

JOLLIBEE FOODS CORPORATION, Opposer,	}	INTER PARTES CASE NO. 4170
	}	Opposition to:
-versus-	}	Serial No. : 86200
	}	Date Filed : 03 June 1993
FOOD OF THE ORIENT & MARKETING VENTURES INC., Respondent-Applicant.	}	Trademark : "JOLLEE"
	}	Used on : Coco jams
x-----x	}	Decision No. : 2000-11

## DECISION

This pertains to the Notice of Opposition filed by herein Opposer, Jollibee Foods Corporation, a corporation duly organized and existing under and by virtue of the laws of the Philippines with principal office address at 5<sup>th</sup>/F., Jollibee Centre Building, San Miguel Avenue, Pasig Metro Manila, in the matter of application for registration of the trademark "JOLLEE" used for coco jam bearing Serial No. 86200 filed on June 3, 1993 by Food of the Orient and Marketing Ventures, Inc. of Antipolo Rizal, which application was published in the Bureau of Patents, trademarks and Technology Transfer (BPTTT) Official Gazette, Vol. VIII, No. I, page 24, released for circulation on March 31, 1995.

The grounds of the Opposition are as follows:

- "1. The trademark "JOLLEE" of the Respondent-Applicant is confusingly similar with the "JOLLIBEE" trademark for herein Opposer which the latter had much earlier adopted and used in commerce in the Philippines as trademark for its food products and as a service mark and business name and for which it has existing trademark registrations with the Bureau of Patents, Trademarks and Technology Transfer. Specifically, the "JOLLEE" mark as applied for by the Respondent-Applicant is confusingly similar with the "JOLLIBEE" trademark of the Opposer. The apparent similarity lies on the fact that the style of letterings adopted by the Respondent-Applicant on its mark is perfectly identical with the style of lettering adopted by the Opposer in its "JOLLIBEE" trademark. While the pronunciation of the mark "JOLLEE" may be little bit different from "JOLLIBEE" trademark due to the omission of the letters ib in the Respondent-Applicant's mark such a very significant or unnoticeable difference is incapable of removing the existence of confusing similarity between the contending marks of the parties if one has to consider them in their entirety.
- "2. The mark "JOLLEE" of the Respondent-Applicant is likewise confusingly similar with the "JOLLY" trademark of the Opposer which the latter has adopted and used for food products and for novelty items and for which it has existing trademark and copyright registrations with the BPTTT and with National Library, respectively.
- "3. The Opposer has been spending tremendous sum of money for the advertisement and promotion of the

“JOLLIBEE” and other trademarks of the Opposer nationwide and its business will be clearly damaged and will suffer irreparable injury by the use and registration of the Respondent-Applicant of the JOLLEE mark;

- “4. Respondent-Applicant by adopting and applying for registration of the mark JOLLEE for food product has no other intention except to ride on the immense goodwill and popularity of the JOLLIBEE and JOLLY trademark of the Opposer to the extreme prejudice of the latter.

Opposer relied on the following facts to support its opposition:

“a) Opposer was the first to adopt and use in commerce in the Philippines the trademark JOLLIBEE for various food products and as a tradename for fastfood restaurants. It was also the first to adopt and use the mark Jolly for food products and novelty items.

“b) The mark “JOLLIBEE” and “JOLLY” are registered trademarks of the Opposer and as the registrant thereof, Opposer has the right to exclude others from using the same or confusingly similar mark.

“c) Opposer has spent huge amount of money for the promotion of the JOLLIBEE, JOLLY and other trademarks of the Opposer in the various media of advertisements.

“d) The continuous and extensive use, as well as the effective advertisements and sales promotion of the mark “JOLLIBEE” and “JOLLY” have reaped so much fame and goodwill in the Philippines that the said marks have metamorphosed into a household word deeply embedded in the mind of the purchasing public. It is not farfetched therefore to say that Respondent-Applicant’s choice of its trademark “JOLLEE” by adopting identical style of lettering and appearance as that of the Opposer’s “JOLLIBEE” mark is intended to take a free ride on the goodwill of the Opposer.

