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The prince and his prince house – where he lived happily ever after

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The Swiss Federal Administrative Court, as the appeal authority in opposition proceedings, supported the decision of the FIIP and ruled that there was a likelihood of confusion between the younger trademark “Prinzenhaus” (engl. prince house) and the earlier trademark “Prinz” (engl. prince) even if the court considered “Prinz” to be descriptive (decision no. B-3072/2021 of 12 April 2022)

The Swiss Federal Appeal Court upheld the FIIP’s decision to grant the opposition based on the trademark PRINZ protected in Nice Class 33 against the trademark PRINZENHAUS, which was filed for various alcoholic and non-alcoholic beverages in Nice Classes 32 and 33.

The Federal Administrative Court confirmed that there is a similarity of goods between beer and wine “since they are consumed on similar occasions, e.g. at an aperitif or a dinner”. Equally, there is a similarity between non-alcoholic beverages (mineral waters, fruit drinks, syrups, etc.) and alcoholic beverages, because they are often combined, e.g. in cocktails, and these beverages are offered in the same selling business.

The court also says that there is a phonetic and visual similarity of signs between PRINZ and PRINZENHAUS, because the word element “Prinz” (engl. prince) is taken over completely and forms the dominant element in the word “Prinzenhaus” (engl. prince house), in particular because the beginning of the word deserves special attention when comparing signs. Because the target public additionally understands “Prinzenhaus” as “house of the prince” and therefore associates it with the prince as the royal heir to the throne or “princely connections”, the similarity of the signs is also affirmed on the basis of the meaning. However, while the first instance still assumed that “Prinz” would not be perceived as an indication of quality and would therefore not be considered laudatory, the Swiss Federal Administrative Court found that a product that is marked with “Prinz”, similar to “König” (engl. king), “Kaiser” (engl. emperor) or “royal”, is a product of excellent quality, which is why “Prinz” certainly has a laudatory effect. “Prinz” is therefore descriptive in the sense of an indication of quality and therefore enjoys only a weakened distinctiveness. This conclusion was reached deliberately contrary to the decision of the first instance and relevant older case law. Finally, despite the weak distinctiveness of the earlier sign, the court concluded that there was a likelihood of confusion anyway due to the similarity of the goods and the similarity of the signs, because the word element “Prinz” was taken over integrally,

and no sufficient difference was created with the addition of the word “-haus” (engl. house).

The decision consolidates the case law of the Swiss courts, according to which, as soon as an older trademark is integrally taken over into a younger trademark, a similarity of the signs is assumed, which gives rise to a likelihood of confusion. This will mostly be true as far as a non-descriptive part of the older trademark is taken over and the younger trademark is not characterized by distinctive additions. Dogmatically, however, the decision is not entirely comprehensible against the background that the word “Prinz” shall be purely laudatory and not distinctive. In that case, even a sign component that is not directly descriptive, such as “house”, should lead to a denial of a similarity of signs in the overall impression. Ultimately, however, the question arises as to whether “Prinz” is actually purely laudatory and so weakly distinctive as the court says. That may be the case with common advertising terms such as “royal”, but not with the word “Prinz” which seems to be a rather less used term in advertising for food products and beverages. We should be careful that any term with a positive connotation is not directly regarded as merely a laudatory statement and not distinctive.

As a result, it is understandable that the prince was saved, but another path could have been taken to do so ...

(Co-written with Andrea Schäffler)

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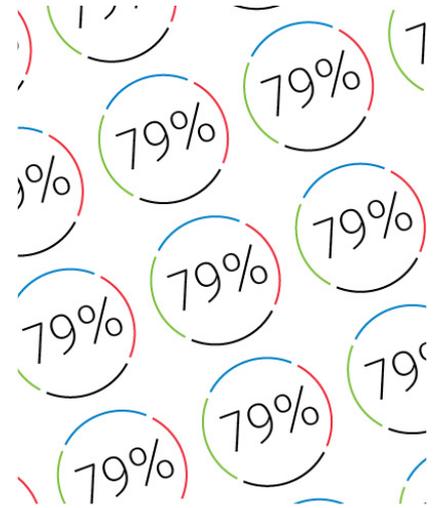
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