

JOLLIBEE FOODS CORPORATION,
Opposer,

-versus-

SPLASH FOODS CORPORATION,
Respondent-Applicant.

X-----X

IPC No. 14-2013-00023
Opposition to:
Appln. Serial No. 4-2012-009685
Date Filed: 06 August 2012

TM: CHEF KIKO CRISPY JOY

NOTICE OF DECISION

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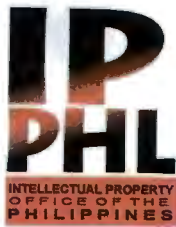
GREETINGS:

Please be informed that Decision No. 2017 - 162 dated 22 May 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPPL 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, 22 May 2017.


MARIYLN F. RETUAL
IPRS IV
Bureau of Legal Affairs



JOLLIBEE FOODS CORPORATION, }
Opposer, }
 -versus- }
 SPLASH FOODS CORPORATION, }
Respondent-Applicant. }
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IPC No. 14-2013-00023
 Opposition to:
 Application No. 4-2012-009685
 Date Filed: 06 August 2012
 Trademark: "CHEF KIKO
 CRISPY JOY"
 Decision No. 2017- 162

DECISION

JOLLIBEE FOODS CORPORATION¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-009685. The application, filed by Splash Foods Corporation² ("Respondent-Applicant"), covers the mark "CHEF KIKO CRISPY JOY" for use on "breading mixes for pork, chicken, fish and seafoods" under Class 30 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"1. Opposer respectfully comes before the Honorable Office to ask for the rejection of the application for the mark CHEF KIKO CRISPY JOY sought to be registered by Respondent-Applicant for being confusingly similar to Opposer's registered mark CHICKENJOY, as well as its other trademarks CRISPYLICIOUS and JOLLY CRISPY FRIES.

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

x x x

"3. The registration of the mark CHEF KIKO CRISPY JOY 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 mark that:

x x x

"4. The registration of the mark CHEF KIKO CRISPY JOY would violate Opposer's property right to the goodwill attached to its business, products and services using the marks CHICKENJOY, CRISPYLICIOUS and JOLLY CRISPY FRIES. This

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

²With address on record at 5F W Building, Bonifacio Global City, Taguig City, 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.

goodwill is a property right expressly protected under, among others, Section 168 of the IP Code.

"5. Opposer has been in existence for nearly four (4) decades and operates the very popular chain of quick-service restaurants called JOLLIBEE that are found all over the Philippines and in at least seven (7) other countries. Throughout the years, Opposer has continuously used the JOLLIBEE name and marks in each Jollibee outlet and in almost all product packaging, advertising and promotional materials. 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.

"6. One of Opposer's most iconic products is its CHICKENJOY fried chicken. This product, which has been in Opposer's store offerings since as early as 1985 and is available in all of its 765 JOLLIBEE restaurants in the Philippines and 87 restaurants abroad, is branded in Opposer's advertising, packaging and store materials as CRISPYLICIOUS. Most recently, American Idol finalist Jessica Sanchez promoted Opposer's CRISPYLICIOUS CHICKENJOY in extensive advertisements all over the country.

"7. Meanwhile, Opposer's French fries are branded as JOLLY CRISPY FRIES.

"8. CHICKENJOY, CRISPYLICIOUS and JOLLY CRISPY FRIES are all registered marks owned by Opposer and/or have earlier filing dates than Respondent-Applicant's mark. The details of some of Opposer's marks registered or applied for registration with the Philippine Intellectual Property Office appear below:

x x x

"9. Respondent-Applicant's mark CHEK KIKO CRISPY JOY is confusingly similar to Opposer's well-known mark CHICKENJOY, as well as its marks CRISPYLICIOUS and JOLLY CRISPY FRIES.

"9.1. The word 'JOY' is identical to the dominant element in Opposer's well-known mark CHICKENJOY. The correlation between 'JOY' and fried chicken (or food products and services in general) is distinctive and highly identified with the Opposer. Moreover, 'JOY' echoes Opposer's company image of being jolly or joyful (hence the name JOLLIBEE).


