

WENGER S.A.,
Opposer,

-versus-

SWISSGEAR SARL,
Respondent-Applicant.

} **IPC No. 14-2014-00456**
} Opposition to:
} Appln. Ser. No. 4-2014-0009515
} Date Filed: 31 July 2014

} **TM: SHIELD-SWISSGEAR**

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NOTICE OF DECISION

SALUDO FERNANDEZ AQUINO & TALEON

Counsel for Opposer
5858 SAFA Building, Alfonso corner
Fermina Streets, Poblacion, Makati City

FEDERIS & ASSOCIATES LAW OFFICES

Counsel for Respondent-Applicant
Suites 2005 88 Corporate Center
141 Valera corner Sedeño Streets,
Salcedo Village, Makati City

GREETINGS:

Please be informed that Decision No. 2017 - 385 dated 22 November 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, 23 November 2017.



MARILYN F. RETUAL
IPRS IV

Bureau of Legal Affairs



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

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-versus-

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Opposition to:
Appln. Serial No. 4-2014-009515
Date Filed: 31 July 2014
TM: SHIELD-SWISSGEAR

Decision No. 2017- 385

DECISION

WENGER S.A.,¹ ("Opposer") filed an Opposition to Trademark Application Serial No. 4-2014-009515. The application, filed by SWISSGEAR SARL² ("Respondent-Applicant") covers the mark **SHIELD-SWISSGEAR** for use on goods such as "spray guns for paint; current generators; water pump; electric egg beater; electric fruit peeler; electric salad mixer; whisks, electric, for household purposes; can openers, electric; coffee grinders, other than hand-operated; fruit presses, electric, for household purposes; dish washer portable electric notch saw; automatic screwdriver; portable electric drilling machine; pneumatic nailing gun; air nailer; electrical hand tools; glue guns, electric; tungsten carbide cutter; electric hand drills; stone grinding wheel; blades [parts of machines]" under class 7; "electric shaver; nail clipper; hair clipper; survival knife; flower cutter; universal cutting pliers; axes; spanners [hand tools]; wrenches [hand tools]; shovels [hand tools]; hand-operated nailing guns; insecticide atomizers (hand tools); lifting jacks, hand-operated; ice picks; tools for slaughtering animals; garden tools, hand-operated; perforating tools [hand tools]; emery grinding wheels; emery files; table knives; forks; spoons; army knife; electric iron" under class 8; "receivers (capturing fitness data); electric measuring devices; headphones; GPS function watch; watch with altimeter, barometer & compass; monitoring apparatus, electric; blank USB flash memory drives; electronic whiteboards; mobile phone and tablet computer accessories, namely, batteries, electric battery chargers, data communication cables, headsets, ear phones, battery chargers for use in a car, leather cases adapted for mobile phones and tablet computers, flip covers for mobile phones and tablet computers, hands free kits and snap on cases adapted for mobile phones and tablet computers, stylus, audio docking stations, screen protective films adapted for mobile phones and tablet computers and portable speakers; portable media players; smart phones; stylus for portable electronic devices; tablet computers; 3D glasses; wearable computer peripherals; wearable peripherals (computers, cell phones, and mobile data receivers); sunglasses; odometers, speed meters, pedometers, altimeters, and barometric altimeters (used in orienteering and hiking); digital cameras; measuring instruments; measuring devices, electric; health bracelet; intelligent bracelet; computer peripheral apparatus; computer bags; computer case; chargers for electric batteries; plugs, sockets and other contacts [electric connections]; helmets (protective-) for sports; fire extinguishing apparatus; sound recording apparatus; internet communication apparatus; theft prevention installation, electric; solar batteries; protection devices for personal use against accidents; paper money verifier; computer software (recording, organizing, transmitting, manipulating, and reviewing text, audio files, video files and computer game programs in connection with televisions, computers, music players, video players, media players and mobile phones)" under class 9; "travelling trunks; backpacks; wallets; handbags; bags for sports; briefcases; school bags; leather straps; umbrellas; clothing for pets; garment bags for travel; bags for campers; toiletry bag (empty); lunch box bag; vanity cases, not fitted; bags for baby accessories; credit card wallet; tool bags of leather; covers for horse-saddles; saddlery" under class 18; "cups; bottle openers; coffee maker; pacifier brush; wok; turner; saucepan; non-stick pot; juicer; coffee services [tableware]; drinking flasks for travelers; tableware, other than knives forks and spoons; electric insect killer; electric mosquito swatters; eye lash brush; brow tweezers; non-electric portable cold boxes; sprinklers for watering flowers and plants; gloves

