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Trade Marks 2022

Switzerland: Law & Practice
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MLL

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SWITZERLAND

Law and Practice

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1. GOVERNING LAW AND TYPES OF TRADE MARKS

1.1 Governing Law

In Switzerland, trade marks are protected by the Federal Act on the Protection of Trade marks and Indications of Source (“Swiss Trade Mark Protection Act”) as well as the Trade mark Protection Ordinance. The Swiss Institute of Intellectual Property (IPI) issues further guidelines, eg, regarding opposition proceedings.

Switzerland is a member to most international treaties concerning trade marks, including:

- the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods;
- the Madrid Agreement Concerning the International Registration of Marks and the Madrid Protocol;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement);
- the Nice Agreement on the International Classification of Goods and Services;
- the Paris Convention for the Protection of Industrial Property (“Paris Convention”);
- the Convention of 13 April 1892 between Switzerland and Germany concerning the Reciprocal Protection of Patents, Designs and Trade marks; and
- the Singapore Treaty on the Law of Trade marks.

Once approved by Switzerland, international legal treaties become an integral part of Swiss law. This means that the provisions of the treaties are, in principle, directly applicable if they are self-executing. In some cases, international legal norms are specified for Switzerland, making use of the available scope to adjust the treaty to the national legal system.

1.2 Types of Trade Marks

In principle, a Swiss trade mark is a sign that is capable of distinguishing the goods and services of one undertaking from those of other undertakings. Provided they can be represented graphically, trade marks may be any kind of sign. Trade marks may be words, letters, slogans, numerals, figurative representations, three-dimensional shapes or combinations of such elements with each other or with colours.

The Swiss Trade Mark Protection Act differentiates between individual, collective, certification and geographical marks. In general, trade marks are protected with the entry into the trade mark register. In certain individual cases, however, unregistered signs may enjoy protection, eg:

- through the Paris Convention as a foreign trade name;
- through the Federal Act against Unfair Competition;
- as a geographical indication;
- as a right to the specific name; or
- through the Federal Act on Copyright and related rights.

1.3 Statutory Marks

Swiss law contains specific rules regarding protected public signs. Protected public signs include flags and coats of arms of the Swiss Confederation and the cantons, sovereign signs of foreign countries and signs of international organisations. Trade marks are generally not allowed to contain such protected signs. Furthermore, names, abbreviations and emblems of the United Nations or other intergovernmental organisations may not be protected as trade marks or as elements thereof.

1.4 Well-Known Foreign Marks

According to the “territoriality of trade mark rights,” rights to trade marks acquired by their owners in one state are generally neither auto-

matically recognised nor protected in another state. Thus, the reputation of a sign abroad is, in principle, of no significance. The Swiss principle of a well-known trade mark breaks through this. A trade mark that is well known in Switzerland within the meaning of the Paris Convention receives trade mark protection as if had been registered in Switzerland.

Generally, owners are only able to exercise their trade mark protection rights if the sign has been registered. Well-known marks are an exception of this rule. Switzerland further protects foreign trade marks through international treaties such as the protection of a trade mark as international trade mark under the Madrid System.

1.5 Term of Protection

In Switzerland, a trade mark is protected for ten years starting from the date of application extendable indefinitely, each term for ten years. Each renewal is subject to payment of a renewal fee. If the owner fails to pay the renewal fees on time, the IPI usually grants an additional period of six month and charges an additional fee.

If a trade mark has not been used for an uninterrupted period of five years, its protection may be challenged on the grounds of non-use before civil courts or the IPI. If no non-use has been claimed, the trade mark right can be restored in case of a commenced use after the five years.

1.6 Exhaustion of Trade Mark Rights

There are certain limits applicable to Swiss trade mark law. The trade mark is a means of distinction and is not intended to secure distribution systems. The trade mark right is therefore deemed to have been exhausted as soon as the marked product has been placed on the market with the consent of the trade mark owner. According to the Swiss view, the principle of international exhaustion applies to trade mark law.

A second limitation concerns previously used marks. According to this rule, if a third party has been using an infringing sign prior to a registration, this specific use of the sign in question can be continued. This self-use is not covered by the trade mark protection rights of the owner of the later registered trade mark; however, it is strictly limited to the already existing use (including the particular extent of usage). The utilisation of the sign cannot be extended in any kind (such as expanding to additional services or good, rebranding with the same mark, etc).

1.7 Symbols to Denote Trade Marks

Under Swiss trade mark law, there are no specific symbols used, such as ®. Acquired (ie, registered) trade mark rights exist regardless of the use of a symbol. However, the use of symbols is possible and does usually not cause negative legal consequences under Swiss law unless such use constitutes an act of unfair competition.

2. ASSIGNMENT AND LICENSING

2.1 Assignment Requirements or Restrictions

Trade mark assignment records can be filed directly with the IPI.

A trade mark may be fully or partially assigned, with the exception of geographical marks which must be fully assigned. A partial assignment request must fulfil the same requirements as a full assignment.

Requests to record the assignment of Swiss trade mark applications or registrations should be made in writing, identify the parties to the assignment (ie, the assignor and assignee) and specify the trade mark(s) subject to the transfer of ownership. The assignment request can be

made by either the previous trade mark owner or by the assignee and must include an express declaration from the previous owner stating the transfer of the mark to the assignee, typically by providing an assignment agreement or declaration of transfer document, as well as other necessary documents such as a power of attorney in the case of a change of representative. Template forms for assignment requests and assignment declarations are available on the IPI website.

2.2 Licensing Requirements or Restrictions

A trade mark owner may grant exclusive, non-exclusive, sole and perpetual licences, which may be registered on the register in Switzerland. In the case of exclusive licences, as long as an exclusive licence is entered on the register, no other licences will be registered for the same trade mark(s) which are incompatible with the licence. In the case of partial licences, the goods and services and/or territory to which the licence covers should be stipulated.

