JOLLY may constitute a valid trademark particularly in combination with another word, to wit:

"xxx JOLLY is an ordinary and generic word and no one has exclusive use to it. The use of JOLLY may constitute a valid trademark particularly in combination with another word, such as the word DAY in the case at bar. The combination of words and syllables can be registered as trademarks for as long as it can individualize the goods of a trader from the goods of its competitors. xxx"


⁶ Decision No. 2007-143.

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.⁷ This Bureau finds that the Respondent-Applicant's mark sufficiently serves this function.

WHEREFORE, premises considered, the instant Opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2010-011213 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 04 NOV 2016.


Atty. JOSEPHINE C. ALON
Adjudication Officer, Bureau of Legal Affairs

⁷ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.