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Lawyer Annual 2020

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# Trademarking in Switzerland – opportunities and threats

Dr. Jeannette Wibmer, Partner at Birgelen Wehrli Attorneys, sets out the Swiss approach to trademark registrations.

## Importance of trademarking in Switzerland

In 2018, almost 17,000 national trademark applications were filed at the Swiss Federal Institute of Intellectual Property ( “Swiss IPI” ). At the end of 2018, more than 507,000 Swiss trademarks were registered in Switzerland in total, an all-time high. To those Swiss national trademark registrations, extensions of international trademarks to Switzerland through the Madrid Union of the World Intellectual Property Organization ( “WIPO” ) must be added. Switzerland was, after the EU, China, the United States, the Russian Federation and Japan, the sixth most-designated Madrid Union member state in 2017. As such, the IPI received numerous designations of Switzerland from trademark holders abroad in numbers similar to domestic Swiss trademark registrations on top.

## Provisional refusals in Switzerland

Under Swiss national trademark law, the IPI will issue office actions in case of certain substantive or formal deficiencies deemed to be not in line with the interests of the Swiss public (so-called “absolute grounds for refusal” ), irrespective of whether trademark applications are national or international extensions to Switzerland within the Madrid Union. Thus, holders of prior trademark rights in Switzerland must themselves raise and defend them in Swiss opposition or civil proceedings; the IPI will not *ex officio* examine whether a new trademark application infringes such prior trademark rights here.

## Absolute grounds for refusal of trademark protection in general

Absolute grounds for refusal exist under Swiss trademark practice for signs which are:

- (1) in the public domain as they lack distinctiveness or must be kept free for all in trade;
- (2) unless they acquire secondary meaning;
- (3) signs which are misleading for the general public or otherwise against Swiss public policy; or
- (4) infringe the so-called “Swissness” legislation protecting the Swiss coat of arms and Swiss white cross on red ground.

However, suggestive words that raise no specific expectations, and new combinations of descriptive



Dr. Jeannette Wibmer

“**A trademark may consist of distinctive and non-distinctive elements, provided that one element is distinctive.**”

signs which create a distinctive general impression, may be registered. A trademark may consist of distinctive and non-distinctive elements, provided that one element is distinctive. No disclaimers are required for non-distinctive elements.

## Non-distinctive signs in the absence of secondary meaning

The following signs are usually deemed to be without distinctiveness in Switzerland unless special circumstances in a particular case allow them to acquire so-called secondary meaning (see below):

- single numerals or single letters of the Latin alphabet; however, not necessarily of foreign alphabets unless those are generally known in Switzerland, which may e.g. be the case for certain signs of the Greek alphabet. However, even such single letter may gain secondary meaning if there is no indispensable need to keep it free, as happened, for example, for the letter “M” used by the retailer Migros for many decades and with a total Swiss food retail market share of over 30% (FSC 134 III 314 - M);
- simple geometrical signs (e.g. circles and rectangles), but not necessarily combinations of these;
- descriptive signs - for example, words that describe the quality, quantity, purpose, value, geographical origin or other characteristics of the goods or services, slogans without a distinctive element, such as e.g. MASTERPIECE and KEYTRADER in Class 36; VERY IMPORTANT PHARMACY in Classes 3, 5 and

## Résumé

### Dr Jeannette Wibmer LL.M (LSE)

Dr Jeannette Wibmer LL.M (LSE), Attorney-at-Law and Partner at Birgelen Wehrli Attorneys, has 30 years of experience in private practice as an international business and trademark lawyer. As head of the growing business enterprises practice group she advises corporate clients and entrepreneurs mainly in the pharmaceutical, life science, IT, VR, AR, micro- and nanotechnology, cryptocurrency fields. She also advises on the commercialization of innovative developments through joint ventures, technology transfer arrangements, licensing, distribution, franchising and other alliances based on comprehensive strategic intellectual property development, protection, marketing and enforcement concepts, as well as venture capital and growth financings, including IP due diligence examinations.