A request to register a licence may be filed by either the trade mark owner or the licensee and should be made in writing, identify the parties subject to the licence, and be accompanied by an express declaration by the trade mark owner permitting the licensee to use the trade mark in question.

The above also applies to sub-licences. In cases where the trade mark owner submits a recordal request of a sub-licence, additional proof must be provided showing that the licensee is entitled to grant sub-licences.

Template licence registration forms are available on the IPI website.

2.3 Registration or Recording of the Assignment

It is not mandatory to register a licence on the Swiss register (“Swissreg”), with the exception of a collective mark, which must be recorded. However, registering a licence may be in the interests of a licensee, as it is not possible to enforce a licence against third parties who have in good faith acquired subsequent rights to the trade mark unless the licence is registered.

2.4 Other Requirements for Licences or Assignments to be Valid

There is no requirement to assign or licence the goodwill related to a trade mark.

2.5 Assigning or Licensing Applications

It is possible to assign trade mark applications or grant a licence in relation to trade mark applications in Switzerland. There are no considerations affecting the assignment or licensing of applications based on use or on intent to use, as there is no requirement to file a Swiss application based on use or intent to use.

2.6 Trade Marks as Security

A trade mark can be given as a security interest and may also be assigned. For requirements see **2.1 Assignment Requirements or Restrictions**.

3. REGISTRATION

3.1 Trade Mark Registration

Under Swiss law, a potential trade mark owner must register their trade mark in order to acquire the rights. The main principles of the application procedure can be found in the Swiss Trade Mark Protection Act (Article 28 et seq) and the associated ordinance (Article 8 et seq).

In order to register a trade mark, an application must be filed with the IPI. The registration can be

carried out by using a form sent by post, e-mail or by using the electronic registration process. The electronic application system guides the applicant step-by-step through the whole process and elaborates on how to fill in the sections. The application is then accessible on Swissreg.

In general, there are no different standards for different types of trade marks. Exceptions are trade marks that have acquired distinctiveness (*Verkehrsdurchsetzung*). In order to protect such trade marks – usually signs that belong to the public domain which is usually a ground for refusal – it needs to be proven that the sign has been used extensively as a trade mark in Switzerland for several years.

3.2 Trade Mark Register

Swissreg is the comprehensive trade mark register in Switzerland. The database is publicly available and administered by the IPI. By default a research is carried out before an application to register the trade mark, carried out by the potential trade mark owner or by professional searchers. The IPI provides a list of platforms which can be consulted, a list of professionals that can be contacted in order to fulfil the research, and offers certain services in connection with trade mark searches.

3.3 Term of Registration

The duration of the examination procedure depends on the individual case, however, usually takes between four and five months from the time of the filling fee. After registration (including payment of registration fee), the respective trade mark is protected for ten years. The registration can be renewed indefinitely, for ten years at a time, if a renewal application has been submitted and the fees have been paid. The request for renewal must be filed with the IPI within the last 12 months before the expiry of the period of validity, and at the latest within six months after its expiry.

The renewal application is a mere formality and usually granted without examination.

3.4 Updating or Refreshing Registrations

Many register changes can be requested online via the Trade Mark Database (<http://database.ipi.ch/>), and must be submitted in German, French or Italian. Changes to the relevant register entry are for example the name of the trade mark owner, the address or the representative. Changes which can be made online are changes to the trade mark owner and changes to the representative, licensees, usufructs and pledgees.

It is not possible to change the trade mark itself or to extend the list of goods and services.

Regarding the withdrawal of a trade mark or the modification of parts of the goods and services (Nice classification), it is necessary to fill out a specific form which needs to be sent to the IPI. Adjustments can be viewed on Swissreg; the portal is generally updated every two to four weeks.

4. APPLYING FOR A TRADE MARK REGISTRATION

4.1 Application Requirements

A Swiss trade mark application must include the personal information of the applicant, the mark itself and a list of the goods and services the trade mark is intended to be used for. Any natural or legal person may register a trade mark in Switzerland.

In cases where the potential trade mark owner is not based in Switzerland, an address for service in Switzerland must be specified. If necessary, the applicant also needs to provide a declaration of priority and, if required, indicate whether the mark is a guarantee mark or a collective mark.

After submitting the application, it is then examined for admissibility by the IPI.

Common Trade Marks

In principle, any sign that is capable of being represented graphically can be registered as a trade mark, provided, that the sign is used to distinguish goods or service from others. The most common types of trade marks are:

- word marks;
- figurative marks (visual elements without any word components); and
- combined word and figurative marks.

Less common types of marks are:

- three-dimensional marks;
- acoustic marks;
- position marks;
- colour marks;
- motion marks; and
- hologram marks.

Possible are also trade marks based on “trade mark-related use”.

Multi-class Applications

Multiple-class applications are possible in Switzerland.

4.2 Use in Commerce Prior to Registration

A trade mark is protected to the extent that it is – after registration – used in connection with the goods and services for which it is claimed. To start usage of a registered trade mark, Swiss law contains a five-year grace period. However, in general, there is no requirement to file a Swiss application based on use or intent to use.

4.3 Series Mark Registrations

Under Swiss Law there are no series trade marks. Each trade mark requires its own registration and is published on Swissreg separately.

4.4 Consideration of Prior Rights in Registration

The IPI only examines absolute grounds for refusal. Absolute grounds for refusal concern cases where:

- signs are in the public domain;
- signs include shapes that constitute the nature of the goods themselves, or shapes of the goods or their packaging that are technically necessary;
- if a sign is misleading; or
- in the event a sign is contrary to public policy, morality or applicable law.

Concerning consent of the (older) trade mark owner in particular, the proprietor may assign their trade mark in whole or in part for the goods or services for which it has been claimed. The assignment is only valid if evidenced in writing. Furthermore, the proprietor of a trade mark may permit others to use it for the goods or services for which it is claimed, in whole or in part, and for the whole territory or a part of Switzerland only. The licence shall be entered in the register at the request of one of the parties.

