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Federal Administrative Court confirms that figurative mark containing the word 'Paris' is deceptive

Switzerland - [Meisser & Partners AG](#)

- Lidl applied to extend protection of the international trademark ESMARA SEE YOU IN PARIS to Switzerland for goods in Classes 14, 18 and 25
- The IGE found that, as the sign contained the geographical indication 'Paris', the mark would be deceptive if the goods did not originate from France
- The Federal Administrative Court agreed that the element 'Paris' would lead consumers to believe that the goods were manufactured in the French capital

The Swiss Federal Administrative Court has confirmed a decision of the Federal Institute of Intellectual Property (IGE) in which the latter had refused to register the figurative trademark ESMARA SEE YOU IN PARIS for goods in Classes 14, 18 and 25 of the Nice Classification (Case B-2510/2019, 8 October 2019).

Background

German company Lidl Stiftung + Co KG applied for the extension of the international trademark No 1328088 (depicted below) to Switzerland for various goods in Classes 14, 18 and 25.



On 8 December 2017 the IGE refused to register the trademark on the ground that it was deceptive. The IGE mainly argued that, as the sign contained the geographical indication 'Paris', the mark would be deceptive if the goods in question did not originate from France.

On 2 May 2019 Lidl filed an appeal against the refusal, arguing that the relevant consumers would not see the element 'Paris' as a geographical indication.

Decision

The Federal Administrative Court first found that the element 'esmara' was the Spanish name of a desert city in Morocco. However, this fact would not be known by the relevant consumers and the element would be perceived as a coined word. The court further found that the element 'see you in Paris' would be easily understood as 'meet you soon in Paris'. The fact that the mark contained an image of the Eiffel tower next to the word 'Paris' clearly showed that that word referred to the capital of France. Therefore, 'Paris' could be qualified as a geographical indication.

Lidl tried to argue that 'esmara' was clearly associated with itself and filed a Google search as evidence. However, the court stated that the search did not show secondary meaning and only related to the element 'esmara'. The court concluded that the element 'Paris' would lead consumers to understand that the goods were manufactured in the French city. Therefore, it dismissed the appeal.

Comment

The decision highlights that the authorities in Switzerland are very strict when it comes to geographical indications. If a mark includes a geographical indication, the goods/services must usually be limited to the country to which it relates. According to jurisprudence, only in exceptional cases will the presence of a geographical name not lead to deceptiveness. Such exceptions include little-known geographical names (eg, Yukon), geographical names with a double meaning (eg, Phoenix) and those with a symbolic use (eg, Copacabana).

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