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The "Panton Chair" decision by the Swiss Federal Supreme Court – the end of the 3-D mark as such?

Marcel Bircher
mbircher@froriep.ch

The so-called "Panton Chair", designed by the Danish designer Verner Panton in 1967, was the very first single-form injection-moulded plastic chair and is considered to be one of the most famous and influential chairs of the 20th century. Verner Panton's widow applied for registration of the "Panton Chair" as a three-dimensional trademark in Switzerland.

This application was rejected by the Swiss Federal Institute of Intellectual Property with the argument that the mark was not inherently distinctive. The Swiss Federal Administrative Court overturned that decision, stating that the particular design would convey a dynamic, sculptural character to the form and that the chair would have enough elements (such as the broad rounded foot of the chair which would remind one of a veil dragged along the floor) to be sufficiently individual in comparison with other chair forms and that thus the trademark was inherently distinctive.

The Swiss Federal Supreme Court once again overturned that decision (ATF 134 III 547). It stated that the issue of distinctiveness had to be decided with regard to the perception of the Swiss end consumer showing an average degree of attentiveness. It went on to state that a three-dimensional trademark has to distinguish itself from all other forms in the claimed product field in a noticeable way, because consumers will not normally consider the shape of a product to be an indication of origin but rather a mere design. According to the Court, to be distinctive, the form will – in particular if a lot of forms exist in the relevant product field – have to have peculiar characteristics, which will only be the case if the form claimed as a trademark is completely different from all other pre-existing forms. Turning to the form in question, the Court noted that there are a wide variety of different forms for chairs. With regard to this variety of forms, the Court decided that the form of the "Panton Chair" would not be so different that consumers would consider this form to be an indication of source, i.e. a reference to a specific enterprise. In fact, in the longterm memory of con-

sumers, the form of the "Panton Chair" would not differentiate it from other excentric chair forms. The Federal Supreme Court thus declared the "Panton Chair" not to be inherently distinctive. It sent the matter back to the Federal Administrative Court which now has to decide whether the form has acquired distinctiveness through use and may be registered under this title. Should this not be the case, then the application will be rejected.

With this decision, the Federal Supreme Court has clearly once again raised the requirements for a successful application for a three-dimensional trademark as such (i.e. if the three-dimensional trademark coincides with the product, as opposed to the situation where the three-dimensional trademark is an extra to the product). The "Panton Chair" decision is regarded by practitioners as making it next to impossible to register three-dimensional trademarks as such for common products since there will always be the argument put forward by the Institute of Intellectual Property (and subsequently by the courts)

that there already exist a wide variety of forms in the relevant product field and that the form in question would be within that range of pre-existing forms.

Calvi – Trelleborg
When Trademarks with Geographical Content are not Misleading

Jörg von Felten
jvfelten@froriep.ch

The Background

Under the Swiss Trademarks Act, misleading signs are excluded from trademark protection (art. 2 lit. c of the Trademarks Act). There has been case law according to which a sign is considered misleading inter alia if it contains geographical information and the addressees understand this geographical information as a designation of origin of the goods but the goods do not in fact come from the respective country or location. On the other hand, if the geographical element of a sign is not understood as a designation of origin, the respective sign is not considered to be misleading.

A geographical element is not considered as a designation of origin if, for example, the geographical description is unknown to the relevant addressees, the addressees consider the sign as an imaginative designation despite its geographical content or the respective location obviously cannot be the place of production or the place of trade of the goods. In these cases, as the geographical element is not misleading, the respective sign may be granted trademark protection under the Swiss Trademarks Act.

Recent Decisions

The Swiss Federal Administrative Court has recently dealt with the question of misleading geographical elements in a couple of cases.

The Swiss Federal Institute of Intellectual Property had decided that the sign "Calvi fig." for goods in the international class 6 was misleading because addressees would expect goods labelled with the sign "Calvi" to come from the small town of Calvi on the island of Corsica or at least from somewhere on Corsica, which was not the case. The Administrative Court annulled this decision. It found that although Swiss consumers may know Calvi (Corsica) as a tourist destination, they would not regard the sign "Calvi, fig." as a designation of origin, because the word "Calvi" has meanings other than the name of the small town on Corsica. There exist other small towns called Calvi in Italy, and Calvi is also a family name. For these reasons, the Administrative Court concluded that addressees in Switzerland would not understand Calvi as a designation of origin and therefore the sign was not misleading and so is to be granted trademark protection.

In another decision, the Administrative Court had to decide whether the international trademark "T TRELLEBORG, fig." could be granted trademark protection in Switzerland for goods in the international classes 7, 9, 12, 17, 19 and 27. The Institute refused to grant trademark protection because it found that the Swedish city Trelleborg is known in Switzerland, in particular because of its important harbour, and therefore the trademark could mislead consumers if the respective goods did not come from Sweden. The Administrative Court found that for most of the claimed goods, only an insignificant part of the consumers addressed would know that Trelleborg had a geographical meaning and therefore these consumers would not understand Trelleborg as a designation of origin. With regard to nautical equipment and boats, however, the Administrative Court was of the opinion that the consumers of such goods, being shipping experts, may know the Swedish city Trelleborg because of its harbour. Therefore the Court concluded that for such goods, the sign "T TRELLEBORG, fig." may be considered as a designation of origin and consequently be misleading. The Administrative Court consequently decided that the trademark "T TRELLEBORG, fig." is to be granted protection in Switzerland, except for nautical equipment and boats.

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The Firm

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For further information:

- ***Dr Alessandro L. Celli***
  tel +41 44 386 60 00, fax +41 44 383 60 50
  acelli@froriep.ch
- ***Dr Roger Staub***
  tel +41 44 386 60 00, fax +41 44 383 60 50
  rstaub@froriep.ch
- ***Nicola Benz***
  tel +41 44 386 60 00, fax +41 44 383 60 50
  nbenz@froriep.ch