

# World Trademark Review Daily

**Condom mark held to dilute Harry Potter brand  
Switzerland - meyerlustenberger**

**Cancellation  
National procedures**

December 08 2010

The Cantonal Court of Schwyz has ordered the cancellation of the mark HARRY POPPER for condoms.

Warner Bros Entertainment Inc sued Magic X AG, a manufacturer and retailer of erotic goods located in Pfäffikon, Switzerland, over its use of the mark HARRY POPPER for condoms, including an image of a bespectacled character waving a magic wand:



In its decision of August 17 2010 (the motivation became available only recently), the Cantonal Court of Schwyz cancelled the HARRY POPPER mark and issued a permanent injunction against Magic X.

Magic X had argued, in vain, that the public did not know that HARRY POTTER was a trademark of Warner Bros. While it was true that the public would associate HARRY POTTER primarily with the eponymous character of JK Rowling's books, this did not mean that HARRY POTTER would not be perceived as a trademark. The public was used to seeing the names of fictitious characters on a variety of merchandising articles, and thus expected that the merchandising of a particular character would be controlled by a single source, even if it was not able to name that source.

The court had no difficulty finding that the HARRY POTTER mark was famous under Article 15 of the Swiss [Trademark Act](#), which roughly corresponds to Article 8(5) of the [Community Trademark Regulation](#) (207/2009) (marks with a reputation). Warner Bros produced various consumer surveys from neighbouring countries which showed a recognition rate of 95% for the HARRY POTTER mark among the general public. Even in the absence of a survey from Switzerland, it was unlikely that the mark was not famous in the country since:

- the same languages were spoken in Switzerland;
- the media were partly the same; and
- the *Harry Potter* books and films had reached a wide audience in the country.

The court found that the use of the sign HARRY POPPER on condoms diluted the Harry Potter brand, but it did not address the tarnishment claim. Magic X's use of the name Harry Popper, in conjunction with the image above, created an association with the famous HARRY POTTER mark and, therefore, diluted the distinctiveness (*Unterscheidungskraft*) of the Harry Potter brand.

Magic X was ordered to pay court fees of Sfr8,000 (roughly €6,000) and to pay Warner Bros compensation for legal costs amounting to Sfr13,000 (approximately €10,000). Warner Bros did not claim financial damages.

Warner Bros had filed suit in May 2008, and the judgment was issued only in August 2010, which seems to be a long time for a relatively simple dilution case. However, this is not uncommon for first instance decisions on the merits in Switzerland. It is likely that Warner Bros did not seek a preliminary injunction because it sent a cease and desist letter to Magic X as early as September 2006 and, therefore, would have been barred from requesting a preliminary injunction in May 2008.

Mark Schweizer, meyerlustenberger, Zurich

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