

JOLLIBEE FOODS CORPORATION,
Opposer,

-versus-

GENOSI, INC.,
Respondent- Applicant.

}
} IPC No. 14-2012-00496
} Opposition to:
} Appln. Serial No. 4-2012-006831
} Date Filed: 06 June 2012
} TM: "CHICKYLICIOUS"
}

x-----x

NOTICE OF DECISION

QUISUMBING TORRES

Counsel for Opposer
12th Floor, Net One Center
26th Street corner 3rd Avenue
Crescent Park West, Bonifacio Global City
Taguig City

ESGUERRA & BLANCO

Counsel for Respondent- Applicant
4th Floor and 5th Floor, S & L Building
Dela Rosa corner Esteban Streets
Legaspi Village, Makati City

GREETINGS:

Please be informed that Decision No. 2016 - 415 dated November 17, 2016 (copy enclosed) was promulgated in the above entitled case.

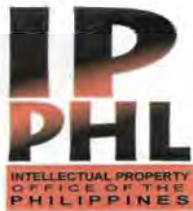
Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, November 18, 2016.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center # 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio,
Taguig City 1634 Philippines • www.ipophil.gov.ph
T: +632-2386300 • F: +632-5539480 • mail@ipophil.gov.ph



JOLLIBEE FOODS CORPORATION, }
Opposer, }
 }
 }
 -versus- }
 }
 GENOSI, INC., }
Respondent-Applicant. }

IPC No. 14-2012-00496
 Opposition to:
 Application No. 4-2012-006831
 Date Filed: 06 June 2012
 Trademark: "CHICKYLICIOUS"

x-----x

Decision No. 2016- 415

DECISION

JOLLIBEE FOODS CORPORATION¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-006831. The application, filed by GENOSI, INC.² ("Respondent-Applicant"), covers the mark "CHICKYLICIOUS" for use on "poultry products namely fresh, frozen, raw, processed and/or cooked chicken to include whole muscle chicken, battered and breaded chicken, chicken nuggets, chicken patties, chicken hotdog and chicken popcorn" under Class 29 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"I. The grounds for opposition are as follows:

"1. Opposer and its JOLLIBEE brand are recognized as one of our country's greatest success stories and is an undeniable symbol of Filipino pride worldwide. It 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. A key element in the JOLLIBEE success is its trademarks, which include the CRISPYLICIOUS and JUICYLICIOUS trademarks. These trademarks have continuously been used in each Jollibee outlet and in almost all product packaging, advertising and promotional materials throughout the years.

"2. Opposer respectfully comes before this Honorable Office to ask for the rejection of the application for the mark CHICKYLICIOUS sought to be registered by Respondent-Applicant for being confusingly similar to Opposer's CRISPYLICIOUS and JUICYLICIOUS trademarks.

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 GMC Compound, Felix Avenue Cainta Rizal, 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.

"3. The details of Respondent-Applicant's trademark application are, as follows:

x x x

"4. The registration of the mark CHICKYLICIOUS is contrary to Section 123.1 (d) of Republic Act No. 8293, as amended, otherwise known as the Intellectual Property Code of the Philippines, which prohibits the registration of a mark that:

x x x

"5. Opposer is the owner and first user of the CRISPYLICIOUS and JUICYLICIOUS trademarks, which were applied for registration with the Philippine Intellectual Property Office earlier than Respondent-Applicant's trademark. The details of these marks appear below:

x x x

"6. Respondent-Applicant's mark CHICKYLICIOUS is confusingly similar to Opposer's famous CRISPYLICIOUS and JUICYLICIOUS trademarks as to be likely to deceive or cause confusion in the minds of the relevant sector of the purchasing public. A cursory examination of the marks, reproduced below, will readily reveal such confusing similarity.

x x x

"6.1. Respondent-Applicant's mark CHICKYLICIOUS and Opposer's mark CRISPYLICIOUS are both made up of thirteen (13) letters, ten (10) of which are identical and similarly positioned.

"6.2. Respondent-Applicant's mark CHICKYLICIOUS and Opposer's mark JUICYLICIOUS have nine (9) common letters out of thirteen (13), with these letters being similarly positioned.

"6.3. Respondent-Applicant's mark CHICKYLICIOUS and Opposer's mark CRISPYLICIOUS and JUICYLICIOUS all contain four (4) syllables each, with the first two syllables being similar and the last two syllables being identical.