“e) The adoption and use of the trademark “JOLLEE” by Respondent-Applicant on its goods will likely mislead, confuse or deceive the purchasing public as to the source or origin of the goods and will tend falsely suggest a connection with the Opposer.

Such adoption and use will, therefore constitute an intent to defraud not only the Opposer but also the public in general.

On June 4, 1995, a Notice to Answer by this Office, requiring the herein Respondent-Applicant to file its Answer within fifteen days after receipt such Notice.

On November 10, 1995, Opposer, through Counsel filed an ex-parte motion to declare Respondent-Applicant in Default for failure of Respondent-Applicant to file its Answer within fifteen (15) days from receipt of the Notice to Answer.

The records show that the Notice to Answer was received by the Respondent-Applicant on July 13, 1995, however, the fifteen days period for filing the answer had long lapsed without any Answer or motion for extension to file such answer being filed by Respondent-Applicant hence, the Ex-parte Motion To Declare Respondent-Applicant in Default was granted by this Office under Order No. 95-863 dated 13 December 1995.

Thus, Opposer was allowed to present its evidence ex-parte on January 5, 1995.

On 29 January 1996 Opposer formally offered its evidence consisting of Exhibits "A" to "F-3".

Opposer submitted its Memorandum on 13 March 1996.

The main issue to be resolved in this case is, whether or not Respondent is entitled to register the mark "JOLLEE" pursuant to the provisions of Sec. 2 and 4 (d) of Rep. Act No. 166 as amended.

This Office takes cognizance of the fact that the herein Application Serial No. was filed on 03 June 1993 when the new Intellectual Property Code (R.A. 8293) was not yet in force. Sec. 235.2 of R.A. 8293 provides inter alia that: "all application for registration of marks or tradename pending in the BPTTT at the effective date of this Act may be amended if practicable to bring them under the provision of this Act. xxx. If such amendments are not made, the prosecution of said application shall be proceeded with or registration thereon granted in accordance with the acts under which said applications were filed and said acts hereby continued in force to the extent only notwithstanding the foregoing repeal thereof. (Underscoring ours.)

Secs. 2 and 4 (d) of the Trademark Law, R.A. 166 as amended, provide as follows:

*Sec. 2. What are registrable.* – Trade-marks, trade-names, and service marks owned by persons, corporations, partnership or association, domiciled in the Philippines and by persons, corporations, partnerships or associations domiciled in any foreign country may be registered in accordance with the provisions of this Act: Provided, That said trade-marks, trade-names, or service-marks are actually in use in commerce and services not less than two months in the Philippines before the time the applications for registration are filed: And provided, further, That the country of which the applicant for registrations is a citizen grants by law substantially similar privileges to citizens of the Philippines, and such fact is officially certified, with a certified true copy of the foreign law translated into English language, by the government of the foreign country to the government of the Republic of the Philippines.

"xxx"

"Sec. 4. Registration of trademarks, tradenames and service marks on the principal register. – There is hereby established a register of trademarks, tradenames, or service marks which shall be known as the principal register. The owner of a trademark, tradename, or service mark used to distinguish his goods, business, or services from the goods, business, or services of other shall have the right to register the same on the principal register, unless it:

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“(d) Consists of or comprises a mark or tradename which so resembles a mark or tradename registered in the Philippines or a mark or tradename previously used in the Philippines by another and not abandoned, as to be likely when applied to or used in connection with the goods, business or services of the applicant to cause confusion or mistake or to deceive consumers.”

(Underscoring ours.)

Interpreting the aforementioned provisions, the Supreme Court ruled that:

“In determining whether the trademarks are confusingly similar, the test is not simply to take their words and compare the spelling and pronunciation of said words. Rather, it is to consider the two marks in their entirety, as they appear in the respective labels, in relation to the goods to which they are attached.” (Mead Johnson and Co. vs. N.V.J. Van Corp., Ltd., SCRA 768) (Underscoring ours.)