"9.2. 'JOY' is the dominant and fanciful element in Respondent-Applicant's mark. It is also the only distinctive element therein (barring the additional 'CHEF KIKO' element which, as will be shown below, was added as an afterthought to try to mask the confusing similarity between the marks and should not be considered). The word 'CRISPY' in Respondent-Applicant's mark was disclaimed for being descriptive of the intended purpose of the goods covered by the opposed mark, i.e., 'breeding mixes for pork, chicken, fish and seafoods'. Being descriptive, it has little value, apart from the mark as a whole.

"9.3. The similarity between the marks creates the risk of public confusion, especially since the goods covered by both marks are similar and related. The Opposer's CHICKENJOY mark is registered for 'fried chicken' in class 29 while the Respondent-Applicant's mark covers 'breeding mixes for pork, chicken, fish and seafoods' in class 30. Purchasers could easily assume that

Respondent-Applicant's breading mixes sold under the name 'CRISPY JOY' is an extension of Opposer's CHICKENJOY products. It is worth emphasizing that Opposer's CHICKENJOY products also uses the mark CRISPYLICIOUS, so it seems like Respondent-Applicant's CRISPY JOY breading mixes for chicken (among others) is somehow related to Opposer's CRISPYLICIOUS CHICKENJOY fried chicken.

"9.4. The presence of other elements in Respondent-Applicant's mark does not remove the confusing similarity between the marks. In Berris Agricultural Co., Inc. vs. Abdayang, the Supreme Court found Berris mark 'D 10 80 WP' confusingly similar with Abdayang's mark 'NS D-10 PLUS'. It stated:

x x x

"10. It is likewise noteworthy that Respondent-Applicant has an earlier application for the word mark 'CRISPY JOY' filed on 7 March 2012 under Application No. 4-2012-002822. Opposer likewise filed an opposition against said mark and the opposition is currently pending. During the extended period to file the opposition documents, the application for 'CHEF KIKO CRISPY JOY' subject of the instant opposition was filed by Respondent-Applicant on 6 August 2012. Thereafter, on 5 October 2012, Respondent-Applicant filed another related application for the composite mark  (CHEF KIKO CRISPY JOY ALL PURPOSE BREADING MIX) under Application NO. 4-2012-012336. In this later application, the 'CHEF KIKO' element is barely noticeable and the dominant feature is clearly the phrase 'CRISPY JOY'.

"11. By filing these later applications, Respondent-Applicant is obviously attempting to thwart trademark rules and authorities by adding the 'CHEF KIKO' element and by filing the same as a word mark and as a composite mark in two separate trademark applications. However the prior application for CRISPY JOY and the design of the composite mark betrays its real intention to capitalize on the CRISPY JOY element. This is not only contrary to the letter of the IP Code but also, and perhaps more importantly, to its spirit of protecting legitimate IP-rights owners against abuse by competitors seeking to unfairly capitalize on the IP-right owner's success and goodwill. Simply put, one cannot simply add new elements to an otherwise confusingly similar mark in order to obtain registration, especially when the purported use of the mark will emphasize the similar elements, as shown below.

x x x

"12. Taking Respondent-Applicant's three applications collectively, there is no doubt that these applications were all filed in bad faith and with the intention of infringing Opposer's trademark rights.

"13. As noted in Del Monte Corporation and Philippine Packing Corporation vs. Court of Appeals and Sunshine Sauce Manufacturing Industries:

x x x

"14. It is surprising that notwithstanding a boundless choice of words, phrases and symbols, Respondent-Applicant has adopted the identical elements 'CRISPY' and 'JOY' for 'breading mixes for pork, chicken, fish and seafoods' when these words are so highly associated with Opposer's CHICKENJOY fried chicken. As a Philippine corporation and one that is engaged in the food industry, Respondent-Applicant must be aware of the existence, prior use, and registration in the Philippines,

the international renown, and goodwill of Opposer's marks - particularly the CHICKENJOY mark - and the fact that CHICKENJOY is used alongside the mark CRISPYLICIOUS. By appropriating the phrase CRISPY JOY in its mark, one can only conclude that it did so to unfairly trade on the fame attached to Opposer's marks and products.

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

"16. 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.

"17. Opposer has not consented to Respondent-Applicant's use and registration of the similar mark CHEF KIKO CRISPY JOY, or any other mark identical or similar to its marks CHICKENJOY, CRISPYLICIOUS, and JOLLY CRISPY FRIES.

