

**JOLLIBEE FOODS CORPORATION,**  
*Opposer,*

**-versus-**

**ZESTAR FOOD CORPORATION,**  
*Respondent-Applicant.*

X-----X

**IPC No. 14-2012-00534**

Opposition to:

Appln. Serial No. 4-2011-000859

Date Filed: 26 January 2011

**TM: JOLLYBIG**

### NOTICE OF DECISION

#### QUISUMBING TORRES

*Counsel for Opposer*  
12<sup>th</sup> Floor, Net One Center  
26<sup>th</sup> Street corner 3<sup>rd</sup> Avenue,  
Crescent Park West, Bonifacio Global City, Taguig

#### ESTURAS LAW OFFICE

*Counsel for Respondent- Applicant*  
Room 205, Puso ng Maynila Building,  
1046 United Nations Avenue corner Mabini Street,  
Ermita, Manila

#### GREETINGS:

Please be informed that Decision No. 2016 - 428 dated 29 November 2016 (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, 29 November 2016.

**MARILYN F. RETUAL**

IPRS IV

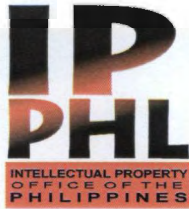
Bureau of Legal Affairs

**Republic of the Philippines**  
**INTELLECTUAL PROPERTY OFFICE**

Intellectual Property Center # 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio,

Taguig City 1634 Philippines • [www.ipophil.gov.ph](http://www.ipophil.gov.ph)

T: +632-2386300 • F: +632-5539480 • [mail@ipophil.gov.ph](mailto:mail@ipophil.gov.ph)



JOLLIBEE FOODS CORPORATION, }  
Opposer, }  
-versus- }  
ZESTAR FOOD CORPORATION, }  
Respondent-Applicant. }  
x-----x

IPC No. 14-2012-00534

Opposition to:  
Application No. 4-2011-000859  
Date Filed: 26 January 2011  
Trademark: "JOLLYBIG"

Decision No. 2016- 428

### DECISION

JOLLIBEE FOODS CORPORATION<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-000859. The application, filed by Zestar Food Corporation<sup>2</sup> ("Respondent-Applicant"), covers the mark "JOLLYBIG" for use on "marshmallow" under Class 32 of the International Classification of Goods and Services.<sup>3</sup>

The Opposer alleges:

x x x

"I. The grounds for opposition are as follows:

"1. Opposer is known as Jollibee Foods Corporation. It has been in existence for nearly four 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, Opposer has continuously used the JOLLIBEE name and mark in each Jollibee outlet in almost all product packaging, advertising and promotional materials. Opposer and its JOLLIBEE brand is recognized as one of our country's greatest success stories and is an undeniable symbol of Filipino pride worldwide.

"2. Opposer respectfully comes before the Honorable Office to ask for the rejection of the application for the mark JOLLYBIG sought to be registered by Respondent-Applicant for being confusingly similar to Opposer's name and marks. Opposer is the registered owner and first user of the internationally well-known JOLLIBEE mark and other related JOLLIBEE and JOLLY trademarks.

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

<sup>1</sup>A domestic corporation duly organized and existing under the laws of the Republic of the Philippines, with address at the 7<sup>th</sup> Floor, Jollibee Plaza Building, Emerald Avenue, Ortigas Center, Pasig City, Philippines.

<sup>2</sup>A domestic corporation with address at #546 Elcano St., Binondo, Manila, Metro Manila, Philippines.

<sup>3</sup>The 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.

x x x

"4. The registration of the mark JOLLYBIG 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 a mark that:

x x x

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

x x x

"6. 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 the 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' trademark. Please note that none of the registrations or advertising presented in the 'In-N-Out' case occurred in the Philippines.

"7. 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

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

"9. The JOLLIBEE mark was first used in the Philippines on 26 January 1978 for quick-service restaurants serving food and beverages. After thirty-four (34) continuous years in business, there are now over 758 JOLLIBEE restaurants in the Philippines alone. In 1986, the first international JOLLIBEE restaurant located in Taiwan opened and there are now 83 JOLLIBEE restaurants abroad located in United States of America, Vietnam, Brunei, Jeddah, Qatar, Hong Kong and Kuwait. The patronage for the JOLLIBEE products is so strong that Filipinos, especially overseas, always form long lines to welcome every store opening. In total, there are more than 830 JOLLIBEE restaurants worldwide serving an estimate of more than 2 million customers on a daily basis.

"10. Following are some of the highlights in the Opposer's history:

"11. It is worth emphasizing that Opposer has continuously used the JOLLIBEE Trademarks in each Jollibee outlet and in almost all product packaging, advertising and promotional materials. Its products and services can



also be viewed online through its website [www.jollibee.com.ph](http://www.jollibee.com.ph) where the JOLLIBEE Trademarks are prominently featured. This shows that the JOLLIBEE mark 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.

"12. It should also be noted that building brand awareness and identity has been central to Opposer's business from its early years. Accordingly, Opposer has invested approximately more than Php 1 Billion for advertising and promotions annually for the years 2010 and 2011. Over the years, this investment has won recognitions and awards as it produced some of the most memorable images in Philippine advertising history, featuring now famous terms such as 'Langhap Sarap' and products such as the iconic 'CHICKENJOY' and 'YUMBURGER'. Among the celebrities that have endorsed the JOLLIBEE restaurant and its products are Aga Muhlach, Sarah Geronimo, Sam Milby, Gerald Anderson, Kim Chiu, Mark Bautista, Enchong Dee, Sam Concepcion, and most recently, Jessica Sanchez, who were featured in equally popular television and print advertisements. Some of the older advertisements can be seen on internet sites such as YouTube ([www.youtube.com](http://www.youtube.com)) where they have thousands of 'hits' from viewers who continue to enjoy watching the advertisements.

"13. Opposer invests just as much, if not more, to making sure that it produces only the best-quality products and services. This attention to quality has resulted in Opposer being among the most recognized and respected businesses in the country. Among the local and international awards received by Opposer are identified below:

x x x

"14. Without a doubt, Opposer's long, continuous and extensive use, promotion and advertising of its JOLLIBEE Trademarks have created a brand that is so popular throughout the Philippines and around the world that a mere mention of the words 'JOLLIBEE' and 'JOLLY' or a mere look at the words 'JOLLIBEE' and 'JOLLY' would immediately cause the consuming public to associate the same with Opposer and its restaurants and other related food products and services.

"15. The renown attributable to Opposer and its JOLLIBEE Trademarks are well-documented. Various articles from Yahoo! Travel, Yahoo! News, The Philippine Star, GMA News, CNN Money, The New York Times, Los Angeles Times, Business World Online, and various blogs from different parts of the world attesting to the renown and well-known status of Opposer and its JOLLIBEE Trademarks worldwide, particularly in the United States of America, Brunei, United Arab Emirates, China, Qatar, Kuwait, Vietnam, Hong Kong, and Singapore have been published. Reproduced below is a portion of the most recent article from Yahoo! Travel entitled 'Best fast-food chains in the world'.

x x x

"16. In the Philippines, the JOLLIBEE Trademarks have been registered by Opposer with the Intellectual Property Office. In total, Opposer owns seventy-four (74) registrations and has eight (8) pending applications for

the JOLLIBEE Trademarks, among related marks. The details of some of these marks are, as follows:

x x x

"17. Internationally, the JOLLIBEE Trademarks have also been registered and applied for registration by Opposer. In total, Opposer owns 199 registrations and has 105 pending applications for the JOLLIBEE Trademarks abroad. The details of some of these marks are, as follows:

x x x

"18. Opposer has invested heavily not only in registering its trademarks but also in enforcing its intellectual property rights. Opposer has achieved notable successes, including one against a mark that appropriated the 'JOLLY' element in Jollibee Foods Corporation vs. Atlas Publishing Company, Inc. (IPC No. 14-2006-00113). This is a trademark opposition case decided on 25 February 2007 against the mark JOLLY KID covering goods under Class 16. In this case, the Honorable Office already recognized the well-known status of the JOLLIBEE Trademarks and stated that:

x x x

"19. In sum, the foregoing exclusively shows that JOLLIBEE is a well-known mark. Not only has it met the standard set in the 'In-N-Out' case, i.e. foreign trademark registrations and advertisements, the evidence presented shows that the JOLLIBEE mark has exceeded this standard, having been registered, used and promoted extensively in the Philippines and abroad. Equally noteworthy is the degree of recognition and brand value attributable to the JOLLIBEE name and mark, as evidenced by the numerous third-party publications and awards recognizing the brand's success. Lastly, the Honorable Bureau itself in Jollibee Foods Corporation vs. Atlas Publishing Company, Inc. has already recognized the well-known mark status of the JOLLIBEE mark and this judgment is further reinforced by the evidence submitted with this opposition.

"20. The JOLLIBEE Trademarks are arbitrary trademarks used on Opposer's goods and services. The terms 'JOLLY' and 'JOLLI' as attached to food-related products and services are unique and very much associated with the Opposer. It is therefore surprising that notwithstanding a boundless choice of words, phrases and symbols, Respondent-Applicant has chosen a mark that closely resembles Opposer's JOLLIBEE Trademarks for use on similar, related and competing goods. In the absence of a plausible explanation from Respondent-Applicant as to how this happened, it is only logical to conclude that Respondent-Applicant deliberately appropriated the similar mark JOLLY BIG to trade on the already established goodwill of the JOLLIBEE Trademarks.

"21. Respondent-Applicant's mark JOLLYBIG is confusingly similar to Opposer's well-known JOLLIBEE Trademarks, as shown below:

"21.1. Respondent-Applicant's mark JOLLYBIG is confusingly similar to Opposer's JOLLIBEE owing to the identity of the first two (2) syllables, i.e. JOLLY vis-à-vis JOL-LI, and the similarity of the last syllables, i.e. BIG vis-à-vis BEE. The similarity is likely to cause public confusion, particularly considering that Respondent-Applicant's

application covers food products for which Opposer is known for. In McDonald's Corporation vs. Macjoy Food Corporation, where the MACJOY & DEVICE mark was held to be confusingly similar to the McDonald's Marks, the Supreme Court held:

x x x

"21.2. Apart from the similarity between the opposed mark and Opposer's well-known JOLLIBEE mark, Opposer also uses and has registrations for the element 'JOLLY' in the same and related classes covered by the opposed mark. The 'JOLLY' in Respondent-Applicant's mark is identical in appearance, spelling, pronunciation and meaning to Opposer's registered marks JOLLY SHAKES, JOLLY KRUNCHY TWIRL, JOLLY CRISPY FRIES, JOLLY CHEEZY FRIES, JOLLY 'ZERTS, and JOLLY HOTDOG.

"21.3. Aside from the identity of majority of the letters in the competing marks, even the font used by Respondent-Applicant is similar to the font used by Opposer in its products and services, and both are also written with the letter J in upper case and the rest of the letters in lower case, to wit:

x x x

"21.4. It is also noteworthy that Respondent-Applicant seeks to register the mark JOLLYBIG for 'marshmallow' in Class 30, under which class the JOLLIBEE Trademarks are also used and registered. It is settled in Philippine jurisprudence that a registered owner is protected not only for the goods and services covered by its registration but also for those covered by the normal potential expansion of its business.

x x x

"22. 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.

"23. Opposer has not consented to Respondent-Applicant's use and registration of the confusingly similar mark JOLLYBIG, or any other mark identical or similar to the JOLLIBEE Trademarks.

"24. The confusing similarity of Respondent-Applicant's mark JOLLYBIG with Opposer's JOLLIBEE Trademarks 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 the JOLLIBEE Trademarks. Hence, the registration of Respondent-Applicant's mark will be contrary to Section 123.1 (d) of the IP Code.

"25. Being the owner of the internationally well-known and registered JOLLIBEE Trademarks, 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

"26. Respondent-Applicant's use of the mark JOLLYBIG on 'marshmallow' in Class 30, for which Opposer's JOLLIBEE Trademarks are also used and registered, will mislead the purchasing public into believing that Respondent-Applicant's goods are produced by, 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 mark JOLLYBIG.

"27. Moreover, the use by Respondent-Applicant of the mark JOLLYBIG in relation to goods which are similar and/or closely related to Opposer's goods and services for which the JOLLIBEE Trademarks are used will take unfair advantage of, dilute the goodwill, and diminish the distinctive character or reputation of Opposer's JOLLIBEE Trademarks.

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

x x x

"29. Opposer's use of the JOLLIBEE Trademarks in relation to goods under Class 30, as well as on related goods and services, is unique and distinctive. Respondent-Applicant's use of JOLLYBIG in relation to similar and related goods in the same Class 30 will indubitably detract from this uniqueness and, ultimately, diminish the ability of the JOLLIBEE Trademarks to distinguish Opposer's goods and services from those of other business entities.

"30. Opposer's goodwill on its JOLLIBEE Trademarks 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

"31. Moreover, considering the substantial investment incurred by Opposer in promoting its goods and services and in identifying itself throughout the world using the JOLLIBEE Trademarks, Respondent-Applicant's attempt to register a mark similar to Opposer's and in exploiting the same can only result in Respondent-Applicant unduly enriching itself at the expense of Opposer.

"32. The foregoing discussion indubitably shows that Respondent-Applicant has no right whatsoever to register the confusingly similar mark JOLLYBIG in its name for being violative of Opposer's long vested right to the registered and world-famous JOLLIBEE Trademarks. The subject application should therefore be denied in accordance with the provisions of the IP Code, as well as the Paris Convention.

The Opposer's evidence consists of the Notice of Opposition; the Affidavit of Atty. Gonzalo D.V. Go III; representative samples of Philippine registrations for the



JOLLIBEE mark and other related JOLLIBEE and JOLLY trademarks; copies of Philippine Trademark Registration Nos. 4-2009-006965, 4-2004-006392, 4-2005-006933, 4-2003-001019, 4-2009-006903, 4-2009-006906, 4-2009-006907, 4-2005-003292, 4-2005-001998, 4-2000-004772, 4-2005-007558, 4-2000-007421, 4-2010-002055, 4-2009-006901, 4-2009006900, 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, 4-2011-003561, 4-2010-004237, 4-2011-003543, 4-2011-003613, 4-2012-000614, 4-2012-001250, 4-2008-007562 for the marks JOLLY CRISPY FRIES, JOLLY CHEEZY FRIES, JOLLY SHAKES, JOLLY HOTDOG, JOLLY HOTDOG SARAP ON-THE-MOVE, JOLLIBEE CRISPY FRIES, BEST FRIENDS FRIES, JOLLY 'ZERTS, JOLLY KRUNCHY TWIRL, JOLLIBEE, JOLLIBEE LOGO & DEVICE, JOLLIBEE BREAKFAST JOYS, JOLLIBEE CHAMP, JOLLIBEE CHAMP. BIG BURGER GOODNESS LIKE NO OTHER, JOLLIBEE CHICKEN BARBEQUE INSIDE A RECTANGULAR DEVICE, JOLLIBEE CHICKEN BARBEQUE DELICIOUS INSIDE AND OUT INSIDE A RECTANGULAR DEVICE (IN COLOR), JOLLIBEE CHICKEN BARBEQUE INSIDE A RECTANGULAR DEVICE, JOLLIBEE FOUNDATION, JOLLIBEE YUMBURGER AND DEVICE, JOLLIBEE SUPER MEALS, JOLLIBEE KIDS TV INSIDE A SQUARE DEVICE (IN COLOUR), JOLLIBEE KIDS TV AND DEVICE WITH JOLLIBEE CHARACTER ON THE LEFT SIDE IN COLOUR), JOLLIBEE KIDS MEAL INSIDE A CIRCLE DEVICE WITH A GRAPHIC DESIGN OF A FORK ON THE LEFT SIDE AND A SPOON ON THE RIGHT SIDE AND A JOLLIBEE CHARACTER ON THE UPPER LEFT SIDE (IN COLOUR), JOLLIBEE KIDS CLUB INSIDE A CIRCLE DEVICE WITH A GRAPHIC DESIGN OF FACES OF KIDS AND A JOLLIBEE CHARACTER ON THE UPPER LEFT SIDE (IN COLOUR), JOLLIBEE KIDS CLUB INSIDE A CIRCLE DEVICE WITH A GRAPHIC DESIGN OF FACES OF KIDS (IN COLOUR), JOLLIBEE MASCOT HOUSE AND DEVICE (IN COLOR), JOLLIBEE MASCOT HOUSE AND DEVICE (IN BLACK & WHITE), JOLLIBEE KIDS TV INSIDE A SQUARE DEVICE, JOLLIBEE KIDS TV AND DEVICE WITH JOLLIBEE CHARACTER ON THE LEFT SIDE, JOLLIBEE KIDS MEAL INSIDE A CIRCLE DEVICE WITH A GRAPHIC DESIGN OF A FORK ON THE LEFT SIDE AND A SPOON ON THE RIGHT SIDE, JOLLIBEE KIDS MEAL INSIDE A CIRCLE DEVICE WITH A GRAPHIC DESIGN OF A FORK ON THE LEFT SIDE AND A SPOON ON THE RIGHT SIDE AND A JOLLIBEE CHARACTER ON THE UPPER LEFT SIDE, JOLLIBEE KIDS CLUB INSIDE A CIRCLE DEVICE WITH A GRAPHIC DESIGN OF FACES OF KIDS, JOLLIBEE KIDS CLUB INSIDE A CIRCLE DEVICE WITH A GRAPHIC DESIGN OF FACES OF KIDS AND JOLLIBEE CHARACTER ON THE UPPER LEFT SIDE, JOLLIBEE IN TRAPEZOID AND BEE HEAD DEVICE, JOLLIBEE IN TRAPEZOID DEVICE, JOLLIBEE CHICKEN BARBEQUE DELICIOUS INSIDE AND OUT INSIDE A RECTANGULAR DEVICE, JOLLIBEE IN TRAPEZOID DEVICE (IN COLOR), JOLLIBEE IN TRAPEZOID AND BEE DEVICE (IN COLOR), JOLLIBEE GRILLED PORK TENDERS, JOLLIBEE MAAGA ANG PASKO LOGO (BLACK & WHITE) and JOLLIBEE MASCOT DESIGN; representative samples of food packaging and containers



