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12

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.

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International Olympic Committee Loses Trademark For its Founder's Name

In a recent decision, the Swiss Federal Administrative Court confirmed the cancellation of a trademark for the name of the founder of the International Olympic Committee.

While the decision contains interesting clarifications on the use requirement for trademarks in Switzerland, it also provides some learnings for how to protect the legacy of and goodwill associated with a deceased person.

Background

Pierre de Coubertin is widely known as the founder of the International Olympic Committee (IOC) and father of the modern Olympic Games. In 2002, the IOC filed for trademark protection for its founder's name in Switzerland and registered the "DE COUBERTIN" and "PIERRE DE COUBERTIN" trademarks for a variety of goods and services, including, for example, books and clothing. The IOC also had these trademarks registered abroad.

Tempting Brands is a Dutch brand development and licensing company that owns trademarks such as "ROUTE 66" or "Marie Antoinette". Starting in 2015, Tempting Brands sought to register "Pierre de Coubertin" as a trademark for clothing and assorted goods in several countries. This led to a number of disputes between the IOC and Tempting Brands worldwide.

In Switzerland, Tempting Brand's trademark was opposed by the IOC based on its prior "PIERRE DE COUBERTIN" trademark. In the following, Tempting Brands filed cancellation requests against the IOC's two Swiss trademarks. Under Swiss law, if a trademark has not been genuinely used for a period of five years, any person may file a cancellation request with the Swiss Federal Institute of Intellectual Property (IPI). In its decisions of 10 March 2020, the IPI ordered the cancellation of the IOC's

two "DE COUBERTIN"-formative trademarks. The IOC appealed the decision concerning the "PIERRE DE COUBERTIN" trademark.

Decision

On appeal, the IOC argued that any use of "PIERRE DE COUBERTIN" by Tempting Brands would be unlawful. As Tempting Brands thus lacked a legitimate interest in the cancellation request, the request constituted an abuse of the law. The IOC further put forward that, contrary to the appealed decision, the "PIERRE DE COUBERTIN" trademark had indeed been put to genuine use.

In its decision of 18 January 2022 (B-2382/2020), the Swiss Federal Administrative Court confirmed its case law that in order to file a cancellation request, no interest by the requesting party was required. Cancellation requests may be considered abusive in exceptional cases only ([see our Newsletter of September 2021](#)). The arguments put forward by the IOC in this regard, in particular that use of the sign by Tempting Brands would be unlawful, did not relate to the genuine use of the "PIERRE DE COUBERTIN" trademark by the IOC as such, and were thus considered to be outside of the scope of the proceedings. Consequently, the Court considered the cancellation request not to be an abuse of the law.

As to genuine use of the "PIERRE DE COUBERTIN" trademark, the Court found that the in-use investigation report submitted by Tempting Brands was sufficient to credibly show that the trademark had not been genuinely used. Hence, as provided for under Swiss law, the IOC would have to credibly show that the trademark had actually been put to genuine use.

As before the IPI, the IOC had argued on appeal that a museum or museum shop could not be expected to achieve the same sales figures as a commercial business. Even modest sales would suffice for a genuine use of a trademark.

In this regard, the Court held that the standard for the required, serious use of a trademark is the customary practice of commercially reasonable business dealings in the relevant industry. The type, scope and duration of the use as well as the circumstances of the individual case such as size and structure of the company in question needed to be considered. However, it was not relevant whether the trademark owner is a commercial business or a non-profit organization, as the trademark conferred the same rights on its owner.

The Court further found that the evidence submitted by the IOC, which mainly related to products sold in the shop of the Olympic Museum in Lausanne, an online game and a medal awarded for extraordinary sportsmanship, was not sufficient to establish a serious use of "PIERRE DE COUBERTIN" as a trademark in Switzerland. Hence, the Court found that the "PIERRE DE COUBERTIN" trademark had not been put to genuine use and dismissed the appeal. The trademark has since been cancelled from the Swiss trademark register.

Comment

The decision contains interesting considerations on genuine use of a trademark under Swiss law. While the assessment of genuine use allows to take into

account to some extent the special circumstances of the case, such as the size and structure of the trademark owner, whether the trademark owner is a commercial business or a non-profit organization is not relevant.

The key takeaway is, however, that a trademark may in some cases not be well suited to protect and preserve the legacy of and goodwill associated with a deceased person. As a Swiss trademark is subject to a use requirement, it is at risk if it is only used as a reference to a person, but not to designate the products for which the trademark is registered. In such case, other means of protection may seem more appropriate and should be considered in addition to a trademark. In particular, protection as a name of a legal entity such as an association or foundation or protection under unfair competition law may be more promising.

Finally, on a side note, the "Pierre de Coubertin" trademark portfolio built by Tempting Brands was assigned to the IOC in the course of 2021. It has not emerged whether this was a consequence of a settlement or a court order. The IOC has thus regained the trademark for its founder's name – at least for now.

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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