1 With principal office at Route de Bale 63, 2800 Delemont, Switzerland.
2 With principal office at Haldenstrasse 5, 6340 Baar, Switzerland.

for household purposes, gardening gloves; indoor aquaria; insulated food warmer bag" under class 21; and "clothing; shoes; hats; socks; gloves [clothing]; scarf s; boots for sports; sports shoes; waterproof clothing; jackets (clothing); anti-sweat underwear; coats; jackets(clothing); sportswear; liveries; uniforms; leather shoes; ski boots; cold weather gloves; ski gloves; belts(clothing)" under Class 25 of the International Classification of Goods.³

Opposer alleges the following, among others:

"2. Opposer is known worldwide for quality watches, clothing, shoes, accessories and various sporting and camping goods such as bags, flashlights, tents, airbeds, pillows, luggage and sleeping bags, to name a few. Opposer has been using the mark internationally for over ten years now, having first used and adopted the same as early as 2003 in North America. In the Philippines, Opposer has first used the mark SWISSGEAR on January 8, 2012.

"3. Opposer Wenger SA was founded in Switzerland in 1893 and since that time has carried on the business of developing, designing, manufacturing, marketing and selling cutlery, knives and parts therefore. Opposer has been one of the two suppliers of knives to the Swiss Army for over 100 years and its Wenger trademarked Swiss Army knife is now world famous. Over the years, Opposer's line of products has grown to include a broad range of wares such as watches, luggage, baggage, backpacks, wallets, bags, travel accessories, camping equipment.

"4. In 2003, Wenger S.A. launched its SWISSGEAR ranges of luggage, backpacks and office/business travel as well as camping equipment (particularly tents, sleeping bags) in North America. The aforesaid good all bear the Wenger Cross device. Sale of Wenger S.A.'s luggage and travel goods as well as camping equipment has subsequently expanded worldwide to cover the following countries: Austria, Belgium, Brazil, Canada, Croatia, Czech Republic, Denmark, Finland, France, Georgia, Germany, Greece, Ireland, Italy, Luxembourg, Mexico, The Netherlands, Poland, Portugal, Romania, Slovenia, Spain, Sweden, Taiwan, Turkey, United Kingdom, United Arab Emirates, United States, Venezuela, Ukraine.

"5. Opposer has registered the trademark SWISSGEAR in about 75 countries throughout the world. The Opposer's trademark SWISSGEAR was first use in relation to the Class 9 goods 'computer carrying cases, camera cases, Class 18 goods 'Luggage, backpacks, wallets', Class 20 goods 'Sleeping bags' Class 22 goods 'Tents' and Class 25 'Footwear, headwear'.

"6. The SWISSGEAR ranges have been promoted and advertised via a number of channels in particular in retail catalogs and newspaper inserts and circulars for major retailers worldwide. Twice Magazine (US), Revista Precio Venta Distributor (Spain), Channel Info (U.K.) among others; and have appeared in tradeshow promotional materials. Additionally, Opposer has promoted its SWISSGEAR luggage products at a number of international trade fair and exhibitions, including: International Consumer Electric Show (CES) Las Vegas, Nevada; Paper World, Frankfurt, Germany; multiple locations U.S., Photo Marketing Association (PMA) Las Vegas, Nevada. Opposer SWISSGEAR goods are sold via retailers in at least twenty-five (25) international airports.

