

# Kluwer Trademark Blog

## SWITZERLAND: IPAD MINI – mini distinctiveness

Jérôme Pernet (Tradamarca) · Monday, February 13th, 2017

Apple Inc.'s International Registration No 1152788 for the mark "IPAD MINI" was provisionally refused in Switzerland in 2014. The Swiss Trademark Office (IPI) considered that the mark was descriptive of the nature of the products in Class 9 ("*Handheld mobile digital electronic device comprising a tablet computer* [...]). It argued that it would be immediately understood as a "small tablet with information technology" or a "small tablet for Internet". The Applicant challenged that provisional refusal with the IPI and presented several arguments such as the fact that the letter "I" may carry several references, the fact that the Applicant owns a family of marks all built with the "I"-prefix (but it didn't actually claim that the mark had acquired distinctiveness). Last but not least, it also pointed out that the IPI had accepted to register the (word) mark "IPAD" in 2010! The IPI nevertheless maintained its position and rendered a rejection decision which the Applicant appealed before the Federal Administrative Court ("the Court").

At this point, it should be reminded that back in 2009 the Court ruled that the mark "IPHONE" lacked distinctiveness. But the IPI's U-turn in the present case is between 2010 and 2014 so that it cannot be a consequence of the Court's 2009 "IPHONE" decision.

In the present case, the Court disagreed with the IPI, reversed the decision and ordered the IPI to grant full protection of the "IPAD MINI" mark in Switzerland.

The Court first applied a strange method of analysis of the mark, splitting "IPAD" into "IP" and "AD", (Internet Protocol and Art Director or Analog-to-Digital...), what of course permits to rule out any descriptive meaning. The Court then said that "I" doesn't necessarily stand for "Internet" or "Information" or "Information Technology", but could have a number of different meanings depending on the context (but it carefully avoided mentioning any other meaning). Turning its attention to "PAD", the Court considered its different meanings, opined that none is necessarily straightforward to the Swiss consumer and concluded that it is not as descriptive as "tablet". But it stated that "PAD" remains weakly distinctive and so does "MINI". The Court finally concluded that "IPAD MINI" (as a whole) was creating an overall impression that remains conceptually unclear in connection with the concerned products of Class 9. The mark was considered "narrowly" distinctive enough and was therefore deemed registrable as a borderline case.

The Court doesn't suggest that its previous ruling on "IPHONE" would be reversed. The fact that "PAD" is not exactly the generic word of the concerned product in Class 9 (like "tablet" is) was probably decisive here. The IPI's lack of consistency certainly played a role, too. The Court's assessment that the meaning of the letter "I" will "depend on the context" maintains a grey area so

that neither the “IPHONE” nor the “IPAD MINI” rulings of the Court can tell anything about the future of other “I”-formative marks such as “IWATCH”, which may be the next to come in the pipeline, should Apple Inc. still have interest in it.

Swiss Federal Administrative Court, [Decision B-7046/2015 of 20 December 2016](#) (not final).

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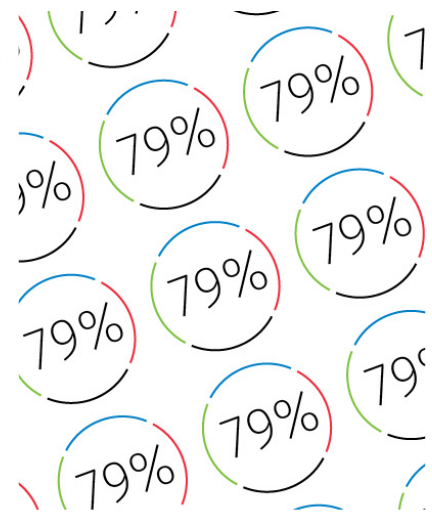
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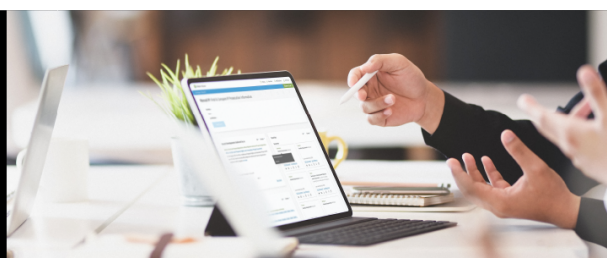


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