

### Qatar Airways fails to register its trademark Switzerland - Meyerlustenberger Lachenal

### Examination/opposition National procedures

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The Swiss Administrative Court has upheld a decision of the [Federal Institute of Intellectual Property \(FIIP\)](#) in which the latter had refused to register the word mark QATAR AIRWAYS for paper goods in Class 16 and services in Class 39 of the [Nice Classification](#) (Case B-5786/2011, November 23 2012).

On January 28 2009 [Qatar Airways QCSC](#) applied for the registration of the word mark QATAR AIRWAYS with the Swiss trademark registry (Application No 50905/2009). The application sought protection for "paper, cardboard and goods made from these materials (not included in other classes); printed matter; bookbinding material; photographs, stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes), printers' type; printing blocks" in Class 16 and "transport; packaging and storage of goods; travel arrangements" in Class 39.

The FIIP rejected the application on June 8 2009, holding that:

- the trademark was descriptive and deceptive with regard to all claimed goods and services; and
- therefore, registration of the mark would violate Swiss and international law.

The applicant responded to the refusal by claiming that the trademark possessed, if not inherent, acquired distinctiveness through extensive use. The FIIP thereafter allowed the registration of the mark for "bookbinding material; photographs, stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); plastic materials for packaging (not included in other classes), printers' type; printing blocks" in Class 16. For the remaining goods in Class 16 and all the services in Class 39, the FIIP withheld its refusal. On September 16 2011 the FIIP issued a final refusal after the applicant had made two additional submissions claiming inherent and acquired distinctiveness.

On October 19 2011 the applicant appealed to the Swiss Administrative Court, requesting that the FIIP's decision be reversed in its entirety and that the trademark QATAR AIRWAYS be admitted for registration. In its appeal, the applicant claimed, among other things, that:

- its trademark should be treated in the same way as the trademarks BRITISH AIRWAYS and SOUTH AFRICAN AIRWAYS, which were registered based on acquired distinctiveness; and
- the requirement of proof of acquired distinctiveness in all parts of Switzerland be waived due to the fact that there is no internationally important airport in the Italian part of Switzerland.

The court dismissed the appeal and upheld the FIIP's decision.

With regard to the products in Class 16, the court held that the mark could describe their content. Contrary to the decision in the [PIRATES OF THE CARIBBEAN case](#), the court held that there was no additional element in the QATAR AIRWAYS mark that could render it fanciful. Concerning the transportation services, the court ruled that the mark was directly descriptive and that there were no exceptional circumstances that would allow registration. In contrast to the [ROYAL BANK OF SCOTLAND](#) and [SWISS ARMY](#) cases, the court saw no reason to favour the applicant on the grounds that it was the only national airline, since the latter had failed to provide sufficient proof that it was, actually and legally, the sole national airline of Qatar. The court also considered extensively the documents provided by the applicant to establish proof of acquired distinctiveness of its mark, and concluded that most of the documents did not pertain to use of the mark itself or use of the mark as a trademark, but rather to use as a company name. Finally, the court dismissed the 'equal treatment' argument, holding that the circumstances were different in the cited cases.

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