"7. The Opposer's licensee's website www.trgcorporate.com and www.groupiico.com are accessible worldwide and prominently showcase the Opposer's diverse line of products.

"8. Clearly, Opposer is the rightful owner of the mark SWISSGEAR having used, adopted and registered the same in several countries in the world much earlier than Respondent.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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.

"9. Being the owner of the mark, Opposer has registered its SWISSGEAR mark for goods under Classes 9, 11, 12, 14, 16, 18, 20, 21, 22, 25 and 28 in over seventy five countries worldwide including U.S.A., Algeria, Argentina, Austria, Australia, Bahrain, China, Canada, Spain, India, Indonesia, Israel, Japan, Mexico, Peru, Hungary, Taiwan, Turkey, U.A.E., United Kingdom, Venezuela and Vietnam, among others.

"10. Opposer has developed goodwill and reputation for its mark SWISSGEAR through the extensive promotion, worldwide registration and use.

"11. Opposer has built, for its mark SWISSGEAR, superior quality-image or reputation through its long use characterized by high standards.

"12. From the foregoing, it is apparent that the Opposer's mark satisfy the criteria set by the Rules and Regulations Implementing RA 8293 to be considered as a well-known mark, entitled to protection under Section 123 (e) and (f) of R.A. 8293.

"13. In presentation, general appearance and pronunciation, Respondent-Applicant's mark SHIELD- SWISSGEAR + LOGO and Opposer's SWISSGEAR are confusingly similar. They both have, for their dominant features, the word 'SWISSGEAR' displayed prominently on their respective marks. Moreover, Respondent-Applicant's mark also replicates the Opposer's WENGER CROSS, featured at the center of the proposed mark's device.

"14. The Wenger Cross trademark was first used by the Opposer at least as early as 1972 in most countries in the world, on or in relation to the Opposer's knife goods. In the United States, for instance, the Wenger Cross trademark was first used by the Opposer on watches with use commencing on or around 1989. This used developed across a range of products with use commencing on smoking articles in 2002, camping equipment and tents in 2003, camera cases, computer cases, mobile phone cases in 2004, clothing in 2005m and various bags and luggage products, cutlery and flashlights in 2006. The Wenger Cross trademark appeared on the goods as badges, or embossed within the fabric of the goods, as well as being on the packaging and label of the products.

"15. The sales of the Opposer's goods including watches, luggage and travel goods as well as camping equipment, all bearing the Wenger Cross trademark, has expanded worldwide to the following countries: Austria, Belgium, Brazil, Canada, Croatia, Czech Republic, Denmark, Finland, France, Georgia, Germany, Greece, Ireland, Italy, Luxembourg, Mexico, The Netherlands, Poland, Portugal, Romania, Slovenia, Spain, Sweden, Taiwan, Turkey, United Kingdom, United Arab Emirates, United States, Venezuela, Ukraine. Opposer has likewise registered the Wenger Cross trademark in about 75 countries throughout the world.

"16. Applicant's combined use of SWISSGEAR and the Wenger Cross, two marks in which the Opposer is recognized internationally, in its proposed mark gives it the colorable likeness of the Opposer's mark. Understandably, this will cause confusion among the public, considering that the goods are similar or related belonging to the same classes and sold in the same channels.

"17. Considering the above circumstances, registration is proscribed by R.A. 8293 Section 123 (d).

"18. If allowed contrary to existing laws and jurisprudence, Respondent's use of the mark SHIELD-SWISSGEAR + LOGO, which is confusingly similar to Opposer's SWISSGEAR and its Wenger Cross, will indicate a connection between the latter's goods and those of the Respondent's, and will likely mislead the buying public into believing that the goods of the Respondent are produced or originated from, or under the sponsorship of Opposer, to the detriment and damage of Opposer's interests, considering the goods are under the same and belong to the same class. Likewise, the use of Respondent of the mark SHIELD-SWISSGEAR + LOGO will diminish or demean or dilute the superior quality image and reputation of

Opposer's mark and products characterized by high-standards which Opposer has carefully built through its long use.

