

# SWISS IP & TECHNOLOGY BRIEFING

NOVEMBER 2009

## Protection for Packaging under Swiss Law MALTESERS vs. KIT KAT POP CHOC II



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The legal argument over whether Nestlé Schweiz AG (“Nestlé”) may introduce its bitesize-snack KIT KAT POP CHOC into the Swiss market is finally settled.

As in other countries, Mars Schweiz AG (formerly Masterfoods AG, “Mars”) filed suit against Nestlé with the Commercial Court of Aargau to prevent the launch of KIT KAT POP CHOC in a red plastic packet dis-

playing images of chocolate-coated balls. Mars claimed the distribution of the product KIT KAT POP CHOC in this packaging would create a likelihood of confusion with its well-known chocolate-coated confectionary MALTESERS, distributed in a similar red plastic packet. By copying the MALTESERS trade dress, Nestlé would also unfairly misappropriate the goodwill in the MALTESERS chocolate balls.

The Commercial Court dismissed the suit concluding that the KIT KAT POP CHOC trade dress does not violate art. 2 and art. 3 lit. d and lit. e of the Swiss Unfair Competition Act. In essence, the Swiss Federal Supreme Court confirmed the decision rendered by the Commercial Court of Aargau (BG 4A\_86/2009 (26.05.2009)).

Like the Commercial Court of Aargau, the Federal Supreme Court found that the KIT KAT POP CHOC trade dress does not create a likelihood of confusion with the MALTESERS trade dress. However, the Federal Supreme Court contradicted the Commercial Court’s view that the MALTESERS trade dress did not have any distinctive character. The Federal Supreme Court pointed out that using the term MALTESERS with respect to chocolate covered malted milk balls is very creative. In addition, the trade dress displays the word elements in a very eye-catching way. According to the Federal Supreme Court, displaying a creative word element noticeably on a trade dress would result in a distinctive character for the trade dress in its entirety.

Nevertheless, the Federal Supreme Court rejected the claim of a likelihood of confusion. It found that when looking at the overall impression, the trade dresses



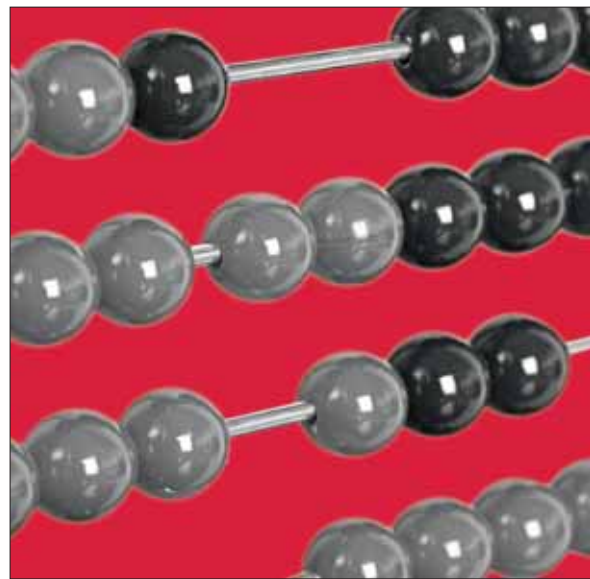
were clearly different. According to the Federal Supreme Court, the overall impression was dominated by the word elements written in stylised letters on each of the trade dresses. The Federal Supreme Court pointed out that the term MALTESERS as well as the term KIT KAT POP CHOC were creative names that could easily be memorised by consumers. Graphically, these written elements were clearly different in shape and the terms used were by no means similar, neither in sound, meaning nor text image.

The Federal Supreme Court found that due to the very different word elements, the relevant consumers would not confuse the MALTESERS chocolate balls with the KIT KAT POP CHOC chocolate balls and, therefore, a likelihood of direct confusion between the trade dresses of MALTESERS and KIT KAT POP CHOC could be excluded. Furthermore, the Federal Supreme Court stated that even a risk of indirect confusion could be excluded. It found that consumers would not have the impression that the products were variants of the same product series and were being distributed by the same company or at least by commercially connected companies.

