

JOLLIBEE FOODS CORPORATION,  
Opposer,

-versus-

AVEX DIGITAL, INC.(formerly Avex  
Entertainment, Inc.),  
Respondent- Applicant.

}  
} IPC No. 14-2014-00329  
} Opposition to:  
} Appln. Serial No. M/0000/01186984  
} Date Filed: 05 November 2013  
} TM: "BEETV"  
}

X-----X

### NOTICE OF DECISION

**JOLLIBEE FOODS CORPORATION**  
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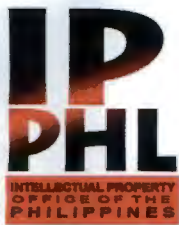
#### GREETINGS:

Please be informed that Decision No. 2017 - 302 dated July 21, 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, July 21, 2017.

  
**MARILYN F. RETUAL**  
IPRS IV  
Bureau of Legal Affairs



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

-versus-

**AVEX DIGITAL, INC. (formerly Avex  
Entertainment, Inc.),**  
*Respondent-Applicant.*

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**IPC No. 14-2014-00329**

Opposition to:  
Appln. Serial No. 01186984  
Date Filed: 5 November 2013  
**TM: "BEETV"**

**Decision No. 2017- 302**

### DECISION

JOLLIBEE FOODS CORPORATION ("Opposer")<sup>1</sup> filed an Opposition to Trademark Application Serial No. 01186984. The application filed by AVEX DIGITAL INC. ("Respondent-Applicant")<sup>2</sup>, covers the mark "BEETV" for use on "*downloadable music files; downloadable image files; downloadable video files; recorded compact discs; recorded video discs and video tapes*" under Class 9 and for "*providing music files through the Internet (not downloadable); providing video files through the Internet (not downloadable)*" under Class 41 of the International Classification of Goods and Services<sup>3</sup>.

The Opposer alleges the following grounds:

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

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

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

<sup>1</sup> A corporation organized under the laws of the Philippines with address at 17<sup>th</sup> Floor, Jollibee Plaza Building, Emerald Avenue, Ortigas Center, Pasig City, Philippines.

<sup>2</sup> A foreign corporation with address at 3-1-30, Minami-Aoyama Minato-ku 107-8577, Tokyo (JP).

<sup>3</sup> The 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.

**Republic of the Philippines  
INTELLECTUAL PROPERTY OFFICE**

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xxx

"4. The registration of the mark BEETV 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 xxx."

The Opposer's evidence consists of the following:

1. Decision dated 25 February 2007 in Jollibee Foods Corporation v. Atlas Publishing Company, Inc., IPC No. 14-2006-00113;
2. Secretary's Certificate;
3. Affidavit of Atty. Sheilah Marie P. Tomarong-Cañabano;
4. Representative samples of trademark registrations for the mark JOLLIBEE, JOLLIBEE KIDS TV and other Jollibee marks;
5. Sample materials for marketing bearing the mark JOLLIBEE KIDS TV;
6. Compact disc containing Jollibee advertisements and other promotional materials;
7. Screenshot of Opposer's website, www.jollibee.com.ph;
8. Table showing Opposer's applications and registration of its Jollibee mark in other countries;
9. Representative samples of registrations and applications of Jollibee trademarks from other countries;
10. Various articles and blogs from other countries about the Jollibee trademarks;
11. Opposer coffee table book entitled "A 25-Year Love Story with the Pinoy";
12. Opposer's Powerpoint Presentation;
13. Opposer's Annual Report for the years 1993-2013; and
14. List of awards received by Opposer.

This Bureau issued a Notice to Answer on 01 October 2014 and served a copy thereof to Respondent-Applicant on 10 October 2014. On 13 January 2015, Respondent-Applicant filed the Answer alleging the following:

"1. Respondent-applicant's mark BEETV is not confusingly similar with Opposer's marks JOLLIBEE and JOLLIBEE KIDS TV; hence, registerable.

"2. Confusion is highly unlikely since the nature of the goods covered by Respondent-Applicant's mark and the Opposer's mark cover non-related and non-competing goods.

"3. Contrary to Opposer's contention, the mark JOLLIBEE is only well-known for its chain of fast food restaurants; and

"4. Contrary to Opposer's contention, Respondent-Applicant has no intention to benefit from the Opposer's alleged reputation, goodwill and advertising.



