

JOLLIBEE FOODS CORPORATION,
Opposer,

-versus-

JOLY FOOD INDUSTRIES CORPORATION,
Respondent- Applicant.

}
} IPC No. 14-2014-00075
} Opposition to:
} Appln. Serial No. 4-2013-005564
} Date Filed: 15 May 2013
} TM: "JOLY"
}

X-----X

NOTICE OF DECISION

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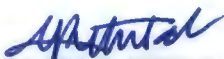
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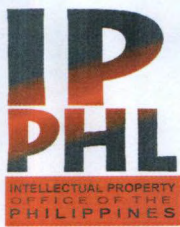
GREETINGS:

Please be informed that Decision No. 2017 - 320 dated August 31, 2017 (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 the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, August 31, 2017.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs



JOLLIBEE FOODS CORPORATION,
Opposer,

- versus -

**JOLY FOOD INDUSTRIES
CORPORATION,**
Respondent-Applicant.

X ----- X

IPC No. 14-2014-00075
Opposition to:

Appln. No. 4-2013-005564
Date Filed: 15 May 2013
Trademark: "JOLY"

Decision No. 2017 - 320

DECISION

JOLLIBEE FOODS CORPOATION ("Opposer")¹, filed a verified opposition to Trademark Application Serial No. 4-2013-005564. The application, filed by JOLLY FOOD INDUSTRIES CORPORATION ("Respondent-Applicant")², covers the mark "JOLY" for use on the following classes of goods³ namely: *"jelly (gelatin), jelly sticks, pudding bar (gelatin), jar (gelatin), nata de coco" (class 29); candy, lollipop, milk pop, flower pop (class 30); and, fruit juices, cola ice candy (class 32).*

The Opposer alleges that it is the registered owner and the first user of the internationally well-known JOLLIBEE mark and other related JOLLIBEE trademarks. In the Philippines, Opposer is the holder of around 80 JOLLIBEE trademark registrations and 12 pending applications with the Intellectual Property Office of the Philippines. Internationally, it also owns 165 registrations and 122 pending applications for the JOLLIBEE trademarks.

According to the Opposer, 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. Throughout the years, the Opposer has continuously used the JOLLIBEE name and mark in each Jollibee outlet and in almost all product packaging, advertising and promotional materials. The Opposer and its JOLLIBEE brand is recognized as one of the country's greatest success stories and is an undeniable symbol of Filipino pride

¹ A corporation organized under Philippine laws, with address at 10th Floor, Jollibee Plaza, F. Ortigas Jr. Avenue, Ortigas Center, Pasig City, Philippines.
² A corporation duly organized and existing under the laws of the Philippines, with business and office address at Kambal Road, Guitnang Bayan, San Mateo, Rizal, with Brenda A. Go Shen, a Filipino, of legal age, as its President and majority stockholder and with the same business and office address as that of Joly Food Industries Corporation.
³ The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

worldwide. The JOLLIBEE mark was first used in the Philippines on 26 January 1978 for quick-service restaurants serving food and beverages. After more than 35 continuous years in business, there are now 800 JOLLIBEE restaurants in the Philippines alone. In 1986, the first international JOLLIBEE restaurant located in Taiwan opened. There are now 100 JOLLIBEE restaurants abroad.

The Opposer's products can also be viewed online through its website www.jollibee.com.ph where the JOLLIBEE mark is prominently featured. For the years 2010 and 2011 alone, Opposer invested more than Php 1 Billion for advertising and promotions annually. Its well-known status was attested in various articles and it has won recognitions and awards as it produced some of the most memorable images in the Philippine advertising history. In fact, in November 2010, the former President Benigno Aquino III, in the ceremony for Opposer's 700th Jollibee store in the Philippines, praised Opposer for its contributions to and role in our nation. The Opposer has also invested in enforcing its intellectual property rights.

In this instant case, the Opposer avers that the registration of the mark JOLY is contrary to the provisions of Sections 123.1 (d), (e) and (f) of Republic Act No. 8293, as amended, also known as the Intellectual Property Code of the Philippines. Respondent-Applicant's trademark JOLY is confusingly similar to the JOLLIBEE and JOLLY trademarks which are registered in Opposer's name. The word JOLLY appears in various products offered by Opposer and has even been registered as part of composite marks in Opposer's name. Such confusion will most likely deceive consumers by suggesting a connection, association or affiliation with Opposer when none exists, thereby causing substantial damage to the goodwill and reputation associated with JOLLIBEE and other JOLLY marks. The use of the mark JOLY on the same or related food products in Classes 29, 30 and 32 will mislead the purchasing public into believing that its goods originate from or are under the sponsorship of Opposer.

The Opposer submitted the following evidence:

1. Decision of Bureau of Legal Affairs dated 25 February 2007 in IPC No. 14-2006-00113;
2. Original notarized Affidavit of Atty. Sheilah Marie P. Tomarong-Canabano;
3. Representative samples of Philippine registrations for the JOLLIBEE mark and other related JOLLIBEE and JOLLY trademarks with Trademark Registration Nos. 4-2005-007558, 4-2000-004772, 4-2000-007421, 4-2010-002055, 4-2009-006965, 4-2004-006392, 4-2005-006933, 4-2003-001019, 4-2009-006903, 4-2009-006906, 4-2009-006907, 4-2005-001998, 4-2009-006901, 4-2009-006900, 4-2009-006905, 4-2010-004204, 4-2010-004233, 4-2010-004234, 4-2008-001694, 4-2003-008178, 4-2005-002450, 4-2010-005306, 4-2010-005305, 4-2010-005304, 4-2010-005302, 4-2010-005303, 4-2010-005367, 4-2010-005366, 4-2010-005152, 4-2010-005151, 4-2010-005153, 4-2010-005154, 4-2010-005155, 4-2010-005156, 4-2011-003560, 4-2011-003560, 4-2011-003561, 4-2010-004237, 4-2011-003543, 4-2011-003613, 4-2012-000614, 4-2012-001250, 4-2008-007562, 4-2013-012443, and 4-2014-003233;
4. Representative samples of JOLLIBEE food packaging and containers;

5. Representative samples of promotional materials and advertisements in television programs, the internet, well-known print publications, in-store promotions, and outdoor promotions for JOLLIBEE products and services;
6. Screenshots of Opposer's website of JOLLIBEE items, food products and restaurant;
7. Table showing the details of Opposer's JOLLIBEE application and registrations;
8. Representative samples of JOLLIBEE registrations and application worldwide;
9. Various articles and blogs worldwide on the status of Opposer and its JOLLIBEE trademarks;
10. Coffee table book entitled "A 25-Year Love Story with the Pinoy";
11. Opposer's Power Point presentation during the WIPO-Sweden Advanced Training Course on Industrial Property in the Global Economy;
12. Opposer's 2002 up to 2011 Annual Report;
13. List of Awards from the years 1981 to 2008;
14. Copy of notarized Special Power of Attorney executed by Ms. Angeline L. Chong; and,
15. Copy of the notarized Secretary's Certificate executed by Ms. Valeria Feria Amante,

On 02 October 2014, Respondent-Applicant submitted its Verified Answer. It denies that the subject Application SN 4-2013-005564 for JOLY mark is proscribed by Section 123.1 (d) of the IP Code. It is neither identical nor confusingly similar to the following principal marks of the Opposer: JOLLIBEE and JOLLIBEE MASCOT; BEE/HEAD DEVICE; CHAMP; YUM/YUM BURGER; and, CHICKEN JOY. At first glance, Respondent-Applicant's mark JOLY may appear to nearly resemble in pronunciation the word JOLLY in Opposer's recently adopted marks such as JOLLY SHAKES, JOLLY KRUNCHY TWIRL, JOLLY CRISPY FRIES, JOLLY CHEEZY FRIES, JOLLY HOTDOG and JOLLY SPAGHETTI. However, a close and careful examination and comparison of the marks will definitely show the difference in their literal, visual and even in their aural characteristics. The specific products of Respondent-Applicant bearing the mark JOLY are different from, and are not otherwise closely related to, Opposer's products bearing the JOLLY marks.

Respondent-Applicant further maintains that it adopted and using in good faith its mark JOLY and its variations, much ahead of Opposer's adoption and use of its JOLLY marks. Brenda A. Go Shen, President and majority stockholder of Respondent-Applicant company, first used the mark JOLY on 14 October 1992 on fruit juices. In fact, on 07 January 1993, Go Shen filed an application for the registration of the mark JOLY in the Principal Register with the then Bureau of Patents, Trademarks and Technology Transfer. On 06 May 1997, Go Shen filed an application for the registration of the mark JOLY on food drinks. Thereafter, Go Shen filed various applications for the registration of the mark JOLY and its variations for ice candies, gulaman and fruit juices, ice pop and cola.

According to Respondent-Applicant, it has been using in good faith JOLY as the dominant part or feature of its trade name, business name and corporate name. It was issued the appropriate Mayor's Permit and Business Licenses, SEC documents for its corporate name Joly Food Industries Corporation, registration with the Bureau of Internal Revenue for its business/trade name, and Certificates of Product Registration by the Bureau of Food and Drugs.

Respondent-Applicant also declared that it never abandon, but continuously use up to the present, its various JOLY marks. Goods bearing the JOLY marks have been widely distributed and sold, as they continue to be distributed/sold in various public markets and sari-sari/retail stores nationwide since 1992 up to the present at prices ranging from P0.55 to P4.00

The Respondent-Applicant submitted the following evidence:

1. Certified true copy (Ctc) of the Certificate of Incorporation of "Joly Food Industries Corporation" issued on 17 January 2003, with the Articles of Incorporation and By-Laws;
2. Ctc of the Certificate of Filing of Amended Articles of Incorporation issued on 05 December 2003;
3. Mayor's Permit and Business License issued in favor of F.P.C. Food Industries/Brenda A. Go on 14 October 1992;
4. Mayor's Permit and Business License issued in favor of F.P.C. Food Industries/Brenda A. Go on 18 January 1993;
5. Duplicate original of Application for the registration of the trademark "JOLY" on 07 January 1993 by Brenda A. Go;
6. Business Permit issued by the Municipality of Marilao, Bulacan;
7. Copy of the Petition to Open a Food Establishment filed with the Bureau of Food and Drugs on 02 April 1993 by Brenda A. Go under the business name F.P.C. Food Industries;
8. Copy of the Report of Analysis of the plastic bags for "JOLY" fruit drinks by the Bureau of Food and Drugs on 02 June 1993;
9. Certificate of Registration (CR) of F.P.C. Food Industries as Fruit Juice Manufacturer issued by the Bureau of Internal Revenue on 13 January 1995 to Brenda A. Go;
10. Mayor's permits and Business Licenses issued to Benda A. Go/F.P.C. Food Industries by the Municipality of Antipolo, Rizal;
11. CR No. P-IV-97-No. 33221 issued by the Department of Trade and Industry on 03 October 1997 for Brenda G. Shen for the business name F.P.C. Food Industries;
12. Application SN 00120386 by Brenda A. Go on 06 May 1997 for the registration of the mark "JOLY" for use on food drinks;
13. Representative sales invoices of Joly Food Industries Corporation for JOLY products from 2005-2014;
14. Ctc of CR No. 4-2001-009286 for the mark "JOLY" under Classes 30 and 32 in favor of Brenda Go Shen;
15. Duplicate original of Application SN 4-2014-003890 on 28 March 2014 by Brenda Go Shen as re-application of Registration No. 4-2001-009286 for "JOLY" on 18 August 2006;
16. Ctc of CR No. 4-2002-009854 for "JOLY" under Class 30 on 0001 July 2005 in favor of Brenda Go Shen;
17. Duplicate original of Application SN 4-2014-003891 on 28 March 2014 by Brenda Go Shen as a re-application of Registration No. 4-2002-009854 for JOLY on 01 July 2005;
18. CR No. 4-2013-005565 for "EPC" under Classes 29, 30 and 32;