4.5 Consideration of Third-Party Rights in Registration

The owner of an earlier trade mark may file an opposition to a registration on the basis of Article 3, paragraph 1 of the Swiss Trade Mark Protection Act. The opposition must be submitted in writing to the SIPI with a statement of reasons within three months of publication of the registration. The relevant opposition fee must be paid within the same time limit. If the opposition is justified, the registration shall be revoked (in whole or in part). In addition to the opposi-

tion, the proprietor of an earlier trade mark also has the option of filing an action before the civil courts either in parallel or at a later stage during the opposition proceedings.

4.6 Revocation, Change, Amendment or Correction of an Application

The applicant can modify their trade mark free of charge during the entire registration process. At a later stage, when the trade mark has been registered, modifications may be made in exchange for an administrative fee.

4.7 Dividing a Trade Mark Application

Irrespective of a partial assignment, the list of goods and services of a trade mark application or registration can be divided at any time in such a way so that two or more trade marks or applications for registration are created. The prerequisite is a written application by the owner, which must indicate precisely how the claimed goods and/or services are to be divided.

The division gives rise to legally independent registrations or applications for registration, which retain the filing and priority date of the original registration or application. In the event of the division of registration applications, a filing fee must be paid for each partial application.

4.8 Incorrect Information in an Application

The IPI informs the applicant in writing about the nature of the legal or factual issue concerning the registration process. Depending on the particular issue, a grace period is set by the IPI. The IPI may be contacted free of charge at any time or the purpose of clarifying such issues and/or any open questions.

4.9 Refusal of Registration

The IPI examines applications based only on absolute grounds of refusal in accordance with Article 2 of the Swiss Trade Mark Protection

Act. Relative grounds for refusal are not subject to the initial evaluation process. However, after publication of an applied-for trade mark, potential opponents have the possibility to file an opposition referring to relative grounds for refusal.

In such opposition proceedings, the IPI will examine relative grounds for refusal. In the event the IPI follows the opposing party's arguments, registration of the applied trade mark will be refused and deleted from the register. The applicant, however, still has the possibility to appeal to the Federal Administrative Court. Additionally, at all stages during the application process (and prior or after such proceedings), the parties are entitled to initiate civil court proceedings having full cognition to examine the legality of a particular trade mark.

The IP can also reject trade marks that are not in accordance with good morals (eg, abusive language, violation of religious feelings) and marks that are abusive or misleading (eg, misrepresentation of product characteristics, obviously incorrect information on origin).

4.10 Remedies against the Trade Mark Office

Decisions of the IPI following from opposition proceedings (see **5. Opposition Procedure**) can be appealed to the Federal Administrative Court of Switzerland (see **5.3 Ability to File an Opposition**). In principle, decisions of the Federal Administrative Court may not be appealed to the Federal Supreme Court. Decisions made by the highest cantonal courts (commercial court, where available) after civil claims have been raised can be appealed to the Federal Supreme Court.

4.11 The Madrid System

Switzerland is a member of the Madrid System. Therefore, it is possible to register a trade mark

in as many countries as the applicant intends (provided the designated countries are also members to the Madrid System). It is possible to submit the trade mark application online or in written form by post or via email.

5. OPPOSITION PROCEDURE

5.1 Timeframes for Filing an Opposition

The owner of an earlier trade mark may file an opposition against the registration of a later trade mark with the IPI on the basis of so-called relative grounds for refusal.

In this case, the opposition must be filed within three months after the publication of the registration, stating the legal grounds for the opposition. An extension of the time limit for filing an opposition is not provided for by law. Within the same period, the opponent must also pay the official opposition fee. In the case of an international registration designating Switzerland, the opposition period begins on the first day of the month following the month of publication in the IR-register.

In addition to an earlier registered trade mark, a well-known trade mark is also considered to be an earlier trade mark. Furthermore, the owner of a filed – but not yet registered – trade mark is authorised to file an opposition. Hence, owners of unregistered trade marks (in Switzerland) are entitled to file an opposition against a later trade mark, provided that the trade mark either qualifies as a notorious or well known trade mark in Switzerland or has at least been applied for with the IPI.

5.2 Legal Grounds for Filing an Opposition

The legal grounds for filing an opposition are, according to Article 3 of the Swiss Trade Mark

Protection Act, that the earlier trade mark is excluded from trade mark protection due to relative grounds for refusal.

In particular, grounds for filing an opposition are that:

- the later sign is identical with an earlier trade mark and the sign is intended for the same goods or services as the earlier trade mark;
- the sign is identical with an earlier trade mark and the sign is intended for similar goods or services, so that there is a likelihood of confusion; or
- the sign is similar with an earlier trade mark and the sign is intended for the same or similar goods or services, so that there is a likelihood of confusion.

Dilution or exploitation of reputation cannot be claimed in opposition proceedings, but only in the regular Courts.

5.3 Ability to File an Opposition

For the initiation of opposition proceedings (and court proceedings), there is, in principle, no requirement to mandatorily be represented by an attorney in Switzerland. However, it follows from the procedural rules under trade mark law that the applicant must have at least an address for service in Switzerland. Mandated attorneys in Switzerland usually ensure such.

Under today's status, the opposition fee, as defined by the IPI, amounts to CHF800. In addition, if legal representation is mandated, costs for the respective attorney fees incur separately. The attorney costs usually vary depending on the complexity of the opposition proceedings. However, with the decision of the IPI on the opposition, the IPI shall determine whether and to what extent the costs of the successful party shall be compensated by the other party.

5.4 Opposition Procedure

The opposition proceeding must be initiated in writing within three months. From this point on, the formal opposition is filed with the IPI. The IPI subsequently carries out an examination and, in this context, evaluates the identification of the opponent, the register or application number of the relevant trade marks, and the legal scope and the grounds of the opposition. In addition, the IPI checks whether the required opposition fee has been paid by the opponent in due time.

