



CHOCOSUISSE,
Opposer,

-versus-

SAPANAN GENERAL FOOD CO., LTD.,
Respondent-Applicant.

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}
} IPC No. 14-2011-00303
} Opposition to:
} Appln. Serial No. 4-2011-003400
} Date Filed: 24 March 2011
} TM: "SWISS 'Z GARDEN & DEVICE"
}

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 - 35 dated February 14, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 14, 2013.

For the Director:

Atty. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs



CHOCOSUISSE,

Opposer,

-versus-

SAPANAN GENERAL FOOD CO., LTD.,

Respondent.

x-----x

IPC No. 14-2011-00303

Case Filed: 23 September 2011

Opposition to:

Appln. Serial No.: 4-2011-003400

Filing Date: 24 March 2011

TM: "SWISS 'Z GARDEN & DEVICE"

Decision No. 2013 - 35

DECISION

CHOCOSUISSE ("Opposer")¹ filed on 23 September 2011 an opposition to Trademark Application Serial No. 4-2011-003400. The application, filed by SAPANAN GENERAL FOOD CO., LTD. ("Respondent-Applicant")², covers the mark "SWISS 'Z GARDEN & DEVICE" for use on "coffee, coffee-based beverages, cocoa, cocoa-based beverages, coffee flavoring, unroasted coffee, artificial coffee, confectionery, tea-based beverages and snacks made from flour" under Class 30³.

The Opposer alleges among other things, the following:

1. The word "SWISS" is a famous geographical indication for goods under International Class 30, i.e., chocolate, sugar confectionery, cocoa and other cocoa-based products, which goods are well-known to have particular qualities associated with their being products of Switzerland. Hence, the word "SWISS" cannot be used as mark for goods under class 30, if such goods do not come from Switzerland or are not in any way connected with Switzerland.
2. The mark "SWISS 'Z GARDEN & DEVICE" is not registrable under Section 123.1 (g) of Republic Act 8293 or the Intellectual Property Code, as it is likely to mislead the public, particularly as to the geographical origin of the goods.
3. Respondent-Applicant, in adopting "SWISS 'Z GARDEN & DEVICE" for its goods, is likely to cause confusion, or to cause mistake, or to deceive as

¹ Association of Swiss Chocolate Manufacturers with business address at Muenzgraben 6, Postfach, CH-3000 Bern 7, Switzerland.

² With address at 9/3 Bangchan Industrial Estate, SO1 4, SERITHAI Road, KAnnayao, Bangkok, 10230 THAILAND.

³ 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.

to the origin of its goods, for which it is liable for false designation of origin under Section 169 of R.A. No. 8293.

4. As a member of the WTO-TRIPS Agreement, the Philippines is duty-bound, under the principle of *pacta sunt servanda*, to refuse the registration of a trademark which contains or consists of a geographical indication of goods not originating in the territory indicated, if the use of said indication in the trademark for such goods is of such a nature as to mislead the public as to the true place of origin of the goods. This is provided in Article 22 (3), Section 3 of the TRIPS Agreement, which the Philippines had ratified.

The Opposer's evidence consists of the following:

Exhibit "A" – Affidavit of Dr. iur. Franz U. Schmid.

1. Annexes "C", "D", "E", "F", "G", "H" and "I" – Copies of certificate of registrations of the marks of the Opposer;
2. Annex "J" – Certificate of Reg. No. 1570455 for the mark SWISS;
3. Annex "K" – Certificate of Reg. No. 324971 for the mark SUISSE;
4. Annex "L" – Certificate of Reg. No. 325071 for the mark SWISS;
5. Annex "M" – Certificate of Reg. No. 325072 for the mark Switzerland;
6. Annex "N" – Certificate of Reg. No. 001483981 for the mark SWISS; and
7. Annex "O" – Certificate of Reg. No. 001484005 for the mark Switzerland.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant. However, no answer was filed. Hence, the instant opposition is submitted for decision based on the opposition and evidence submitted by the Opposer.

Should the Respondent-Applicant's trademark application be allowed?

The Opposer in this instant opposition, ("CHOCOSUISSE") is the Association of Swiss Chocolate Manufacturers which was founded on 01 July 1901. It is a cooperative which represents the common interests of the Swiss Chocolate products which fall under Class 30 of the International Classification of Goods. It has an existing Certification Mark "SWISS" registered on 05 December 1989 bearing Reg. No. 1,570,455 issued by the United States Patent and Trademark Office for chocolate and products made from chocolate under Class 30 of the International Classification of Goods⁴ and likewise registered in Canada under Reg. No. 325071 on 20 March 1987⁵. OHIM of European Union, Certificate of Registration No. 001483981 for SWISS Class 30 of the International Classification of Goods⁶.

In this regard, the Opposer opposes the Respondent-Applicant's trademark pursuant to Sec. 123.1 (g) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). The mark applied for registration by the Respondent-Applicant's as

⁴ Annex "J".

⁵ Annex "L".

⁶ Annex "N".

shown below, obviously makes reference to the Switzerland. Not only is the word "SWISS" present, the mark also depicts mountain which reminds one of the "Alps" mountain ranges, a big part of it being bounded by Switzerland.



The Respondent-Applicant however, is not based in Switzerland but in the Philippines and that the products covered by the Trademark, cocoa, cocoa-based beverages under Class 30 which is similar to chocolate are manufactured outside Switzerland. Thus, the trademark will clearly mislead the buying public into believing that its products originate in Switzerland, when in fact they do not but actually in the Philippines.

It cannot be denied therefore that when the public sees chocolate products bearing the word "SWISS", it immediately identifies them as high quality chocolate products found in Switzerland.

It is difficult to understand why the Respondent-Applicant included the word SWISS as part of its trademark if not to mislead the public that its products are originating from the same place considering that Switzerland is popularly known for chocolate products of superior quality than products coming from other territories or regions.

Accordingly, the Respondent-Applicant's trademark application is proscribed by Section 123.1 (g) of the IP Code.

WHEREFORE, premises considered the opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-003400, together with a copy of this Decision be returned to the Bureau of Trademarks for information and appropriate actions.

SO ORDERED.

Taguig City, 14 February 2013.


ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs

