



Jeannette Wibmer

Office actions in Switzerland: Pitfalls and chances for owners of international trademarks and of prior Swiss trademark rights

Jeannette Wibmer, Attorney-at-Law and Partner of Birgelen Wehrli Attorneys, Zurich, discusses the most important pitfalls and chances for owners of international trademarks and owners of prior Swiss trademark rights in Swiss office actions.

Switzerland is neither a member of the European Union nor of the European Economic Area, thus European Union trademarks do not extend to Switzerland and Swiss trademark law is not like European Union trademark law. Historically, Switzerland pursued a more global approach instead. It was among the first adopters of the Paris Convention for the Protection of Industrial Property (*Paris Convention*), the Madrid Agreement and Protocol Concerning the International Registration of Trademarks (*Madrid Agreement* and *Madrid Protocol*, collectively the *Madrid Union* if referred to collectively), as well as all other important international trademark conventions.

Legal framework for office actions against international trademark extensions to Switzerland and against national Swiss trademark applications

Based on article 5.2 of the Madrid Agreement as well as article 5.1 of the Madrid Protocol, the Swiss Intellectual Property Institute ('Swiss IPI', see www.ige.ch) will check

international trademark extensions to Switzerland solely based on Swiss national trademark law. Thereunder, provisional refusals will be issued *ex-officio*, in case the Swiss IPI finds certain substantive or formal deficiencies not in line with interests of the general public (so-called 'absolute grounds for refusal', see below, point 2). Such absolute grounds for refusal may exist in Switzerland irrespective of whether the same trademark was accepted for the same goods and services in its country of origin or not. An example of this is "MASTERPIECE" – it could not be trademarked in Switzerland for financial services, irrespective of the fact that it was a registered trademark abroad (Federal Court Decision 129 III 225ff.).

However, unlike many other economically important countries like the USA, China, India, and other Asian tiger states – or also the European Union Intellectual Property Office ("EUIPO") – the Swiss IPI will NOT itself search for prior trademark rights of third parties. The Swiss IPI neither uses such third-party rights as a basis for provisional refusals against younger trademark applications (so-called 'relative grounds for refusal') like, for example, in the USA, China, India etc., nor will it alert the owners of prior trademark rights like the EUIPO!

For this reason, owners of international trademark registrations extended to Switzerland are – like owners of Swiss domestic trademark rights – well advised to have not only new international but also Swiss domestic trademark registrations professionally monitored for infringements of their prior rights in the economically potent Swiss market. Upon application, Swiss trademarks are officially published in the public Swiss IPI database www.swissreg.ch, where you can do searches for them and their status; this can also be completed via the internet from abroad. Only if you do this, you as trademark owner will have a chance to oppose any younger Swiss trademarks, the latest within the three months opposition period upon their publication in the Swiss Commercial

Résumé

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Gazette (www.shab.ch) upon domestic registration or – for international trademarks – upon protection grant by the Swiss IPI for Switzerland.

Should any trademark owners fail to meet this deadline, such owners would then have to resort to ordinary court proceedings for trademark infringement in Switzerland (see *The Trademark Lawyer* 3/2017 article “*Trademarks in Switzerland: Registrations and settling of disputes in and out of court*” by the same author). If the owners of prior trademark rights would then wait too long with these, they would, on top, even risk forfeiting their rights to enforce their prior trademark rights in Switzerland by way of acquiescence.

Admissible trademarks and absolute grounds for refusal in the interests of the general Swiss public

a) General Overview

The circle of registrable trademarks in Switzerland grew over time. Apart from the traditional word trademarks, graphical trademarks and combinations thereof, new forms, such as three-dimensional form trademarks (for instance the ‘Coca Cola®’ bottle or the Mercedes® star), phonetic sound trademarks (like the ‘Migros Jingle®’), abstract color trade marks (e.g. the ‘yellow’ shade traditionally used by the Swiss Post, however not the signal red used as a position mark on the outer sole of Christian Louboutin® high heels), identification threads of textiles and distinctive slogans (‘Nespresso, what else? ®’), smells, holograms as well as moving image sequences (see the sequence in CH 585720 below) became – like combinations of any of the above – registrable as trademarks in Switzerland to the extent they could distinguish the goods or services of one undertaking from those of another undertaking.