In the event all requirements are met, the IPI sets a time limit for the counterparty to submit a written response. The counterparty's statement is usually followed by a second exchange of correspondence. The opposition proceedings are thus exclusively conducted in writing and are terminated at the latest after the second exchange of correspondence by means of a decision of the IPI, resulting in rejection or approval.

In summary, it has to be noted that opposition proceedings offer an alternative to regular court proceedings and, therefore, allow the owner of an earlier trade mark in a relatively simple way to enforce its exclusive right towards the applicant of a later mark. However, this also means that only limited legal grounds can be raised in such opposition proceedings and they cannot replace regular court proceedings.

5.5 Legal Remedies against the Decision of the Trade Mark Office

Decisions of the IPI following from opposition proceedings can be appealed to the Federal Administrative Court of Switzerland. The Federal Administrative Court then makes a final decision, which precludes any further appeal to the highest Swiss court (the Federal Supreme Court) with respect to decisions in connection with the opposition proceedings.

However, the decision on the opposition does not have substantive legal effect (*materielle Rechtskraft*). If the opposition is rejected (or upheld) by the IPI, the other party is always free to file an action before a regular civil court. If a party decides to leave the decision of a trade mark dispute to a civil court during ongoing opposition proceedings before the IPI, the opposition proceedings before the IPI must be suspended.

6. REVOCATION / CANCELLATION PROCEDURE

6.1 Timeframes for Filing Revocation/ Cancellation Proceedings

Any person may file a request for cancellation of the trade mark with the IPI on the grounds of non-use of the trade mark at any time. Such request may be filed at the earliest within five years following the expiry of the opposition period, or, alternatively, in the event of opposition proceedings, five years after the conclusion of opposition proceedings.

6.2 Legal Grounds for Filing a Revocation/Cancellation Proceeding

Revocation or cancellation proceedings before the IPI – which are administrative in nature – are (only) available due to non-use of the respective trade mark. Further cancellation reasons have to be examined through civil court proceedings (or through opposition proceedings). The decision of the IPI may be appealed to the Federal Administrative Court.

6.3 Ability to File a Revocation/ Cancellation Proceeding

Any natural or legal person may file an application for cancellation of a trade mark on the grounds of non-use. A legal interest is not

required to initiate trade mark cancellation proceedings before the IPI.

6.4 Revocation/Cancellation Procedure

Cancellation proceedings may be initiated either before the IPI due non-use of a trade mark or by initiating opposition proceedings within three months after publication in the trade mark register. Alternatively, the cancellation of a trade mark requires a final civil court decision holding that a respective trade mark must be cancelled based on legal grounds such as absolute or relative grounds for refusal. If no proceedings are initiated, an applied trade mark will generally remain on the Swiss trade mark register.

6.5 Partial Revocation/Cancellation

A trade mark may be cancelled partially in cancellation proceedings.

6.6 Amendment in Revocation/Cancellation Proceedings

Disclaimers may be amended on the list of goods and services.

6.7 Combining Revocation/Cancellation and Infringement

The defence of non-use of a trade mark can also be raised as a defence in ordinary proceedings against an action for an injunction.

6.8 Measures to Address Fraudulent Marks

Trade marks that were filed fraudulently must be cancelled before an ordinary civil court by means of an action for cancellation.

7. INITIATING A LAWSUIT

7.1 Timeframes for Filing Infringement Lawsuits

Defence actions are generally not subject to the statute of limitations (ie, actions for declaratory

judgment, injunctions and actions to remedy an existing infringement). The admissibility of such actions can only be prevented by the loss of the legal interest in the civil action, ie, forfeiture.

However, according to current Swiss case law, such forfeiture may not be affirmed easily and usually requires at least five years of inactivity and knowledge of the infringing acts on the side of the entitled person. Furthermore, the party being infringed can counteract the forfeiture of its claims with a warning notice, ie, a cease and desist letter (C&D letter). The warning notice interrupts the forfeiture period. Conversely, such notice destroys the good faith of the infringer (at least temporarily).

However, with respect to further civil claims such as claims for damages and compensation, the regular statutes of limitation apply; to claims for damages and claims for handing over of profits the statute of limitations is three years and starts after knowledge of the damage and the identity of the damaging party. The three-year period begins to run in the event the infringing conduct ceases. As long as the infringer continues to perform infringing acts, the question of limitation does not arise. Furthermore, if the infringer acts criminally and intentionally, a longer statute of limitations applies.

7.2 Legal Grounds for Filing Infringement Lawsuits

C&D Letter

In general, owners of earlier trade marks may prohibit others from using an identical or similar mark for identical or similar goods, including company names and domain names. However, before the owner of a registered trade mark initiates the judicial enforcement of their trade mark rights and files a corresponding lawsuit, they will usually contact the alleged infringer by means of a C&D letter.

Before the initiation of regular court proceedings, there is the possibility in urgent cases that the trade mark owner may enjoin so-called precautionary/provisional measures (in particularly urgent matters so-called superprovisional measures) ordered by the competent court. Due to time urgency, it usually will in such cases not be made use of the opportunity to contact the other party by means of a C&D letter. In this regard, it has to be noted that a prior warning via C&D letter and/or enjoining precautionary measures is not mandatory under Swiss law to initiate legal proceedings. Hence, legal proceedings can also be initiated immediately before the competent court by means of a regular action.

Initiating Legal Actions

Under applicable Swiss law, legal actions can only be initiated by the trade mark owner if the trade mark serving as the basis for the action is already registered in the Swiss trade mark register with the IPI. Thus, there is no right of action if the owner of a trade mark has so far only filed a trade mark application which is still pending with the IPI.