44; HYDE PARK in Classes 12 and 28; and OKTOBERFEST-BIER in Class 32 (the Administrative Court - unlike the EU Intellectual Property Office - rejected a trademark application for OKTOBERFESTBIER (FAC B-5169/2011) as it was regarded as a mere designation for a sort of beer) and KNOT was regarded to be descriptive for the form of goods (FAC B-7402/2016);

- general indications of quality or purely promotional signs (e.g. HYPE, ONE&ONLY, SUPER, MASTERS, TOP, ROYAL or ETERNA); however, they may become registrable as trademarks if combined with a distinctive term, such as e.g. with NESPRESSO in NESPRESSO, WHAT ELSE for coffee or WHISKAS for cat food in KATZEN WÜRDEN WHISKAS KAUFEN (cats would buy WHISKAS) or even if two descriptive or customary terms are combined, e.g. NEXTEL WORLDWIDE;
- common or banal signs (e.g. ENTERPRISE, NETTO and top-level domains such as .com and .ch );
- registered trademarks which have subsequently become understood merely as a technical term like WALKMAN or BOTOX (Commercial Court Zurich, sic! 2015, 24 - BOTOX/CELLCARE BOTOCARE);
- shapes of the goods or their packaging which are technically necessary, such as e.g. the three-dimensional form of a Paris fashion icon ladies' handbag (2004, 98 CHRISTIAN DIOR); and shapes which constitute the nature of the goods themselves, such as e.g. a three-dimensional oval egg-shaped form for filled chocolate candies (SFC 4A\_374/2007 PRALINE);
- names of persons and characters may be registered as trademarks, unless they are frequently cited to describe certain goods or services (e.g. MOZART for audio products) or must be kept free for trade (e.g. RAPUNZEL in Classes 9, 14, 16, 20, 21, 28 and 41);
- 3D signs added to goods and 3D packaging (i.e. the star on Mercedes-Benz cars, the Coca Cola bottle, or the traditional form of a nutcracker man, FAC B-1061/2017) are usually distinctive unless they represent the shape of the goods themselves, their features are merely of an aesthetic nature, determined by technical necessities or the same as the expected and familiar shapes in the sector. However, the combination of shapes with two-dimensional elements (e.g. words and logos) which significantly affect the overall impression may add the distinctiveness required in a particular case; and
- signs which must be kept free for trade are e.g. those designations which are indispensable to that trade, e.g. THINK OUTDOORS for shoes and cloths (SFC 4A\_330/2014), YOU and ONLY YOU for soaps, cosmetics etc. (SFC 139 III 176); GIPFELTREFFEN (i.e. summit) for congresses and gatherings (SFC 4A\_492/2007), POST for postal services (SFC 4A\_370/2008), the color blue for beverages or MARCHÉ for restaurant and food services).

### Secondary meaning allowing for the trademark registration of non-distinctive signs

Signs which initially lack distinctiveness may, if they are not deemed to be absolutely indispensable for the trade in general, be registered based on evidence of extensive use as a trademark in Switzerland for - usually - 10 years in all major Swiss language regions i.e. in the German, French and Italian speaking part (FAC B-6173/2018 WORLD ECONOMIC FORUM / ZURICH ECONOMIC FORUM, FSC 128 III 441, 444 - Appenzeller, FAC B-8240/2010 - Aus der

Region, für die Region). This was e.g. possible for the cylindrically shaped three-dimensional SMARTIES box trademark which was illegally copied for M&M's in Switzerland (SFC 131 III 121ff.).

It should be noted in this respect, that it is, unlike in many other jurisdictions, usually not necessary to show with opinion polls how many people resident in Switzerland have recognized a certain trademark upon representation. In the case of world-famous companies like APPLE, the Swiss Federal Court even held that the general Swiss public predominantly sees the relevant company origin, i.e. this sign could even be registered as trademark in classes in which it had never been used by Apple Inc. beforehand, irrespective of the fact that it originally referred to a fruit or its shape (FSC 4A\_503/2018).

