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
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 no 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

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

IR no. 1'031'242

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

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

➢ Distinctive for toys

IR no. 1'111'356

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

<table>
<thead>
<tr>
<th>TM</th>
<th>Device Mark (2D)</th>
<th>3D-Trademark</th>
</tr>
</thead>
<tbody>
<tr>
<td>Register-No.</td>
<td>IR 1 109 077</td>
<td>IR 1 109 213</td>
</tr>
<tr>
<td>Representation</td>
<td><img src="image1.jpg" alt="Image" /></td>
<td><img src="image2.jpg" alt="Image" /></td>
</tr>
<tr>
<td>Goods</td>
<td>Implants for osteosynthesis, ortheses, endoprostheses and organ substitutions, anchors for endoprostheses and dental protheses, articular surface replacement, bone spacers; hip joint balls, acetabular shell, acetabular fossa and knee joint components.</td>
<td></td>
</tr>
<tr>
<td>Color claim</td>
<td>Pink (Pantone 677C, edition 2010)</td>
<td></td>
</tr>
</tbody>
</table>
Medical Preps

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

- 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.

CH no. 57946/2013

➢ 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 certain 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»
Thank You