

Registration of MOBILITY trademark allowed for certain services Switzerland - Meyer Lustenberger

Examination/opposition National procedures

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The Federal Administrative Court has partly reversed a decision of the [Federal Institute of Intellectual Property](#) (IGE) refusing to register the trademark MOBILITY for goods and services in Classes 12, 35, 36, 38, 39 and 42 of the [Nice Classification](#) (Case B-7405/2006, September 21 2007).

On March 12 2004 [Mobility Genossenschaft](#), the biggest Swiss car-sharing company, filed an application for the registration of the trademark MOBILITY for the following goods and services:

- vehicles (Class 12);
- business management, business administration and office functions (Class 35);
- insurance, financial affairs and monetary affairs (Class 36);
- telecommunications using computerized support (Class 38);
- transportation, in particular car transports; vehicle, garage and parking place rental; transport of passengers, chauffeur services and courier services; travel arrangements, travel booking and reservation services (Class 39); and
- technical research and technical project studies (Class 42).

The IGE rejected the application on the grounds that the trademark MOBILITY was descriptive of the goods in Class 12 and the services in Classes 38, 39, and 42. Mobility argued that the trademark was inherently distinctive and had also acquired distinctive character. The IGE concluded that proof of acquired distinctiveness existed only for car rental services, and not for the remaining products. Mobility appealed the decision.

The Federal Administrative Court allowed the appeal in part and granted the registration of the trademark MOBILITY for the following services:

- vehicle, garage and parking place rental; travel booking and reservation services in Class 39; and
- technical research and technical project studies in Class 42.

The court confirmed the IGE's decision with regard to:

- vehicles in Class 12;
- telecommunications using computerized support in Class 38; and
- transportation, in particular car transports; transport of passengers, chauffeur services, courier services; travel arrangements in Class 39.

The decision may be appealed to the Supreme Court.

The decision emphasizes the fact that the descriptive character of a trademark must be assessed for every product claimed. Furthermore, the decision applies the rule established by the Supreme Court that trademarks involved in borderline cases should be registered; this rule is often ignored by the IGE.

The decision also dealt with the issue of whether documents establishing the use of the trademark for car rental services could also serve as proof of use for the remaining services. The court answered this question in the negative, arguing that the trademark was being used differently for the various services.

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