### Misleading signs, and signs against Swiss public policy

A trademark will be regarded as misleading if it gives a wrongful impression about the goods or services for which it is used (like e.g. CHAMP for alcoholic beverages like beer - i.e. other than champagne, SFC 4A.14/2006, GOLDEN RACE for only gold plated jewels, and the designation CAFÉ for coffee substitutes). The most relevant cases in this field are geographical terms that mislead as to the origin of the designated goods or services. The IPI is strict when it comes to geographical terms and holds that a sign consisting of or containing a geographical term evokes the expectation that the goods in question originated in that location. Nevertheless, the following are possible trademarks in Switzerland despite their geographical connotation:

- designations of geographic places not known to the general Swiss public (HAMILTON);
- signs with a clear and direct symbolic character (e.g. PARADISE ISLAND) or other symbolic meaning;
- places which are obviously unsuitable for the production or commerce of the goods at issue;
- signs which have acquired secondary meaning; or
- signs which have degenerated into a denomination for a certain kind of products (e.g. Hamburger for a food product).

On top, trademark applications for designations indicating a certain geographical origin of the goods or services may still be registered if the covered goods are restricted to the origin suggested (e.g. SAN FRANCISCO FORTY NINERS for US clothing and AFRI-COLA for African beverages). Whenever a foreign indication of origin has been accepted as a registered trademark in the country of origin, it will usually also be accepted in Switzerland unless it must, based on the special circumstances of the particular case, be regarded as misleading for the Swiss public.

Signs which are regarded as infringing public policy, morality or Swiss law include religious symbols and the names of prominent individuals without their consent, e.g. 'BUDDHA BAR in Classes 9 and 41 for a bar (FAC B-438/2010) as well as MADONNA for soaps, fashion etc. (SFC 136 III 474ff.) because these signs were regarded to negatively affect the religious feelings of Buddhists and Catholics respectively in Switzerland.

### “Swissness” legislation

Under the Swissness legislation, the Trademarks Act, and the Federal Act on the Protection of the Coat of Arms and Other Official Signs have been revised. The designation SWISS may only be used for either natural products, which are grown and harvested in Switzerland, for foodstuffs of which 80% of the raw material weight is of Swiss origin and the processing step that gives the product its essential characteristics is carried out in Switzerland (like Swiss chocolate





made of foreign cocoa beans), or for industrial products of which 60% of the manufacturing costs are accrued in Switzerland and the processing steps which give a product its essential characteristics are carried out in Switzerland.

Prior to the new 'Swissness' legislation it was, in principle, also illegal to use the Swiss cross for trademarks unless such use was merely decorative. As this did not properly reflect the Swiss business and general public's needs, the legislation was revised and the Swiss cross as in the form of the Swiss flag is now registerable in a trademark. However, the use and registration of the Swiss coat of arms is still not permitted, with the exception of signs of organizations with a quasi-official role, like the logo of the Swiss Polo Association, a private organization of Swiss polo clubs which has for decades been responsible for disciplinary sanctions in the Swiss polo sport, and which selects the Swiss national polo team.

The new Swissness legislation also established a Swiss register of protected designations of origin and geographical indications for non-agricultural products, and a register for geographical marks. It is now possible to register protected designations of origin and geographical indications (both agricultural and non-agricultural), wine designations recognized by the cantons, and indications of source which are the subject of a Federal Council ordinance (e.g. for watches) as geographical trademarks in a special register administered by the IPI (e.g. VACHERIN MONT D'OR for a certain type of cheese and SAUCISSON VAUDOIS for a typical type of sausage are so protected). The applicant for such a geographical trademark must be a representative group in the

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***The Swiss cross in the form as in the Swiss flag is now registerable in a trademark.***  
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related industry or business sector and must file regulations governing the use of the mark. However, such an applicant will, if successful, not have the right to exclusive use; rather, anyone, even a foreigner producing this type of goods here, i.e. who fulfils the requirements of such regulations, will be entitled to use a certain geographical mark in Switzerland for them.

### Summary finding

Foreign brand owners who wish to globally trademark or enforce certain signs also in Switzerland are well advised to have them professionally monitored for infringements by younger trademark registrations effective in Switzerland as well. Vice versa, such foreign brand owners should – ideally – also seek Swiss legal advice as to the protectability of their foreign brands in Switzerland prior to their adoption and protection abroad to avoid later unwelcome surprises in provisional refusals affecting them in the economically important Swiss market when they wish to receive trademark protection here as well.

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