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Federal Administrative Court: no likelihood of confusion between IMPERIAL marks

Switzerland - [Meisser & Partners AG](#)

- Owner of IMPERIAL mark in Class 33 opposed registration of TIERRA IMPERIAL in same class
- IGE found that 'imperial' was laudatory term that could not be monopolised
- Court agreed that 'imperial' was merely descriptive

The Swiss Federal Administrative Court has upheld a decision of the Federal Institute of Intellectual Property (IGE) in which the latter had dismissed an opposition against the mark TIERRA IMPERIAL based on the mark IMPERIAL (and design), finding that 'imperial' was a laudatory term that could not be monopolised (Case B-5164/2017, 7 August 2018).

Facts

Compañía vinícola del Norte de España SA (CVNE) is the owner of the international trademark IMPERIAL (and design) (No 191596), which covers Switzerland and is registered in Class 33:



Bodegas Verdúgez SAT subsequently filed the international trademark TIERRA IMPERIAL (No 1314007), also in Class 33 and designating Switzerland.

CVNE filed an opposition against the Swiss part of the TIERRA IMPERIAL mark. The IGE dismissed the opposition in its entirety. It held that the element 'imperial' would have a positive connotation. In the field of gastronomy, it would be used as a descriptive and common term for a product of quality. In relation to wines, it would be a directly descriptive term for a specific bottle size (six litres). As such, the opposed sign would be sufficiently distinguishable, as it contained the additional element 'tierra'.

CVNE appealed the decision to the Administrative Court, asking it to overturn the decision of the IGE.

Administrative Court decision

The court agreed with CVNE that the inclusion of the main element of one mark into another mark generally causes a likelihood of confusion. The court also agreed that the element 'imperial' in CVNE's mark would be perceived as an independent element, while the graphical elements would have weak distinctive character. The opposed trademark would be understood as meaning 'imperial earth/land/soil', as the Spanish word '*tierra*' would be understood as such (from the Italian and French words). The court went on to state that the trademarks were phonetically, visual and conceptually similar.

As to whether the marks were confusingly similar, the court considered the word 'imperial' and its scope of protection. The court came to the conclusion that 'imperial' would be understood in Switzerland as meaning "relating to the empire" or "of great quality". As the term would be merely descriptive, the presence of 'imperial' in TIERRA IMPERIAL would not lead to a likelihood of confusion. The appeal was thus dismissed and the opposition upheld.

The court also dismissed the argument that a similar opposition had been upheld by the EU instances as CVNE had based that opposition on another trademark (the IMPERIAL word mark) and, as such, the decision would not be considered as a precedent. According to the practice in Switzerland, certain titles of nobility, such as king, are considered descriptive (eg, the Administrative Court refused to register the trademark MUFFIN KING in Class 30 as it was descriptive (B-528/2016, 17 May 2017)).

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TAGS

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