Within the framework of article 6 quinquies lit. B sec. 2 and 3 Paris Convention, however, Article 2 Swiss Trademark Act excludes certain signs from trademark protection in Switzerland, which will thus become subject of a provisional refusal if also extended to Switzerland as part of an international trademark registration with WIPO. Signs excluded are:

- Signs deemed to be in the public domain unless they acquired distinctiveness (a ‘secondary meaning’) through long and non-contested use or an applicant accepts a carve-out in the list of goods and services (below b);
- Shapes that constitute the nature of the goods themselves or shapes of the goods or their packaging which are technically necessary; misleading signs and signs contrary to public policy, morality or applicable law, including signs which are not allowed under the so-called “Swissness Legislation” governing the use of ‘Swiss’, ‘Switzerland’ as well as the Swiss national flag cross and colors for goods and services (below c).

In addition, the Swiss IPI may – since 2017 – also provisionally refuse certain items on the list of goods and services of an international trademark extended to it. Compared to other countries, this, however, only occurs rarely. The Swiss IPI generally accepts the Nice classification as applied by the World Intellectual Property Organization (‘WIPO’) in Geneva.

b) Signs normally deemed to belong to the public domain and remedies for trademark applicants through ‘carve-outs’ in the list of goods and services or the presentation of evidence for a ‘secondary meaning’

Signs are usually deemed to belong exclusively to the public domain (and often to also lack the distinctiveness required for trademark protection in Switzerland at the same time) and they should, from the perspective of the applicant’s competitors, remain available to everybody active in the same or a similar trade or providing the same or similar services. This applies, in particular, to the following:

- Originally or degenerated generic or descriptive words like e.g. ‘THINK OUTDOORS’ for shoes and clothes (Federal Court 4A_330/2014), ‘YOU’ and ‘ONLY YOU’ for soaps, cosmetics etc. (Federal Court Decision 139 III 176); ‘GIPFELTREFFEN’ (i.e. summit) for congresses and gatherings (Federal Court 4A_492/2007), ‘POST’ for postal services (Federal Court 4A_370/2008) or the non-proprietary pharmaceutical names adopted by the World Health Organization (‘WHO’) are regarded to be originally generic and may not be registered or enforced as word trademarks in Switzerland. In addition, terms may degenerate to generic terms over time in the eyes of the general public (e.g. ‘MONTESSORI’ for kindergarten services, Federal Court Decision 130 III 113). Nevertheless, e.g. a figurative trademark ‘JOY’ was enforceable against another figurative trademark ‘ENJOY’ for software, paper and online publications, entertainment services etc. (Federal Administrative Court B-5312/2015), i.e. this figurative sign was not regarded as purely descriptive for those in Switzerland. If trademark owners fear, that a sign is so descriptive for the goods or services at issue in Switzerland, they are thus well advised to also seek trademark protection for a figurative word design at the same time.
- Purely promotional or customary terms and slogans like e.g. ‘MASTERPIECE’ for financial services (Federal Court Decision 129 III 225ff.), ‘WOW’ for optometric services (Federal Administrative Court B-6747/2009), ‘ROYAL COMFORT’ for toilet paper (sic! 2003, 495) or ‘TOGETHER WE WILL GO FAR’ for banking services (Federal Administrative Court B-1561-2011) are regarded to lack the distinctiveness necessary for trademark protection here. However, they may become registrable as trademarks in Switzerland if applicants combine them 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®’.
- Single letters, punctuations and numbers as well as simple geometric shapes like circles, squares, rectangles, and triangles, may likewise never be registered or protected as trademarks in Switzerland. However, letter words in languages which are not official Swiss languages (i.e. other than German, French, Italian or Rumantsch), or otherwise not regarded to be generally known in Switzerland (unlike e.g. English which is deemed to be so generally known) are admissible as trademarks here, e.g. ‘GAMMA®’ (other than for gamma rays) or ‘DELTA®’.