"6.4. Due to the identity of most of the letters and syllables, the competing marks are visually and phonetically alike.

"6.5. The likelihood of confusion is enhanced since the competing marks cover the same and competing goods under Class 29, i.e. Opposer's 'chicken' and Respondent-Applicant's 'poultry products namely fresh, frozen, raw, processed and or cooked chicken to include whole muscle chicken, battered and breaded chicken, chicken nuggets, chicken patties, chicken hotdog and chicken popcorn.' Accordingly, the goods are found in the same channels of business and trade, belong to the same food industry, and cater to the same sector of the consuming public.

"7. In the similar case of American Wire & Cable Company vs. Director of Patents, the Supreme Court held that there is confusing similarity between the competing marks due to similarity of most of the letters forming the competing word marks and the similarity of the covered goods, to wit:

x x x

"8. It is surprising that notwithstanding a boundless choice of words, phrases and symbols, Respondent-Applicant has adopted the identical letters L-I-C-I-O-U-S from Opposer's CRISPYLICIOUS and JUICYLICIOUS trademarks, and added the similar element CHICKY before such letters, to form the CHICKYLICIOUS mark. The public who are therefore familiar with Opposer's famous CRISPYLICIOUS and JUICYLICIOUS trademarks may be led to believe that CHICKYLICIOUS is another variant of Opposer's trademarks. In the absence of a plausible explanation from Respondent-Applicant as to how this happened, it is only logical to conclude that Respondent-Applicant is aware of the existence, prior use, and renown and reputation of Opposer's marks and deliberately appropriated the mark CHICKYLICIOUS to trade on the goodwill attached to Opposer's marks.

"9. As held in the case of American Wire & Cable Co. vs. Director of Patents:

x x x

"10. It is further well-settled that exact duplication of the mark is not necessary for public confusion to occur. In Del Monte Corporation and Philippine Packing Corporation vs. Court of Appeals and Sunshine Sauce Manufacturing Industries, the Supreme Court stated:

x x x

"11. Opposer has used the CRISPYLICIOUS and JUICYLICIOUS trademarks in the Philippines and elsewhere prior to the filing date of the application subject of this opposition. In the Philippines, Opposer first used the CRISPYLICIOUS and JUICYLICIOUS trademarks as early as December 31, 2005. To date, Opposer continues to use these trademarks throughout the Philippines, as well as abroad.

"12. Over the years, Opposer has also obtained significant exposure for the products upon which the marks CRISPYLICIOUS and JUICYLICIOUS are used in various media, including television commercials, outdoor advertisements, internationally well-known print publications, and other promotional events. Its products can also be viewed online through its website www.jollibee.com.ph where the marks CRISPYLICIOUS and JUICYLICIOUS are prominently featured.

"13. To date, products bearing the marks CRISPYLICIOUS and JUICYLICIOUS are sold and served in 756 JOLLIBEE restaurants in the Philippines and 83 JOLLIBEE restaurants abroad located in the United States of America, Vietnam, Brunei, Jeddah, Qatar, Hong Kong and Kuwait.

"14. Through Opposer's long, continuous and extensive use, promotion and advertising of its trademarks CRISPYLICIOUS and JUICYLICIOUS and its chicken popularly described as CRISPYLICIOUS and

JUICYLICIOUS, the same have become so famous throughout the Philippines and around the world such that a mere mention of the words 'CRISPYLICIOUS' and 'JUICYLICIOUS' would immediately cause the consuming public to associate and equate the same with Opposer, its 756 JOLLIBEE restaurants in the Philippines and 83 JOLLIBEE restaurants abroad, and its famous chicken called CHICKENJOY. Thus, Respondent-Applicant's use of the confusingly similar mark CHICKYLICIOUS would cause purchasers to believe that its chicken and chicken products originate from or are sponsored by Opposer.

"15. It is worth noting that Opposer is a very famous and dynamic food product and service provider that comes out with variants for its products regularly. The confusing similarity between Respondent-Applicant's mark CHICKYLICIOUS and Opposer's CRISPYLICIOUS and JUICYLICIOUS trademarks will most likely 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 Opposer and its marks. The fact that Respondent-Applicant's mark covers 'poultry products namely fresh, frozen, raw, processed and/or cooked chicken to include whole muscle chicken, battered and breaded chicken, chicken nuggets, chicken patties, chicken hotdog and chicken popcorn' only aggravates the probability of public confusion since these are products which Opposer is popularly associated with. Hence, Respondent-Applicant's mark should not be allowed and registered under the explicit provision of Section 123.1 (d) of the IP Code.

