

Switzerland: provisional refusal definitely limits grounds for refusal

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In a recent decision, the Federal Administrative Court reminded everybody that under Article 5(2)(a) Madrid Protocol, any refusal of protection of an international mark may only be based on the reasons that have been notified to International Bureau (WIPO) within the one year period from the date on which the notification of the extension has been sent to the national IPO. The decision concerns Switzerland, but applies in principle whenever the Madrid Protocol applies.

Applicant had extended protection of its international mark TITAN, claiming protection among others for car shampoo, to Switzerland. The Swiss IPO provisionally refused protection based on the reasoning that TITAN is descriptive, and therefore lacks distinctiveness, for goods containing titanium (dioxide). Applicant subsequently amended the list of goods with the disclaimer "any of the aforementioned goods not containing titanium or titanium dioxide".

The Swiss IPO, never slow to find grounds for refusal, now pointed out that the mark was *deceptive* for goods not containing titanium (dioxide).

The applicant appealed the final refusal to the Federal Administrative Court and won. The Court reasoned that the initial refusal only mentioned lack of distinctiveness as ground of refusal, not deceptiveness (which is mentioned in a different subsection of Article 2 Swiss Trade Mark Act). The amendment of the list

of goods did not justify the admission of the late raised ground of refusal “deceptiveness”. The IPO could have been expected to raise this ground in the provisional refusal. Deceptiveness could therefore not justify the refusal, and the mark was allowed to register.

The case is interesting because technically speaking, the mark finally admitted on the register is not identical to the mark for which the protection was initially extended to Switzerland because of the amended list of goods. Is in such a case the provisional refusal really binding for the national office? The Federal Administrative Court believes so. One can see reasons to see it differently. But as the case stands, applicants should carefully check whether the grounds for refusal in the final office action are the same as those mentioned in the provisional refusal, otherwise, they stand a good chance to win on a technicality. Do not be surprised, however, if the Swiss IPO now adopts a “laundry list” approach to absolute grounds of refusal in provisional refusals.

Decision B-2363/2015 of 11 October 2016.