"18. Opposer has used the marks CHICKENJOY, CRISPYLICIOUS and JOLLY CRISPY FRIES in the Philippines and elsewhere prior to the filing date of the application subject of this opposition. In the Philippines, Opposer first used the mark CHICKEN JOY as early as 5 December 1985, the mark CRISPYLICIOUS as early as 31 December 2005, and the mark JOLLY CRISPY FRIES as early as 1 June 2004. To date, Opposer continues to use these trademarks throughout the Philippines, as well as abroad.

"19. The confusing similarity between Respondent-Applicant's mark CHEK AND CRISPY JOY and Opposer's marks CHICKENJOYU, CRISPYLICIOUS and JOLLY CRISPY FRIES 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 CHICKENJOY, CRISPYLICIOUS and JOLLY CRISPY FRIES. Hence, the registration of Respondent-Applicant's mark will be contrary to Section 123.1 (d) of the IP Code. Moreover, the registration of Respondent-Applicant's mark CHEK KIKO CRISPY JOY would unduly curtail Opposer's zone of potential business expansion which is supposed to be protected by virtue of its existing trademark registrations.

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

x x x

"21. The Trademark Regulations do not require that all of the criteria mentioned above be met before a mark can be considered as 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 upheld the decision of the Director of Bureau of Legal Affairs ('BLA') finding 'In-N-Out' a well-known mark merely on the basis of: (1) a handful of foreign trademark registrations for the 'In-N-Out' trademark; and (2) evidence of the advertising activities for the 'In-N-Out' trademarks. It is noteworthy that none of the registrations or advertising presented in the 'In-N-Out' case occurred in the Philippines.

"22. 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

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

"24. The mark CHICKENJOY has been registered and/or applied for registration by Opposer in various trademark registries worldwide such as Bahrain, Brunei Darussalam, Cambodia, Canada, Indonesia, Italy, South Korea, Kuwait, Malaysia, Oman, Qatar, Saudi Arabia, Singapore, Spain, Turkey, United Arab Emirates, United States of America, and Vietnam in connection with goods under Class 29 and services under Class 43.

"25. Opposer has extensively promoted the mark CHICKENJOY in the Philippines and around the world. Over the years, Opposer has obtained significant exposure for the products and services upon which the mark CHICKENJOY is used in various media, including television commercials, outdoor advertisements, internationally well-known print publications, and other promotional events. Its products and services can also be viewed online through its website www.jollibee.com.ph where the mark CHICKENJOY is prominently featured. This shows that the mark CHICKENJOY 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.

"26. To date, products and services bearing the mark CHICKENJOY are sold and rendered in 765 JOLLIBEE restaurants in the Philippines and 87 JOLLIBEE restaurants abroad located in United States of America, Hong Kong, Brunei, Vietnam, Jeddah, Qatar and Kuwait.

"27. Through Opposer's long, continuous and extensive use, promotion and advertising of its mark CHICKENJOY, the same has become so popular throughout the Philippines and around the world such that a mere mention of the word 'CHICKENJOY' would immediately cause the consuming public to associate the same with Opposer, its restaurants, and its CRISPYLICIOUS fried chicken. Thus, Respondent-Applicant's use of the confusingly similar mark CHEF KIKO CRISPY JOY would cause purchasers to believe that the goods offered by Respondent-Applicant emanate from or are sponsored by Opposer.

"28. Indeed, Opposer's mark CHICKENJOY is well-known and world-famous. Hence, the registration of Respondent-Applicant's confusingly similar mark CHEK KIKO CRISPY JOY will also violate Sections 123.1 (e) and 123.1 (f) of the IP Code.

"29. Being the owner of the internationally well-known mark CHICKENJOY, 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

"30. Respondent-Applicant's use of the mark CHEF KIKO CRISPY JOY on 'breeding mixes for pork, chicken, fish and seafoods' in Class 30, which are related to the goods and services of Opposer under the mark CHICKENJOY, will mislead the purchasing public into believing that Respondent-Applicant's goods 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 confusingly similar mark CHEF KIKO CRISPY JOY.

"31. Moreover, the use by Respondent-Applicant of the mark CHEF KIKO CRISPY JOY in relation to goods which are similar and/or closely related to Opposer's goods and services for which the mark CHICKENJOY is used will take unfair advantage of, dilute the goodwill, and diminish the distinctive character or reputation of Opposer's well-known mark CHICKENJOY.

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

x x x

"33. Opposer's use of the CHICKENJOY in relation to goods and services under Classes 29 and 43, as well as on related goods and services, is unique and distinctive. Respondent-Applicant's use of the confusingly similar mark CHEF KIKO CRISPY JOY in relation to similar and related goods in Class 30 indubitably detract from this uniqueness and, ultimately, diminish the ability of the mark CHICKENJOY to distinguish Opposer's goods and services from that of other business entities.

"34. Opposer's goodwill on its mark CHICKENJOY 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

"35. Moreover, considering the substantial investment incurred by Opposer in promoting its goods and services and in identifying itself throughout the world through its mark CHICKENJOY, 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.

"36. 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 verified notice of opposition; the affidavit of Atty. Gonzalo D.V. Go III with its attachments, namely: Philippine Trademark Registration No. 4-2004-006569 for CHICKENJOY in Class 29, Philippine Trademark Registration No. 4-2012-004770 for CHICKENJOY in Class 43, Philippine Trademark Registration No. 4-2012-000563 for CRISPYLICIOUS in Class 29, Philippine Trademark Registration No. 4-2009-006965 for JOLLY CRISPY FRIES in Class 35, Philippine

Trademark Registration No. 4-2004-006392 for JOLLY CRISPY FRIES in Class 29, Philippine Trademark Registration No. 4-2009-006907 for JOLLY CRISPY FRIES BEST FRIENDS FRIES in Class 35, Philippine Trademark Registration No. 4-2009-006901 for JOLLIBEE BREAKFAST JOYS in Classes 29 and 35, Philippine Trademark Registration No. 4-2000-004772 for JOLLIBEE in Classes 29, 30, 32 and 42, Philippine Trademark Registration No. 4-2000-007421 for JOLLIBEE in Classes 16 and 28, Philippine Trademark Registration No. 4-2005-007558 for JOLLIBEE in Classes 9, 18, 20, 21, 24 and 25, Philippine Trademark Registration No. 4-2010-002055 for JOLLIBEE LOGO & DEVICE in Classes 29, 30 and 43, Philippine Trademark Registration No. 4-2011-003560 for JOLLIBEE IN TRAPEZOID AND BEE HEAD DEVICE in Class 43, Philippine Trademark Registration No. 4-2011-003561 for JOLLIBEE IN TRAPEZOID DEVICE in Class 43, Philippine Trademark Registration No. 4-2011-003613 for JOLLIBEE IN TRAPEZOID AND BEE HEAD DEVICE (IN COLOR) in Class 43, Philippine Trademark Registration No. 4-2011-003543 for JOLLIBEE IN TRAPEZOID DEVICE (IN COLOR) in Class 43, Philippine Trademark Registration No. 4-2009-006900 for JOLLIBEE CHAMP in Classes 29 and 35, Philippine Trademark Registration No. 4-2009-006905 for JOLLIBEE CHAMP BIG BURGER GOODNESS LIKE NO OTHER in Class 35, Philippine Trademark Registration No. 4-2010-004204 for JOLLIBEE CHICKEN BARBECUE INSIDE A RECTANGULAR DEVICE in Classes 29 and 35, Philippine Trademark Registration No. 4-2010-004233 for JOLLIBEE CHICKEN BARBECUE DELICIOUS INSIDE AND OUT INSIDE A RECTANGULAR DEVICE (IN COLOR) in Classes 29 and 35, Philippine Trademark Registration No. 4-2010-004234 for JOLLIBEE CHICKEN BARBECUE INSIDE A RECTANGULAR DEVICE (IN COLOR) in Classes 29 and 35, Philippine Trademark Registration No. 4-2010-004234 for JOLLIBEE CHICKEN BARBECUE DELICIOUS INSIDE A RECTANGULAR DEVICE (IN COLOR) in Classes 29 and 35, Philippine Trademark Registration No. 4-2010-004237 for JOLLIBEE CHICKEN BARBECUE DELICIOUS INSIDE AND OUT INSIDE A RECTANGULAR DEVICE in Classes 29 and 35, Philippine Trademark Registration No. 2003-008178 for JOLLIBEE YUMBURGER AND DEVICE in Classes 29 and 43, Philippine Trademark Registration No. 4-2005-002450 for JOLLIBEE SUPER MEALS in Class 43, representative samples of food packaging and containers bearing the marks CHICKENJOY, CRISPYLICIOUS, JOLLY CRISPY FRIES and other 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 marks CHICKENJOY, CRISPYLICIOUS, JOLLY CRISPY FRIES and other Jollibee trademarks, CD-ROM containing a copy of a television commercial for JOLLIBEE Spaghetti, CD-ROM containing a copy of television commercial JOLLITOWN, and showing the JOLLIBEE Mascot, Jollibee Flyer for "JOLLITOWN Christmas Bucket Treats", Jollibee Flyer for "Juice Up 'N Win a Mini", Jollibee Flyer for "Chicken Nugget Crunchers", Jollibee Flyer for "Grilled Pork Tenders", Jollibee Flyer for "Crunchy

