

Newsletter No.

3

Swiss IP News we provide you with updates on new decisions, the relevant legislative process and other trends in the fields of intellectual property and unfair competition law from a Swiss perspective.

The Swiss Federal Institute of Intellectual Property (Institute) specifies its registration practice on the trademark protection of public signs under the Coat of Arms Protection Act (CAPA)



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Swiss public signs, like the Swiss coat of arms, etc., may be registered as trademarks or elements of trademarks, provided their use meets the requirements of the CAPA. With regard to public signs consisting of official designations (“Amtliche Bezeichnungen”), such as “Confederation”, “federal”, “canton”, “cantonal”, “commune”, “communal” or any other terms that imply a Swiss authority or an official or semiofficial activity, the Institute has recently amended its registration practice (cf. Newsletter of the Institute 2020/04-05 of 27 May 2020).

In principle, an official designation may only be legitimately used by the public body to which it belongs. According to the CAPA, however, a third party may legitimately use an official designation if it is combined with additional word or figurative elements and provided that such use is neither misleading nor contrary to public policy, morality or applicable law. If these conditions are met, the Institute also grants a third party trademark protection for a sign including an official designation.

According to the Institute, the above provisions of the CAPA have led to questions and uncertainties in trademark registration proceedings, especially with regard to the scope of protection of acronyms and abbreviations of official designations. In this light, the Institute has specified the following:

i. known acronyms and abbreviations of the federal authorities (this would apply in particular to the federal departments) as well as the abbreviations of cantonal authorities or

organizational units known across cantonal borders (e.g. the abbreviations of certain cantonal hospitals or universities) would constitute official designations within the meaning of the CAPA. It would follow that a third party could not register a trademark consisting exclusively of such an official designation, irrespective of the goods and services claimed by the applicant;

- ii. not commonly known acronyms or abbreviations of the authorities may also fall under the protection of the CAPA. However, third parties would be allowed to register trademarks consisting exclusively of such a sign under the condition that there is no risk of consumers being misled as to the official character of the supplier of the goods or services claimed. This would in principle only be the case for goods or services typically offered by the authority concerned;
- iii. any official designation or protected abbreviation within the meaning of the CAPA, irrespective of whether it is commonly known to the public or not, could be registered as a trademark element if it is combined with an additional element and if there is no risk of consumers being misled as to the official character of the supplier of the goods or services claimed. When deciding about the registrability of the trademark, the Institute would consider all circumstances of the case, in particular the overall impression conveyed by the sign.

You may find more information on the protection of official signs under the CAPA and the Institute's examination practice with regard to protected public signs, including references to databases containing protected signs, on the Institute's [website](#).

The Walder Wyss Newsletter provides comments on new developments and significant issues of Swiss law. These comments are not intended to provide legal advice. Before taking action or relying on the comments and the information given, addressees of this Newsletter should seek specific advice on the matters which concern them.

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