Intellectual Property - Switzerland

TOURBILLON decision – no rule of football

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Recently the Federal Administrative Court had to decide whether the trademark TOURBILLON was misleading in terms of the Trademark Act. The word '*tourbillon*' in French means 'swirl' or 'whirlwind', and in watch-making terms it refers to the addition of a watch escapement to the mechanics. However, it is also the name of a mountain and castle in Sion, the capital of the Swiss canton of Wallis, and the name of Sion Football Club's stadium.

Facts

In 2007 Swatch Group Inc filed an application to register the trademark TOURBILLON for goods and services under Classes 14, 35 and 37. While the Trademark Office accepted the trademark for the Classes 35 and 37 (both covering services) it rejected the registration for Class 14 (watches) because of a geographic reference to the city of Sion. This rejection was appealed by Swatch Group, which argued that consumers recognise the word *tourbillon* as a reference to the clockwork mechanism of a watch and not to the city of Sion. It argued that such an interpretation is obvious because of the trademark's graphical element (a symbolised watch escapement) and because of the particular goods protected under Class 14.

A trademark with a geographic reference cannot be registered if the goods do not originate from the referenced geographic area, because it could be qualified as misleading under Swiss law. An exception can be made only if consumers do not understand the geographic reference as identifying a certain provenance of the goods. This exception was further specified under Swiss law by the Federal Supreme Court in the *Yukon* decision. According to that decision, a trademark is not considered as a geographic reference if:

- consumers do not know the geographic place in question;
- consumers consider the mark as a fantasy symbol;
- the geographic place cannot be considered as a place of production for the goods in question;
- the mark is well known for a certain company;
- the mark can be considered as a type designation; or
- the mark can be considered as a generic designation.

Decision

Based on these earlier legal findings, the Federal Administrative Court held that the word *tourbillon* has different meanings and that the average consumer differentiates between these meanings. In the case at hand, the consumer would make the connection between the goods and the graphical element of the mark to determine the intended meaning. Therefore, '*tourbillon'* cannot be understood as a geographical reference by the average consumer of the protected goods in question (watches).

Comment

The Trademark Office seems to have associated *tourbillon* primarily with football; the judges of the Federal Administrative Court on the other hand made the association between *tourbillon* and (expensive) watches. Even though the Federal Administrative Court's reasoning is well founded, the decision proves again that decisions in trademark law very much depend on the personal background and prejudices of the decision maker. However, the decision does not represent a major change in the jurisprudence of the Federal Administrative Court regarding geographical trademarks.

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