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SWITZERLAND: Controversial Decision About the Registration of Trademarks Consisting of a Foreign GI

Contributor: Thomas Widmer, Lalive, Geneva, Switzerland

Verifier: Florian Traub, Squire Patton Boggs (UK) LLP, London, United Kingdom
Co-Chair, INTA Bulletins Law & Practice—Europe Subcommittee

In a recent decision, the Swiss Administrative Court held that the word mark “Clos d’Ambonnay,” literally “Ambonnay [a French village] walled vineyard,” was eligible for trademark registration in Switzerland on the sole basis that it was registered in France. (ATAF B-5004/2014, June 8, 2017—“Clos d’Ambonnay.”) This decision would indicate an important shift in the Swiss registration practice for marks consisting of a foreign geographical indication (GI); however, the decision is not yet final.

Under Swiss law, trademarks consisting exclusively of a GI usually lack inherent distinctiveness and are registrable only if they have acquired distinctiveness (secondary meaning). Such marks are barred from registration in any event if there is an “absolute need to keep [them] free.” This hurdle applies both to geographical places that are currently associated with the claimed goods in the mind of the relevant public and to those places that it is reasonable to assume will, in the future, be associated with the claimed goods. A similar principle is found in EU trademark law.

According to the current practice of the Swiss Institute of Intellectual Property (the Institute), in place since 2005, a trademark consisting exclusively of a foreign geographical place must have a distinctive character in Switzerland (i.e., either inherently or by way of an intensive use in Switzerland), regardless of whether such trademark has acquired, in the foreign country, a secondary meaning and/or is registered. However, if a trademark consisting exclusively of a foreign geographical place is registered in the foreign country, there is no “absolute need to keep [the mark] free.”

The applicant sought to register the word mark “Clos d’Ambonnay.” The Institute refused the registration on the grounds that (1) it lacked inherent distinctiveness, since it merely described the geographical origin of the claimed products (essentially, wine); (2) the applicant did not show that the mark had acquired distinctiveness through intensive use in Switzerland; and (3) the fact that the mark had been registered in France was relevant to lift the “absolute need to keep free” condition, but had no bearing on the mandatory requirement of distinctiveness.

On appeal, the Swiss Administrative Court disagreed and accepted the registration of the “Clos d’Ambonnay” mark in Switzerland. It held that distinctiveness and the “absolute need to keep free” principle were synonymous in this context. The court further held that it sufficed that the mark had been registered (in the name of the applicant) in France to allow its registration in Switzerland, regardless of whether said mark was perceived as distinctive in Switzerland.

Two brief comments must be made regarding the court’s decision.

First, the approach adopted by the court seems to be at odds with the widely accepted concept that distinctiveness and the “absolute need to keep free” principle are distinct and cumulative, and that a mark failing to meet either requirement is not registrable. In accordance with this concept, a nondistinctive mark is refused registration without the need to assess whether it is, as well, subject to an “absolute need to keep free.” Swiss law is in line with EU trademark law in this respect.

Second, it is unclear from the decision whether the “Clos d’Ambonnay” mark was registered in France as being inherently distinctive or as a mark having acquired a secondary meaning. This information could, however, be relevant, since earlier decisions by the Swiss Supreme Court specifically referred to marks that had acquired, abroad, a secondary meaning through intensive use.

It is expected that the Swiss Administrative Court’s decision will be appealed to the Swiss Supreme Court.

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