Cybersquatting

Cybersquatting may be combated within the framework of trade mark law. According to Swiss trade mark law, the trade mark owner has the exclusive right to use and dispose of the trade mark to identify the goods or services for which it is claimed. Reserved is Article 15 of the Swiss Trade Mark Protection Act according to which the proprietor of a famous trade mark may also prohibit others from using their trade mark for any type of goods or services if such use threatens the distinctiveness of the trade mark or exploits or damages its reputation. As long as no commercial activities are carried out by using a certain trade mark, no action can be taken against the infringer.

Other Options

As an alternative, however, name and personality rights as well as company law and unfair competition law are potentially available in such cases. For instance, the Swiss Unfair Competition Act may allow proceedings against unfair behaviour. This may include, inter alia, hindering and blocking as well as unnecessary imitation and exploitation of reputation or creation of a risk of confusion. Furthermore, the World Intellectual Property Organization (WIPO), having established a special panel for that purpose, may decide disputes concerning domain names.

7.3 Parties to an Action for Infringement

Primarily, the right-holder, ie, the owner of the trade mark, is entitled to bring an action before a competent court (plaintiff). In contrast, the infringer of the trade mark rights acts as defendant to the proceedings. In this connection, defendant during the proceedings is always the infringer, ie, the person or company violating Swiss trade mark law (Article 13, or in certain cases, Article 15, paragraph 1 (ie, famous trade marks) of the Swiss Trade Mark Protection Act).

An action for performance may be raised only after the entry of the trade mark Swissreg. Claims for damages may be raised retroactively from the time at which the defendant obtained knowledge of the content of the application for registration (Article 55 paragraph 2 bis of the Swiss Trade Mark Protection Act).

Based on the explicit legal provision of Article 55, paragraph 4 of the Swiss Trade Mark Protection Act, the exclusive licensee furthermore is also entitled initiate legal proceedings before a competent court. In particular, this means that any person who holds an exclusive licence is entitled to bring a separate action irrespective of the registration of the licence in the trade mark register unless this is expressly excluded in the licence agreement. Any exclusive licensees may

join an infringement action in order to claim for their own damages. Conversely, non-exclusive licensees have no legal standing by law.

7.4 Representative or Collective Actions

A legal instrument such as a US class action does not exist under Swiss law. In order to participate in the legal effects of a court judgment, the interested parties concerned must also participate and be named explicitly as party in the court proceedings as such and thus have to be named as plaintiffs to the respective action. For this purpose, a “joinder of parties” is available under Swiss civil procedural law.

7.5 Prerequisites and Restrictions to Filing a Lawsuit

There are no prerequisites with regard to filing a lawsuit such as prior mediation, conciliation attempts or submission of C&D letters, etc (Article 197 ff of the Swiss Civil Procedure Code).

With respect to opposition proceedings, see **5. Opposition Procedure**.

7.6 Initial Pleading Standards

In order to initiate litigation, whether preliminary or regular proceedings, a statement of claim must be filed with the competent court. As mentioned in **7.5 Prerequisites and Restrictions to Filing a Lawsuit**, in Switzerland, a single cantonal court, usually the Highest Court and, where available, the Commercial Court, has sole jurisdiction to hear trade mark disputes.

The statement of claim shall include, inter alia, the statement of value in dispute, the allegations of fact, and notice of evidence offered for each allegation of fact. Accordingly, the statement of claim must specify the claims asserted and must provide detailed facts and present the grounds on which these claims are based. In general, trade mark proceedings follow the applicable

standard civil procedure rules as applicable to non-intellectual property civil proceedings.

7.7 Lawsuit Procedure

In principle, the trade mark owner has the possibility to file their lawsuit at any time with a competent court. Due to the specific subject matter of intellectual property law, the legislator has provided for some cantonal court authority to handle, among other things, trade mark disputes (Article 5, paragraph 1 lit a of the Swiss Civil Procedure Code). The respective court in this connection is usually either the higher court of the canton concerned or, if available, the commercial court of the canton in which such a court exists (ie, at the moment Cantons of Zurich, St. Gallen, Berne and Aargau).

Decisions on trade mark disputes can then be appealed to the Federal Supreme Court. Thus, Swiss law follows a system of two instances with respect to civil claims regarding intellectual property rights.

7.8 Effect of Trade Mark Office Decisions

The IPI is responsible for the registration process of a trade mark and objection of registered trade marks by so-called opponents. The IPI has certain competences in the field of administrative law and conducts the trade mark registration examination process and, provided opposition proceedings are initiated, co-ordinates and decides oppositions that may be filed earlier trade mark right-holders.

Opposition proceedings are purely administrative. The proceedings are concluded by a decision of the IPI (ie, approval or rejection). However, the judgement has no substantive legal force. Accordingly, in the event of a rejection of the IPI following the opposition proceedings, the opposing party still has the option of initiating regular court proceedings before a civil court.

In the event that the opposition is upheld by the IPI, it remains possible for the other party to sue for negative declaratory judgment in civil court proceedings. Hence, the final decision on the admissibility of a trade mark ultimately rests with the competent civil court.

Moreover, even during ongoing opposition proceedings before the IPI, there is always the possibility, from the point of view of both parties involved, to initiate parallel proceedings before a competent civil court. In this case, the opposition proceedings before the IPI must be suspended accordingly and the decision from the civil court proceedings must be awaited.

7.9 Declaratory Judgment Proceedings and Other Protections for Potential Defendants

As mentioned, the judgment of the IPI has a purely administrative effect and is therefore not binding with respect to potential civil court proceedings. In principle, the defendant (or the alleged infringer/opposed party) has the option of initiating a negative declaratory action before a competent civil court at any time prior or during opposition proceedings. In the latter event, the proceedings before the IPI will be suspended.

7.10 Counterfeiting

Since counterfeits have enormous potential to cause damages to the holder of a trade mark, the Swiss Trade Mark Protection Act explicitly prohibits any manufacture and/or sale of counterfeits. It is furthermore forbidden to import counterfeits into Switzerland, which also applies to private individuals. The Swiss Trade Mark Protection Act prohibits not only the unauthorised imitation of protected products (by trade mark law) and the trade in these counterfeits, but also their import, export or transit through Switzerland.