"16. Moreover, the use by Respondent-Applicant of the mark CHICKYLICIOUS in relation to the goods which are the same as and competing with Opposer's goods for which the marks CRISPYLICIOUS and JUICYLICIOUS are used will take unfair advantage of, dilute the goodwill, and diminish the distinctive character or reputation of Opposer's known CRISPYLICIOUS and JUICYLICIOUS trademarks. Please note that the CRISPYLICIOUS and JUICYLICIOUS trademarks are used in connection with Opposer's extremely popular CHIKENJOY fried chicken products which, again, is the same as and competing with the goods covered by Respondent-Applicant's mark CHICKYLICIOUS.

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

x x x

"18. Opposer's goodwill on its CRISPYLICIOUS and JUICYLICIOUS 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

"19. Moreover, considering the substantial investment incurred by Opposer in promoting its goods and in identifying itself throughout the world through its CRISPYLICIOUS and JUICYLICIOUS trademarks, as well as other JOLLIBEE trademarks, it is clear that Respondent-Applicant's 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.

"20. The foregoing discussion indubitably shows that Respondent-Applicant has no right whatsoever to register the confusingly similar mark CHICKYLICIOUS in its name for being violative of Opposer's vested rights over the earlier-filed and earlier-used CRISPYLICIOUS and JUICYLICIOUS trademarks. The subject application should therefore be denied in accordance with the provisions of the IP Code, as well as the Paris Convention to which the Philippines is contractually and legally bound.

The Opposer's evidence consists of the Notice of Opposition; the Affidavit of Atty. Gonzalo D.V. Go III and its attachments: a copy of Philippine Trademark Application No. 4-2012-000563 filed on 16 January 2012 for CRISPYLICIOUS in Class 29, a copy of Philippine Trademark Application No. 4-2012-000564 filed on 16 January 2012 for JUICYLICIOUS in Class 29, representative samples of food packaging and containers bearing the CRISPYLICIOUS and JUICYLICIOUS trademarks, screenshots of Opposer's website, www.jollibee.com.ph featuring the various items and food products bearing the CRISPYLICIOUS and JUICYLICIOUS trademarks and other JOLLIBEE trademarks, JOLLIBEE restaurant locations in the Philippines and overseas and other relevant information about Opposer, representative samples of promotional materials and advertisements in television programs, the internet, well-known print publications, in-store promotions, and outdoor promotions for products and services bearing the CRISPYLICIOUS and JUICYLICIOUS trademarks and other Jollibee trademarks; sample photographs of JOLLIBEE restaurants/branches; the Special Power of Attorney executed by William Tan Untiong 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 these proceedings; 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 07 December 2012. The Respondent-Applicant filed their Answer on 05 February 2013 and avers the following:

x x x

"Defenses

"11. Under Section 138 of Republic Act ('R.A.') No. 8293, otherwise known as the 'Intellectual Property Code of the Philippines,' GenOsi's Certificate of Registration for CHICKYLICIOUS is evidence of its exclusive right to use the same in connection with the goods specified in the certificate, and those that are related thereto, to wit:

x x x

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

"12. The Supreme Court reiterated the foregoing presumption under Section 1, Rule 18 of A.M. No. 10-3-10-SC, entitled 'Rules of Procedure for Intellectual Property Rights Cases,' which states: x x x

"13. As held by the Supreme Court in *Societes Des Produits Nestle, S.A. v. Dy*, the protection of trademarks extends beyond identical goods, to wit:

x x x

"14. In *Dermaline, Inc. vs. Myra Pharmaceuticals, Inc.*, the Supreme Court reiterates that the extent of protection to which the trademark owner is entitled, and states that: x x x

"15. In this case, it cannot be denied that GenOsi is entitled to exclusively use the trademark CHICKYLICIOUS on goods and services under Classes 6, 16, 18, 20, 25, 28, 35 and 41 as specified in its Certificate of Registration. Likewise, GenOsi is entitled to the exclusive use of CHICKYLICIOUS on goods and services that are related to those specified in its Certificate of Registration, including poultry products under Class 29 for which GenOsi has already been using the mark CHICKYLICIOUS since August 2006.

