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A butterfly like no other gives wings to the Supreme Court

On September 8, 2022, the Supreme Court ruled in case [4A_158/2022](#) on the possibility of registering the word mark “Butterfly” in relation to bags, suitcases and other briefcases (class 18), clothing and shoes (class 25) and toys (class 28).

I. The descriptive nature of the mark

It should be remembered that under the terms of art. 2 lit. a of the Trademark Law, signs belonging to the public domain are excluded from protection. This includes signs considered to be descriptive in the sense that potential buyers are likely to associate them directly with the properties or characteristics of the goods or services for which protection is claimed.

In the opinion of many practitioners, the Federal Institute of Intellectual Property, whose quality can be widely praised, follows a restrictive practice in this matter, sometimes leading to results that are, to say the least, questionable.

Let us take as an example class 9, which refers in particular to software and other data carriers. Thus, the applicant whose mark potentially refers to the content incorporated on the said medium is most often qualified as a descriptive sign. In other words, according to this practice, any trademark that could be understood by purchasers of data carriers as referring to the content on the said carrier would be excluded from protection.

As far as I am concerned, such a practice has always seemed to me to be, to say the least, questionable; I would tend to believe that a sign should only be considered as having a descriptive character in relation to the goods or services covered by the class in which protection is claimed, as set out in the registration.

In other words, if we take the example of class 9, the question would be whether, in the minds of purchasers, the term in question is descriptive of the software or the data carrier itself, and not of the content incorporated therein, which can be very varied and that is not by itself protected by class 9. Needless to say, the answer would then often be quite different.

II. The Butterfly decision

Following a similar approach, the Institute had refused to register the term “Butterfly” for a number of products in the above-mentioned classes, a refusal that the Federal Administrative Court, being more generous, had already relativized by admitting the registration more broadly, but by refusing it nevertheless for the products indicated in the preamble.

The only thing left for the plaintiff to do was to hope for a more liberal approach from the Supreme Court. While the case obviously requires further confirmation, the litigants can hope that a door to a new practice has now been opened by the Federal Court.

The Supreme Court considered that the term “Butterfly”, generally understood by a large part of the Swiss public as meaning “butterfly” and interpreting it as a symbol of freedom and joy, had been regularly used as a motif for many years in the textile industry.

Unlike terms such as “GOLD BAND”, easily understood by the smoking public as referring to the small gold band traditionally used to open packages for tobacco products, the term “Butterfly” is not as evocative and directly associated in the public mind with a particular idea related to bags or clothing (let alone toys).

As the Supreme Court points out, to decide otherwise would be to say that any term likely to evoke a particular shape or design should thus be excluded from registration for these products, which is not the case:

“[...] ist zunächst festzuhalten, dass es selbstredend nicht angeht, jedes Wortzeichen, das auf eine bestimmte denkbare, mögliche Form oder ein bestimmtes denkbare, mögliches Motiv für Gepäck, Kleider, Schuhe oder Spielzeug Bezug nimmt, wegen beschreibenden Charakters vom Markenschutz auszunehmen. Andernfalls wären für diese Waren nur noch Begriffe als Marken schützbar, die sich nicht gegenständlich darstellen. Dies ginge zu weit, [...]”

Only what is descriptive and excluded in relation to the category of goods in question for which protection is claimed must be

considered descriptive and excluded. This is obviously not the case for the term “Butterfly”, as there are so many possible alternatives. As for the absolute need for availability, it is non-existent in the case of the word term, the protection of which cannot extend to the graphic motif itself representing a butterfly.

III. Concluding remarks

The approach taken by the Federal Court in this case is to be welcomed.

Seemingly putting the church back in the middle of the village, the Supreme Court seems to opt for a restrictive approach to the notion of descriptive character. Could this decision be interpreted as meaning that only a term likely to be considered as such in relation to the category of goods or services for which protection is claimed should be descriptive? Therefore, a term that can be understood by the public and used in relation to the said goods in a general manner and, where applicable, for goods belonging to different classes, would no longer be descriptive, but only if it is descriptive in relation to the category of goods or services at issue.

This approach seems correct to me. It remains to be seen whether this is a case in point and whether the Institute will take it into account in its practice from now on, which we can hope for, as this practice appears to be sound and not harmful to the proper functioning of competition. To be continued.

Source :

<https://www.wg-avocats.ch/en/news/intellectual-property/a-butterfly-like-no-other-gives-wings-to-the-supreme-court/>