Chicken Burger”, Jollibee Flyer for “Crisscut Fries”, Jollibee Flyer for “Bucket Treats”, Jollibee advertisements for “CHICKENJOY” featuring Sarah Geronimo, Advertisement for Jollibee products in the 14-20 October 2010 issue of the Las Vegas Asian Journal, Advertisement for Jollibee products in the 15 October 2010 issue of The Asian Journal SF Magazine, Advertisement for Jollibee products in the U.S.A., Advertisement for Jollibee CHICKENJOY in the 11 July 2012 issue of The Philippine Star, Advertisement for Jollibee’s 35th Anniversary celebration in the 14 January 2013 issue of Philippine Daily Inquirer, copies of registrations and application for the mark CHICKENJOY from Brunei, Brunei Darussalam, Cambodia, Canada, Indonesia, Italy, South Korea, Kuwait, Malaysia, Oman, Qatar, Saudi Arabia, Singapore, Spain, Turkey, United Arab Emirates, United States of America, and Vietnam, sample photographs of JOLLIBEE restaurants/branches; 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 and the authority of Quisumbing Torres to represent Opposer in this case; and secretary’s certificate executed by William Tan Untiong for this opposition case.⁴

This Bureau issued a Notice to Answer and sent a copy thereof upon Respondent-Applicant on 28 February 2013. The Respondent-Applicant filed its Answer on 29 May 2013 and avers the following:

x x x

“SPECIAL AND AFFIRMATIVE DEFENSES

“Respondent repleads and incorporates herein by reference, all the foregoing allegations insofar as they are material and relevant thereto, and in further support of the foregoing denials, pleads the following special and affirmative defenses:

“23. Opposer has no valid cause of action against the respondent.

“24. Opposer has no proprietary rights over the word/mark ‘CRISPY’ and/or ‘JOY’ for which the words CRISPY JOY in respondent’s CHEF KIKO CRISPY JOY trademark was derived because ‘CRISPY’ and/or ‘JOY’ and/or ‘CRISPY JOY’ are not registered trademarks of the opposer.

“25. The registrability of the respondent’s CHEF KIKO CRISPY JOY has been determined and resolved by no less that the Intellectual Property Office (IPO) when the latter, through the Bureau of Trademarks, allowed registration of the said trademark despite the existing CHICKENJOY, JOLLY CRISPY FRIES and CRISPYLICIOUS prior trademark registrations/application of the opposer. As a matter of fact, none of the aforesaid trademark registrations/application of the opposer was cited by the Bureau of Trademarks during the substantive/merit examination of the CHEF KIKO CRISPY JOY trademark application of the respondent.

⁴ Marked as Exhibits “A” to “J”, inclusive.

"26. Contrary to opposer's claim, the CHEF KIKO CRISPY JOY trademark of the respondent is visually, aurally and conceptually different from any of the CHICKENJOY, JOLLY CRISPY FRIES and CRISPYLICIOUS trademarks of the opposer. A side by side comparison between the contending marks of the parties will confirm this fact.

"27. The trademark CHICKENJOY is a single word mark, coined from the words CHICKEN and JOY. As a coined word mark, CHICKENJOY is distinctive as a whole. The distinctive character of CHICKENJOY as a whole is confirmed by the fact that the word CHICKEN in the CHICKENJOY trademark is not disclaimed in the certificate of registration of the trademark. On the other hand, respondent's CRISPY JOY in its CHEF KIKO CRISPY JOY trademark is clearly a combination of two separate words: CRISPY and JOY, each having a definite dictionary meaning.

"28. The registration of the CHICKENJOY trademark does not vest in favor of the opposer the right to prevent others from using JOY as a trademark or as part of the trademark. Since JOY is not the trademark of the opposer for fried chicken or for any goods under Class 30, respondent can freely use JOY in combination with the word CRISPY as its trademark or as part of its CHEF KIKO CRISPY JOY trademark for all purpose breading mix, a goods which is different from the fried chicken goods of the opposer.

"29. In like manner, opposer cannot question the use by respondent of the word CRISPY as part of the CRISPY JOY trademark since CRISPY is not a registered trademark of the opposer and it is incapable of exclusive use for being a descriptive mark.

"30. The trademark CRISPY JOY in respondent's CHEF KIKO CRISPY JOY was conceptualized and adopted in consideration of the kind or characteristics of the all purpose breading mix product that respondent will manufacture and sell and the perception or feeling that respondent wants to impress upon to the consumers. Thus, the trademark CRISPY JOY was adopted because respondent wants its all purpose breading mix when used will give the breaded food a crispy texture and taste making the customers/users feel the joy of frying and/or eating food breaded with the CHEF KIKO CRISPY JOY product of the respondent.

"31. It is therefore untrue and far from the mind of the respondent the claim of opposer that the mark CRISPY JOY was adopted by the respondent to ride on the alleged popularity and goodwill generated by the opposer's CHICKENJOY trademark.

"32. Opposer is engaged in fastfood restaurant business for almost 4 decades. Through out the said period JOLLIBEE food products, including CHICKENJOY fried chicken and JOLLY CRISPY FRIES, have been sold only at JOLLIBEE fastfood restaurants. For the same period of time, opposer never engaged in the manufacture and sale of other processed or packed food items for sale in groceries and retail outlets. On the other hand, the goods of the respondent bearing the CHEF KIKO CRISPY JOY trademark is a food ingredient prepared and processed differently and are sold in different channel of trade. These facts belie opposer's claim that the purchasing public will be misled into believing that respondent goods originate from or are under the sponsorship of the opposer and that the registration of the CHEF KIKO CRISPY JOY trademark will cause

substantial damage to the goodwill and reputation associated with the CHICKENJOY, CRISPYLICIOUS AND JOLLY CRISPY FRIES trademarks.

"33. The CHICKENJOY, CRISPYLICIOUS or the JOLLY CRISPY FRIES trademarks of the opposer were not in the mind of the respondent when the latter was choosing the trademark to be used for its all purpose breeding mix products. It is therefore preposterous for the opposer to claim that respondent is using the CRISPY JOY trademark in its CHEF KIKO CRISPY JOY ALL to ride on the alleged popularity and goodwill of the CHICKENJOY trademark. Moreover, opposer is not the proprietor of or the registered owner of the trademarks JOY and CRISPY for Class 30 goods. Its trademarks are CHICKENJOY, CRISPYLICIOUS, and JOLLY CRISPY FRIES. Opposer's use and registration of the trademarks CHICKENJOY, CRISPYLICIOUS and JOLLY CRISPY FRIES do not vest in its favor automatic ownership of the trademark JOY or CRISPY. And since the word JOY or CRISPY is not owned or registered by the opposer or by others, respondent has the right to appropriate and register the said words as its trademark, or part of its mark especially if it is used for goods that are different from the goods of the opposer.

"34. With all the foregoing, it can be said that the filing of the instant Notice of Opposition is an abuse in the exercise of intellectual property rights on the part of opposer to the prejudice and damage of the respondent.