Respondent-Applicant's evidence consists of the following:

1. Printout of the details of the mark QUEEN BEE from the IPOPHL Trademark Database;
2. Printout of the details of the mark WORKING BEE & Device from the IPOPHL Trademark Database;
3. Printout of the details of the mark KINDER BEE from the IPOPHL Trademark Database;
4. Printout of the details of the mark BEE LUCKY from the IPOPHL Trademark Database;
5. Printout of the details of the mark QUIZ BEE from the IPOPHL Trademark Database;
6. Printout of the details of the mark KILLER BEE from the IPOPHL Trademark Database;
7. Copy of the registrations of the mark BEETV in Indonesia, Malaysia and Thailand;
8. Copy of Respondent-Applicant's advertisements, articles and other promotional materials for the mark BEETV;
9. Printout of the relevant page of the website <http://pc.beetv.jp/>;
10. Copy of printouts from the websites Facebook, Twitter, LinkedIn and YouTube showing the BEETV mark;
11. Copy of Respondent-Applicant's Annual Report for 2014;
12. Notarized and legalized Certification dated 26 December 2014;
13. Notarized and legalized Affidavit-Testimony of Yoshinori Shiba dated 26 December 2014;
14. Request for recordal of change of name and address of Respondent-Applicant from Avex Entertainment, Inc. to Avex Digital, Inc. filed with WIPO; and
15. Acknowledgement receipt from WIPO.

Pursuant to Office Order No. 154, s. 2010, the case was referred to the Alternative Dispute Resolution ("ADR") for mediation on 28 January 2015. However, the parties failed to settle their dispute. On 15 October 2015, the preliminary conference was terminated and the parties were directed to submit position papers. On 23 October 2015, the Respondent-Applicant filed its Position Paper while Opposer did so on 26 October 2015.

Should the Respondent-Applicant's BEETV mark be allowed registration?

Section 123.1 (d), (e) and (f) of Republic Act No. 8293, otherwise known as the "Intellectual Property Code of the Philippines (IP Code)", as amended, provides for the grounds for registration of a mark, to wit:

**Section 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;

x        x        x

(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 services 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.

Explicit from the afore-cited provision of the IP Code that whenever a mark subject of an application for registration resembles another mark which has been registered or has an earlier filing or priority date, or resembles a well-known mark, said mark cannot be registered.

Records will show that at the time Respondent-Applicant applied for registration of its mark BEETV on 05 November 2013, Opposer already has an existing registration for its mark JOLLIBEE KIDS TV and JOLLIBEE KIDS TV INSIDE A SQUARE issued way back in 16 December 2010 for goods under Classes 16, 35 and 41. As such, pursuant to Section 138 of the IP Code, Opposer's certificate of registration is "a prima facie evidence of the registrant's ownership of the mark, and of the exclusive right to use the same in connection with the goods or services specified in the certificate and those that are related thereto."

But are the marks of the parties confusingly similar as to likely cause confusion, mistake or deception on the part of the buying public?

The marks of the parties are herein reproduced for comparison:



Opposer's Mark



Respondent-Applicant Mark

BEETV



Respondent-Applicant's mark is similar to Opposer's because of the presence of the words "BEE" and "TV", which is also part of the Opposer's JOLLIBEE KIDS TV mark. However, this Bureau finds that the presence of the word "BEE" and "TV" in the marks are insufficient to establish a finding of confusing similarity between the competing marks to sustain the opposition. The word "BEE" is a word commonly used as a stand-alone mark or in combination with other word or words. That is why, the word "BEE" in combination with other terms or even a device has been registered as a trademark in this Office in various classes. As correctly pointed out by Respondent-Applicant, the IPOPHL's Trademark Database would show that the term "bee" has been used in various trademarks such as QUEEN BEE, WORKING BEE, KINDER BEE, BEE LUCKY, QUIZ BEE and KILLER BEE, among others. Since the word "bee" is widely used as a trademark and taken alone is not very distinctive as to effectively identify the source of goods or services. On the other hand, the letters "TV" stands for television which cannot be exclusively appropriated by anyone.