"19. Opposer hereby alleges that the Respondent-Applicant's adoption of SHIELD- SWISSGEAR + LOGO trademark which is confusingly similar to that of Opposer's SWISSGEAR was clearly done with the illegal intent of riding on the popularity and goodwill of Opposer's quality-built reputation and will cause great and irreparable injury.

"20. Further, Respondent-Applicant is clearly in bad faith in so using and adopting the same trademark as that of Opposer's SWISSGEAR, which Opposer has, because of prior use and registrations, gained worldwide notoriety for said mark."

Opposer's evidence consist of the following:

1. Legalized and authenticated Affidavit-Testimony of Jean Daniel Bussard;
2. Certified copies of Official Receipts issued in 2012 showing sale of Wenger and SWISSGEAR products in the Philippines, Sales Invoice dated 26 August 2014 issued in Germany for the sale of Wenger and SWISSGEAR products of Opposer, Purchase Order issued in Korea, and list of SWISSGEAR product sold in UK by VTG Europe in 2014;
3. Copy of Report on Weekly Supply Chain Performance Best Buy from 02-29 October 2005;
4. Photocopies of certificates of registration for the mark SWISS GEAR issued in Brazil, India, Indonesia, OHIM, Israel, Mexico, Korea, U.S.A, Madrid Protocol and Peru;
5. Sample catalog of SWISSGEAR products, copies of brochures and magazines showing Swissgear products;
6. Photocopy of Swissgear by Wenger 2006 Dealer Price List;
7. Copy of expense report for the promotion of Swissgear products;
8. Legalized and authenticated Special Power of Attorney;
9. Legalized and authenticated Secretary's Certificate; and
10. Copy of Statement of Sales for 2012 and 2013.

On 06 January 2015, this Bureau issued a Notice to Answer and served the same to Respondent-Applicant's counsel on 12 January 2015. After several motions for extension, Respondent-Applicant filed the Answer on 23 April 2015 alleging the following Special and Affirmative Defenses, among others:

"The opposition finds no support in Section 123.1 (d) of the IP Code;

"Opposer's alleged trademarks, SWISSGEAR and CROSS logo do not qualify as well-known trademarks.

"Opposer cannot claim exclusive use of the CROSS logo.

" The goods covered by the opposed application are expensive and high-tech products which cater to the discriminating consumers who are expected to meticulously investigate the

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products prior to purchase. It is therefore highly unlikely for these types of consumers to be easily deceived or misled when purchasing the products they intend to buy.

"Respondent-Applicant owns the corporate name SWISSGEAR and as such enjoys protection under Section 165 of the IP Code. In that context it is wrong to accuse Respondent-Applicant as unduly taking advantage of the Opposer's goodwill, or that the registration of the subject application will result in the dilution of Opposer's SWISSGEAR trademark."

Respondent-Applicant's evidence consists of the following:

1. Legalized and authenticated Affidavit-Testimony of Li Zhi Jian;
2. Certified copy of the Certificate of Incorporate;
3. Product catalog and photographs of products bearing the mark SHIELD-SWISSGEAR;
4. Copies of certificates of registration issued in Denmark, Switzerland, Germany, Lebanon;
5. Copies of trademark applications of Respondent-Applicant;
6. Advertising and marketing materials used by Respondent-Applicant;
7. Legalized and authenticated Special Power of Attorney with Certification of Authority; and
8. Corporate Director's Certificate.

On 27 April 2015, Opposer filed its Reply. On 29 April 2015, the case was referred to the Alternative Dispute Resolution (ADR) Services for mediation conference, however, the parties failed to settle their dispute. On 02 December 2015, the preliminary conference was terminated and the parties were directed to submit position papers. On 17 December 2015, the parties filed their respective Position Papers.

Should the Respondent-Applicant's mark **SHIELD-SWISSGEAR** be registered?