19. Duplicate original of Application SN 4-2013-005564 by Joly Food Industries Corporation for JOLY under Classes 29, 30 and 32;
20. Printout of e-Gazette showing publication of Application SN 4-2013-005564;
21. Mayor's Permits and Business Licenses issued by the Municipality of San Mateo, Rizal for the years 1998 up to 2002 to Brenda A. Go/FGC Food Industries;
22. Mayor's Permits and Business Licenses issued by the Municipality of San Mateo, Rizal for the years 2003 up to present to Joly Food Industries Corporation;
23. Duplicate original of the Amended Declaration of Actual Use (DAU) on 11 April 2014 in connection with Application SN 4-2013-005564 with attachments;
24. Representative sales invoices of Joly Food Industries Corporation of JOLY marks;
25. Representative sales invoices of F.P.C. Food Industries of JOLY marks;
26. Representative labels and packagings for JOLY products;
27. Various Certificates of Product Registration by the Bureau of Food and Drugs in favor of F.P.C. Food Industries and Joly Food Industries Corporation for its products;
28. Various Licenses to Operate by the Bureau of Food and Drugs in favor of F.P.C. Food Industries and Joly Food Industries Corporation;
29. Price List of Joly Food Industries Corporation's products; and,
30. Duly notarized affidavit of Brenda A. Go Shen.

The preliminary conference was held and terminated on 29 June 2015. The parties submitted their respective Position Papers⁴. After which, this instant case is deemed submitted for resolution.

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

A careful perusal of the records show that the Opposer has valid and existing registrations for the trademark "JOLLIBEE", which certificate was issued as early as 24 September 2005⁵. The Opposer has also registrations for the trademark "JOLLY" and its variations, the earliest of which was issued on 08 June 2006 for "JOLLY 'ZERTS"⁶. On the part of Respondent-Applicant, through Brenda A. Go Shen, the applications for registration of the mark JOLY were filed on the following dates earlier than that of the Opposer: 07 January 1993⁷, 06 May 1997 for use on food drinks⁸, 12 December 2001 for use on ice candies, gulaman and fruit juices which ripened into Registration No. 4-2012-009286 on 19 August 2006⁹, and on 18 November 2002 for use on ice candy, fruit juices, ice pop and cola which also ripened into Registration No. 4-2002-0098656 on 01 July 2005¹⁰. However, these registrations were cancelled due to non-filing of Declaration of Actual Use, to which Respondent-Applicant re-applied for the same mark and goods¹¹.

⁴ Opposer submitted its Position Paper on 14 July 2015. Respondent-Applicant submitted its Position Paper on 08 July 2015.

⁵ Included in Annexes "A" to "A-42" of Affidavit/ Exhibit "D" of Opposer.

⁶ Id.

⁷ Exhibit "4" of Respondent-Applicant.

⁸ Exhibit "10" of Respondent-Applicant.

⁹ Exhibit "12" of Respondent-Applicant.

¹⁰ Exhibit "14" of Respondent-Applicant.

¹¹ Exhibits "13" and "15" of Respondent-Applicant.