Sometimes, trademark owners may save their trademark protection for Switzerland by explicitly carving-out certain goods or services from the list of goods and services for which it is sought, e.g. the cryptocurrency sign ‘DIM’ (CH 714416) became registrable as a Swiss trademark (apart from other goods and services) also for various software applications by explicitly carving out software applications for the dimming of light.

More importantly, in practice, trademark owners may also try to overcome the hurdle of non-distinctiveness and achieve a registration by demonstrating that a particular sign acquired distinctiveness through long, important, and non-contested use in each of the three major language regions of Switzerland. This means not only in the German, French, or Italian speaking part of Switzerland alone or in only two out of these three. This was therefore possible for the

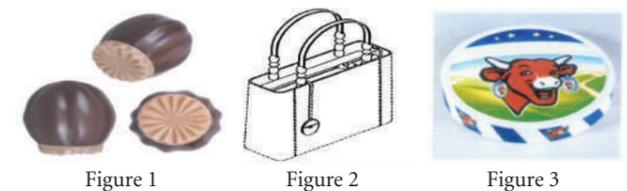
cylindrically shaped three-dimensional ‘SMARTIES’ box® trademark which was illegally copied for ‘M&M’s in Switzerland (Federal Court Decision 131 III 121ff.).

As a general rule, the Swiss IPO requires evidence of use for a time period of 10 years or more before the filing of a new application or extension of an international trademark to Switzerland is accepted. However, this period may be shorter if intensive and extensive use, as well as significant promotional efforts and/or an increasing turnover over time, can be demonstrated. In this respect, also demoscopic surveys may serve to prove, that a trademark has acquired distinctiveness in the eyes of the relevant public.

c) Signs always belonging to the public domain

However, certain signs may never acquire such distinctiveness by carving out certain goods or services or by acquiring a secondary meaning under Swiss trademark law. As a result, they are absolutely and without any remedy barred from trademark protection in Switzerland because they are deemed to always belong into the public domain. This applies, in particular to the following:

- Shapes that constitute the nature of the goods themselves, such as e.g. a three-dimensional oval ‘eggish’ form for filled chocolate candies (see Figure 1 and Federal Court Decision 4A_374/2007 ‘PRALINE’);



- 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 (see Figure 2 and sic! 2004, 98 ‘CHRISTIAN DIOR®’); unless the respective registrations are – similar to the corresponding technique for slogans reported above – again combined with a distinctive sign, such as e.g. in the combination of a three-dimensional round carton packaging for cheese with a print of the characteristic laughing cow of this brand (see Figure 3 of the three-dimensional trademark of the ‘LA VACHE QUI RIT®’ packaging cardboard);
- Misleading signs such as e.g. ‘Champ’ for alcoholic beverages like beer (i.e. other than champagne, Federal Court 4A.14/2006); ‘GOLDEN RACE’ for only gold-plated jewels;
- Signs contrary to public policy, morality or applicable law, such as e.g. ‘BUDDHA BAR’ for a bar (Federal Administrative Court B-438/2010) as well as ‘MADONNA’ for soaps, fashion etc. (Federal Court 136 III 474ff.), because these signs were regarded to negatively affect the religious feelings of Buddhists and Catholics respectively in Switzerland or signs which are not allowed under the so-called “Swissness Legislation” governing the use of ‘Swiss’, ‘Switzerland’ to goods and services originating from Switzerland as well as signs consisting of the Swiss national (cross and colors), cantonal or communal flags which are exclusively reserved to the respective public bodies.

As can be seen from the above, Swiss trademark law practice may be stricter than foreign laws with regard to the non-admissibility of certain signs as trademarks.

Thus, foreign brand owners who wish to globally trademark or enforce certain signs also in Switzerland are well advised to seek Swiss legal advice in advance with a view to avoid later unwelcome surprises in the economically important Swiss market.