In order to enforce these regulations, the Swiss Customs Administration has been given the appropriate powers. If Customs finds counterfeit goods in tourists' luggage, for example, or in parcels sent by the post office, Customs is entitled to detain and destroy such goods. The Swiss Customs Administration will also inform the right-holder following such event (eg, the owner of the trade mark). The right-holder has then possibility to take civil action against any person who tried to bring a counterfeit of such goods into Switzerland. Anyone who intentionally infringes a trade mark rights for commercial purposes is also liable to criminal prosecution.

If Customs discovers large consignments where there is a suspicion that someone intended to import counterfeits on a commercial basis, the state must take action ex officio, ie, without a request from the right-holder. In such cases, a prison sentence of up to five years or a fine of approximately CHF1 million may be imposed.

8. LITIGATING TRADE MARK CLAIMS

8.1 Special Procedural Provisions for Trade Mark Proceedings

There are no jury decisions within court proceedings or any other administrative law based proceedings. In principle, court proceedings with respect to trade mark disputes follow the same rules and principles of regular civil procedure law. However, the Swiss Trade mark Protection Act (as well as related ordinance law) regulates the civil procedure with respect to trade mark disputes selectively with regard to certain issues such as the admissible types of action (ie, the declaratory action, the action for performance and the action for assignment of a trade mark), the shifting of the burden of proof in the case of indications of origin, the right of associations, consumer organisations to file suit, the confisca-

tion of objects in civil proceedings, the initiation of precautionary measures and the publication of civil court judgments.

Declaratory Judgments

As a general rule, any person who can demonstrate a legal interest may apply to the court for a declaratory judgement as to whether a right or legal relationship governed by the Swiss Trade Mark Protection Act does or does not exist. Furthermore, with respect to trade mark litigation, the plaintiff may bring an action for the assignment of the trade mark instead of a declaration of nullity of the trade mark registration if the defendant has usurped the trade mark. This right, however, shall lapse two years after publication of the registration or after withdrawal of the proprietor's consent under Article 4 of the Swiss Trade Mark Protection Act.

In particular with respect to the action for performance, the law states that any person whose right to a trade mark or an indication of source is infringed or threatened may request the court:

- to prohibit an imminent infringement;
- to remedy an existing infringement; or
- to require the defendant to provide information on the origin and quantity of items in their possession that unlawfully bear the trade mark or the indication of source and to name the recipients and disclose the extent of any distribution to commercial and industrial customers.

In its judgment concerning trade mark disputes, the competent court may order the forfeiture of items, which unlawfully bear a trade mark or an indication of source or of equipment, devices and other means that primarily serve their manufacture.

Preliminary Measures Requests

Any person requesting preliminary measures concerning trade mark disputes may, in particular, request that the court orders measures to:

- secure evidence;
- establish the origin of items unlawfully bearing a trade mark or indication of source;
- preserve the existing state of affairs; and
- provisionally enforce claims for injunctive relief and remedy.

8.2 Requirement to Establish Use of a Sign as a Trade Mark

During civil proceedings, the plaintiff has to establish that the defendant illicitly used the queried trade mark (or sign) for marketing respective goods and/or services. Purely descriptive use of a sign does not violate Swiss trade mark law, but may be problematic (under certain circumstances) in the light of unfair competition law.

8.3 Factors in Determining Infringement

The decisive criterion is the likelihood of confusion. Whether such a likelihood exists has to be determined by the overall impression based on the criteria of identity/similarity of the signs and identity/similarity with respect to the goods and services offered (*Gleichartigkeit*). In other words, the more similar the goods and services offered are, the greater the difference between the marks must be.

The calculation also takes into account the target group for the goods and services offered and the effect of the signs within this target group. As a result, the assessment of these criteria is always a matter of a discretionary decision-making. The higher the degree of similarity of the older mark, the more likely the court must assume a likelihood of confusion.

8.4 Elements of Other Trade Mark Claims

A mere dilution of the trade mark cannot be asserted on the basis of trade mark law if no trade mark-relevant actions are carried out with a use of the trade mark or a younger sign, respectively. Complementary to trade mark law, however, claims under unfair competition law as well as name, personality and company name law are also available (eg, regarding cybersquatting).

8.5 Effect of Registration

Although the registration of a trade mark is mandatory in order to be able to assert claims under trade mark law, the effects of the trade mark registration remain limited. In particular, the entry on Swissreg lacks positive legal effect/force under Swiss law. Information provided in the Swiss trade mark register has no formal publicity, so that the content of the register entry is not deemed to be generally known.

In Swiss trade mark law, there is no shifting of the burden of proof in civil court proceedings due to information provided in the trade mark register so that the regular civil procedure rules of evidence apply. As a result, the trade mark register (except for its constitutive effects on trade mark rights) has only informative and practical relevance. The judge does not have to assume the legal validity of the trade mark because of the registration, which is why a trade mark can also be challenged by way of a defence.

8.6 Defences against Infringement

An action for a declaratory judgment or an action for an injunction can be filed against the infringement of trade mark rights. At the same time, the same rights with regard to the determination of non-infringement are also available to the party wishing to defend itself against an unfair accusation of trade mark infringement. The subject matter of such legal proceedings may be, for

example, the descriptive character, non-use of a trade mark, forfeiture or infringement of competition law.

8.7 Obtaining Information and Evidence

Swiss trade mark law does not provide for disclosure. If the owner has filed an action against the infringer before a civil court, the respective owner of a trade mark is explicitly entitled to claim for disclosure of certain information against the defendant. This means that any person whose right to a trade mark or indication of source is infringed or threatened may request the court to require the defendant to provide information on the origin and quantity of items in their possession that unlawfully bear the trade mark or the indication of source and to name the recipients and disclose the extent of any distribution to commercial and industrial customers to assess damages.

