



JOLLIBEE FOODS CORPORATION,
Opposer,

-versus-

JOE SANTOS UY,
Respondent-Applicant.

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IPC No. 14-2014-00520

Opposition to:

Appln. Serial No. 4-2014-008564

Date Filed: 09 July 2014

TM: JOLLY LOLLY

NOTICE OF DECISION

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1215 Acacia Avenue, Madrigal Business Park
Ayala Alabang, Muntinlupa City

JOE SANTOS UY
Respondent- Applicant
2302 Jose Abad Santos Avenue,
Sta. Cruz, Manila

GREETINGS:

Please be informed that Decision No. 2017 - 134 dated 20 April 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, 21 April 2017.

Marilyn F. Retual
MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

JOLLIBEE FOODS CORPORATION,	} IPC NO. 14-2014-00520
Opposer,	} Opposition to:
	}
-versus-	} Appln. Ser. No. 4-2014-008564
	} Date Filed: 9 July 2014
	}
JOE SANTOS UY,	} Trademark: "JOLLY LOLLY"
Respondent-Applicant.	}
	}
x-----x	} Decision No. 2017- <i>134</i>

DECISION

JOLLIBEE FOODS CORPORATION, (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2014-008564. The application, filed by JOE SANTOS UY (Respondent-Applicant)², covers the mark "JOLLY LOLLY", for use on "Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking powder, salt, mustard, vinegar, sauces (condiments), spices" under Class 30 of the International Classification of Goods³.

The Opposer anchors its opposition on the ground that the registration of the JOLLY LOLLY mark is contrary to the provisions of Sections 123.1 (d), (e) and (f) of Republic Act 8293, as amended.

The Opposer alleges the following facts:

"2. Opposer is the owner and first user of the internationally well-known JOLLY mark, which is the alternate form of its internationally well-known JOLLIBEE mark. The JOLLY mark is used by the Opposer for various food and beverage products in classes 29, 30 and 32. Opposer is also the owner and first user of other JOLLY marks for food and beverage products in classes 29 and 30, and services in class 35.

"3. The JOLLY mark and JOLLY-related marks are registered or pending registrations with the IPO. xxx

¹ A corporation duly organized and existing under Philippine laws with address at 10th Floor, Jollibee Plaza Building, #10 Emerald Avenue, Ortigas Center, Pasig City

² Filipino with address at 2302 Jose Abad Santos Avenue, Sta. Cruz, Manila

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

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“4. The JOLLY mark and related marks are also registered or pending registration in the name of the Opposer in various countries around the world. xxx

“5. The element 'JOLLY' in the Respondent-Applicant's JOLLY LOLLY mark is identical and confusingly similar in terms of appearance, spelling and pronunciation to the Opposer's JOLLY marks as to be likely deceive or to cause confusion.

“6. Confusion is all the more likely considering that Respondent-Applicant's JOLLY LOLLY mark is applied for registration for the same products in the same class 30 in which the Opposer's JOLLY mark and related marks are used and registered.

“7. Opposer's JOLLIBEE mark and its alternate form, JOLLY, are well-known and famous marks. Hence, the registration of the Respondent-Applicant's JOLLY LOLLY mark will constitute a violation of Sections 123.1 (e) and 123.1 (f) of Republic Act 8293.

“8. This Honorable Office has recognized the well-known status of the JOLLIBEE and JOLLY marks in its decision in Jolibee Foods Corporation vs. Atlas Publishing Company, Inc. dated 25 February 2007 where it held that:

"xxx Jollibee continues to use the JOLLIBEE mark in each Jollibee outlet and in almost all product packaging, advertising and in promotional materials. The JOLLIBEE mark has become so well known in the Philippines that the mere use of the mark that includes 'JOLLI' or 'JOLLY' would immediately cause consumers to believe that the goods or services offered under the mark are sponsored by Jollibee."

“9. Opposer has used its JOLLY mark in the Philippines and elsewhere in the world as early as 1988 or way prior to the filing date of the application subject of this opposition. At present, Opposer continues to use its JOLLY mark and related marks in the Philippines and abroad in connection with its fast-food restaurant business, goods and services.

“10. Opposer has extensively used and promoted its JOLLY marks in the Philippines and abroad. Over the years, Opposer has obtained significant exposure for the products and services upon which its JOLLY marks are used in various media, including television commercials, outdoor advertisements, internationally well-known print publications, and other promotional events.

“11. Opposer has not consented to Respondent-Applicant's use and registration of the JOLLY LOLLY mark, or any other mark identical or similar to the Opposer's well-known and registered JOLLY marks. xxx”

To support its opposition, the Opposer submitted as evidence the following:

1. Original Notarized Notice of Opposition;
2. Affidavit of Atty. Sheilah Marie P. Tomarong-Canabano dated 23 January 2015;
3. Restaurant menu item and product wrappers bearing mark "JOLLIBEE" and "JOLLY";
4. Notarized Special Power of Attorney executed by Atty. Sheilah Marie P. Tomarong-Canabano; and
5. Notarized Secretary's Certificate executed by William Tan Untiong dated 9 January 2015⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 17 February 2015. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 9 September 2015 Order No. 2015-1398 declaring the Respondent-Applicant to have waived its right to file an Answer.

Should the Respondent-Applicant be allowed to register the mark "JOLLY LOLLY"?

Records show that at the time Respondent-Applicant applied for registration of the mark "JOLLY LOLLY" the Opposer already registered the mark "JOLIBEE" and "JOLIBEE marks" in several registrations⁵. The goods covered by the Opposer's trademark registration are also under Class 29, 30 and 32 for various food and beverage products, while the Respondent-Applicant's trademark application indicates use as "Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking powder, salt, mustard, vinegar, sauces (condiments), spices" under class 30.

The competing marks are depicted below:

Opposer's mark

JOLLIBEE

Respondent-Applicant's mark



⁴ Exhibits "A" to "E" with submarkings

⁵ Exhibit "B"1-12

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The Bureau takes judicial notice of its decision rendered in Decision No. 2007-17, dated 25 February 2007 entitled *Jollibee Foods Corporation v. Atlas Publishing House*⁶, wherein the Bureau held:

"xxx Jolibee continues to use the JOLLIBEE mark in each Jolibee outlet and in almost all product packaging, advertising and in all promotional materials. The JOLLIBEE mark has become so well known in the Philippines that the mere use of the mark that includes 'JOLLI' or 'JOLLY' would immediately cause consumers to believe that the goods or services offered under the mark are sponsored by Jollibee."

Records and evidence show that the JOLLIBEE and/or JOLLY marks have been promoted and advertised extensively in the Philippines. Promotional materials, screenshots of the company website, celebrity endorsements, registrations⁷ have submitted to show the marks popularity.

Succinctly, because the Respondent-Applicant uses its mark on goods that are similar or closely related to the Opposer's it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.⁸

The public interest, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that 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

⁶ Exhibit "B"

⁷ Exhibit "B" with submarkings

⁸ *Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁹

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2014-0008564 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 20 APR 2017.



ATTY. ADORACION U. ZARE, LL.M.
Adjudication Officer
Bureau of Legal Affairs

⁹*Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).