"16. It is clear therefore that GenOsi has the right to seek protection for its trademark CHICKYLICIOUS through a trademark registration with this Honorable Office for an additional class of related goods. Furthermore, GenOsi should be allowed to continue to enjoy the trade reputation and the goodwill that flows from its trademark, and to be protected from unwarranted interference by the opposer, Jollibee, which is one of the competitors of GenOsi's customers, McDonald's Philippines.

"17. From the foregoing, Jollibee has no basis for claiming that GenOsi merely adopted the 'LICIOUS' portion of CHICKYLICIOUS from the trademarks 'CRISPYLICIOUS' and 'JUICYLICIOUS.' Records of this Honorable Office show, and Jollibee admits, that it filed its application for the trademarks 'CRISPYLICIOUS' and 'JUICYLICIOUS' only on 16 January 2012, long after GenOsi has been using CHICKYLICIOUS on its poultry products since 2 August 2006, and after the mark was registered on 30 April 2007. Considering that GenOsi has been using and registered the trademark CHICKYLICIOUS before Jollibee filed its applications for 'CRISPYLICIOUS' and 'JUICYLICIOUS,' based on its own reasoning, Jollibee was fully aware of the existence and prior use of GenOsi's CHICKYLICIOUS, and Jollibee deliberately appropriated and copied the 'LICIOUS' portion of CHICKYLICIOUS to ride on the goodwill attached thereto. On this ground alone, this Honorable Office should dismiss Jollibee's Opposition to the registration of CHICKYLICIOUS for an additional class of related goods.

"18. In determining whether or not a mark is identical, confusingly similar, or likely to deceive, the Supreme Court has consistently referred to either the dominance test or the holistic test. To distinguish the two tests, the Supreme Court explained in *Skechers, USA v. Inter Pacific Industrial Trading Corp.* that:

x x x

"19. Under the Holistic or Totality test, there are ample differences in the sound, pronunciation, appearance, form, ideas connoted, meaning and spelling of the subject marks. In applying said test, the discerning eye of the observer must

focus not only on the predominant portions, but also on the other features appearing on both labels when the marks are actually used so that the observer may draw the conclusion on whether one is confusingly similar to the other. The Supreme Court's discussion in *Emerald Garment Manufacturing v. Court of Appeals, et al.* is instructive, to wit: x x x

"20. To be sure, in the above-cited case, the word 'LEE' is prominently featured in the competing marks. Yet, the Supreme Court held that the trademark should be considered as a whole and not on a piecemeal basis. In this case, the suffix 'LICIOUS' is not even featured prominently in the competing marks, but it merely forms part of the marks. Likewise, the prefixes 'CHICKY' and 'CHICKEN' are not featured prominently in the trademarks CHICKYLICIOUS and CHICKENJOY. For reference, the reproductions of the subject mark as applied for and as actually used are shown below: x x x

"21. Clearly, applying the totality test, there are differences in the spelling, pronunciation, font, style, and ideas connoted by the foregoing trademarks as applied for, and as actually used in the market. Thus, there can be no confusing similarity between the competing trademarks.

"22. On the other hand, under the Dominancy test, one has to check if there is a similarity of the prevalent or dominant features. An examination of the foregoing trademarks shows that each of the four trademarks use a uniform font size and style. Thus, there is no prevalent feature in each of the four trademarks subject of this case, other than each of the whole trademark itself. Hence, Jollibee has no basis for claiming that 'due to the identity of most of the letters and syllables, the competing marks are visually and phonetically alike.'

"23. Furthermore, Jollibee cannot be allowed to appropriate the suffix 'LICIOUS,' which is derived from the adjective 'delicious,' and which is used to describe the taste of the product. Being descriptive in nature, the suffix 'LICIOUS' cannot be appropriated exclusively by a single person. Similarly, Jollibee cannot appropriate the exclusive use of the word 'CHICKEN' or 'CHICKY' for being generic for the products that it seeks to identify.