8.8 Role of Experts and/or Surveys

Each party may present expert testimonies or statements as well as expert surveys during civil proceedings. Certain factual issues cannot be sufficiently proven in civil proceedings without expert surveys or opinions. Hence, expert surveys and/or testimonies may be of importance in trade mark disputes. In particular, consumer surveys regularly constitute a relevant factor and may even be decisive for the decision of the court in the respective case.

8.9 Trade Mark Infringement as an Administrative or Criminal Offence

Swiss trade mark law specifically includes several provisions concerning criminal offenses in connection with the use of trade marks. For example, on complaint of the injured party, any person who wilfully infringes the trade mark right of another is liable to a custodial sentence not exceeding one year or a monetary penalty if they:

- appropriate, counterfeit or imitate the trade mark of the other person; or
- places goods on the market or provides services, or offers, imports, exports, carries in transit, stores for the purpose of placing on the market or advertises such goods or services under the appropriated, counterfeited or imitated trade mark.

8.10 Costs of Litigating Infringement Actions

The costs of a trade mark lawsuit include court costs (*Gerichtskosten*), which depend on the value matters and usually start in trade mark case at about CHF8,000. The lawyer's fees for drafting and submitting an infringement claim start at about CHF15,000, depending on the complexity of each case.

9. REMEDIES

9.1 Injunctive Remedies

A trade mark may be enforced through preliminary injunction.

To grant a preliminary injunction, the party is required to prove:

- that the claim of the requesting party has occurred or is imminent;
- that the infringement threatens to cause a prejudice that cannot be easily remedied;
- there is some urgency; and
- that the party requesting the preliminary injunction has a sufficient interest in legal protection.

The defence of the opposing party refers to the same procedurally relevant arguments as the aforementioned. Under Swiss civil procedure law, there is also a special means of defence in the form of a protective letter. If a party fears that it may be sued in court in the future (including the

initiation of precautionary/preliminary measures), it can send the court a protective letter with the arguments as to why, in the event that precautionary measures are initiated, the motions of the suing party should not be granted.

9.2 Monetary Remedies

Apart from the actions of performance, the actions brought under the Code of Obligations for damages, satisfaction and handing over of profits in accordance with the provisions concerning agency without authority remain reserved (Article 55 paragraph 2 of the Swiss Trade Mark Protection Act).

The focus is usually on compensation for lost profit or loss of sales as Swiss law does not entail punitive damages.

9.3 Impoundment or Destruction of Infringing Articles

Switzerland does provide a remedy of impoundment and/or destruction of infringing products. Any person whose right to a trade mark or an indication of source is infringed or threatened may request the court to remedy an existing infringement. Impoundment of items with subsequent destruction is usually the most important means to remedy an existing infringement. As the remedy of an existing infringement is subject to the principle of proportionality, impoundment and destruction shall only be ordered if less drastic orders are not expedient.

The owner of a trade mark in particular may also ask the Customs Administration for the destruction of goods alongside with the request to refuse the release of goods, if they have clear indications of the imminent transport of goods that unlawfully bear a trade mark or an indication of source into or out of the customs territory of Switzerland (Article 72 of the Swiss Trade Mark Protection Act). If the destruction of goods proves to be unjustified afterwards, the applicant

is exclusively liable for the resultant loss (Article 72 f of the Swiss Trade Mark Protection Act).

9.4 Attorneys' Fees and Costs

The costs for litigation consists of attorney's fees and court costs. Court costs are calculated based on the value in litigation, which is set in the claim and in a potential counterclaim by the parties. Before trial, the claimant is obliged to make an advance payment for the estimated court costs calculated by the court. As the courts generally publish schedules for the court costs, the parties can estimate those costs beforehand.

The attorneys' fees are generally set by the attorneys as well as the parties on private basis and depend on the complexity and length of the preparation and proceedings. The prevailing party is entitled to recover the court costs and part of its attorneys' fees from the losing party. In the case of a partial decision, the court will split these costs and fees accordingly between the parties.

9.5 Ex Parte Relief

In general, notice is required. Only in cases of special urgency, and in particular where there is a risk that the enforcement of the measure will be frustrated, the court may order the interim measure immediately and without hearing the opposing party (Article 265 of the Swiss Civil Procedure Code). The special urgency may be given in particular, if there is a risk that the opposing party will make it impossible for the claimant to realise their rights.

In those ex-parte interim measures, the parties will be summoned to a hearing or the opposing party will be asked to submit a written statement. This way, the right to be heard at a certain stage during the proceedings is sufficiently granted to the opposing party.

9.6 Rights and Remedies for the Prevailing Defendant

Civil remedies typically include damages with regard to reimbursement of legal costs including court costs as well as attorney's fees. The prevailing defendant may furthermore use the judgment to make use of their trade mark in practice since the judgment (provided no remedies have been invoked) gains legal force between the respective parties. Furthermore, potential criminal charges will be dismissed.

9.7 Customs Seizures of Counterfeits or Criminal Imports

The Federal Customs Administration is authorised to withhold infringing goods upon request of the trade mark owner or on their own accord. Within ten days after notification of the withholding of potentially infringing goods (extendable by another ten days), the trade mark owner must obtain an injunction by a civil court, a seizure order by a criminal prosecution authority or obtain the goods' owner to agree to the destruction of the withheld goods.

9.8 Different Remedies for Different Types of Trade Marks

Swiss civil procedure law and trade mark law do not contain differing types of remedies with respect to different types of trade marks. Hence, the regular remedies are available to each type of trade mark or issue in this connection.

10. RESOLVING LITIGATIONS

10.1 Options for Settlement

Swiss Law does not provide for detailed settlement mechanisms. The opposing parties, in general, are free to settle at any time and at any stage. Swiss Civil Court usually invite the parties to a reconciliation hearing after the first exchange of writs. Those hearings are effective,

approximately 80% of all trade mark cases are settled in such hearings.

