

Comments and observations of Switzerland
in relation to
the areas of convergence identified in document SCT/35/4

1. Area of convergence No. 1 (Notion of country name)

The notion of country name as detailed in this area of convergence is the same as in Switzerland. Specifically, country names are considered direct indications of origin, i.e. specific designations as to the geographical origin of goods or services. Linguistically correct derivatives – e.g. adjectives – are treated on the same footing as the country names themselves.¹

2. Area of convergence No. 2 (Non-registrable if considered descriptive)

In Switzerland, marks consisting exclusively of country names are also denied registration owing to their descriptive character. Indications of a descriptive nature are objective indications on goods or services (in this connection, see in particular Article 6quinquies (B)(2) of the Paris Convention²). Interested parties do not perceive them as references to any particular company (devoid of distinctive character) and they should in principle remain freely available to all market players (availability requirement)³.

3. Area of convergence No. 5 (Invalidation and opposition procedures)

During the registration procedure, the Swiss Federal Institute of Intellectual Property (the “Institute”) checks as a matter of course whether there are any absolute grounds to deny trademark protection. If so, applications for registration are refused.

¹ Swiss Federal Institute of Intellectual Property, [Trademark Guidelines \(French\)](#) (the “Guidelines”), p. 164. See also Ruling B-5274/2009 of the Federal Administrative Court, point 2.7 – SWISSDOOR.

² This Article stipulates: “*Trademarks covered by this Article may be neither denied registration nor invalidated except [...] when they are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed.*”

³ Guidelines (see footnote 1), p. 109.

Descriptive marks (*grounds for refusal set out in possible area of convergence No. 2*) are denied registration in accordance with Article 2(a) of the [Trade Mark Protection Act \(TmPA\)](#)⁴ on the basis that they are devoid of any concrete distinctive character.

Marks liable to mislead as to geographical origin are denied registration in accordance with Article 2(c) TmPA (*grounds for refusal set out in possible areas of convergence Nos. 3 and 4*). Thus, marks containing country names are denied registration if the list of goods and services is not limited to the indicated country of origin. Under the Institute's restriction practices, any sign containing a reference to a particular geographical origin may be registered as a mark only if it concerns the goods or services corresponding to that reference. The list of goods or services is consequently restricted in line with the expectations of consumers to avoid their potentially being misled. For simple indications of Swiss or foreign origin, the Institute imposes a restriction to the country of origin.⁵ For example, the mark "SWISSPOR" (mark No. [P-470286](#)) is registered in Switzerland for class 17 goods originating from Switzerland.

Individuals establishing that they have a legal interest may file an action with the competent judicial authorities for the annulment of any mark considered to have been registered despite the existence of absolute grounds for exclusion.

4. Area of convergence No. 6 (Use as a mark)

In light of the requirements of Article 10 in relation to Article 9 of the Paris Convention (PC), the Member States should provide the appropriate legal means to interested parties to prevent the use of false indications as to the source of products or services. As specified by the Guide to the Application of the Paris Convention, this provision applies "*to all direct or indirect uses of a false indication of the source of goods, irrespective of whether such indication is the name of a specified locality or country or is joined to a trade name of a fictitious character or used with fraudulent intention*"⁶.

In Switzerland, geographical indications are afforded general protection *sui generis*, independent of any registration. Accordingly, any goods, agricultural or otherwise, are protected provided they meet the conditions set out in the TmPA, an Act which protects any direct or indirect reference to the geographical origin of goods or services against unlawful use (false or misleading indications of origin, TmPA Article 47) with a view to perpetually protecting the value of Swiss indications of origin and establishing a basis on which to effectively combat abusive usages. For example, the indication "St Gallen" is protected for embroidery despite not being listed in any federal or cantonal register.

Where inaccurate indications of origin are used, the TmPA provides for legal action through civil claims. Under Article 52 of the TmPA, any individual who establishes a legal

⁴ Federal Act of 28 August 1992 on the Protection of Trade Marks and Indications of Source (Trade Mark Protection Act), SR 232. 11.

⁵ Guidelines (see footnote 1), p. 180.

⁶ Bodenhausen, Guide to the Application of the Paris Convention for the Protection of Industrial Property, 1969, p. 138.

interest has the capacity to bring an action for recognition of a right or legal relationship. Any individual whose right to an indication of origin has been infringed may also file an injunction to prohibit or eliminate said infringement under TmPA Article 55. An aggrieved party may also file actions for damages, compensation of non-pecuniary losses and forfeiture of profits under TmPA Article 55(2).

The use of inaccurate indications of origin is also a criminal offence prosecutable *ex officio* under TmPA Article 64(1). Intentional use of an inaccurate indication of origin is punishable by fine or custodial sentence of up to one year. If the offender acts commercially, the act is punishable by fine or custodial sentence of up to five years. In the event of a custodial sentence, a fine is also issued.

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