



International Trademark Association  
*Representing the Trademark Community since 1878*

March 17, 2005

Mme Myrtha Hurtado  
Swiss Federal Institute of Intellectual Property

Dear Mme Hurtado,

It has come to the attention of the International Trademark Association (INTA) that your office has issued a revised version of its guidelines on trademark examination, registration and opposition proceedings (“the Swiss guidelines”).

You might be interested to know that INTA had in 1998 developed a set of Guidelines for Trademark Examination to serve as a general reference document for trademark offices worldwide. The guidelines, which are enclosed with this letter, are a result of a collaborative effort involving INTA members representing a variety of different jurisdictions and legal systems. They are not limited to any particular group of trademark offices but reflect an international consensus, supported by INTA, to further the international development and harmonization of trademark laws and practices.

Most of the topics contained in the Swiss guidelines are also covered by INTA’s guidelines, although in some areas, particularly those dealing with non-traditional marks, device marks and relative grounds examination, there are some differences which we have highlighted below.

Specifically referring to non-traditional marks, although INTA does not treat this type of marks any differently from traditional marks and considers that, for example, only graphical representation be accepted, it admits that this could raise particular issues for non-traditional trademarks. (See sections 3.1, 3.1.1 through 3.1.5 of the enclosed guidelines.)

We have also noted that under the Swiss guidelines simple geometrical shapes such as triangles, squares and circles cannot be registered as trademarks due to their non-distinctive character. Under INTA’s guidelines, distinctiveness should be a required element for registration of a three-dimensional mark as it is for all trademarks. The required distinctiveness can be inherent or acquired through use. If, for example, the Examiner determines that the mark, while not inherently distinctive, has acquired distinctiveness, the

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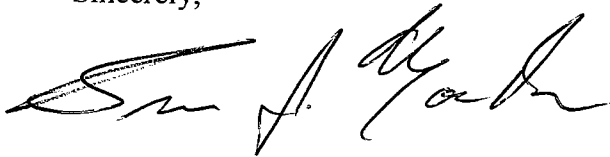
resulting registration of the mark should provide the same scope of protection as if the mark had been determined to be inherently distinctive. (See section 4.1.2.1.)

Contrary to what is covered by the Swiss guidelines in connection with letters and numerals, INTA's guidelines provide that letters and numerals should be registrable if they function to identify source or origin of goods and services and enjoy distinctiveness (either acquired or inherent). Of course they cannot be merely descriptive or deceptively misdescriptive and their distinctiveness may be enhanced by the addition of stylised font and/or design features. (See section 4.1.1.)

As to relative grounds examination and the factors involved in assessing likelihood of confusion, you might find useful the recommendations contained in INTA's guidelines, in particular those referring to the comparison of the appearance of the marks which include recommendations for the comparison of composite and figurative trademarks. (See sections 5, 5.1, 5.1.1, 5.1.2, 5.2, 5.2.1 through 5.2.7.)

INTA is interested in exchanging ideas with you on issues of examination and would welcome your comments or suggestions. If you have any questions, or if we can provide further information, please feel free to contact Ms. Piin-Fen Kok of INTA's staff at +1(212) 642-1715 or [pkok@inta.org](mailto:pkok@inta.org).

Sincerely,

A handwritten signature in black ink, appearing to read "Bruce J. MacPherson". The signature is fluid and cursive, with a large initial "B" and "M".

Bruce J. MacPherson  
Director, External Relations

Enclosure