



INTELLECTUAL PROPERTY
OFFICE OF THE
PHILIPPINES

JOLLIBEE FOODS CORPORATION,

Opposer,

-versus-

STEVE C. CHUA,

Respondent-Applicant.

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IPC No. 14-2013-00028

Opposition to:

Appln. Serial No. 4-2011-009482

Date Filed: 10 August 2011

TM: JOLLY & DEVICE

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 62 dated 07 March 2017 (copy enclosed) was promulgated in the above entitled case.

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

Taguig City, 08 March 2017.

MARILYN F. RETUAL

IPRS IV

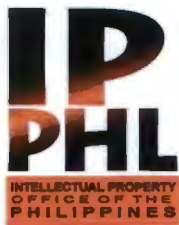
Bureau of Legal Affairs

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INTELLECTUAL PROPERTY OFFICE**

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IPC No. 14-2013-00028
 Opposition to:
 Application No. 4-2011-009482
 Date Filed: 10 August 2011
 Trademark: "JOLLY &
 DEVICE"
 Decision No. 2017- 62

DECISION

JOLLIBEE FOODS CORPORATION¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-009482. The application, filed by Steve C. Chua² ("Respondent-Applicant"), covers the mark "JOLLY & DEVICE " for use on "plastic housewares namely furniture, particularly: chairs, benches, tables, stools, cabinets, shelves, drawers, frames, cases" under Class 20 and "plastic housewares namely household and kitchen utensils made of plastic particularly containers, bins, boxes, trays, baskets made of plastic" under Class 21 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"4. The registration of the mark JOLLY 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, which prohibit the registration of a mark that:

x x x

"5. In determining whether a mark is internationally well-known, Rule 102 of the Implementing Rules and Regulations on Trademarks, Service Marks, Tradenames and Marked or Stamped Containers provides that the following criteria may be taken into consideration:

x x x

"6. The Trademark Regulations do not require that all of the criteria mentioned above be met before a mark can be considered well known. It expressly states that 'any combination' of the above criteria may be used. Indeed, in *Sehwani, Incorporated and/or Benita's Frites, Inc. vs. In-N-Out Burger, Inc.*, the Supreme Court

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

² A domestic corporation with principal office address at 12 Banaybanay, Cabuyao, Laguna, Philippines.

³ The 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.

upheld the decision of the Director of the Bureau of Legal Affairs ('BLA') finding 'IN-N-Out' a well-known mark merely on the basis of: (1) a handful of foreign trademark registration for the 'In-N-Out' trademark; and (2) evidence of the advertising activities for the 'In-N-Out' trademark. Please note that none of the registrations or advertising presented in the 'In-N-Out' case occurred in the Philippines.

"7. As the only Supreme Court case applying Rule 102 of the Trademark Regulations, the 'In-N-Out' case sets the benchmark for which all other marks vying for well-known mark status should be judged. The decision sets a judicial precedent that must be followed in the absence of strong and compelling reasons to deviate from this sacred rule.

x x x

"8. As will be shown hereunder, Opposer's JOLLIBEE mark significantly exceeds the benchmark set in the 'In-N-Out' case and is therefore entitled to be officially recognized as a well-known mark.

"9. The JOLLIBEE mark was first used in the Philippines on 26 January 1978 for quick-service restaurants serving food and beverages. After thirty-four (34) continuous years in business, there are now about 765 JOLLIBEE restaurants in the Philippines alone. There are now 87 JOLLIBEE restaurants abroad located in the United States of America, Hong Kong, Brunei, Vietnam, Jeddah, Qatar and Kuwait. In total, there are more than 850 JOLLIBEE restaurants worldwide serving an estimate of more than 2 million customers on a daily basis. The patronage for the JOLLIBEE products is so strong that Filipinos, especially overseas, always form long lines to welcome every store opening. Just an example, a video of the opening of Opposer's store in New York, USA can be viewed on YouTube and it shows that long lines and excitement of customers waiting to enjoy Opposer's food and services. Comments therein refer to lines 'going for blocks' long after the store opened.

