



What is a registerable TM?

- requirements and limitations on registrability -

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Introduction

Like many other jurisdictions, CH has **no numerus clausus of possible TMs.**



Source: https://d2v9y0dukr6mq2.cloudfront.net/video/thumbnail/VkvG-2Ccliksa7zxw/modern-city-aerial-view-crowded-highway-cars-crossing-bridge-shanghai-china-day_ht4zq40x__F0000.png



Introduction

- **Art. 1 Swiss TMA:**

“A trade mark is a sign capable of distinguishing the goods or services of one undertaking from those of other undertakings.”

- TM-protection shall be open for development (new trademarks)

- Main criteria: **Distinctiveness**



Restrictions

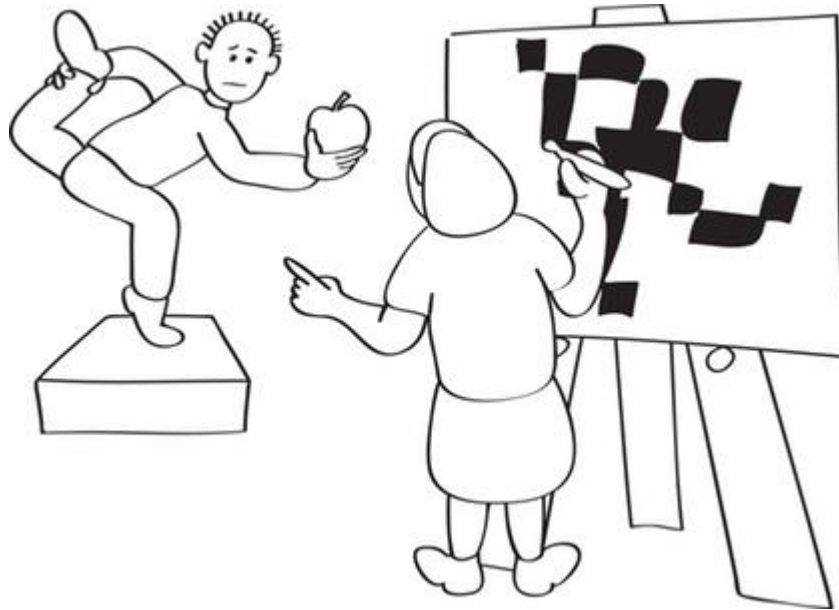
However there are restrictions:





Restrictions

Technical restriction: **Representation**



Source: <http://csunplugged.org/image-representation/>

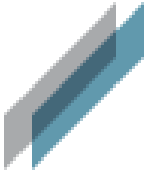


Representation

- **Art. 11 Swiss Trademark Ordinance**

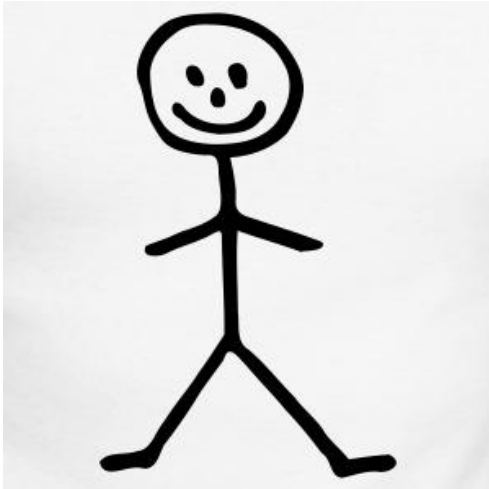
“The trade mark must be capable of graphic representation.”

- Solution clear for
 - Sounds = indication of the score
 - Smells = indication of the chemical formula
- **But what about**
 - Color marks consisting of more than one color?
 - Store designs?



Restrictions

Material restriction: **Distinctiveness**



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Restrictions

Again Art. 1 TMA: *“A trade mark is a sign capable of distinguishing the goods or services ...”*

No distinctiveness if

- technical necessary,
- shape of the good/packaging,
- sign is not perceived as TM in the narrow sense

→ Last point is very important for new TMs



Distinctiveness

- TM-Offices require **high standards**, especially regarding new trademarks
- Often protection only possible with **acquired distinctiveness**
- Too severe? Not necessarily, because “***its all about the balance***”



Its all about the balance

Monopoly vs. free trade



- Patents, Copyrights, designs are timely limited, TMs are not (TM grants a timely unlimited monopoly).



- You don't have a "give"-effect similar to other rights (namely patents).

➤ TM-monopoly must not easily be granted



Its all about the balance

- “New” trademarks especially interfere into free trade
 - Example of 3D-Trademarks (Panton Chair, TrippTrapp etc.)



- Balance becomes more viable in order to avoid excessive monopolies
 - **Restrictive registration practise in principle justified**



Practical Examples



Swiss Case Law



Colour / Position TMs



IR no. 1'031'242

Swiss Federal Court dated February 7, 2017 (Case no. 4A_363/2016)

- Red shoe sole = aesthetic design element
 - ***Not distinctive for shoes***
- Acquired distinctiveness was not brought up



Device mark



IR no. 1'111'356


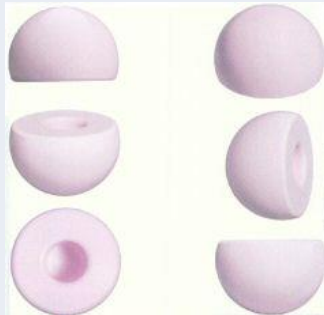
- Large variety of forms
- Specific representation nevertheless unusual and unexpected

➤ ***Distinctive for toys***

Swiss Federal Administrative Court dated September 1, 2015
(Case no. B-1920/2014)



Medical Implants

TM	Device Mark (2D)	3D-Trademark
Register-No.	IR 1 109 077	IR 1 109 213
Representation		
Goods	Implants for osteosynthesis, orthoses, endoprotheses and organ substitutions, anchors for endoprotheses and dental protheses, articular surface replacement, bone spacers; hip joint balls, acetabular shell, acetabular fossa and knee joint components.	
Color claim	Pink (Pantone 677C, edition 2010)	



Medical Preps

Swiss Federal Administrative Court dated September 14, 2016
(Case no. B-3612/2014)



CH no. 57946/2013

- Shape is usual/banal and not distinctive
- Design possibilities are restricted to the capsule (shell) design
- White stands for purity; yellow is a basic colour.

➤ ***Non distinctive for medical preps***



What will be next?





Regulatory issues

- Regulatory issues become more important
 - Example: **Plain packaging** in tobacco market
- This will influence consumers perception
 - TMO has to stay flexible (possibly adapt practice in ceratain areas)



Perpetuation of monopolies

- Increased need to perpetuate monopolies due larger markets, longer approval procedures, higher competition etc.
- Certain perpetuation of monopolies is somehow justified and generally possible
- However
 - Only possible to a certain extent
 - Balance between monopoly / free market must be respected



Solution?

- **Interplay** between protective rights becomes more and more important.
- Tailor made and effective protection strategy often **not only bases on one right** but uses the advantages of **all available possibilities** (TM, copyright, design, GIs, company names, personality rights etc.).
- Protection strategy must constantly be monitored and adjusted.



Solution?

- **Interplay** between protective rights becomes more and more important.
- Tailor made and effective protection strategy often not only bases on one right but uses the advantages of all available possibilities (TM, copyright, design, GIs, company names, personality rights etc.).
 - ***No «one fits for all»-solution***



Solution?

- Protection strategy must constantly be monitored and adjusted.
- Especially «new» trademarks often require some creativity and «thinking outside the box»