bearing the JOLLIBEE Trademarks; screenshots of Opposer's website, www.jollibee.com.ph featuring the various JOLLIBEE food and food products as well as JOLLIBEE restaurant locations in the Philippines and overseas; 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 JOLLIBEE Trademarks, table showing the details of Opposer's applications and registrations for the JOLLIBEE Trademarks from different countries worldwide; various articles and blogs from different parts of the world attesting to the renown and well-known status of Opposer and its JOLLIBEE Trademarks worldwide; Opposer's coffee table book entitled 'A 25-Year Love Story with the Pinoy'; Opposer's Power Point presentation; copies of Opposer's 2002- 2011 Annual Reports; list of awards received by Opposer; and the 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 certificate of non-forum shopping on behalf of the Opposer and the authority of Quisumbing Torres to represent Opposer in the proceedings.<sup>4</sup>

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 13 December 2012. The Respondent-Applicant filed their Answer on 07 January 2013 and avers the following:

x x x

"3. The Opposer's threshold argument that the registration of defendant-applicant's trademark 'JOLLYBIG' is contrary to the provisions of Section 123.1 (d), (e) and (f) of Republic Act No. 8293, as amended, is without factual and legal basis on account of the following:

"(a) Defendant-Applicant is aware of the existence, popularity, T.V. commercials, awards and recognition in the Philippines and internationally of Jollibee Food Corporation being a known fast-food chain in the Philippines, as well as, the registration of its trademarks 'JOLLIBEE' and 'JOLLY' food brands.

"(b) However, Defendant-Applicant's mark is not in any wise, manner or respect nearly resemble as to deceive or cause confusion nor is identical with or confusingly similar to or constitutes a translation of a mark well known internationally and in the Philippines or registered in the Philippines.

"(c) R.A. 8293, Sec. 123.1 (d) postulates three (3) basic factors to determine if the applicant's mark is 'Identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the following, namely: (1) the same goods or services; (2) closely related goods or services; and (3) if it nearly resembles such a mark as to be likely to deceive or cause confusion.' Under none of these crucibles does Opposer's mark fall as to suggest intimately or even remotely its confusing analogy with Defendant-Applicant's mark and vice-versa.

---

<sup>4</sup>Marked as Exhibits "A" to "Y", inclusive.

"(d) There is nothing in Defendant-Applicant's trademark 'Jollybig' to enunciate or vocalize Opposer's trademark 'Jollibee' nor is there a similarity of sound or pronunciation in both trademarks. Hence, the first factor finds no application to Defendant-Applicant's trademark.

