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SWISS RE - WE MAKE THE WORLD MORE RESILIENT: Federal Supreme Court confirms that services need not be limited to those of Swiss origin

Switzerland - [Walder Wyss](#)

- **The Federal Supreme Court has agreed that the mark was not misleading and was registrable without any geographical limitation of the services**
- **If there is no risk of deception from the outset, there is no reason to restrict the list of goods or services**
- **This is good news for Swiss companies operating globally which seek to protect signs incorporating geographic indications**

The Federal Supreme Court has confirmed the [decision of the Federal Administrative Court](#) regarding the registrability of the trademark SWISS RE - WE MAKE THE WORLD MORE RESILIENT. It considered that the mark was not misleading despite its geographical content and that there was no need to limit the services to those of Swiss origin (Case 4A_361/2020, 8 March 2021).

Background

The lower instances had qualified the service mark SWISS RE - WE MAKE THE WORLD MORE RESILIENT as an indication of source under Article 47(1) of the Trademark Act. The Federal Institute of Intellectual Property (IGE) had held that, in the course of its examination, it would go beyond its capacity to verify whether an indication of source of a service mark was correct under Article 49 of the act. In particular, the IGE held that the place of effective administration under Article 49(1)(b) of the act - a newly adopted prerequisite - could not be subject to review during trademark examination. It therefore requested the list of services to be limited to those of Swiss origin.

The Federal Administrative Court, upon an appeal filed by the trademark owner, Swiss Re Ltd, found that the submitted extract from the commercial register not only showed that the mark owner had its domicile in Switzerland, but also that the majority of persons with signatory powers resided in Switzerland. The court concluded that the criteria to be met in accordance with Article 49 of the act were available to examination with a justifiable effort. Accordingly, the trademark in question was not misleading and could be registered without any geographic limitation of the services at issue. The IGE challenged this decision before the Federal Supreme Court.

Decision

The Federal Supreme Court dismissed the appeal and confirmed the decision of the Federal Administrative Court. It held that the newly-adopted practice of the IGE, whereby the risk of deception could not be offset by anything other than an explicit geographical limitation of the claimed services, went too far. The court opined that, if there was no risk of deception from the outset, there was no reason to restrict the list of goods or services.

In the present case, as the Federal Administrative Court had bindingly found, the trademark fulfilled the requirements of Article 49(1) of the act because the registered office of the trademark owner was undisputedly located in Switzerland, as was the place of actual administration. Hence, the Federal Supreme Court concluded that the services offered by the trademark owner originated from Switzerland in terms of trademark law. Therefore, the mark SWISS RE - WE MAKE THE WORLD MORE RESILIENT - even if it were to be understood as an indication of source, which the Federal Supreme Court did not examine - was held to be admissible under Articles 2(c) and 47(3) of the act, and could be registered without any geographic limitation of the list of services. The court thus disagreed with the IGE's justification for the limitation request due to the concern of avoiding excessive examination efforts.

The Federal Supreme Court further held that the risk of a service mark being misleading could be assessed at the time of registration (such risk was negated in the present case). The fact that the trademark might be transferred or licensed in the future to a party which might not meet the requirements of Article 49 - as the IGE objected - was irrelevant. However, the Federal Supreme Court also confirmed that this conclusion did not impact its own practice regarding trademarks with a geographical element which protect goods. Since the IGE, at the time of registration, cannot have any knowledge of the origin of the goods that the trademark owner will offer under the trademark in the future, it will still be required to limit protection to goods from the corresponding geographical area.

Comment

The Federal Supreme Court's rejection of the IGE's undifferentiated position - whereby the registration of all service marks with an indication of source would be conditional on a geographical limitation of the list of services for precautionary reasons, and without any examination - is significant for Swiss companies operating globally which use and seek to protect signs incorporating geographic indications. The Federal

Supreme Court's final judgment has eliminated the risk of a negative impact on such companies' international filing strategies (see the report on the lower court's decision [here](#)).

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