"24. It is unreasonable for any party to be allowed to appropriate said descriptive or generic words or suffixes as the Supreme Court explained in *American Cyanamide Company vs. Director of Patents*, to wit:

x x x

"25. It should be stressed also that this Honorable Office allowed and approved the registration of the following marks that use the suffix 'LICIOUS' for products under Class 29 and those related thereto, viz:

x x x

"26. Clearly, this Honorable Office does not consider the suffix 'LICIOUS' as subject to exclusive appropriation of a single person. Considering that there are prior existing registrations that use the suffix 'LICIOUS,' Jollibee cannot claim exclusive ownership over said suffix. Hence, this Honorable Office cannot declare that CHICKYLICIOUS is confusingly similar to CRISPYLICIOUS or JUICYLICIOUS just because they have the same suffixes.

The Respondent-Applicant's evidence consists of a copy of the Articles of Incorporation of GenOsi; a copy of the Secretary's Certificate showing the appointment of Esguerra & Blanco; a print-out of OSI Group's website showing GenOSI as its global location in the Philippines; a copy of Certificate of Registration No. 4-2006-004025; a copy of GenOSI's Declaration of Actual Use dated 10 August 2006; a copy of Certificate of Copyright Registration and Deposit dated 12 September 2006; and a copy of GenOSI's trademark application No. 4-2012-006831.⁵

Should the Respondent-Applicant be allowed to register the trademark CHICKYLICIOUS?

The Opposer anchors its opposition on Sections 123.1, paragraph (d) 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;"

Records show that at the time the Respondent-Applicant filed its trademark application on 06 June 2012, the Opposer already has trademark applications for CRISPYLICIOUS under Application Serial No. 4-2012-000563 and JUICYLICIOUS under Application Serial No. 4-2012-000564. Both applications cover "chicken" under Class 29. On the other hand, Respondent-Applicant filed its trademark application for the mark CHICKYLICIOUS on 18 April 2006 for goods under Classes 06, 16, 18, 20, 25, 28, 35 and 41. Also, Respondent was issued Certificate of Copyright Registration and Deposit for the work entitled "CHICKYLICIOUS IS YUMMY GOODNESS...NEW COUNTRY PRIDE CHICKEN NUGGETS ANIMAL SHAPED" on 30 August 2006, with date of creation on 01 August 2006.

Hence, the question, does CHICKYLICIOUS resemble CRISPYLICIOUS and JUICYLICIOUS marks such that confusion or deception is likely to occur? The marks are shown below:

⁵Marked as Exhibits "1" to "8"

CRISPYLICIOUS JUICYLICIOUS

CHICKYLICIOUS

Opposer's marks

Respondent-Applicant's mark

This Bureau finds that confusion or deception is unlikely to occur at this instance. Although both have similar poultry products and have the same last two (2) syllables "LICIOUS", Opposer can not exclusively appropriate the last two syllables as "LICIOUS" is derived from the word DELICIOUS, very pleasant to taste.⁶ In the Trademark Registry, the contents of which this Bureau can take cognizance of via judicial notice, there are registered marks covering goods under Classes 29, 30 and 32 that have the suffix - "LICIOUS", such as Butter-Licious! with Reg. No. 42009500533, Butter-Licious Label Design with Reg. No. 42010501460, B-Licious Cupcake with Reg. No. 420153550, MD Mami D'Licious with Reg. No. 42015503509 and Nutri-Licious with Reg. No. 42011008527, which are owned by entities other than the Opposer. Hence, this Bureau cannot sustain the opposition solely on the ground that both marks contain or end with "LICIOUS". To do so would have the unintended effect of giving the Opposer exclusive right over the suffix "LICIOUS". To determine whether two marks that contain the suffix "LICIOUS" are confusingly similar, there is a need to examine the other letters or components of the trademarks. In this regard, when the syllables "CHICKY" is appended to "LICIOUS", the resulting mark when pronounced can be distinguished from CRISPYLICIOUS and JUICYLICIOUS.

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. 4-2012-006831

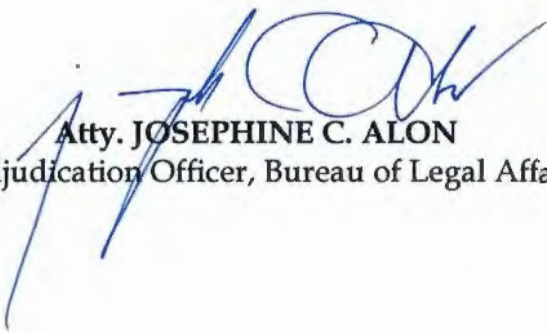
⁶Merriam-Webster dictionary definition of DELICIOUS.

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

together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 17 NOV 2016.



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