"(e) Defendant-Applicant's mark can hardly, if at all, be regarded as confusingly similar vis-à-vis Opposer's mark because although both marks contain the word 'Jolly', Defendant-Applicant's mark is too unlikely to cause deception among the public, since only one product is being sold in the market compared to fast-food chain products of the Opposer. Therefore, no confusing similarity whatsoever is engendered or produced in the process on account of their distinct and disparate distinguishing features and classification of food products.


"(f) The Opposer's trademarks 'JOLLIBEE' and 'JOLLY' are used for food chain products, particularly the following: jolly 'zerts, jolly shakes, jolly crunchy twirl, jolly crispy fries, jolly cheezy fries, jolly hotdog, jolly spaghetti and other Jollibee food brand products registered under its Trademark. Whereas, Defendant-Applicant's mark covers marshmallow products only. In this sense, the buying public would neither be deceived nor be confused between the similarities of the Opposer's mark and Defendant-Applicant's mark since the products being sold by both parties are not the same.

"(g) The Oppositor's contention that 'Without a doubt, Opposer's long and continuous and extensive use, promotion and advertising of its JOLLIBEE Trademarks have created a brand that is so popular throughout the Philippines and around the world that a mere mention of the words 'JOLLIBEE' and 'JOLLY' or a mere look at the words 'JOLLIBEE' and 'JOLLY' would immediately cause the consuming public to associate the same with Opposer and its restaurants and other related food products and services.

"(h) True, the 'JOLLIBEE' brands are recognized as one of the country's most famous and popular food chains all over the Philippines and in all its international franchises.

"(i) Does it mean that the Opposer has the right to own the exclusive use of the word 'JOLLY' upon the registration of its JOLLIBEE AND JOLLY Trademarks? Is the word 'JOLLY' automatically inter-related to Jollibee food products and marks?

"(j) Defendant-Applicant begs to disagree. Opposer cannot exclusively claim the word 'JOLLY' in all its food chain products, because, since time immemorial, said word has been in existence even before Jollibee food chains and products were established.

"(k) The term 'JOLLY' as defined in Merriam Webster Dictionary means full of high spirits and merry. Thus, it is a generic term which cannot be owned exclusively by anyone. 



"(l) The use of the Opposer and Defendant-Applicant's trademarks can be properly identified. The Opposer's trademark covers different classes of goods or services including Class No. 30 but without mentioning marshmallow products. On the other hand, Defendant-Applicant's trademark is, likewise, classified under Class No. 30 but for particular marshmallow products only. Hence, there is no truth to the assertion of the Opposer that the trademark 'JOLLYBIG' of the Defendant-Applicant would cause confusion or deceit to the buying public, and damage to the Opposer's registered and well-known trademark for being allegedly the same x x x

"(m) In Defendant-Applicant's sample label of Jollybig Long Marshmallows, it becomes manifest and crystal clear that Defendant-Applicant's mark offers no leeway for competition with Opposer's mark for vivid lack of confusing similarity with the latter's mark. x x x

"(n) Said sample label is a proof that Defendant-Applicant has no intention whatsoever to imitate, infringe and damage the reputation of Opposer's registered trademark.

"(o) On the whole, therefore, Defendant-Applicant's mark must be viewed and considered in its entirety, not alone or separately because of the word 'JOLLY' that is not even akin to or approximating Opposer's mark without the symbol of a 'BEE' because if viewed in its completeness, Defendant-Applicant's mark will not cause deception among the public for being allegedly confusingly similar.

"(p) Moreover, before our application was allowed, it was subjected to a very rigid and strenuous process, and after complying with the requirements, the IPRS-in-charge has permitted its registration.

"(q) The Defendant-Applicant believes and submits that, upon payment of the Notice of Allowance on June 22, 2011, and marked as Exhibit '3', the Intellectual Property Philippines (IPP), has unconditionally and decidedly accepted and approved the registration of the trademark 'JOLLYBIG' without question whatsoever as to its similarity to any other trademark that was registered under the IPP.

"4. Likewise devoid of merit is Opposer's second forefront contention that Defendant-Applicant's mark 'Jollybig' is confusingly similar to Opposer's mark 'Jollibee'. Nothing can be farther from the truth. In Defendant-Applicant's mark, the letter 'y' is very prominent and pronounced, while in Opposer's mark, the letter 'i' is readily visible. Moreover, Defendant-Applicant's mark ends in 'g', while Opposer's mark end in 'ee'. Hence, public confusion is very unlikely to occur, contrary to Opposer's pretense.