In this case at bar, the mark JOLLEE of herein Respondent-Applicant is not only similar but is almost identical, in terms of over all appearance and style of lettering to Opposer’s JOLLIBEE trademark. That although the pronunciation of the mark “JOLLEE” may be a little bit different from Opposer’s “JOLLIBEE” due to the fact that Respondent made a little variation by omitting the letters “ib” in its mark, such a very significant or unnoticeable difference is incapable of removing the existence of confusing similarity between the contending marks of the parties if one has to consider them in their entirety and considering further that goods or products covered by the competing marks belong to the same class, as shown in Exhibits “B-1”, “E-1”, “C-1”, “D”, “D-1”, “E” vs. “F-1” and “F-2”.

Moreover, the Opposer has been spending tremendous amount of money for the advertisement and promotion of its “JOLLIBEE” and other trademarks nationwide and its business will be damaged and will suffer irreparable injury by the use and registration by the Respondent of the “JOLLEE” mark (Exhibit “E”).

Further, the style of lettering adopted in “JOLLEE” mark is the dominant feature of the mark of the Respondent. It is noteworthy to mention at this point that in determining confusing similarity where exact duplication of the contending marks is wanting that the test of dominancy is the applicable rule.

Thus, the Supreme Court, particularly in the cases of *Co Tiong Sa v. The Director of Patents* (95 Phil. 1(1954)); *Sapolin Corp. vs. Balmaceda* (67 Phil. 705 ); and *Forbes Nurma & Co. vs. Ang San To* ( 40 Phil 272 ), applied the dominancy test in determining the existence or confusing similarity between trademarks. The Supreme Court categorically ruled in these cases that if there is similarity with the essential or dominant feature of the trademark, despite some differences or variations in detail, there is infringement.

Thus, with the predominance of the style of lettering adopted in “JOLLEE” which is also the same style of lettering in Opposer’s “JOLLIBEE” trademark, the inevitable conclusion is, there is confusing similarity between the trademark “JOLLIBEE” and “JOLLEE” specially considering the fact both marks are being used on products falling under Class 30 of the International Classification of Goods i.e., food and ingredient of food.

Moreover as held in the case of *ESSO Standard Eastern, Inc. vs. Court of Appeals*, 116 SCRA 336, infringement of trademark depends on whether the goods of the two contending parties using the same trademark such as “ESSO” are so related as to lead the public to be deceived. “Goods are related when they belong to the same class or have the same descriptive

properties, when they possess the same physical attributes or essential characteristics with reference to their form, composition, texture or quality. They may also be related because they have the same purpose or are sold in grocery stores. Thus, biscuits were held related to milk because they are both food products. Soap and perfume, lipstick and nail polish are similar related because they are common household items nowadays. The trademark "Ang Tibay" for shoes and slippers was disallowed to be used for shirts and pants because they belong to the same general class of goods. Soap and pomade, although non-competitive, were held to be similar or belong to the same class, since both are toilet articles.

"xxx"

The foregoing conclusion is all the more strengthened when Respondent allowed itself to be declared in default, as held in the case on DELBROS HOTEL Corp. vs. Intermediate Appellate Court, 159 SCRA 533,543 (1988) that:

"Fundamentally, default orders are taken on the legal presumption that in failing to file an Answer, the Defendant does not oppose the allegations and relief demanded in the complaint."

Indeed this Office cannot but notice the lack of concern the Respondent had shown in protecting the mark it had applied for registration, contrary to the disputable presumption that a person takes ordinary care of his concern enunciated in Sec. 3 (d) of Rule 131 of the Rules of Court.

WHEREFORE, the instant Notice of Opposition is, as it is hereby SUSTAINED. Application bearing Serial No. 86200 for the mark filed by Food of the Orient and Marketing Ventures, Inc., is hereby, REJECTED.

Let the filewrapper of the trademark application for "JOLLEE", subject matter of this case be forwarded to the Administrative, Financial and Human Resource Development Services Bureau for appropriate action in accordance with this Decision with a copy to be furnished the Bureau of Trademarks (BOT) for information and to update its record.

SO ORDERED.

Makati City, September 11, 2000.

ESTRELLITA BELTRAN ABELARDO  
Director