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Online use is not sufficient to maintain trademark rights in Switzerland

The Swiss Federal Commission of Appeal for IP Rights has ruled that use of a trademark on a website hosted under a generic top-level domain (gTLD) that is not aimed at Swiss customers does not amount to use within the meaning of Swiss trademark law. Accordingly, a trademark that is used only on such a website becomes unenforceable in Switzerland after five years (Decision MA-WI 26/03, June 24 2004).

The ruling stems from an opposition action filed by the [Chicago Mercantile Exchange \(CME\)](#) against the application by [Globix Corporation](#), a provider of application management services, to register the marks GLOBIX and GLOBIX THE INTERNET EXCHANGE in Switzerland for various services in Classes 25, 37, 38, 41 and 42 of the [Nice Classification](#). CME claimed that the marks would be confusingly similar to its prior GLOBEX mark, registered in Switzerland in 1993 for financial services in Class 36. In its reply to the opposition action, Globix argued that CME had not used the GLOBEX mark sufficiently in Switzerland during a continuous period of five years, resulting in abandonment of the mark. The Federal Institute of Intellectual Property (IGE) upheld Globix's argument and dismissed CME's opposition. CME appealed.

The Federal Commission of Appeal for IP Rights upheld the IGE decision. It stated that under Swiss trademark law, the owner of a trademark may no longer assert its rights in the mark if it fails to use the mark in connection with the goods or services for which it has been registered for five consecutive years. Use can consist of deliveries of trademarked goods to customers in Switzerland or advertising if the ads are specifically directed towards customers in Switzerland. The mere use of a trademark on a website accessible under a gTLD, however, is insufficient to amount to use if the website is not specifically aimed at Swiss customers. The commission found that CME operates an online [platform](#) under the trademark GLOBEX available under 'cme.com', which is accessible from Switzerland, but no advertising on that website is specifically directed at Swiss customers. The commission also found that CME had failed to demonstrate that its services were regularly requested by Swiss customers. Accordingly, the commission concluded that CME could not use its GLOBEX mark as the basis of an opposition action against the GLOBIX marks since the use CME had made of its mark in Switzerland during the previous five years was insufficient to maintain trademark rights in that country.

The decision shows that the mere use of a mark on the Internet is not enough to maintain rights in a Swiss trademark registration. Trademark owners should ensure that (i) their advertisements are specifically aimed at Swiss customers, and (ii) they keep records enabling them to prove that Swiss customers regularly request the services offered under the trademark.

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