"5. In seeking the registration of its mark, Defendant-Applicant did not knowingly, willfully and in bad faith adopt Opposer's mark with the intention to ride on its well-known reputation, popularity, goodwill, and for being famous as known fast-food chains in the Philippines and abroad.

"6. The use by Defendant-Applicant of its mark will neither mislead the buying public nor amount to unfair competition, absent as is glaringly here the

similarity or likeness of said mark to Opposer's mark as to induce or give rise to confusion and consequent deception.

"7. The registration of defendant-applicant's mark will not violate the pertinent provisions of the Paris Convention in conjunction with R.A. 8293 or cause potential damage to the Opposer, much less unduly enrich Defendant-Applicant at the expense of the Opposer, in view of the manifest absence of confusing similarity between the two (2) trademarks.

The Respondent-Applicant's evidence consists of a sample mark for JOLLYBIG; copy of sample label for JOLLYBIG; and a copy of the Notice of Allowance with stamped date on 02 October 2012.<sup>5</sup>

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

The Opposer anchors its opposition on Sections 123.1, paragraphs (d), (e) and (f) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), to wit:

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;

<sup>5</sup>Marked as Exhibits "1" to "3".



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 JOLLYBIG resemble JOLLIBEE Trademarks such that confusion or deception is likely to occur? The marks are shown below:



JOLLIBEE

Opposer's trademarks



Respondent-Applicant's mark

This Bureau finds that while the product indicated in Respondent-Applicant's trademark application is not exactly similar to those covered by the Opposer's registration in Class 30, confusion is still likely to occur in this instance because of the close resemblance between the marks. Respondent-Applicant's mark JOLLYBIG adopted the dominant features of Opposer's mark JOLLIBEE. The JOLLYBIG mark is stylized and printed using the same font and colors of JOLLIBEE trademark/s which is predominantly red and white. JOLLYBIG appears and sounds almost the same as Opposer's trademark JOLLIBEE. The first four (4) letters and the 6<sup>th</sup> letter of both marks are the same. It could result to mistake with respect to perception because the marks sound so similar. Under the idem sonans rule, the following trademarks were held confusingly similar in sound: "BIG MAC" and "BIG MAK"<sup>6</sup>, "SAPOLIN" and LUSOLIN"<sup>7</sup>, "CELDURA" and "CORDURA"<sup>8</sup>, "GOLD DUST" and "GOLD DROP". The Supreme Court ruled that similarity of sound is sufficient ground to rule that two marks are confusingly similar, to wit:

Two letters of "SALONPAS" are missing in "LIONPAS": the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. And where goods are advertised over the radio, similarity in sound is of especial significance...."SALONPAS" and "LIONPAS", when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties.<sup>9</sup>

<sup>6</sup> *MacDonalds Corp, et. al v. L. C. Big Mak Burger*, G.R. No. L-143993, 18 August 2004.

<sup>7</sup> *Sapolin Co. v. Balmaceda and Germann & Co*, 67 Phil, 705.

<sup>8</sup> *Co Tiong SA v. Director of Patents*, G.R. No. L- 5378, 24 May 1954; *Celanes Corporation of America vs. E. I. Du Pont de Nemours & Co.* (1946), 154 F. 2d 146 148.)

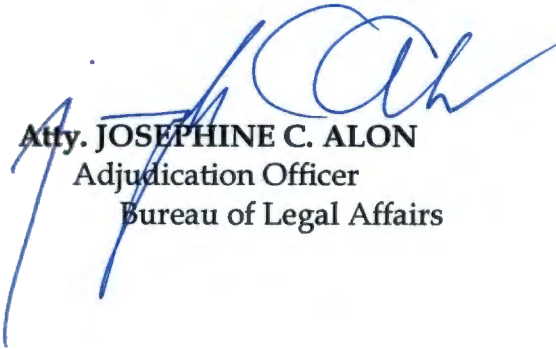
<sup>9</sup> *Marvex Commerical Co., Inc. v. Petra Hawpia & Co., et. al.*, G.R. No. L-19297, 22 Dec. 1966.

In conclusion, the subject trademark application is covered by the proscription under Sec. 123.1 par. (d) (iii) of the IP Code.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2011-000859 is hereby SUSTAINED. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 29 NOV 2016.



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