"10. Following are some of the highlights in the Opposer's history:

x x x

"11. On 10 October 2012, Opposer hosted the delegates of the Follow-up Session to the WIPO-Sweden Advanced Training Course on Industrial Property in the Global Economy from Asia, Africa, Europe and Latin America, at the request of the IPO. This event is a testament as to how the Company has successfully leveraged the use of its intellectual property rights to gain business competitive advantage not only in the Philippines but also internationally. A group photo from the said event is shown below:

x x x

"12. It is worth emphasizing that Opposer has continuously used the JOLLIBEE Trademarks in each Jollibee outlet and in almost all product packaging, advertising and promotional materials. Its products and services can also be viewed online through its website www.jollibee.com.ph where the JOLLIBEE Trademarks are prominently featured. This shows that the JOLLIBEE mark and the other JOLLIBEE Trademarks have been used and promoted for a long time, and that such use and promotion are extensive and cover a wide geographical area.

"13. It should also be noted that building brand awareness and identity has been central to Opposer's business from its early years. Opposer has invested more than PHP 1 Billion for advertising and promotions for each of the years 2010 and 2011. Over

the years, this investment has won recognitions and awards as it produced some of the most memorable images in Philippine advertising history, featuring now famous terms such as 'Langhap-Sarap' and products such as the iconic 'CHICKENJOY' and 'YUMBURGER'. Among the celebrities that have endorsed the JOLLIBEE restaurant and its products are Aga Muhlach, Sarah Geronimo, Sam Milby, Gerald Anderson, Kim Chiu, Mark Bautista, Enchong Dee, Sam Concepcion, and most recently, Jessica Sanchez, who were featured in equally popular television and print advertisements. Some of the older advertisements continue to be patronized on internet sites such as YouTube (www.youtube.com) where they have thousands of 'hits' from viewers.

"14. Opposer invests just as much, if not more, in making sure that it produces and renders only the best quality products and services. This attention to quality has resulted in Opposer being among one of the most recognized and respected businesses in the country. Among the local and international awards received by Opposer are identified below:

x x x

"15. No less than President Benigno Aquino III, during the opening ceremony for the Opposer's 700th Jollibee store in the Philippines, has praised Opposer for its contributions to and role in our nation. In his speech, the President noted how Jollibee stores served as their landmarks during the presidential campaign period to show them where they are, attesting to the extensive network of Jollibee outlets nationwide. A video of the President's speech can be viewed online with the following description:

x x x

"16. Without a doubt, Opposer's long, continuous and extensive use, promotion and advertising of its JOLLIBEE Trademarks have created a brand that is so popular throughout the Philippines and around the world that a mere mention of the words 'JOLLIBEE' and 'JOLLY' or a mere look at the words 'JOLLIBEE' and 'JOLLY' would immediately cause the consuming public to associate the same with Opposer and its restaurants and other related products and services.

"17. The renown attributable to Opposer and its JOLLIBEE Trademarks are well-documented. Various articles from the WIPO publication, 'In Good Company: Managing Intellectual Property Issues in Franchising', International Law News of the American Bar Association, Yahoo! Travel, Yahoo! News, The Philippine Star, GMA News, CNN Money, The New York Times, Los Angeles Times, BusinessWorld Online, and various blogs from different parts of the world attesting to the renown and well-known status of Opposer and its JOLLIBEE Trademarks worldwide, particularly in the United States of America, Brunei, United Arab Emirates, China, Qatar, Kuwait, Vietnam, Hong Kong, and Singapore have been published. Reproduced below is a portion of the article from Yahoo! Travel entitled 'Best fast-food chains in the world':

x x x

"18. In the Philippines, the JOLLIBEE trademarks have been registered by Opposer with the Intellectual Property Office. In total, Opposer owns seventy-five (75) registrations and has five (5) pending applications for the JOLLIBEE Trademarks, among other related marks. The details of some of these marks are, as follows:

x x x

"19. Internationally, the JOLLIBEE Trademarks have also been registered and applied for registration by Opposer. In total, Opposer owns 202 registrations and has 100

pending applications for the JOLLIBEE Trademarks abroad, among others. The details of some of these marks are, as follows:

x x x

"20. Opposer has invested heavily not only in registering its trademarks but also in enforcing its intellectual property rights. Opposer has achieved notable successes, including one against a mark that appropriated the 'JOLLY' element in the case entitled Jollibee Foods Corporation vs. Atlas Publishing Company, Inc. (IPC No. 14-2006-00113). This is a trademark opposition case decided on 25 February 2007 against the mark JOLLY KID covering goods under Class 16. In this case, the Honorable Office already recognized the well-known status of the JOLLIBEE Trademarks and stated that:

x x x

"21. In sum, the foregoing conclusively shows that JOLLIBEE is a well-known mark. Not only has it met the standard set in the 'In-N-Out' case, i.e. foreign trademark registrations and advertisements, the evidence presented shows that the JOLLIBEE mark has exceeded this standard, having been registered, used and promoted extensively in the Philippines and abroad. Equally noteworthy is the degree of recognition and brand value attributable to the JOLLIBEE name and mark, as evidenced by the numerous third-party publications and awards recognizing the brand's success. Lastly, this Honorable Office itself in Jollibee Foods Corporation vs. Atlas Publishing Company Inc. has already recognized the well-known mark status of the JOLLIBEE mark and this judgment is further reinforced by the evidence submitted with this opposition.

"22. The JOLLIBEE Trademarks are arbitrary trademarks used on Opposer's goods and services. The terms 'JOLLY' and 'JOLLI' as attached to various products and services in the food industry are unique and very much associated with the Opposer. It is therefore surprising that notwithstanding a boundless choice of words, phrases and symbols, Respondent-Applicant has chosen a mark that closely resembles Opposer's JOLLIBEE Trademarks for use on similar and related goods. In the absence of a plausible explanation from Respondent-Applicant as to how this happened, it is only logical to conclude that Respondent-Applicant deliberately appropriated the similar mark JOLLY to trade on the already established goodwill of the JOLLIBEE Trademarks. As stated by the Supreme Court:

x x x

"23. Respondent-Applicant's mark JOLLY is confusingly similar to Opposer's well-known JOLLIBEE Trademarks, as shown below:

x x x

"23.1. Respondent-Applicant's mark JOLLY is confusingly similar to Opposer's JOLLIBEE trademark owing to the identity of the first two (2) syllables, i.e. JOL-LY vis-à-vis JOL-LI. In McDonald's Corporation vs. Macjoy Fastfood Corporation, where the MACJOY & DEVICE mark was held to be confusingly similar to the McDonald's marks, the Supreme Court held:

x x x

"23.2. The dominant word element 'JOLLY' in Respondent-Applicant's mark is identical in appearance, spelling, pronunciation and meaning to Opposer's prior and subsisting registrations for the marks JOLLY SHAKES, JOLLY KRUNCHY TWIRL, JOLLY CRISPY FRIES, JOLLY CHEEZY FRIES, JOLLY 'ZERTS, and JOLLY HOTDOG.

"23.3. Aside from the identity of the letters and syllables in Respondent-Applicant's mark and Opposer's marks, the color schemes of the marks as being used or as will be used are also similar, with red being the predominant color, as shown below:

x x x

"23.4. The likelihood of confusion is further enhanced since Respondent-Applicant seeks to register the mark JOLLY for the goods 'plastic housewares namely furniture, particularly: chairs, benches, tables, stools, cabinets, shelves, drawers, frames, cases' in Class 20 and 'plastic housewares namely household and kitchen utensils made of plastic particularly containers, bins, boxes, trays, baskets made of plastic' in Class 21. These goods are the same as and directly competing with the goods 'furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics' in Class 20 and 'household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes' in Class 21, among others, covered by Opposer's subsisting registration for the mark JOLLIBEE under Certificate of Registration No. 4-2005-007558.

"23.5. Moreover, the goods covered by Respondent-Applicant's mark are also related to the goods and services covered by Opposer's other existing JOLLIBEE Trademarks, as well as to the business of Opposer, i.e. quick-service restaurants using plastic housewares, including plastic chairs, benches, tables, stools, utensils, containers, trays, etc. Opposer, as the registered owner, is protected not only for the goods and services covered by its registrations but also for those goods, like Respondent-Applicant's goods, that are within the normal potential expansion of its business. Thus, the Supreme Court has held that:

x x x

"24. It is further well-settled that exact duplication of the mark is not necessary for the likelihood of public confusion to occur. As noted in Del Monte Corporation and Philippine Packing Corporation vs. Court of Appeals and Sunshine Sauce Manufacturing Industries:

x x x

"25. 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 and services 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.

