



Looking into location

Dr Mark Schweizer seeks to shed light on a peculiarity of Swiss IP practice

The Swiss IPO – the Institute for Intellectual Property (IIP) – is notoriously strict regarding applications for trade marks containing geographical terms. This article will try to shed light on some peculiarities of the Swiss practice, and shows how an objection can potentially be overcome, specifically regarding geographical indications and the presumption of understanding geographical terms as geographical indications.

According to Swiss practice, a (known) geographical name will be understood as a geographical indication. It is up to the applicant to demonstrate that the relevant consumers do not understand the term in its geographical sense. This can be successful, for example, when the non-geographical meaning is emphasised by an accompanying figure (for instance displaying a bird in connection with the term PHOENIX, which will then be understood as reference to the mythical creature rather than the city in Arizona).

If the products for which the mark is sought to be protected are used by different classes of consumers – for example, both the general public and a professional audience with special knowledge – it is sufficient

for a rejection that one part of the body of consumers understands the term in its geographic sense. For example, when seeking to register WILSON for tobacco products, the applicant has to show that even consumers of tobacco products do not understand the term WILSON as a reference to the city of the same name in North Carolina, which may not be well known by the general public but is known for its tobacco products.

YUKON factors

Even if a trade mark contains a geographical indication, it may still be registered if one of the YUKON factors is applicable. Under the Federal Supreme Court's YUKON practice (BGE 128 III 454), a trade mark containing a geographical indication can be registered if:

- a) the geographical indication is not recognised as such by the relevant public (example: SAVANNAH does not refer to the city of the same name in Georgia, but rather to a type of vegetation);
- b) the geographical indication designates a territory that is - in principle and also for the foreseeable future - unsuitable for the production of the products in question (examples: ALASKA for menthol cigarettes, or YUKON for industrial goods, but not CAPRI for tobacco products, because theoretically, tobacco could be grown on the Italian island of Capri);
- c) indications of type - for example, "telephone model VENICE"; or
- d) geographical indications that have become generic terms for a type of good, for example HAMBURGER for meat patties, or EAU DE COLOGNE for perfume (obviously, these will only be registered in combination with a distinctive sign).

Misleading marks

According to Swiss practice, trade marks containing a geographic indication, such as VIRGINIA SLIMS NO 602 are refused as misleading if the goods covered by the application do not actually originate from the indicated territory. This is quite remarkable - the European approach is only to refuse such marks in case they are descriptive (for the

Trade marks containing a geographic indication are refused as misleading if the goods covered by the application do not originate from the indicated territory

RECENT IIP APPEALS RELATED TO GEOGRAPHICAL TERMS

GREY <i>Objection overcome</i>	RED <i>Objection sustained</i>	RELEVANT MEANING ACCORDING TO FEDERAL ADMINISTRATIVE COURT
TRADE MARK/ PRODUCTS COVERED	RELEVANT MEANING ACCORDING TO IIP	
KALMAR <i>for engines</i>	<i>town in southern Sweden</i>	<i>squid with 10 arms</i>
WILSON <i>for tobacco products</i>	<i>town in North Carolina, USA</i>	<i>surname</i>
BURLINGTON <i>for cosmetics, clothing</i>	<i>town in Vermont, USA</i>	<i>name</i>
BÜRGENSTOCK <i>for hotel services</i>	<i>mountain in Switzerland</i>	<i>mountain in Switzerland</i>
SAVANNAH <i>for clothing</i>	<i>city in Georgia, USA</i>	<i>type of vegetation</i>
QATAR AIRWAYS <i>for services of an airline</i>	<i>Qatar, Arab Emirate of</i>	<i>Qatar, Arab Emirate of</i>
FRANKONIA <i>for retail services</i>	<i>as Franconia, the region of the Franks</i>	<i>many, other meanings are more prevalent</i>
AUSTIN <i>for explosives</i>	<i>city in Texas, USA</i>	<i>city in Texas, USA</i>
VICTORIA CUP <i>for sport events</i>	<i>province in Canada</i>	<i>first name</i>
GERRESHEIMER	<i>as reference to Gerresheim, a district in the city of Düsseldorf, Germany</i>	<i>name</i>
ZACAPA <i>for rum</i>	<i>province in Guatemala</i>	<i>province in Guatemala</i>
AMALVI <i>for furniture</i>	<i>as reference to Amalfi, a town in Italy</i>	<i>fantasy name</i>
MILANELLO <i>for several goods and services</i>	<i>as reference to the city of Milan, Italy</i>	<i>as reference to the city of Milan, Italy</i>
PARIS RE <i>for insurance services</i>	<i>as reference to the city of Paris, France</i>	<i>as reference to the city of Paris, France</i>