10.2 Prevalence of ADR

Swiss law does not contain any mandatory provisions regarding alternative dispute resolution mechanisms. Hence, the plaintiff may take direct legal action without being obliged to initiate any ADR. However, the parties may contractually provide for arbitration proceedings. This dispute resolution mechanism is in particular relevant in connection with licence agreements.

10.3 Other Court Proceedings

Trade mark proceedings in Switzerland may be either administrative or civil. In particular, opposition and/or cancellation proceedings due to non-use can be initiated before the IPI and are of administrative nature. Such administrative proceedings before the IPI may only be initiated during in compliance with certain deadlines (three-month period in opposition proceedings an five year of non-use for trade mark cancellation proceedings). Outside of administrative proceedings before the IPI, civil court proceedings, in principle, may be initiated at any time including examination of infringing actions, etc. Decisions made during civil court proceedings are binding to the IPI which is why parallel proceedings before the IPI have to suspended in the event civil court proceedings are ongoing.

11. APPEAL

11.1 Timeframes for Appealing Trial Court Decisions

Under Swiss procedural law, only two instances are available for civil intellectual property disputes. Since only one cantonal instance decides on a case, the appeals are directed to the Federal Supreme Court.

A decision may be appealed within 30 days after the written opening of the decision. It usually takes between one to three years to obtain a judgment before the cantonal court.

11.2 Special Provisions for the Appellate Procedure

Swiss law does not foresee any special provisions concerning the appellate procedure for civil trade mark proceedings and therefore such proceedings follow the regular civil procedure rules.

11.3 Scope of the Appellate Review

The Federal Supreme Court primarily judges violations of the law, and a review of the determination of the facts is only possible in exceptional cases. This means that the lower court's determination of the facts is binding on the Federal Supreme Court. An incorrect determination of the facts may only be asserted if it is:

- obviously incorrect; or
- based on a violation of the law, whereby in both cases it would have to be further shown that the rectification of the defect may be decisive for the outcome of the proceedings.

12. TRADE MARKS AND OTHER INTELLECTUAL PROPERTY

12.1 Copyright and Related Rights

A trade mark may also be protected by copyright or related rights if the applicable prerequisites and conditions are met. For example, in order to enjoy protection under copyright law, a logo would need to be an intellectual creation of individual character. Other related rights are rights under name and personality law, company name law as well as unfair competition law. The rules under unfair competition law are regularly invoked in connection with trade mark disputes

and may offer a good legal alternative to successfully enforce against unauthorised use of marks.

12.2 Industrial Design

A trade mark may also be protected by industrial design laws in case the prerequisites applicable are met. There is cumulative design protection by design and trade mark law.

12.3 Rights of Publicity and Personality

Article 2 of the Swiss Trade Mark Protection Act contains absolute grounds for refusal. Signs contrary to public policy, morality or applicable law are such an absolute ground for refusal. These grounds are also applicable if famous signs violate, for example, the moral opinion. Simple publicity and fame of a person do not usually lead to prohibiting others from using the designation/sign in question under Swiss trade mark law.

If there is no collision with third party rights, parties are allowed to use publicly known designations. Misrepresentation or misleading use by using famous names is not allowed. In the case of a very famous person, a risk of misrepresentation or misleading use could be assumed under certain circumstances.

12.4 Unfair Competition

In Switzerland a trade mark may also be protected by the federal law against unfair competition, if the prerequisites are met. It aims to ensure fair competition and protect, among other things, against reputational exploitation and business conduct that is contrary to good faith or morality. Unfair and unlawful actions are, for example, actions of a competitor that may cause confusion between products and thus mislead customers. If these conditions are met, action against imitation and counterfeiting may be taken under the federal law against unfair competition.

13. ADDITIONAL CONSIDERATIONS

13.1 Emerging Issues

In 2017, the special rules governing the use of designations such as “Swiss quality”, “Made in Switzerland” or “Swiss Made” have been updated (ie, Swissness). Such marks may only be used for goods or services manufactured in Switzerland (and only under certain circumstances and conditions). How much “Switzerland” a product must contain for it to be allowed being marketed under such a designation is primarily defined in the Swiss Trade Mark Protection Act. The Trade Mark Protection Act distinguishes between the categories food, natural products and industrial products. The latest revision (ie, Swissness Revision) provided a better protection for Swiss geographical indications.

13.2 Trade Marks and the Internet

Marketing products on the internet, in general, follows the same rules as every other sales platform. If trade mark rights are violated the owner has the right to prohibit such use by invoking trade mark law. In practice warning letters are issued to evaluate the legal arguments of the counterparty as well as to avoid unnecessary litigation. The purpose of warning letters is therefore to convince the counterparty to (immediately) cease and desist from causing further trade mark violations.

13.3 Trade Marks and Business

Intellectual property rights are becoming increasingly important for companies’ assets, which is why legal protection is also becoming more important. Trade mark protection law is only available for registered trade marks being used for respective goods and/or services. It is therefore advisable to register trade marks if they are considered important for a business.

Even in the absence of a trade mark registration, the existing use of a sign can be preserved in case a later trade mark registration of the sign by a competitor. In this case, however, the preservation of such use is very limited and users of such signs do not have the option to further expand the use of their sign, ie, self-use-limitation.

MLL has an IP Team that has grown steadily since the 1990s, comprising some of Switzerland's leading intellectual property lawyers, covering all aspects of patent, know-how, trade mark, copyright, design and unfair competition law. This includes clarifying the non-infringement of third-party rights, management of worldwide IP portfolios, exploitation and enforcement of intellectual property rights and defence against infringement allegations, both out

of court and before state courts and arbitral tribunals. The firm's highly experienced team has the specialised expertise and human resources to help Swiss and foreign clients succeed. The firm typically works in an international context. The firm, as it follows the important legal, economic and technical developments in Switzerland and worldwide, often helps shape them. Clients include innovative companies, whether small, medium-sized or large.

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