

3D pen shape mark is refused registration Switzerland - meyerlustenberger

Examination/opposition National procedures

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In *Prodir SA v Federal Institute of Intellectual Property* (Case B-5456/2009, June 8 2010), the Swiss Administrative Court has upheld a decision of the [Federal Institute of Intellectual Property](#) (IGE) in which the latter had refused to register a three-dimensional (3D) trademark consisting of the shape of a pen for services in Class 35 of the [Nice Classification](#).

On November 29 2006 Prodir SA filed an application for the registration of the mark for "the advertisement, marketing and distribution of promotional materials", "services in connection with the personalization of promotional pens, namely printing logos and/or company names on pens, and consultation services in connection with the printing of pens", as well as "consultation services in connection with promotional materials" in Class 35.

The application was rejected by the IGE on the grounds that the mark was descriptive. Prodir argued that the mark did not target the average consumer, but marketing specialists, who would recognize the shape of the pen and perceive it as the source of origin of the services. In addition, Prodir emphasized that the same mark had been accepted for registration for marketing services in Class 35. The IGE dismissed all of these arguments and Prodir appealed to the Administrative Court.

The court upheld the IGE's decision, concluding that the mark was not able to serve as an indication of origin. The court reasoned that 3D marks could be descriptive of services if they were not sufficiently different from the forms commonly used in the relevant market. With regard to the services at issue (ie, services in connection with promotional materials), the court held that the target consumers consisted not only of marketing professionals, but also of the average consumer. In this respect, the court pointed out that, in smaller companies, it was not necessarily marketing professionals who would order promotional materials.

The court further held that, since the goods were closely linked to the services at issue, the mark was to be examined under the test set forth in Article 2(b) of the [Swiss Trademark Act](#). Based on this test, the court concluded that the cap of the pen and all the other elements of the mark were purely functional and, therefore, devoid of distinctive character.

Finally, the court dismissed the argument that the IGE had granted protection to an identical mark for marketing services. Prodir had also argued that a 3D mark consisting of the shape of a hanger had been registered for marketing services. However, the court dismissed this argument, holding that applicants are not entitled to equal treatment because the public interest must prevail.

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