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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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Risk to the Recognition of Shape Marks' Inherent Distinctiveness – 3D Sign for Tetra Pak Was Refused Protection

In a recent decision, the Federal Administrative Court upheld the refusal of the Swiss Federal Institute of Intellectual Property to register Tetra's three-dimensional packaging mark on the grounds that the packaging was a mere variant of the typical shapes of the segment in question and was therefore not distinctive ([B-3904/2021](#) of 29 August 2023).

Background

Tetra Laval Holdings & Finance SA, a producer of industrial cardboard packaging solutions for liquids (the "Plaintiff"), filed an application for the following three-dimensional trademark, amongst others, for packing containers and packing materials made from paper:



After a thorough examination of the Plaintiff's submissions, the Swiss Federal Institute of Intellectual Property ("IPI") ended up rejecting the application, claiming that the packaging did not sufficiently deviate from other ordinary shapes within the same product segment. The IPI further argued that the Plaintiff had not credibly demonstrated the sign's distinctiveness acquired through use.

Challenging the IPI's rejection, the Plaintiff appealed to the Federal Administrati-

ve Court (the "Court"), maintaining that the packaging was indeed distinctive and therefore protectable as a trademark.

Decision

Assessing the trademark's distinctiveness as a three-dimensional sign under Article 2(a) of the Trademark Act, the Court held that it was first necessary to analyse the typical and expected shapes of the goods in question in order to determine the range of shapes within the respective segment and then, in a second step, to examine how the three-dimensional sign in question differed from these shapes.

In its description of the shape in question, the Court referred to a parallelepiped or a cobblestone, white in colour. It observed a large variety of shapes in the segment of packaging for liquid foods and beverages and asserted that this made the creation of a distinctive shape within the segment rather difficult. The Court pointed out that the parallelepiped shape was widely used in the packaging of liquids and non-alcoholic beverages. Referring to the trademark's square base, the Court concluded that the packaging was a mere variant of the typical shapes and thus not sufficiently original to imprint itself on the minds of

even the most attentive members of the public. In response to the Plaintiff's argument that the shape was neither functionally nor aesthetically driven, the Court observed that rounded edges facilitated the handling of the packaging which it considered to be very much a result of a practical modality. Hence, the Court held that the shape was not inherently distinctive.

On the Plaintiff's assertion that its three-dimensional sign had acquired distinctiveness through use, the Court criticised the lacking submission of a demoscopic survey, which it considered to be the most reliable evidence in this respect. Although it recognised that a demoscopic survey was barely possible on such a small scale (the Plaintiff considered only 40 people to be part of the targeted demographic, i.e. specialist circles), this did not, according to the Court, relieve the Plaintiff of its duty to present more than one opinion supporting its claims. Furthermore, the Court considered neither the referenced sales figures nor the quoted turnover sufficient to show acquired distinctiveness.

As a result, the Court found that the IPI had legitimately refused to register the three-dimensional sign as a trademark and dismissed the appeal.

Comment

This decision adds another example to a long list of decisions on trademark protection of three-dimensional packaging shapes. It confirms the restrictive approach of the Swiss courts with regard to the recognition of inherent distinctiveness of three-dimensional shape marks. The greater the required differentiation from the pre-existing set of shapes in a segment, the more the protectability of new packaging marks is called into question (unless proof of acquired distinctiveness succeeds). This becomes ever more relevant given the

constantly increasing variety of shapes for goods and packaging.

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