



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

JOLLIBEE FOODS CORPORATION,
Opposer,

-versus-

JOLY FOOD INDUSTRIES CORP.,
Respondent-Applicant.

IPC No. 14-2015-00427

Opposition to:

Appln. Ser. No. 4-2014-003891

Date Filed: 28 March 2014

TM: FPC JOLY

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 416 dated 13 December 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, 14 December 2017.

MARILYN F. RETUAL

IPRS IV

Bureau of Legal Affairs

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IPC No. 14-2015-00427

Opposition to Trademark
Application No. 4-2014-003891
Date Filed: 28 March 2014
Trademark: "FPC JOLY"

Decision No. 2017- 416

DECISION

Jollibee Foods Corporation¹ ("Opposer") filed an opposition to Application No. 4-2014-003891. The contested application, filed by Joly Food Industries Corporation² ("Respondent-Applicant"), covers the mark "FPC JOLY" for use on "*ice candy and ice pop*" and "*fruit juice and cola*" under Classes 30 and 32, respectively, of the International Classification of Goods³.

The Opposer anchors its opposition on paragraphs (d), (e) and (f) of Section 123 of the Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). It contends that the Respondent-Applicant's mark "FPC JOLY" is confusingly similar to its own "JOLLIBEE" and "JOLLY" marks, considering that both are used for goods under Classes 30 and 32. It asserts that the goods covered by the applied mark are covered within the zone of natural expansion of its business. It also claims that its "JOLLY" and "JOLLIBEE" marks are well-known.

According to Opposer, it has registrations and/or pending applications of its "JOLLIBEE" marks in various countries around the world. It is also the owner and first user of the "JOLLY" mark used for various food and beverage products in Classes 29, 30, 32 and 35. It has used its marks as early as 1978 and 1988. In support of its opposition, the Opposer submitted the following:⁴

1. original notarized affidavit of Atty. Angeline L. Chong, with annexes;
2. copy of restaurant menu items and food wrapper showing the "JOLLIBEE" and "JOLLY" marks; and,

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

²A domestic corporation with address at Kambal Road, Guitnangbayan II, San Mateo, Rizal, Philippines.

³The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the 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 Purpose of the Registration of Marks concluded in 1957.

⁴Marked as Exhibits "B" to "D", inclusive.

3. copies of various articles on its inclusion in the Forbes Asia Fabulous 50 list of most outstanding companies in the Asia Pacific.

The Respondent-Applicant filed its Answer alleging, among other things, that in through its president, Brenda A. Go/Brenda A. Go Shen, it adopted "FPC JOLY" from its business name "F.P.C. Food Industries" and "JOLY", her expression of endearment to her husband. To protect her "JOLY" marks, she registered the same. For lack of proper advice about the need therefore, however, the pertinent Declarations of Actual Use (DAUs) were not filed resulting to the cancellation of the registration certificates. Despite the cancellation, the mark was continuously used. The Respondent-Applicant evidence consists of the affidavit of Brenda A. Go Shen, with annexes.⁵

The Preliminary Conference was conducted and terminated on 26 October 2017 wherein the parties were directed to file their respective Position Papers within ten days therefrom. After the submission thereof, the case is deemed submitted for resolution.

The issue to be resolved is whether the trademark "FPC JOLY" should be allowed.

Records reveal that the Opposer has a valid and existing registration of its trademark "JOLLIBEE", which certificate was issued as early as 24 September 2005. The latter has several other registrations under its name for its "JOLLIBEE" and "JOLLY" marks. On the other hand, the Respondent-Applicant has no existing registration for "FPC JOLY".

Be that as it may, this Adjudication Officer does not agree with Opposer's contention that the mark "FPC JOLY" is confusingly similar to the Opposer's "JOLLIBEE" and other "JOLLY" trademarks. In fact, the Trademark Registry shows many other registered marks belonging to different entities using the term for goods belonging to Classes 30 and/or 32, including: "JOLLY", "JOLLY FRESH" and "JOLLY SHANDY" under Certificate of Registration Nos. 01846, 4-2015-004995 and 047022, respectively. Noteworthy, "JOLLY SHANDY" was issued as early as 23 November 1989, way before the Opposer's earliest registration.

Apparently, the word "JOLLY" alone is not highly distinctive. "JOLLY" is a common English word and hence, what will determine whether the marks are indeed confusingly similar are the words and/or device that accompany the same. In this case, the "FPC JOLY" mark is distinguishable from any of the Opposer's "JOLLY" and "JOLLIBEE" marks. The former is pronounced with a short letter "o"

⁵ Marked as Exhibits "1" to "27", with annexes.

because of the single letter "L" and has no dictionary meaning. "JOLLY", on the other hand is pronounced with a short letter "a" and means happy or joyful. Thus, the competing marks are distinguishable visually, aurally and in connotation.

Moreover, the Opposer's goods and services can only be purchased and availed of in its restaurants and fast food chains while that of Respondent-Applicant in ordinary stores. In view thereof, it is highly improbable that the consumers will be deceived, or at least confused, that "FPC JOLY" products are the same or are sourced from the Opposer as they flow in different channels of trade. Records of this case also reveal that the Respondent-Applicant has registered in the Philippines its "JOLY" marks as early as 01 July 2005 but were cancelled for its failure to submit the requisite DAUs. This implies the two competing marks previously co-existed and no confusion and/or deception to the public were shown to have occurred.

Therefore, the mere use of "JOLLY" and/or "JOLY" is insufficient to conclude that there is likelihood of confusion. To rule otherwise is tantamount to conferring upon the Opposer exclusive right over the common word "JOLLY". Doing so will have the unintended effect of opening doors for cancellation of valid and existing trademark registrations of parties using "JOLLY" as their trademark or a part thereof to the latter's damage and prejudice. 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.

Consequent to the findings that there is no confusing similarity between "FPC JOLY" and the Opposer's trademarks, there is no reason to delve on the issue of whether "JOLLIBEE" and its other family of marks are well-known.

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.⁶ It is found that Respondent-Applicant sufficiently met the requirements of the law.

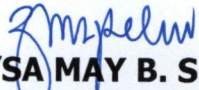
WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filer wrapper of Trademark Application No. 4-2014-003891 be

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

returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 13 DEC 2017


ATTY. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs