

**World
Trademark
Review**

Switzerland

Meyerlustenberger Lachenal

Michael Ritscher, Guillaume Fournier and Peter Schramm

Designs

2017

A Global Guide

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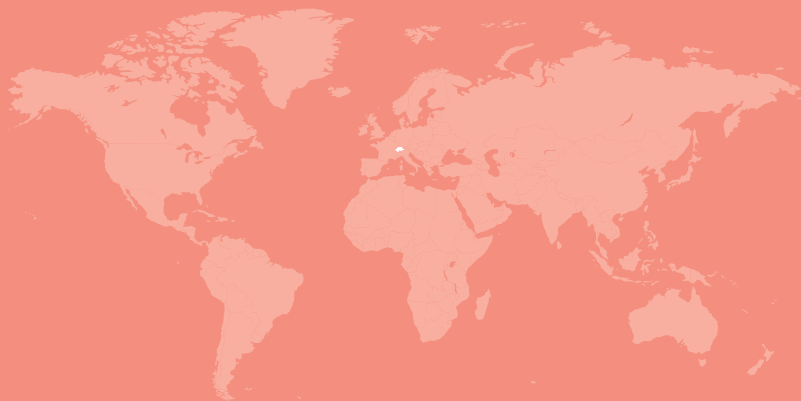
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Legal framework

Design law in Switzerland is governed by the Federal Design Act (2001) and the Ordinance to the Federal Design Act, which contains subsidiary provisions regarding the application and registration procedure before the Swiss Institute of Intellectual Property (IPI). Other legislation that may be relevant includes:

- the Federal Unfair Competition Act (1986);
- the Federal Copyright Act (1992); and
- the Federal Trademark Act (1992).

Switzerland is a signatory to most international treaties, including:

- the Hague Agreement Concerning the International Registration of Industrial Designs and the Geneva Act of the Hague Agreement;
- the Paris Convention for the Protection of Industrial Property;
- the Locarno Agreement Establishing an International Classification for Industrial Designs; and
- the Agreement on Trade-Related Aspects of Intellectual Property Rights.

However, since it is not a member of the European Union, EU design directives and regulations do not bind Switzerland.

Switzerland provides protection for designs of products (or parts of products) as characterised by the arrangement of lines, surfaces, contours, colours and materials used. Design protection requires registration, which can be obtained by applying for either a national design before the IPI or an international design under the Hague System (designating Switzerland). However, since Switzerland is not a member of the European Union, Community designs have no effect.

Unregistered designs

No specific protection for unregistered designs exists in Switzerland. However, an unregistered design may be protected under the Federal Copyright Act if it qualifies as an intellectual creation with individual character, or under the Unfair Competition Act in certain circumstances.

Registered designs

The creator of a design or his or her successor

is entitled to register the design. An employer has the right to register designs created by an employee during and in performance of an employment contract. Any natural or legal person can file a design, irrespective of nationality.

A design right belongs to the first party to register it. However, the priority date may be that of the first filing of the same design in another signatory state to the Paris Convention, provided that the Swiss filing takes place within six months of the first filing date.

To be protected, a design must be novel

and possess individual character. A design is not considered to be novel if an identical design has been disclosed to the public before the date of deposit or priority. Further, a design is not considered to possess individual character if its major characteristics do not differ substantially from those of designs which are already publicly known. The decision regarding whether a design possesses individual character is made through a design-by-design comparison, not by using a mosaic of prior art combining features from different designs.



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Michael Ritscher heads the IP team of Meyerlustenberger Lachenal, an outstanding group of professionals in all areas of IP law who are also noted for their excellent team spirit. He is one of the most experienced and highly esteemed IP litigators and arbitrators in Switzerland. In addition to his substantial patent litigation and arbitration practice in all technical fields, including life sciences, he is often involved in trademark, design and copyright disputes. Dr Ritscher has advised and represented a leading manufacturer of design furniture in all IP matters worldwide for many years. His expertise therefore covers not only Swiss, but also EU and international law, and he is familiar with the perspective of in-house counsel.



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Guillaume Fournier is co-head of Meyerlustenberger Lachenal's trademark and design group. His practice encompasses all aspects of IP law, with a focus on IP litigation and arbitration, trademark and design prosecution and contractual and commercial intellectual property. He has extensive experience in litigating IP cases (both technical and non-technical) in both the French and German-speaking parts of Switzerland. Dr Fournier's clients are active in a wide range of industries, including luxury goods, cosmetics, pharmaceuticals, furniture, technology, automotive and wine. Having taken care of clients' IP issues in China for a long time and practised in China for a year, he regularly advises rights holders on China-related IP and anti-counterfeiting strategies (both inbound and outbound).

The novelty and originality of a registered design can be destroyed by prior disclosure, including by the creator or rights holder. However, the Federal Design Act provides a 12-month grace period after disclosure during which the rights holder can file the design. The grace period presupposes that the disclosure has been effected by the rights holder or by a third party which has acted abusively and to the detriment of the rights holder.

A design cannot be protected if it infringes federal law or international treaties, or if it is contrary to public policy or accepted

principles of morality. Equally, a design cannot be protected if its features are dictated solely by its technical function. However, where at least one alternative in shape exists to realise the same technical or functional effect of the design for which protection is sought, protection cannot be refused.

Spare parts may be protected by design law in Switzerland provided that their shape is not dictated solely by a technical function. Contrary to Community design law, Swiss design law contains no provision that excludes so-called 'must fit' and 'must match' spare parts from design protection.

Once registered, a design benefits from the legal presumption of novelty and individual character and can be challenged only through a legal action (in which the plaintiff bears the burden of proof).

Following the first five-year protection period, validity can be renewed for four further five-year periods. Thus, a design can be protected for a maximum of 25 years. The request for renewal can be made within the 12 months preceding the end of a protection period and no later than six months after protection has expired. Renewal is completed on timely full payment of the renewal fee.

Procedures

The applicant may file the application personally or through a representative. Applicants which do not reside in Switzerland or have their principal place of business there must designate a representative in Switzerland or specify a Swiss correspondence address. The application must be made electronically or by ordinary mail by completing the official IPI form in German, French or Italian.

Article 20 of the Federal Design Act provides for the collective filing of various designs in a multiple registration, provided that they belong to the same product class under the Locarno Agreement. The number of designs covered by a multiple-registration filing is unlimited.

The applicant may request that publication be deferred for up to 30 months from the filing or priority date. In such case, the institute will keep the registered design secret until the deferral period expires. If the application is withdrawn before the deferral period expires, secrecy will be maintained



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If a design is capable of distinguishing the products or services of one business from those of another, it may be protected and registered as a 3D trademark

indefinitely. During the deferral period, the rights holder may request immediate publication at any time.

The Federal Institute of Intellectual Property conducts only a formal examination, including the quality of the images; the design's novelty and originality are not included in the examination.

Enforcement

A rights holder may prevent others from using its registered design for commercial purposes. This includes manufacturing, storing and offering, distributing, importing, exporting, carrying in transit and possessing products for such purposes.

The scope of protection of a design includes not only identical shapes, but also all designs that copy the essential features and thus produce the same overall impression as the registered design. The overall impression resulting from a direct comparison by informed users is decisive, and variation of the details will not create sufficient distinction from the protected design.

The owner of a design registration has several options for taking action against infringers. In particular, it may apply for an injunction against imminent infringement or an action to eradicate existing infringement and ask for compensation of legal costs and damages.

Only attorneys at law admitted to the Swiss Bar can represent parties in design law litigation before the courts. In contrast to patent law proceedings, which are handled before the unitary Federal Patent Court, design law proceedings are not assigned to a single court. Instead, each Swiss canton has a specific court to hear these cases. In ordinary proceedings at most Swiss courts, a reconciliation hearing will take place after

the first exchange of submissions (after approximately three to four months), in which the court gives a preliminary assessment of the case. In many cases, litigation is concluded in these hearings by means of settlement agreements.

The courts may grant a preliminary injunction in case of *prima facie* infringement or validity and irreparable harm. In urgent cases, the courts may also grant *ex parte* injunctions. Contrary to German law, main proceedings must always be initiated within 30 days of a preliminary injunction in order to confirm the injunction.

Finally, in order to prevent potentially infringing goods from being imported, exported or carried in transit, the rights holder may apply for assistance from Customs. In such cases, customs officials will check consignments for suspicious products and, where appropriate, withhold them so that the rights holder can obtain preliminary measures. However, preliminary measures are not necessary in order for the rights holder to request the infringing goods to be destroyed by Customs.

Ownership changes and rights transfers

A design right can be freely transferred in whole or in part. In order to be valid, the assignment must be effected in writing. Recordal of the assignment in the trademark register has no influence on the validity of the assignment; however, the transfer of a design can be enforced against third parties acting in good faith only once it has been entered in the register.

Design rights can be licensed either exclusively or non-exclusively. The licence is valid without being recorded in the design register. However, if a licence is recorded in the register it will be enforceable against any subsequently acquired right on the design.

Design rights may be pledged and can be the subject of attachment and foreclosure.

Related rights

Swiss case law extends the cumulative design protection provided under the Unfair Competition Act. To date, such protection has been limited to cases where products are imitated or otherwise commercialised in a way that creates a likelihood of confusion. According to recent case law of the Federal Supreme Court, the prohibition against unnecessary comparative advertising also applies to the offering of lookalike products. Finally, although the thresholds are high, exploiting the good reputation of a competitor's products can be unlawful under the Unfair Competition Act's general clause if the alleged infringer's approach is systematic or parasitic, or copies a multitude of the competitor's designs.

If a design is capable of distinguishing the products or services of one business from those of another, it may be protected and registered as a 3D trademark. The design must not constitute the essential nature of the goods or any technically necessary packaging of the goods. In contrast to Community trademark law, no grounds for refusal for 'substantial value' exist in Switzerland. In

most cases, the applicant must prove acquired distinctiveness through use to obtain a trademark registration.

A design may be protected as a work of applied art under the Federal Copyright Act if it qualifies as an intellectual creation with individual character. However, according to Swiss practice, copyright protection is generally not granted to products that are considered to be mere industrial products. The allegedly infringing design need not be identical, but merely recognisable in the older copyright-protected work. **WTR**

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