Opposer anchors its opposition on Section 123.1 (d) and (e) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), as amended, which provides:

Section 123. *Registrability.* - 123.1. A mark cannot be registered if it:

xxx

(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;

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.

The marks of the parties are reproduced below:

SWISSGEAR



SHIELD-Swissgear

Opposer's Marks

Respondent-Applicant's Mark

Clearly, the manifest similarity between the two marks is the presence of the word "swissgear". While Respondent-Applicant's mark also contain an image of a shield, it will not effectively avoid a finding of confusing similarity between the two marks. What is striking to the eye and gives a lasting impression is the word "swissgear". The likelihood that the consumers will be confused into thinking that the marks of the parties are related, associated or otherwise affiliated to each other is not remote. The presence of the word "swissgear" in both marks would create an impression that the mark of Respondent-Applicant is merely a variation of the mark of Opposer or vice versa. In addition, since the goods of the parties are also competing and related, the likelihood that the consumers will be confused or mistaken into believing that the goods of the Respondent-Applicant comes from or sponsored by Opposer or vice-versa is not far-fetched.

However, Respondent-Applicant posits that Opposer's trademark has no legal protection in the Philippines, as such the registration of its mark is not proscribed by Section 123.1 (d) of the IP Code.

Records will show that at the time Respondent-Applicant filed its application for registration of the mark SHIELD-SWISSGEAR on 31 July 2014, Opposer has no existing registration or pending application for registration of its SWISSGEAR mark. Thus, it would seem that at the time Respondent-Applicant filed the application for registration of the subject mark, there was no bar to its registration. In spite of this, Opposer was able to prove that while it did not have a registration or a pending application for registration for the mark

6. A handwritten signature in black ink, appearing to be the initials 'J.P.' or similar, located at the bottom right of the page.

SWISSGEAR, it has used the mark in commerce as early as 2012 as evidence by the Official Receipts issued by an establishment here in the Philippines showing sales of SWISSGEAR products of Opposer. As such, between Opposer and Respondent-Applicant, the former was the first user in commerce of the SWISSGEAR mark in the country.

Registration of a mark is based on ownership. While the IP Code espouses the first-to-file rule as stated under Sec. 123.1(d), this must not, however, be interpreted to mean that ownership should be based upon an earlier filing date. Even with the removal of the previous requirement of proof of actual use prior to the filing of an application for registration of a mark, proof of prior and continuous use is still necessary to establish ownership of a mark. Ownership of trademark has always been a creation of use and belongs to one who first used it in trade or commerce.³ Consequently, ownership of a trademark constitutes sufficient evidence to oppose the registration of a mark.

Accordingly, since Opposer is the owner of the SWISSGEAR mark by reason of prior use in commerce of the mark in the Philippines, Respondent-Applicant's confusingly similar mark SHIELD-Swissgear cannot be registered.

As whether Opposer's SWISSGEAR mark can be considered as a well-known mark, Rule 102 of the Trademark Regulations sets forth the following criteria in determining whether a mark is well-known:

RULE 102. Criteria for determining whether a mark is well-known. - In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
 - (b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
 - (c) the degree of the inherent or acquired distinction of the mark;
 - (d) the quality-image or reputation acquired by the mark;
 - (e) the extent to which the mark has been registered in the world;
 - (f) the exclusivity of registration attained by the mark in the world;
 - (g) the extent to which the mark has been used in the world;
 - (h) the exclusivity of use attained by the mark in the world;
 - (i) the commercial value attributed to the mark in the world;
 - (j) the record of successful protection of the rights in the mark;
 - (k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark;
- and
- (l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his mark is a well-known mark.

³ *Beris v. Nory Abdayang*, G.R. No. 183404, October 13, 2010.

In this regard, any combination of the above-mentioned criteria may be taken into account to determine whether Opposer's SWISSGEAR mark is a well-known mark. In this case, Opposer failed to establish a combination of the criteria set forth above. As such, it cannot be considered as a well-known mark.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2014-009515, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 22 NOV 2017


MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs