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Switzerland

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Online trademarks granted same level of protection as famous marks

In *Deutsche Telekom AG v Télésonique SA* (Case 4C.377/2002), the Swiss Supreme Court has ordered the transfer of 'tonline.ch' to the plaintiff - the owner of the T-ONLINE mark. The court's reasoning suggests that all registered trademarks used online should receive the same degree of protection that famous trademarks receive offline, that is, protection against use for any (not just similar or identical) goods and services.

[Deutsche Telekom](#) owns the trademark T-ONLINE. It brought a complaint against [Télésonique](#) for trademark infringement following its registration and use of 'tonline.ch'. Télésonique was using the domain name to host a website offering telecommunication services.

The Supreme Court upheld Deutsche Telekom's claim and ordered the transfer of the domain name. The court's conclusion is perhaps not surprising but two points of note arise out of its reasoning. First, the court stated that the goods and services offered via a disputed domain name are not relevant in assessing the likelihood of confusion between that domain name and a registered trademark. Previous case law in Switzerland has held that likelihood of confusion results from a combination of the degree of similarity between (i) the disputed domain name and a registered trademark, and (ii) the goods and services offered by the parties involved. The Supreme Court's decision seems to suggest that all registered trademarks used online should receive the same degree of protection that famous trademarks receive offline, that is, protection against use for any (not just similar or identical) goods and services.

Second, this is the first time the court has ordered the transfer of a domain name based on trademark law. Previously, courts and commentators have found that the Trademark Act does not grant a legal basis for a claim to transfer a domain name because it only provides for injunctive relief and monetary damages (Article 13(2) of the Trademark Act). The court based its decision to transfer on a provision of the [Code of Obligations](#) that allows awards of non-monetary damages and concluded that the appropriate relief in this case was the transfer of the domain name.

While the result of the Supreme Court's decision is appropriate in view of the facts of the case, it remains to be seen whether the reasoning can withstand close scrutiny.

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