The Respondent-Applicant's evidence consists of the Answer; the Secretary's Certificate/Board Resolution of Splash Foods Corporation and Special Power of Attorney; the Affidavit of Ms. Rhodette Y. Gamba, the Acting General Manager of Splash Foods Corporation; copy of the Certificate of Incorporation with Articles of Incorporation and Amended By-Laws of Splash Foods Corporation; copy of Certificate of License to Operate (LTO) as Food Distributor/Wholesaler issued by the Food and Drug Administration (FDA) to Splash Foods Corporation; copy of Certificate of Product Registration of the CRISPY JOY All Purpose Breeding Mix issued by the FDA; copy of Certificate of Trademark Reg. No. 4-2011-005661 for trademark CHEF KIKO; proposed packaging/product label showing the composite CHEF KIKO CRISPY JOY ALL PURPOSE BREADING MIX trademark; and copies of trademark application for the trademarks "CRISPY JOY", "CHEF KIKO CRISPY JOY" and "CHEF KIKO CRISPY JOY ALL PURPOSE BREADING MIX".⁵

On 24 September 2013, the Preliminary Conference was terminated. Then after, the Opposer and Respondent-Applicant filed their respective position paper on 04 October 2013.

Should the Respondent-Applicant be allowed to register the trademark CHEF KIKO CRISPY JOY?

⁵ Marked as Exhibits "1" to "9", inclusive.

Records show that Opposer filed its first JOLLIBEE trademark application in 1978 for the mark JOLLIBEE YUMBURGER under Application Serial No. 4-1978-403981. The application covered "hamburger sandwich" under Class 30. Thereafter, Opposer filed other JOLLIBEE trademark applications locally and in foreign countries covering goods in Classes 16, 18, 20, 21, 24, 27, 28, 29, 30 and 32 and services in Classes 35, 41, 42, 43 and 44.

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.

Hence, the question, does CHEF KIKO CRISPY JOY resemble JOLLIBEE Trademarks specifically CHICKENJOY, CRISPYLICIOUS and JOLLY CRISPY FRIES such that confusion or deception is likely to occur? The marks are shown below:

CHICKENJOY

CRISPYLICIOUS

JOLLY CRISPY FRIES

Opposer's trademarks

CHEF KIKO CRISPY JOY

Respondent-Applicant's mark

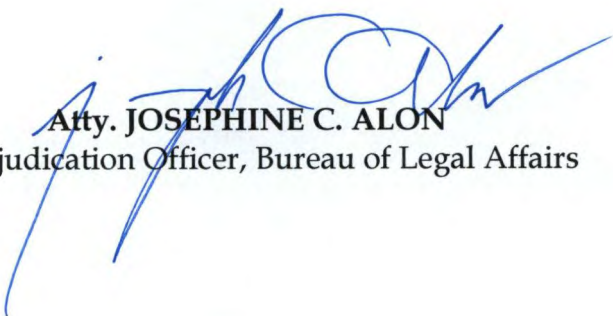
This Bureau finds that confusion or deception is unlikely to occur at this instance. Although both have similar food and/or food ingredient products and have the same words CRISPY and JOY, Opposer can not exclusively appropriate these words. In the Trademark Registry, the contents of which this Bureau can take cognizance of via judicial notice, there are registered marks covering goods under Class 30 that have the words CRISPY or JOY, such as Crispy Fry with Reg. No. 4200310792, Crispy with Reg. No. P-2016-502855, Crispy 6 with Reg. No. 4-2014-11746, Joy with Reg. No. 4-1978-403840, Joy Mixx with Reg. No. PH-M-O-1309526, Ice Cream Joy with Reg. No. 4-1992-427930 and Coco Joy with Reg. No. PH-M-0-1273723, which are owned by entities other than the Opposer. Hence, this Bureau cannot sustain the opposition solely on the ground that both marks contain the words CRISPY and JOY. To do so would have the unintended effect of giving the Opposer exclusive right over these words "JOY" and "CRISPY" for food and/or food ingredient products. To determine whether two marks that contain the words "CRISPY" and "JOY" are confusingly similar, there is a need to examine the other letters or components of the trademarks. In this regard, when the words CHEF KIKO are appended to the words "CRISPY" and "JOY", the resulting mark when pronounced can be distinguished from CHICKENJOY, CRISPYLICIOUS and JOLLY CRISPY FRIES.

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.⁶ 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. 4-2012-009685 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 22 MAY 2017.


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

⁶ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.