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

"27. The confusing similarity of Respondent-Applicant's mark JOLLY with Opposer's JOLLIBEE 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 the JOLLIBEE Trademarks. Hence, the registration of Respondent-Applicant's mark will be contrary to Section 123.1 (d) of the IP Code.

"28. Being the owner of the internationally well-known and registered JOLLIBEE Trademarks. Opposer is likewise entitled to protection against marks of third parties that are liable to create confusion in the minds of the public or used in bad faith under Article 6bis of the Paris Convention for the Protection of Industrial Property, thus:

x x x

"29. Respondent-Applicant's use of the mark JOLLY on 'plastic housewares namely furniture, particularly: chairs, benches, tables, stools, cabinets, shelves, drawers, frames, cases' in Class 20 and 'plastic housewares namely household and kitchen utensils made of plastic particularly containers, bins, boxes, trays, baskets made of plastic' in Class 21, which are the same as, related to and within the normal potential expansion of business of Opposer, will mislead the purchasing public into believing that Respondent-Applicant's goods are produced by, originate from, or are under the sponsorship of 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 put on the market by the Respondent-Applicant under the mark JOLLY.

"30. Moreover, the use by Respondent-Applicant of the mark JOLLY in relation to goods which are similar and/or closely related to Opposer's goods and services for which the JOLLIBEE Trademarks are used and known for will take unfair advantage of, dilute the goodwill, and diminish the distinctive character or reputation of Opposer's JOLLIBEE Trademarks.

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

x x x

"32. Opposer's use of the JOLLIBEE Trademarks in relation to goods and services in the food industry is unique and distinctive. Respondent-Applicant's use of JOLLY in relation to similar and related goods in Classes 20 and 21 will indubitably detract from this uniqueness and, ultimately, diminish the ability of the JOLLIBEE Trademarks to distinguish Opposer's goods and services from those of other businesses.

"33. 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

"34. Moreover, considering the substantial investment incurred by Opposer in promoting its goods and services and in identifying itself throughout the world using the JOLLIBEE Trademarks, Respondent-Applicant's attempt to register a mark similar to Opposer's and in exploiting the same can only result in Respondent-Applicant unduly enriching himself at the expense of Opposer.

"35. The foregoing discussion indubitably shows that Respondent-Applicant has no right whatsoever to register the confusingly similar mark JOLLY in his name for

being violative of Opposer's long vested right to the registered and world-famous JOLLIBEE Trademarks. The subject application should therefore be denied in accordance with the provisions of the IP Code, as well as the Paris Convention.

The Opposer's evidence consists of the verified notice of opposition; copy of Decision dated 25 February 2007 in Jollibee Foods Corporation vs. Atlas Publishing Company Inc., IPC No. 14-2006-00113; the affidavit of Atty. Gonzalo D.V. Go III; representative samples of Philippine registrations for the JOLLIBEE mark and other related JOLLIBEE and JOLLY trademarks; representative samples of food packaging and containers bearing the JOLLIBEE Trademarks; screen shots of Opposer's website, www.Jollibee.com.ph featuring various JOLLIBEE items and food products, 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 JOLLIBEE Trademarks; table showing the details of Opposer's applications and registrations for the JOLLIBEE Trademarks worldwide; representative samples of registrations and applications for the JOLLIBEE Trademarks from different countries worldwide; various articles and blogs from different parts of the world attesting to the renown and well-known status of Opposer and its JOLLIBEE Trademarks worldwide; Opposer's coffee table book entitled 'A 25-Year Love Story with the Pinoy'; Opposer's Power Point presentation shown to the participants of the Follow-up Session to the WIPO-Sweden Advanced Training Course on Industrial Property in the Global Economy during their visit to Opposer's establishment on 10 October 2012, and photographs taken during the said visit; Opposer's 2002-2011 Annual Reports; list of awards received by Opposer from the Wall Street Journal, FinanceAsia.com, Euromoney, Far Eastern Economic Review, AsiaMoney, Ernst & Young, and Forbes Asia, among others, from the years 1981 to 2008; 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 certification of non-forum shopping on behalf of Opposer; and secretary's certificate executed by William Tan Untiong.⁴

This Bureau issued a Notice to Answer and sent a copy thereof upon Respondent-Applicant on 28 February 2013. The Respondent-Applicant filed their Answer on 16 May 2013 and avers the following:

x x x

SPECIAL AND AFFIRMATIVE DEFENSES

"28. Opposer has no valid cause of action against the respondent.

"29. The word JOLLY in respondent's JOLLY & DEVICE was adopted because of its meaning, i.e. 'cheerful', 'merry' or 'happy' which is a pleasing mark

⁴ Marked as Exhibits "A" to "Y".

or name for goods and for business. On the other hand, the logo or the device in the JOLLY & DEVICE trademark which is a representation of four colors revolving around a diamond design symbolizes wealth and dynamic and colorful life.

"30. Contrary to opposer's claim, the JOLLY & DEVICE trademark of the respondent is visually, aurally and conceptually different from the JOLLIBEE or any of the JOLLIBEE trademarks of the opposer. The trademark JOLLY & DEVICE trademark of the respondent is a composite mark consisting of the word JOLLY which is a common dictionary term and a very distinctive DEVICE of four colors (red, green, blue and orange) revolving around a diamond design. This combination makes respondent's trademark, as a whole, not confusingly similar with the JOLLIBEE and various JOLLY trademarks of the opposer.

"31. Respondent's products for which the trademark JOLLY & DEVICE is used are plastic house wares and furniture. On the other hand, opposer's JOLLIBEE trademarks are used for food products. The fact that respondent and opposer's products are far from being related makes respondent's JOLLY & DEVICE mark not confusingly similar with the JOLLIBEE trademarks.

"32. Moreover, opposer is engaged in food and fast food restaurants business while respondent is engaged in the manufacture and sale of plastic house wares and furniture a line of business that is far from being related to the business of the opposer. This factor is sufficient to prove that likelihood of confusion between the parties' products, trademarks and business would not exist.

"33. The registration of the JOLLIBEE trademark in favor of the opposer does not vest in its favor the exclusive right to prevent others, like the herein respondent, who is engaged in different trade and goods from using the word JOLLY as a trademark or part of a trademark. No less than this Honorable Office has recognized the rights of other parties to use and register the mark JOLLY as a trademark or part of a trademark even for goods that are closely related to the goods of the opposer. The records of the Intellectual Property Office readily show that different parties have registered JOLLY as a trademark or as part of their trademark for the same class or closely related goods. To name a few: Fly Ace Corporation has registered the mark JOLLY Spreads and Sandwich Design ('Spreads' & 'Sandwich design' are disclaimed) in Class 29 for bottled packed spreads under Reg. No. 4-2005-009938 on April 14, 2008; JOLLY Pure Goodness & Design ('Pure Goodness' is disclaimed) in Class 29 for canned goods, namely: fruit cocktail and tropical fruit cocktail with guava under Reg. No. 4-2005-002871 on November 14, 2008; JOLLY COW & Device ('COW' & 'Rep. of Cow' are disclaimed) in Class 29 for dairy products, fresh milk products in can and boxes under Reg. No. 4-2009-005014 on December 16, 2010; JOLLY Pure Goodness Heart Mate & Design ('Pure Goodness' is disclaimed) in Class 29 for edible oil, under Reg. No. 4-2009-011061 on September 9, 2010; Dynamix, Inc. has registered the mark JOLLY PONG in Class 30 for wheat based snack food, under Reg. No. 4-2010-004667 on October 28, 2010; Crown Prime Asia Corporation has registered the mark JOLLY Ole Chef with Chef Illustration in Class 30 for cornstarch, all purpose flour and breading mix under Reg. No. 4-2009-10931 on May 19, 2011; Huhtamaki Finance B.V. has registered the mark JOLLY RANCHER in Class 30 for Candy, cookies, chewing gum, under Reg. No. 4-2007-010168 on February 11, 2008. Copies of the above-mentioned trademark registrations are attached to the Affidavit of the lone witness of the respondent.

"34. If the Honorable Office allowed the above-mentioned trademark registrations for foods to exist among themselves and with the JOLLIBEE and various JOLLY trademarks of the opposer then with more reason that respondent's JOLLY & DEVICE trademark, which is used for plastic wares and furniture, be allowed to be registered and to co-exist with the JOLLIBEE, various JOLLY trademarks and the above-mentioned trademark registrations.

"35. The registrability of respondent's JOLLY & DEVICE trademark 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 JOLLIBEE and various JOLLY (in combination with other elements) trademarks of the opposer. As a matter of fact, none of the aforesaid trademark registrations of the opposer and of the other parties was cited by the Bureau of Trademarks during the substantive/merit examination of the JOLLY & DEVICE trademark application of the respondent.

"36. The mark JOLLY & DEVICE has been used in the market as early as year 2000 through Jolly Plastic Molding Corporation, a corporation for which the respondent is currently the President and major stock holder. From the time the JOLLY & DEVICE trademark was used in year 2000 or for more than 12 years already respondent and the said corporation never received any single complaint from the consuming public showing that respondent's JOLLY & DEVICE trademark was mistaken to be the trademark of the opposer. It is also noticeable that opposer, despite its voluminous documentary exhibits and long allegations in the notice of opposition, failed to present or cite any incident of actual or perceived confusion as to the source or ownership of the JOLLY & DEVICE trademark of the respondent. These only prove that the alleged confusing similarity between the respondent's JOLLY & DEVICE trademark and the JOLLIBEE trademarks of the opposer's is more of an imagination than for real.

"37, Even assuming that JOLLIBEE is considered a well-known trademark this will not prevent respondent from using and registering the mark JOLLY & DEVICE for the same reason that JOLLIBEE is not confusingly similar to the said trademark of the respondent.

"38. With all the foregoing, it can be said that the filing of the instant Notice of Opposition is without factual and legal bases and can be considered an abuse in the exercise of intellectual property rights on the part of the opposer to the prejudice and damage of the respondent.

The Respondent-Applicant's evidence consists of the Affidavit of Esteve C. Chua; copies of Articles of Incorporation and By-Laws of Jolly Plastic Molding Corporation; copy of 2012 General Information Sheet (GIS) of Jolly Plastic Molding Corporation submitted with the SEC; list of items bearing the JOLLY & DEVICE trademark; samples of actual product labels bearing the trademark JOLLY & DEIVCE trademarks; product brochure showing pictures of different plastic wares and furniture bearing the trademark JOLLY & DEVICE; list of Distributors/Sellers of JOLLY & DEVICE brand of plastic wares and furniture; representative samples of actual invoices showing sale of

the JOLLY & DEVICE brand of plastic wares and furniture; and copies of certificate of registrations of JOLLY trademarks in the name of different parties.⁵

On 27 February 2014, the Preliminary Conference was terminated. Then after, the Opposer and Respondent-Applicant filed their respective position paper on 19 August 2014 and 10 March 2014, respectively.

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

The Opposer anchors its opposition on the following provisions of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"):

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.

⁵ Marked as Exhibits "1" to "5".

Hence, the question, does JOLLY & DEVICE resemble JOLLIBEE Trademark/s such that confusion or deception is likely to occur? The marks are shown below:

JOLLIBEE



Opposer's trademark

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. However, apart from the letters J, O, L, and L, there are other essential features in the Respondent-Applicant's mark consisting of revolving drops/splash around a crystal design before the word JOLLY. Both marks are similar only in the use of the letters J,O,L,L, 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 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"

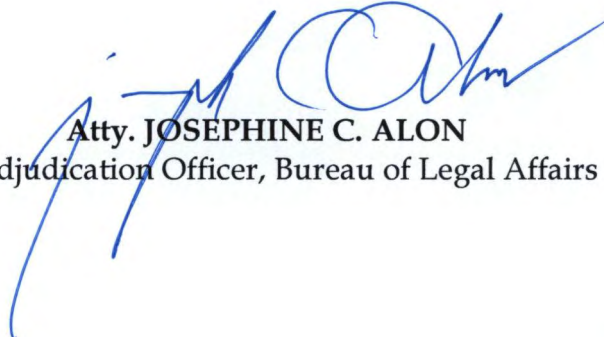
⁶ Decision No. 2007-143.

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. 4-2011-009482 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 07 MAR 2017.



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.