geographic origin of the goods in question).

Objection options

Considering these examples, how could the applicant, or you as its representative, successfully deal with an objection by the IIP?

1) Limit the list of goods and services

If you can, limit the list of goods and services to “goods originating from” the indicated territory, such as the US for the VIRGINIA SLIMS NO 602 mark mentioned earlier. This is often not possible, because the goods in question do not actually come from the indicated place, but if it is an option, it is the easiest way to deal with an objection.

Note that it is not recommended that the list of products be limited to goods originating from a place from which they do not actually come. The IIP will not object; however, should you ever try to enforce the trade mark after the five-year grace period for non-use, the trade mark is most likely unenforceable for non-use because it is not actually used for the goods it covers.

2) Argue the geographic term is not understood as such

The IIP, unfortunately, will almost always argue that a geographic term is understood as a reference to the place with the same name. However, this is one area where the Federal Administrative Court often sides with the applicant. You must try to argue that the place is unknown, of limited economic importance, far away from Switzerland, and has no touristic significance. Additionally, or alternatively, you can try to argue that the geographic reference is only a secondary meaning, and the term is primarily understood in a non-geographic sense, for example as a personal name.

The table on page 29 shows the appeals against objections by the IIP based on misleading geographical terms to the Federal Administrative Court, and their outcome, during the past three years. As you can see, success is by no means guaranteed, but the rate of success is far greater in this

domain than in any other domain of trade mark law.

Since the determination of the relevant meaning of a term is a factual enquiry under Swiss law, an appeal to the Federal Supreme Court, while theoretically possible, is almost always futile, because the review by the Supreme Court is limited to legal issues. This cuts both ways – a rejection by the Administrative Court is practically final, but so is a decision allowing the registration of the mark (the IIP has the right to appeal such decisions to the Supreme Court).

3) Add a figurative sign to your application

If you can – ie, if the application is not an international one – and you face the objection that your mark contains a term that is primarily understood as a geographic indication, try adding a figurative sign that consumers will associate with the non-geographic meaning of the term, like the bird in connection with the term PHOENIX. This will lead to a new filing date, and a limited scope of protection, but may be preferable to abandoning the application. There are no official fees due for such a change.

4) Show secondary meaning

Finally, you can try to show that your mark has acquired secondary meaning rather than geographic indication. The IIP’s practice is rather strict, however, and you should be prepared to back up your claim with a demographic survey of Swiss

consumers (the IIP is very sceptical that any valid inferences can be drawn from consumer surveys in other countries).

... and what not to do

There are two arguments that it is tempting to make, but are almost certain to fail.

1) Claiming equal protection

While in principle, applicants have a constitutional right to equal protection under the law, arguing that your trade mark should be registered because a similar trade mark – or an identical mark for similar goods – has been registered in the past is almost certain to fail. The IIP and the courts always find grounds to distinguish the cases.

2) Pointing to corresponding foreign registrations

“But the [OHIM/UK IPO/USPTO] registered the same mark for the same goods,” is never going to convince Swiss courts. While in principle it is recognised that, in close cases, foreign registrations should be given some weight, in practice the IIP and the courts almost always insist that the specific case is not a close case. As frustrating as it may be, the fact that the rest of the world has accepted your application does not amount to much in Switzerland.



Combined with the image of a bird, the term PHOENIX will not be understood as reference to Phoenix, Arizona



Dr Mark Schweizer LL.M.

is Senior Associate with Meyerlustenberger Lachenal Attorneys at Law, Zurich
mark.schweizer@mll-legal.com