With this, the Federal Supreme Court deviated from its judgement of December 2006. In July 2006, Mars had obtained a preliminary injunction from the Commercial Court of Aargau, preventing the launch of Nestlé's product KIT KAT POP CHOC in the trade dress described above on the basis that it violated art. 2 and 3 lit. d of the Swiss Unfair Competition Act. The decision was appealed to the Swiss Federal Supreme Court. Surprisingly, the Federal Supreme Court confirmed the lower court's decision, noting that consumers could have the impression that the product came from the same source and was being introduced by the same manufacturer as a variant on its existing product range (see the article in our June 2007 briefing).

However, with the present judgement, the Federal Supreme Court returns to the restrictive handling of protection of trade dress under Swiss unfair competition

law. It clearly confirms the general freedom to imitate. Work results that are not protected by any kind of intellectual property right will be protected against imitations under Swiss unfair competition law only in very specific circumstances.



### **Increase in official fees for trademark registrations from 1 January 2010**

In order to propagate electronic trademark filings, the Swiss Federal Institute of Intellectual Property has applied reduced fees for electronic filings over the past years. Now that apparently 95% of all trademark applications are filed electronically, the Institute is abolishing these reductions.

The trademark registration fee will thus effectively be increased from CHF 350 to CHF 550 on 1 January 2010. This fee includes three classes of goods and services. The fee for each additional class will in effect be raised from CHF 60 to CHF 100.

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## “What on earth was she doing there?": Privacy and Google Street View



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Google Street View went “live” for Switzerland in August 2009. It’s now possible to explore the streets of various places in Switzerland without leaving the comfort of your desk. You can admire our offices at Bellerivestrasse 201 in Zurich for example. But who is that entering our building? Is it a client? In fact, it is my colleague Christina Federle and it is no secret that she works here. But it is easy to appreciate how the capture of someone entering a lawyer’s office could infringe their right to privacy, and the same may be true of people entering or leaving hospitals, prisons or establishments of low repute.

Google Street View has provoked privacy concerns in many jurisdictions and Switzerland is no exception. Around one month after Google Street View’s images of Switzerland went online, the Swiss Data Protection Commissioner reacted with a list of recommendations addressed to Google. People caught on Google’s cameras can already notify Google that they wish their faces or properties to be blurred or deleted. Requests are promptly dealt with. But this procedure depends on the individual concerned being aware that he or his property has been caught on camera. The Data Protection Commissioner found that to be an unsatisfactory solution, particularly as individuals are often still recognizable even after supposed anonymisation. In addition, the Data Protection Commissioner was concerned that the height at which the Google camera is mounted allows it to see into gardens and other private areas normally hidden from the street.

Google reacted to the Swiss Data Protection Commissioner’s recommendations in the middle of October. Apparently the software for anonymising faces will be improved and areas where it may be “embarrassing” for people to be caught on camera will in future be photographed at times of day when few people are about. However, Google is not prepared to accept the Data Protection Commissioner’s recommendation that its camera be mounted lower, explaining that a lower mounting would affect the image quality of street signs and buildings. Nor is Google prepared to give advance notice of new areas to be photographed, as unforeseen factors such as the weather or traffic problems can force Google to change its plans at the last minute. The Data Protection Commissioner had recommended that such information be made available a week before new images were collected and again a week before they were published on the internet. The Data Protection Commissioner is now studying the response from Google and will decide in the coming weeks whether to take further action. If not satisfied, he has the power to refer the matter to the Swiss Federal Administrative Court for a decision.



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### The IP and Technology Group

The IP and Technology Group is active both in transaction and project work and in contentious matters. We have a reputed team dedicated to supporting clients in making the most out of their intellectual property and technological assets. We advise on all aspects of protection, enforcement and exploitation of IP, including advice on related areas such as competition and tax law, and on IP, IT and telecoms contracts.

### The Firm

Froriep Renggli is a leading law firm with offices in Zurich, Geneva, Zug, Lausanne, London and Madrid. For over 40 years Froriep Renggli has been offering its broad range of services to companies and private individuals.

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