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SWISS RE – WE MAKE THE WORLD MORE RESILIENT found to not be misleading

Switzerland - [Walder Wyss](#)

- **The mark was qualified as an indication of source and the IGE requested that the list of services be limited to Swiss origin to avoid misleading the public**
- **The Federal Administrative Court found that the mark was not misleading and could be registered without any geographical limitation of the services**
- **This is positive for companies registered in Switzerland that use the country as the base for their international filings**

In a decision of 25 May 2020 (Case B-5011/2018), the Federal Administrative Court has held that the Swiss word mark SWISS RE – WE MAKE THE WORLD MORE RESILIENT was not misleading despite its geographical content and ordered the Swiss Federal Institute of Intellectual Property (IGE) to register the mark without limiting the services to those of Swiss origin.

Background

Article 47(1) of the Trademark Act states that, if the relevant public expects a geographical indication of a trademark to specify the origin of the claimed goods or services, this is considered to be an indication of source. Trademarks containing an indication of source can be registered provided that they are not misleading (Article 2(c)). This means that this type of mark can be registered only for goods or services for which the actual origin corresponds to the indication of source as per Article 48.

The IGE had qualified SWISS RE – WE MAKE THE WORLD MORE RESILIENT as an indication of source and held that, in the course of the trademark examination, it would go beyond its capacity to verify whether an indication of source of a service mark is correct according to Article 49. In particular, it held that the place of effective administration as per Article 49(1)(b) – a new prerequisite incorporated into law under the Swissness regulation – cannot be subject to review in trademark examination as this fact cannot easily be proven and verified. In order to exclude any likelihood of being misleading, it requested the list of services to be limited to Swiss origin. Swiss Re Ltd challenged this decision before the Federal Administrative Court.

Decision

The Federal Administrative Court held that the relevant public – in this case both experts and the wider public – would not only understand the words ‘Swiss Re’ as ‘Swiss Reinsurance’, but also know the meaning of the English ‘we make the world more resilient’. Due to the word element ‘Swiss’, it was of the opinion that the trademark indicates a geographical source and confirmed the IGE’s view that the mark represents an indication of source as per Article 47.

The Federal Administrative Court then examined whether the IGE was right to dismiss the submitted proof in relation to the services’ origin and to request the trademark’s list of services to be limited to a certain origin. The court found that the extract from the commercial registry shows not only that the trademark owner has its seat in Switzerland, but also that the majority of persons with signatory rights are resident in Switzerland. Therefore, it held that there was no doubt as to a place of effective administration in Switzerland. The Federal Administrative Court concluded that the criteria to be met cumulatively in accordance with Article 49 are available to examination with a justifiable effort and that the IGE cannot refuse to examine these criteria to avoid an excessive examination effort. Accordingly, the trademark in question was held to not be misleading, and the court stated that it should be registered without any geographical limitation of the services concerned.

Comment

Although it seems questionable whether the mark represents an indication of source or constitutes a mere reference to a well-known business, the court’s decision is to be welcomed. It will be a relief for global companies with a registered seat in Switzerland which seek to protect signs incorporating geographical indications and use Switzerland as the starting point of their international filings. Precautionarily limiting the services protected by a Swiss mark to Swiss origin would have a significant impact on international filing strategies. For example, if the trademark owner wished to claim priority of the Swiss registration or use the Madrid system, it would be bound by the limitation of the services of its Swiss registration, which would quite often cause problems when enforcing trademark rights outside of the country. It would not only have an effect on the mark’s scope of protection, but also raise difficulties in establishing right-preserving use, particularly where the trademark owner renders its services abroad through local, affiliated companies only (which may even be requested by national regulation). In such cases, the trademark owner would not use the mark for services of Swiss origin and may therefore lose its trademark rights. To avoid this, the owner would be forced to file its applications (without the geographical limitation of the services) country by country.

The Federal Administrative Court’s decision, if confirmed by the Supreme Court, will relieve globally active Swiss trademark owners from such a costly and ineffective procedure, and will allow them to use the Madrid System without limiting their services to those of Swiss origin.

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