Furthermore, the goods of the parties are non-competing and not related. Opposer's JOLLIBEE KIDS TV mark is used on *"papers, cardboard and goods made from these materials, not included in other classes, namely, paper and cardboard boxes, paper and cardboard cartons, paper and cardboard carriers for food and beverages, paper and cardboard containers, paper and cardboard hand tags, paper and cardboard signboards; printed matter, bookbinding material, photographs, stationery; adhesives for stationery or household purposes; artists` materials; paint brushes, typewriters and office requisites (except furniture), instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers` type; printing blocks"* under Class 16; *"advertising services"* under Class 35; and *"educational and entertainment services, programs about kids values"* under Class 41. On the other hand, Respondent-Applicant's BEETV mark is used on *"downloadable music files; downloadable image files; downloadable video files; recorded compact discs; recorded video discs and video tapes"* under Class 9 and for *"providing music files through the Internet (not downloadable); providing video files through the Internet (not downloadable)"* under Class 41. While both marks are used on goods under Class 41, this cannot be a basis to deny the registration of Respondent-Applicant's mark.

In *Taiwan Kolin Corporation Ltd. v. Kolin Electronics Co., Inc.*<sup>4</sup>, the Supreme Court held:

In resolving one of the pivotal issues in this case—whether or not the products of the parties involved are related—the doctrine in *Mighty Corporation* is authoritative. There, the Court held that the goods should be tested against several factors before arriving at sound conclusion on the question of relatedness. Among these are:

- (a) the business (and its location) to which the goods belong;
- (b) the class of product to which the goods belong;
- (c) the product's quality, quantity, or size, including the nature of the package, wrapper or container;
- (d) the nature and cost of the articles;
- (e) the descriptive properties, physical attributes or essential characteristics with reference to their form, composition, texture or quality;
- (f) the purpose of the goods;
- (g) whether the article is bought for immediate consumption, that is, day-to-day household items;

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<sup>4</sup> G.R. No. 209843, 25 March 2015

- (h) the fields of manufacture;
- (i) the conditions under which the article is usually purchased; and
- (j) the channels of trade through which the goods flow, how they are distributed, marketed, displayed and sold.

As mentioned, the classification of the products under the NCL is merely part and parcel of the factors to be considered in ascertaining whether the goods are related. It is not sufficient to state that the goods involved herein are electronic products under Class in order to establish relatedness between the goods, for this only accounts for one of many considerations enumerated in *Mighty Corporation*. In this case, credence is accorded to petitioner's assertions that:

- a. Taiwan Kolin's goods are classified as home appliances as opposed to Kolin Electronics' goods which are power supply and audio equipment accessories;
- b. Taiwan Kolin's television sets and DVD players perform distinct function and purpose from Kolin Electronics' power supply and audio equipment; and
- c. Taiwan Kolin sells and distributes its various home appliance products on wholesale and to accredited dealers, whereas Kolin Electronics' goods are sold and flow through electrical and hardware stores.

Clearly then, it was erroneous for respondent to assume over the CA to conclude that all electronic products are related and that the coverage of one electronic product necessarily precludes the registration of similar mark over another. In this digital age wherein electronic products have not only diversified by leaps and bounds, and are geared towards interoperability, it is difficult to assert readily, as respondent simplistically did, that all devices that require plugging into sockets are necessarily related goods.

Clearly, even if the goods are classified under the same class, when the goods/services belong to different sub-classification, they are considered as different or unrelated goods/services. In this case, Respondent-Applicant's service is different from the service upon which the mark of Opposer is being used. In view thereof, the possibility that the consumers or the public in general will likely be confused or mistaken or be deceived that the product of Respondent-Applicant comes from, originated or sourced from or manufactured by Opposer is remote.

Moreover, this Bureau is also convinced that Respondent-Applicant did not adopt its BEETV mark merely to ride on the popularity of Opposer's mark. Records will show that Respondent-Applicant has been providing mobile TV content with a subscriber of more than 1 Million and is considered as the leading music and video content company in Japan thru the BEETV mobile app which was launched in 2009. Because of its popularity, the BEETV mark has gained its own goodwill and reputation through its presence in the online platform.

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.<sup>5</sup>

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<sup>5</sup>See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.



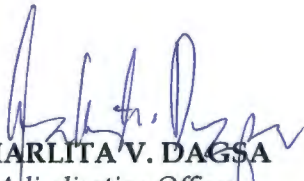
This Bureau finds that the Respondent-Applicant's mark meets this function.

Lastly, since there is no confusing similarity between the competing marks, there is no need to discuss on whether Opposer's mark is well-known.

WHEREFORE, premises considered, the instant opposition is hereby *DISMISSED*. Let the filewrapper of Trademark Application Serial No. 01186984 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 21 JUL 2017.

  
**MARLITA V. DAGSA**  
Adjudication Officer  
Bureau of Legal Affairs