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For further scrutiny, some of the Opposer's marks are presented for comparison with Respondent-Applicant's subject mark:



JOLLY Jolly 'Zerts



Opposer's Trademarks

Respondent-Applicant's trademark

This Bureau does not agree with Opposer's contention that the mark "JOLLY" is confusingly similar to the Opposer's "JOLLIBEE" and other "JOLLY" trademarks. "JOLLY" is a common English word. In fact, the Trademark Registry shows many other registered marks belonging to different entities using the term for goods either belonging to the same class/es or other classes as the Opposer's. In this regard, the Trademark Registry, the contents of which this Bureau takes cognizance of via judicial notice, consist of marks that contain "JOLLY", such as: **JOLLY RANCHER** (Reg. No. 10168 dated 11 February 2008 for class 30); **JOLLY SPREADS** (Reg. No. 4-2014-009420 dated 04 December 2014 for class 29); **JOLLY FRESH** (dated 14 January 2016 for classes 29 and 32); **JOLLY** (Reg. No. 64429 filed on 11 April 1994 for class 21); **JOLLY** (Reg. No. 018473 dated 28 November 2013 and filed on 28 July 1970 for class 30); **JOLLY** (Reg. No. 4-2015-000554 dated 25 June 2016 for class 29); and, **JOLLY** (Reg. No. 03235925 dated 25 June 2016 for class 29)¹². The fact that the "JOLLY" marks co-exist in the market, each with its own distinctive presentation and coverage of goods or services, does not indicate a likelihood of confusion.

Apparently, the word "JOLLY" alone is not highly distinctive. In this case, Respondent-Applicant's "JOLLY" is distinguishable from any of the Opposer's "JOLLY" and "JOLLIBEE" marks. Respondent-Applicant's "JOLLY" is pronounced with a short "o" because it consists of single letter "o" which has no word meaning; whereas, Opposer's "JOLLY" is pronounced with a short "a", which obviously means happy or joyful. In this instance, the Opposer failed to show its right to exclusively use the word "JOLLY".

Further, as enumerated in its Application SN 4-2013-005564, Respondent-Applicant has been using its mark "JOLLY" on jelly (gelatin), jelly sticks, pudding bar (gelatin), jar (gelatin), nata de coco falling under Class 29; candy, lollipop, milk pop, flower pop falling under Class 30, and fruit juices, cola ice candy falling under Class 32¹³. On the other hand, Opposer uses its marks containing the word "JOLLY" on strawberry sundae, mango caramel sundae, choco mallow pie, bubble gum, crunchy swirl, ice cream coffee jelly, shakes, crispy fries, hotdog and spaghetti¹⁴. Evidence shows that Respondent-Applicant does not deal with any of Opposer's products. In exchange, Opposer does not also deal with any of the products of Respondent-

¹² IPOPHL Trademarks Database, available at <http://www.wipo.int/branddb/ph/en/> (last accessed 30 August 2017).

¹³ File wrapper records.

¹⁴ Id. at 11.

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Applicant bearing the mark "JOLY". In addition, the Opposer's goods can only be purchased and availed of in restaurants and fast food chains, while that of Respondent-Applicant in sari-sari or convenience stores, grocery stores and markets. In view thereof, it is highly improbable that the consumers will be deceived, or at least confused that the Respondent-Applicant's products are the same or are sourced from the Opposer as they flow in different channels of trade and bears difference in cost.

Moreover, records of this case reveal that Respondent-Applicant has registered in the Philippines the "JOLY" mark as early as 2005, even before the application or registration of any of the Opposer's JOLLY" mark and its variations. It is underscored therefore that the Respondent-Applicant's mark was applied and registered in the Philippines even prior the Opposer. It bears noting that the Respondent-Applicant has in fact, proved priority in use of the trademark "JOLY"¹⁵, and has fully complied with the submission of documentary requirements for its operation¹⁶.

Finally, it is emphasized that 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.¹⁷ This Bureau finds that the Respondent-Applicant's mark meets this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2013-005564 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. **31 AUG 2017**



Atty. GINALYN S. BADIOLA, LL.M.
Adjudication Officer, Bureau of Legal Affairs

¹⁵ par. 4.4, Answer and including the attached Exhibits.

¹⁶ Exhibits "23" and "24" and series of Respondent-Applicant.

¹⁷ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.