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TICK DIFFERENT: Apple loses to watchmaker Swatch before Swiss court

Switzerland - [Walder Wyss](#)

- Apple opposed Swatch's application for TICK DIFFERENT in Class 14, arguing that its slogan "Think different" was well-known mark under Paris Convention
- Court held that THINK DIFFERENT mark was well known in Switzerland from 1998 to 2006
- However, Apple failed to show that its mark was well known in Switzerland in 2015, when Swatch filed its application

In a recent case (Decision B-5334/2016, 15 March 2019), the Swiss Federal Administrative Court considered an opposition filed by Apple against Swiss watchmaker Swatch's registration of the trademark TICK DIFFERENT for several Class 14 goods, including jewellery and watches. The US tech company claimed that Swatch's trademark was confusingly similar to Apple's slogan "Think different", which was popular in the late 1990s. The case is part of an international dispute between the two companies.

Background

Apple did not base its opposition on a Swiss trademark or an international registration designating Switzerland. Rather, it argued that its slogan "Think different" was a well-known trademark under the [Paris Convention](#). Such well-known trademarks are protected in Switzerland and may serve as a basis for opposition provided that, among other things, the sign in question is protected as a trademark abroad and that it is well known in Switzerland. In this respect, Apple had argued that the slogan "Think different" was protected in the United States as an unregistered common law trademark and that, given Apple's international reputation and decades of use of the slogan, the trademark was also well known in Switzerland. Swatch disagreed, arguing that Apple had shown neither that "Think different" was protected as a trademark in the United States, nor that this trademark was well known in Switzerland.

Decision

The court agreed with Apple that, in the United States, trademark protection may arise solely through use of the mark. The judges further considered it credible that, at the time Swatch filed the TICK DIFFERENT trademark, the slogan "Think different" was protected in the United States for computers in Class 9 by such unregistered trademark. However, Apple failed to show protection in the United States for jewellery and watches in Class 14.

The court then turned to the question of whether Apple's trademark was well known in Switzerland. The court specified that this requires an increased level of public awareness of the trademark in question. While the trademark does not necessarily have to be used in Switzerland, it must be established in the country. Further, the court clarified that the protection of well-known trademarks is limited only to the goods and services for which they are actually used.

In the case at hand, the court found that it was not sufficient for APPLE to be well known in Switzerland. Rather, Apple would have had to show that the trademark THINK DIFFERENT was well known. In this regard, Apple provided little evidence of actual use of the slogan "Think different". On the basis of this evidence, the court held that the THINK DIFFERENT trademark was well known in Switzerland from 1998 to 2006.

However, the court went on to state that a well-known trademark may lose its level of public awareness over time. In order to be protected as a well-known trademark, constant awareness of the trademark is required. Although, as Apple had emphasised, a well-known trademark does not require use in Switzerland, a trademark that is not used or advertised in Switzerland can, for practical reasons, hardly be regarded as well known. Since Apple had not submitted convincing evidence of use of the THINK DIFFERENT trademark after 2009, the court found that the US company had failed to show that the trademark was well known in Switzerland in 2015 when Swatch filed its TICK DIFFERENT trademark. For this reason already, Apple's opposition was unfounded. As a consequence, the court did not have to assess whether the two signs were similar and whether there was a likelihood of confusion.

Comment

This ruling illustrates once again that it is very difficult to win an opposition in Switzerland based on an allegedly well-known earlier trademark. Due to the high threshold, substantial evidence of actual use or advertising will be required in most cases to show the necessary public awareness and that the trademark is (and continues to be) established in Switzerland.

This may well not be the last time that the Swiss courts have to deal with a dispute between Apple and Swatch. In Switzerland, Swatch filed not only the above-mentioned TICK DIFFERENT trademark in Class 14, but also a separate trademark in Class 9. An opposition against the Class 9 trademark is still pending at the Swiss Institute for Intellectual Property. Further, after opposing Swatch's trademark, Apple filed two Swiss THINK DIFFERENT marks in Classes 9 and 14, among others. Both registrations were opposed - most likely by Swatch. It will be interesting to see how this dispute evolves.

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