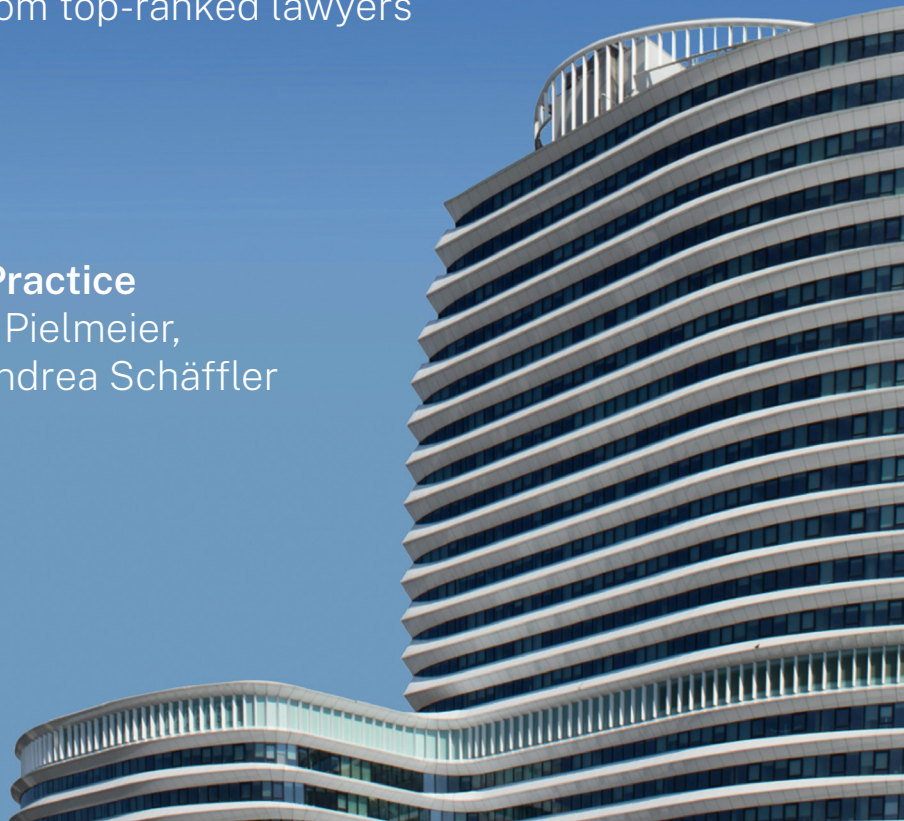

CHAMBERS GLOBAL PRACTICE GUIDES

Trade Marks & Copyright 2025

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Switzerland: Law and Practice

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MLL Legal



SWITZERLAND



Law and Practice

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MLL Legal is one of the most reputable international law firms in Switzerland, with experienced and dynamic lawyers offering innovative and solution-focused services. It is present in the key Swiss economic centres, with offices in Zurich, Geneva, Zug and Lausanne. The firm has one of the strongest and largest IP/ICT and digital teams in Switzerland, bringing together some of the most reputed experts in all legal aspects related to traditional ICT topics as well as new technologies. Its strong data privacy

practice makes it a top choice for matters concerning digitalisation and new technologies, and Swiss and international clients alike – from corporations and banks to private individuals – appreciate the accessibility and involvement of the firm’s partners in representing their interests. MLL Legal’s experience in serving clients from across a variety of sectors has given its lawyers a practical understanding of business that ensures the delivery of legal advice that is applicable in a commercial context.

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1. Trade Mark and Copyright Law

1.1 Governing Law

As Switzerland is governed by a civil law system, both copyright and trade mark law are governed by statutory law.

- Trade marks are protected by the Federal Act on the Protection of Trade Marks and Indications of Source (“Swiss Trade Mark Protection Act”) and the Ordinance on the Protection of Trade Marks and Indications of Source. The Swiss Institute of Intellectual Property (IPI) issues further guidelines – eg, regarding opposition proceedings.
- The rules on copyright are stipulated in the Federal Act on Copyright and Related Rights (“Swiss Copyright Act”).

Common law trade marks (in terms of trade mark protection that is acquired without registration by mere use) are not provided by Swiss trade mark law, and common law copyright (in terms of copyright that is acquired or that extends beyond the scope granted by statutory law) does not exist in Switzerland. However, the law against unfair competition provides some protection against appropriation and imitation, which can have a similar effect to copyright and trade mark law.

1.2 Conventions and Treaties/Rights of Foreign IP Holders

Copyright protection in Switzerland can be claimed by all authors for all their protected works, regardless of the country of publication or the nationality of the author. Switzerland is a member of most international treaties concerning intellectual property law, including the following.

- Copyright:

- (a) the Berne Convention for the Protection of Literary and Artistic Works, in its various versions still applicable, last revised in Paris in 1979 (Berne Convention);
 - (b) the Universal Copyright Convention (UCC);
 - (c) the Geneva Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of their Phonograms (Geneva Phonogram Convention);
 - (d) the Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations;
 - (e) the Brussels Convention Relating to the Distribution of Programme-Carrying Signals Transmitted by Satellite (Brussels Satellite Convention);
 - (f) the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS);
 - (g) the WIPO Copyright Treaty (WCT);
 - (h) the WIPO Performances and Phonograms Treaty (WPPT)
 - (i) the Beijing Treaty on Audiovisual Performances; and
 - (j) the Marrakesh Treaty to Facilitate Access to Published Works for Persons Who Are Blind, Visually Impaired or Otherwise Print Disabled.
- Trade marks:
 - (a) the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods;
 - (a) the Madrid Agreement Concerning the International Registration of Marks and the Madrid Protocol;
 - (b) the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS);
 - (c) the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks;
 - (d) the Paris Convention for the Protection of

- Industrial Property (Paris Convention);
- (e) the Convention of 13 April 1892 between Switzerland and Germany concerning the Reciprocal Protection of Patents, Designs and Trade Marks; and
- (f) the Singapore Treaty on the Law of Trade-marks.

Once approved by Switzerland, international legal treaties become an integral part of Swiss law, meaning that the provisions of the treaties are, in principle, directly applicable if they are self-executing. For example, the Federal Supreme Court has held that the three-step test set forth in Article 9 paragraph 2 of the Berne Convention is directly applicable in Switzerland. This also applies to the minimum protection set out in the Berne Convention and the WCT, for example. Swiss national law must be interpreted in conformity with the above-mentioned conventions by national courts.

2. Trade Mark Ownership, Protection and Rights

2.1 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, including:

- words;
- letters;
- slogans;
- numerals;
- figurative representations;
- three-dimensional shapes; or
- combinations of such elements with each other or with colours.

Scents cannot be protected as a trade mark in Switzerland.

The Swiss Trade Mark Protection Act differentiates between individual, collective, certification and geographical marks. Specifically, Swiss law allows trade mark protection of:

- service marks;
- design marks;
- trade dress;
- collective marks;
- certification marks;
- geographic indicators;
- product marks (both product design and packaging);
- industrial designs; and
- surnames.

In order to meet the increased requirement to keep three-dimensional shapes available to competitors, Swiss law provides an absolute ground for refusal of shapes that constitute the nature of the goods or shapes that are technically necessary.

The Swiss jurisdiction provides protection of armorial bearings, flags and other State emblems against unauthorised registration and use as trade marks, in accordance with Article 6ter of the Paris convention. 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. Furthermore, names, abbreviations and emblems of the United Nations or other intergovernmental organisations may not be protected as trade marks or as elements thereof. Unlike Germany, for example, Switzerland does not provide special protection to the Olympic insignia; Switzerland is not a member of

the Nairobi Treaty on the Protection of the Olympic Symbol.

According to the “territoriality of trade mark rights”, rights to trade marks acquired by their owners in one state are generally neither automatically recognised nor protected in another state. Thus, the reputation of a sign abroad is, in principle, of no significance. Nevertheless, Switzerland provides protection for famous foreign marks that are not yet in use or registered within Switzerland, in accordance with Article 6bis of the Paris Convention and the WIPO Joint Recommendation Concerning Provisions for the Protection of Well-Known Marks, provided that the respective mark is famous within Switzerland. A trade mark that is well known in Switzerland within the meaning of the Paris Convention receives trade mark protection as if it had been registered in Switzerland.

2.2 Essential Elements of Trade Mark Protection

Generally, all signs that can be represented graphically are potentially capable of acquiring trade mark protection (see **2.1 Types of Trade Marks**). The fundamental requirements for trade mark protection for such signs in Switzerland can be categorised into three stages.

- First, the sign must be distinctive from an abstract point of view. This is not the case when consumers will under no circumstance and in relation to any product or service perceive the sign as an indication of origin (eg, long texts). Such abstract distinctiveness is assessed by the Swiss Institute for Intellectual Property *ex officio*.
- Secondly, Swiss law provides *inter alia* an absolute ground for refusal for signs that lack specific distinctiveness with regard to the goods and services claimed (signs in

the public domain). Signs are excluded from trade mark protection as part of the public domain if consumers do not perceive them as an indication of the commercial origin of the goods and services claimed, or if the signs must be kept available in the interest of competitors to describe the goods or services or their characteristics. Specific distinctiveness is assessed by the Swiss Institute for Intellectual Property *ex officio*. The exclusion can be overcome by signs that have acquired distinctiveness. Acquired distinctiveness can be proved indirectly by proving facts such as significant sales made under a sign over a long period of time or intensive advertising efforts. The most reliable means of proving acquired distinctiveness is, however, by providing a market survey.

- Finally, Swiss law provides relative grounds for refusal for trade marks that are likely to cause confusion with older trade marks (priority principle). Relative grounds for refusal are not assessed *ex officio* by the Swiss Institute for Intellectual Property but must be claimed by the respective right-holders (eg, by opposing the respective younger application).

In general, trade marks are protected with their entry into the trade mark register. Unlike in Germany, for example, acquired public recognition cannot establish trade mark protection (no “trade mark acquired by use”). In certain individual cases, however, unregistered signs may enjoy protection, as in the following examples:

- through the Paris Convention as a foreign trade name (see **2.1 Types of Trade Marks**);
- 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.

2.3 Trade Mark Rights

The trade mark right provided by Swiss law does not grant a (positive) right to use the mark, but solely a (negative) right to exclude others from using the same or confusingly similar marks in a way that is likely to cause confusion (right of prohibition).

The rights are outlined by Articles 13 and 15 of the Swiss Trade Mark Protection Act. Article 13 provides a non-exhaustive enumeration of examples of acts that the trade mark owner is entitled to prohibit, namely:

- affixing the sign to goods or their packaging;
- offering goods, placing them on the market or storing them for such purposes under the sign;
- offering or providing services under the sign;
- importing, exporting or carrying in transit goods under the sign; or
- using the sign on business papers, in advertising, or otherwise in the course of trade.

These rights persist throughout the term of protection without restriction.

Unlike the majority of other jurisdictions, Swiss trade mark law provides a right of prior use. According to Article 14 of the Swiss Trade Mark Protection Act, the proprietor of a trade mark may not prohibit another person from continuing to use a sign to the same extent as already previously used prior to the filing of the application.

2.4 Use in Commerce

Use prior to application or “(declaration of) intent to use”, as seen in the US for example, is not a requirement of trade mark protection in Switzer-

land (see **2.2 Essential Elements of Trade Mark Protection**).

Once registered for protection, Swiss law provides a five-year grace period, during which actual use of the trade mark is not demanded by law.

After the expiry of the grace period, the trade mark becomes vulnerable insofar as third parties can claim its invalidity due to non-use. Such invalidity can be actively claimed by third parties in civil court proceedings (negative declaratory action), as a counterclaim in infringement proceedings or in office procedures relating to declarations of invalidity. Non-use after expiration of the grace period does not affect a trade mark’s validity *ipso iure*.

2.5 Notices and Symbols

Trade mark rights exist regardless of the use of symbols such as ®. However, the use of symbols is admissible and does not cause negative legal consequences under Swiss law, unless such use constitutes an act of unfair competition. Misleading advertising would be constituted by using the symbol ® or TM, for example, after trade mark protection has lapsed.

2.6 Related Rights

A trade mark can be protected by copyright or related rights – eg, in case of a logo – if the respective sign meets the terms of protection. There is no exclusivity between the different IP rights in Switzerland, but the different regimes of protection are applicable in cumulation. For example, 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 and 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.

Surnames can be protected by trade mark law in Switzerland (see **2.1 Types of Trade Marks**). However, a trade mark application would be rejected if the relevant public considered the name to be descriptive in relation to the goods claimed (eg, Mozart for music). Should the application violate a person's moral rights to their name (confusion about the name), the persons or descendants might be entitled to a cancellation of the respective trade mark.

A trade mark depicting a copyright protected work (eg, a logo) without the rights-holder's consent would constitute a copyright violation and entitle the rights-holder to a cancellation of the respective trade mark.

3. Copyright Ownership, Protection and Rights

3.1 Types of Copyrightable Works

Swiss law provides the following non-exhaustive enumeration of specific categories of works that are potentially subject to copyright protection, under Articles 2(2), (3) and (4), 3 and 4 of the Swiss Copyright Act:

- literary, scientific and other linguistic works;
- musical works and other acoustic works;
- works of art, in particular paintings, sculptures and graphic works;
- works with scientific or technical content, such as drawings, plans, maps or three-dimensional representations;
- works of architecture;
- works of applied art;

- photographic, cinematographic and other visual or audiovisual works;
- choreographic works and works of mime;
- computer programs (software);
- drafts, titles and parts of works;
- derivative works; and
- collections of works.

Swiss copyright law provides protection consistent with the obligations constituted by international law. Accordingly, industrial designs are entitled to copyright protection as works of applied art in accordance with Article 2(1) of the Berne Convention. Statutory law does not provide for specific or additional requirements for protection. Consequently, industrial designs are copyright protected if they meet the general conditions for protection laid down in Article 2(2) of the Swiss Copyright Act (see **3.2 Essential Elements of Copyright Protection**).

The federal Supreme Court holds the opinion that a work of applied art can only be protected by copyright law if the respective creation reaches at least the threshold of protection under design law ("individual character"). A significant factor in determining protection is therefore the absence of prior art and, for example, the influence of the design in question on the subsequent history of design art. Protection can also be supported by the fact that the design has a "surprising effect" on the observer, meaning that its purpose is not recognisable at first glance. In some cases, Swiss case law unfortunately still requires a so-called statistical uniqueness as a condition for protection. It remains unclear whether the Cofemel and Mio rulings and the Kwantum decision will have a liberalising and clarifying effect on Swiss case law.

Databases can theoretically be protected as collections of works, but rarely ever meet the

necessary requirements for protection (intellectual creation with an individual character). A *sui generis* (neighbouring) right as introduced by the European Union (96/9/EG) does not exist in Switzerland. Unfair competition law can provide protection in the case of carbon copies that lack any own effort of the infringer.

3.2 Essential Elements of Copyright Protection

According to Article 2(1) of the Swiss Copyright Act, a work must fulfil the following conditions in order to be protected by copyright.

- The work must be objectified and observable, although a physical fixation of the work in a tangible medium is not required. For example, a speech cannot be protected while still only existing in a politician's thoughts, but gains protection after the speech is held (even when not recorded). This requirement corresponds to the expression criterion of the CJEU, for example.
- The work must be an expression of a person's intellectual activity. Works that are results of non-human acts are therefore not protected under Swiss copyright law (eg, monkey selfies or AI creations).
- The work must express individual character (originality).

The Copyright arises *ipso iure* in the moment of creation without any formalities, and is held by the author who created the work (see 3.3 Copyright Authorship).

3.3 Copyright Authorship

Authorship is defined by Article 6 of the Swiss Copyright Act. The only condition of the attribution of authorship is that the respective person has created the work in question. No other requirements must be met.

The work made for hire doctrine does not apply in Switzerland. However, Article 17 of the Swiss Copyright Act applies for the creation of computer programs. The statute does not constitute a work made for hire doctrine; the copyright in computer programs is consequently held by the author. The rule merely constitutes a presumption (reverse burden of proof) that a creator fulfilling a labour or other contract in creating the program grants an extensive right to use the work result (license) to its employer or client. The rule corresponds to Article 2(3) of Directive 2009/24/EG.

No authorship can be claimed in a work that was not created by a human – eg, by artificial intelligence software or an animal. Authorship can, however, be claimed in works that have been created by a human using AI or animals as tools to create an own intellectual creation.

Joint authorship arises from objective participation in the creation of a work combined with a subjective intention to collaborate. To give rise to joint authorship, contribution must be creative: carrying out instructions without freedom for own creative choices cannot establish joint authorship.

As consequence of joint authorship, the copyright in the work is owned jointly by the co-authors. The co-authors can in general only dispose of the work jointly, and none of them can independently dispose of a share in the work. The co-authors are bound by the principle of good faith – they must, for instance, consent to the publication of the work (permission to use the work). An independent exploitation of the work is only permissible if the contributions to the work as a whole are separable, because they belong to different work categories (eg, text and illustrations of a book).

3.4 Copyright Rights

The rights granted to authors are statutory and are outlined in Articles 9, 10 and 11 of the Swiss Copyright Act; they all persist throughout the term of copyright protection.

The author's rights can be divided into two groups:

- moral rights (*droit moral*), which are the rights of the recognition of authorship, the right of publication and the right to oppose distortion of the work; and
- (economic) exploitation rights, which are granted universally by an undefined general clause.

Articles 10(1) and 11 of the Swiss Copyright Act state that it is the author's exclusive right to decide if, when and how the work is used. The right is illustrated by a non-exhaustive enumeration of examples, including the rights to:

- produce copies of the work, such as printed matter, phonograms, audiovisual fixations or data carriers (reproduction right);
- offer, transfer or otherwise distribute copies of the work (distribution right);
- recite, perform or present a work, or make it perceptible somewhere else or make it available directly or through any kind of medium in such a way that persons may access it from a place and at a time individually chosen by them (performance, communication and making available right);
- broadcast the work by radio, television or similar means, including by wire (broadcasting right);
- retransmit works by means of technical equipment, the provider of which is not the original broadcasting organisation, including in particular by wire (rebroadcasting right);

- make works made available, broadcast and retransmitted perceptible (making perceptible right); and
- decide if, when and how the work may be altered and if, when and how the work may be used to create a derivative work or may be included in a collected work (adaptive use right).

The author of a computer program also has the exclusive rental right (rental right – only for computer programs).

The moral right's essence/core elements cannot be assigned or waived. Exploitation rights can be assigned, unlike in Germany, for example.

3.5 Term of Protection and Termination

Copyright protection in all works, regardless of the respective category, terminates 70 years after the death of the author (*post mortem auctoris*). In the case of computer programs only, the protection terminates 50 years after the death of the author. The term of protection regarding joint works terminates 70 years after the death of the last surviving author (50 years for computer programs).

Copyright terminates in total; no rights survive the expiration of the term. Swiss law does not provide for protection of moral rights *post-mortem* based on other statutes. Other means of protection, such as unfair competition law or trade mark law, potentially do not terminate and are applicable after the copyright term expires (principle of cumulation).

3.6 Collective Rights Management Systems

There are collective rights management and corresponding collecting societies in Switzerland, which aim to facilitate the exploitation of copy-

right and neighbouring rights in cases of mass use. The corresponding statutes are incorporated in Articles 40–60 of the Swiss Copyright Act. The goals of the system are as follows:

- primarily to enable creators to realise their rights in cases of mass use, which is deemed to be practically impossible without collective rights management;
- to ensure smooth legal relations between authors and users, for example by the simple and accessible organisation of licensing;
- to control the market power of the collecting societies and prevent misuse of such market power by implementing an obligation of equal treatment (of both authors and users) and implementing non-profit status for the societies; and
- to ensure international co-operation and thus facilitate international rights exploitation.

Where there is significant increased public interest in accessing protected works, the legislator legalises such use by means of a limitation while sometimes imposing a compulsory remuneration, which can only be asserted through a collecting society (eg, the limitation for use of works for educational purposes).

The five Swiss collecting societies are:

- ProLitteris for collecting royalties for the copying and reproduction of written works;
- SSA for enforcing performance rights, broadcasting rights, other rights of public communication and reproduction rights of authors in the fields of drama, musical drama, choreography, audiovisual media and multimedia;
- Suissimage for enforcing audiovisual works by film authors, screenwriters and directors;

- SUISA for enforcement of copyrights of music creators and composers, lyricists and publishers in musical works; and
- SWISSPERFORM for enforcement of the neighbouring rights of performing artists, producers and broadcasting organisations.

3.7 Copyright Registration

Copyright protection in Switzerland is not subject to any formalities, such as a registration requirement (unlike Swiss trade mark law, for example) or the use of symbols such as ©. A copyright register does not exist. Unlike Germany, for example, Switzerland does not provide a public register for anonymous and pseudonymous works, either.

3.8 Copyright Application Requirements

There are no requirements to apply for the registration of a copyright; see **3.7 Copyright Registration**.

3.9 Refusal of Registration

The registration of a copyright cannot be refused by the copyright office as there are no requirements to apply for the registration of a copyright; see **3.7 Copyright Registration**.

3.10 Related Rights

Work results that are subject to copyright protection can be protected by any other intellectual property right, such as design law, trade mark law or patent law, and by any neighbouring right, if the intangible good in question meets the respective requirements for protection. Swiss law applies the “principle of cumulation” of IP rights.

4. Trade Mark Registrations and Applications

4.1 Trade Mark Registration

Trade mark rights in Switzerland can only be obtained by registration: use of a sign cannot create trade mark protection. There are no different standards when registering different marks, including in trade dress registrations (see **2.2 Essential Elements of Trade Mark Protection**).

4.2 Trade Mark Register

The (unitary) Swiss trade mark register is publicly available on the website of the Swiss Institute for Intellectual Property (IPI), at www.swissreg.ch.

Prior trade marks may constitute relative grounds for refusal (see **2.2 Essential Elements of Trade Mark Protection**). Consequently, a search for prior trade marks is highly recommended before applying to register a mark. The IPI does not examine applications for relative grounds for refusal (older trade marks) *ex officio*. Should an application be opposed by the appropriator of an older right without prior warning (warning letter), the applicant can avoid procedural costs by swift withdrawal of the opposed trade mark.

The IPI database is a good starting point when searching for older trade marks, but it only provides an identity search; an additional, professional similarity search is highly recommended. The IPI provides a list of platforms that can be consulted and a list of professionals that can be contacted in order to fulfil the research, and offers certain services in connection with trade mark searches.

4.3 Term of Registration

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 the 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 months and charges an additional fee. Renewals can be filed from one year before expiration of the protection until six months after the expiration. If no renewal is filed within this timeframe, the trade mark right is lost irrevocably, and a new application is required to rebuild protection. In exceptional cases only, *restitutio in integrum* might be granted.

Continued use is not a requirement for extension. 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.

4.4 Application Requirements

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 or email, or by using the electronic registration process (a discount of CHF100 applies for online applications). The electronic application system guides the applicant through the whole process step by step, 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 apply to 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.

A Swiss trade mark application must include the personal information of the applicant, the mark itself and a list of the goods and services for which the trade mark is intended to be used. Any natural or legal person may register a trade mark in Switzerland. Multiple-class applications are admissible. Any applicant that is not domiciled or resident in Switzerland must designate an address for service 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 guaranteed mark or a collective mark. After submitting the application, it is then examined for admissibility by the IPI.

Fees for trade mark applications amount to CHF350 for online applications (otherwise CHF450) for up to three classes (CHF100 for each additional class). A decision regularly takes between three and five months. Expedited applications (decision in about four weeks) are available for an additional fee of CHF400.

4.5 Use in Commerce Prior to Registration

Use prior to registration is not required under Swiss law. If a trade mark is not used for the goods and services for which it obtained protection, it may be subject to invalidity proceedings before the IPI or the civil courts after the grace period has expired (see 2.4 Use in Commerce). Invalidity for lack of use may also be raised as a

defence in opposition or infringement proceedings.

The requirements for establishing genuine use are use of the trade mark in commercial trade, in Switzerland, as an indication of origin in relation to the claimed goods/services. The use must reach an economically meaningful extent (genuine intention of satisfying the markets' demand).

4.6 Consideration of Prior Rights in Registration

The trade mark office does not consider the existence of prior rights in its examination of an application for registration (see 2.2 Essential Elements of Trade Mark Protection).

4.7 Revocation, Change, Amendment or Correction of an Application

Any applicant can modify their trade mark free of charge during the entire registration process. Material changes are admissible but result in a postponement of the filing/priority date. At a later stage, when the trade mark has been registered, modifications to the list of goods and services (restrictions only), for example, may be made in exchange for an administrative fee. Once the trade mark has been registered, the sign cannot be changed.

Amendments require a formal request, which can be submitted in writing, via email to tm.admin@ekommm.ipi.ch or via the IPI online platform.

4.8 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.

Dividing a trade mark can facilitate the application process – eg, by splitting components that could potentially give rise to conflicts from unproblematic parts. Some rights owners divide trade marks to facilitate licensing or assignment.

4.9 Incorrect Information in an Application

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

4.10 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. Absolute grounds for refusal concern cases where:

- signs are in the public domain (eg, merely descriptive);
- signs include shapes that constitute the nature of the goods themselves, or shapes of the goods or their packaging that are technically necessary;
- a sign is misleading; or

- a sign is contrary to public policy, morality or applicable law (eg, in cases of insignia of international organisations).

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 (see **5. Trade Mark Procedure for Inter Partes Proceedings**).

When the IPI concludes that the application should be dismissed, it gives the applicant a reasoned preliminary opinion. The applicant is invited to submit a reasoned opinion to overcome the IPI's objections (eg, by accepting proposed alterations to the list of goods and services).

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 of the Madrid System). It is possible to submit the trade mark application online or in written form by post or via email.

5. Trade Mark Procedure for Inter Partes Proceedings

5.1 Timeframes for Filing an Opposition or Cancellation

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

same period, the opponent must pay the opposition fee of CHF800. 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, oppositions can be based on well-known trade marks as earlier rights. 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.

Unlike EU trade mark law, Switzerland does not provide a statutory cooling-off period, but the parties can mutually apply for a suspension of proceedings, which is regularly granted by the IPI for an unlimited period of time.

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, in the event of opposition proceedings, five years after the conclusion of opposition proceedings. Other statutory limitations or time periods (eg, for certain arguments or grounds for refusal) do not apply.

Copyright is an unregistered right in Switzerland, so no opposition or cancellation proceedings apply. The non-existence of copyright protection for a particular subject matter can, under certain circumstances, be established by means

of an action for a negative declaratory judgment before the civil courts.

5.2 Legal Grounds for Filing an Opposition or Cancellation

According to Article 3 of the Swiss Trade Mark Protection Act, the legal grounds for filing an opposition are 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 to an earlier trade mark and is intended for the same goods or services as the earlier trade mark;
- the sign is identical to an earlier trade mark and is intended for similar goods or services, so that there is a likelihood of confusion; or
- the sign is similar to an earlier trade mark and 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 a civil action before the regular courts.

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 (particularly all the above-mentioned absolute and relative grounds for refusal) have to be examined through civil court proceedings (or through opposition proceedings in the case of relative grounds for refusal).

The decisions of the IPI may be appealed to the Federal Administrative Court and subsequently to the Federal Supreme Court. However, the

Federal Administrative Court is the court of last instance for decisions in opposition proceedings: an appeal to the Swiss Supreme Court is excluded by law.

5.3 Ability to File an Opposition or Revocation/Cancellation

For the initiation of opposition proceedings (and court proceedings), there is, in principle, no mandatory requirement to be represented by an attorney in Switzerland. However, it follows from the procedural rules under trade mark law that the applicant must at least have an address for service in Switzerland, and mandated attorneys in Switzerland ensure such. For the material requirements to initiate such proceedings, see **5.2 Legal Grounds for Filing an Opposition or Cancellation**.

The opposition fee, as defined by the IPI, currently amounts to CHF800. 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.

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. To invoke absolute or relative grounds for refusal in civil proceedings (civil action for annulment), the plaintiff must demonstrate an individual interest. Such interest can be demonstrated by the application for protection or use of a similar trade mark, for example.

5.4 Opposition or Revocation/Cancellation 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 grounds of the opposition. In addition, the IPI checks whether the required opposition fee has been paid by the opponent in due time.

If all requirements are met, the IPI sets a time limit for the counterparty to submit a written response. The counterparty's statement is usually not followed by a second exchange of correspondence. The opposition proceedings are 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 to enforce its exclusive right towards the applicant of a later mark in a relatively simple way. However, this also means that only limited legal grounds can be raised in such opposition proceedings (only relative grounds for refusal) and they cannot replace regular court proceedings.

Cancellation proceedings may be initiated either before the IPI due to 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 in the Swiss trade mark register. Non-use is not examined ex officio.

A trade mark may be cancelled partially in opposition or cancellation proceedings, if grounds for refusal do not concern the whole trade mark (eg, if only certain goods or services are concerned). Disclaimers may be amended on the list of goods and services.

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. Proceedings at the Federal Administrative Court usually take around nine months.

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.

Decisions can be appealed immediately after the respective IPI submission has been served.

5.6 Amendment in Revocation/Cancellation Proceedings

In cancellation proceedings before the IPI, amendments are possible insofar as actions can be restricted (eg, to certain goods or services of the opposed trade mark). Extensions are inadmissible but can be brought before the IPI by filing a second invalidity action.

Amendments in civil cancellation proceedings are admissible according to the general rules on civil proceedings (Article 226 of the Swiss Civil Procedure Code).

5.7 Combining Revocation/Cancellation and Infringement

Cancellation proceedings before the IPI concern only the question of non-use; questions of infringement cannot be brought before the IPI but are exclusively heard by the civil courts.

In infringement proceedings, cancellation actions are regularly brought as a counterclaim (defence) by the defendant. It is also possible to bring both infringement claims and cancellation actions against the same defendant before one civil court to be heard together. Such claims are decided simultaneously.

5.8 Measures to Address Fraud

Trade marks that were filed fraudulently must be cancelled before an ordinary civil court by means of an action for cancellation; no special rules apply.

Fraudulent use of a trade mark, however, is subject to criminal prosecution under Article 62 of the Swiss Trade Mark Protection Act.

6. Assignments and Licensing

6.1 Assignment Requirements and Restrictions

A trade mark application or registration 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. An effective assignment requires written form. Trade marks are transmissible upon death.

Trade mark assignment recordals can be filed directly with the IPI but are not necessary for the validity of assignment (declaratory nature). 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 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 a 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's website.

Copyright can be assigned both by contract and upon death. No formalities apply, so copyright can be assigned even by conduct. Moral rights, however, remain with the author regardless of contractual agreements; assignments and waivers are excluded.

6.2 Licensing Requirements or Restrictions

A trade mark owner may grant exclusive, non-exclusive, sole and perpetual licences, and no formalities such as written form or registration are required.

Trade mark licences may be registered on the register in Switzerland. As long as an exclusive licence is entered on the register, no other licences will be registered for the same trade mark(s) that are incompatible with the licence. In the case of partial licences, the goods and services and/or territory covered by the licence 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 for a sub-licence, additional proof must be provided showing that the licensee is entitled to grant sub-licences.

Template trade mark licence registration forms are available on the IPI's website.

A copyright owner may grant exclusive, non-exclusive, sole and perpetual licences, and no formalities such as written form or registration are required, although written form is highly recommended for purposes of proof.

6.3 Registration or Recording of an Assignment or Licence

It is not mandatory to register a trade mark licence on the Swiss register (“Swissreg”), except for a collective mark, which must be recorded. However, registering a licence may be in the interest 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.

Copyright licences cannot be registered because copyright is an unregistered right in Switzerland and therefore no copyright register exists.

7. Initiating Trade Mark and Copyright Lawsuits

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; for claims for damages and claims for the handing over of profits, the statute of limitations is three years and starts from 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 Claims for Infringement Lawsuits and Their Standards

The Swiss legal system provides the following civil law claims for the infringement of copyright and trade mark law:

- claim for injunctive relief;
- claim to remedy an existing infringement;
- claim for damages and compensation;
- claim for information (usually to gain knowledge about the scope of infringement or further possible infringers);
- claim for confiscation and destruction of infringing objects (and tools to produce such);
- declaratory claims (eg, for non-infringement or cancellation of a trade mark/non-existence of copyright protection); and
- claim for publication of the judgment at the cost of the losing party.

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.

The claims apply equally to direct infringement, contributory infringement and vicarious infringement. Unlike most other jurisdictions, trade mark claims can also be brought against private individuals who import infringing goods (eg, fake Gucci bags from a holiday in Thailand).

The available claims are the same, regardless of whether the trade mark is registered or unregistered.

Trade mark infringement is constituted by:

- the existence of a trade mark right (registered or unregistered);
- infringing use of the trade mark (conditions are identical to the requirements of relative grounds for refusal, particularly likelihood of confusion); or
- unlawful use (no limitations apply; no right to use – eg, no licence).

Copyright infringement is constituted by:

- the existence of copyright protection (own individual creation);
- infringing use of the protected work (identical or adaptive);
- infringement of the author's moral rights (distortion of the work, violation of the author's right to be named as the author); or
- unlawful use (no limitations apply; no right to use – eg, licence).

The plaintiff is obliged to present all facts that prove protection and use, while the defendant must present all facts that justify the use, such as the legal requirements of exceptions and limitations. The burden of proof generally lies with the party for whom the respective fact is legally useful or favourable.

In the case of well-known marks, Swiss law provides for extended protection by granting claims against use for goods or services for which the well-known mark is not protected, if such use constitutes dilution or exploitation of reputation (image transfer). The plaintiff must prove Swiss consumers' widespread awareness of the respective trade mark, which usually requires a market survey, unless such awareness is self-evident to the court.

Legal remedies related to copyright management information correspond to Article 12 of the WIPO Copyright Treaty and can be found in Article 39c of the Swiss Copyright Act. Copyright management information is defined in Article 39c(2) of the Swiss Copyright Act as all "electronic information that identifies works and other subject-matter or information about the terms and conditions of use as well as any numbers or codes that represent such information". Swiss law prohibits the unauthorised removal of such information and the use of works after the unlawful removal of such information.

7.3 Factors in Determining Infringement

The decisive criterion in determining trade mark infringement is likelihood of confusion (Article 3(1) of the Swiss Trade Mark Protection Act). Whether such a likelihood exists must be determined by the overall impression based on the criteria of identity/similarity (*Gleichartigkeit*) of the signs and with respect to the goods and services offered. In other words, the more similarity between the goods and services offered, 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 discretionary decision-making. The higher the degree of similarity of the older mark, the more likely the court must assume a likelihood of confusion.

Trade mark infringement is determined by comparing the overall impression of the earlier work and the potentially infringing creation (Articles 10 and 11 of the Swiss Copyright Act). All creations that represent the individual character of the original work fall within the scope of protection and are therefore infringing.

7.4 Prerequisites and Restrictions to Filing a Lawsuit

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

Unfair competition law prohibits misleading and abusive threats, including misleading warning letters. For example, a warning letter might be considered an act of unfair competition if the originator has serious doubts about the accuracy of the infringement accusation. It must be noted that the receipt of a warning letter usually entitles the recipient to bring a negative declaratory action against the originator (declaring non-protection and/or non-infringement).

7.5 Lawsuit Procedure

Due to the specific subject matter of intellectual property law, the legislature has provided for a cantonal court authority to handle, among other things, trade mark and copyright 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 (currently the cantons of Zurich, St. Gallen, Berne and Aargau).

In order to initiate litigation, whether preliminary or regular proceedings, a statement of claim must be filed with the competent court. 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, provide detailed facts and present the grounds on which these claims are based. In general, IP proceedings follow the applicable standard civil procedure rules as applicable to non-intellectual property civil proceedings.

Decisions on trade mark and copyright disputes can 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.

While representation by a lawyer is not mandatory in IP civil law proceedings in Switzerland, such representation is imperative for both plaintiffs and defendants. Pre-procedural costs, such as for legal advice, drafting and filing a C&D letter and potential settlement negotiations, vary widely, depending on many factors. Such costs roughly range from CHF1,000 to CHF10,000.

Foreign rights owners can bring IP claims in Switzerland, as they enjoy trade mark or copyright protection under Swiss law. Trade mark claims consequently require a Swiss registered trade mark or a famous foreign mark, in accordance with Article 6bis of the Paris Convention. As copyright is an unregistered right free of formalities in Switzerland, corresponding claims exist independently from any registration.

7.6 Declaratory Judgment Proceedings and Other Protections for Potential Defendants

As a general rule, any person who can demonstrate a legal interest may apply to the court for a declaratory judgment as to whether or not a right or legal relationship governed by the Swiss Trade Mark Protection Act or the Swiss Copyright Act exists. Receipt of a warning letter alleging trade mark or copyright infringement constitutes such legal interest to apply for a declaratory judgment stating non-protection (invalidity) or non-infringement.

A potential defendant can file protective briefs under Article 270 of the Swiss Civil Law Code. Protective briefs are valid for a period of six months after submission and must be considered by the competent courts in preliminary injunction proceedings. The purpose of such briefs is to ensure a fair hearing of the factual and legal submissions of potential defendants in urgent cases where the court might grant an interim injunction without a prior hearing.

7.7 Small Claims

Switzerland does not provide a general dispute resolution option in IP matters, such as the European Union does, for example (EUIPO Mediation Centre). There is, however, a sector-specific Institution for IT and Data Dispute Resolution (ITDR), available at www.itdr.ch/en.

7.8 Effect of Trade Mark and Copyright Office Decisions

The IPI has certain competencies in the field of administrative law. It conducts the trade mark registration examination process and, provided proceedings are initiated, co-ordinates and decides oppositions that may be filed by earlier trade mark right-holders and cancellation proceedings based on alleged non-use.

IPI proceedings are purely administrative. The proceedings are concluded by a decision of the IPI (ie, approval or rejection), but the judgment has no substantive legal force. Accordingly, in the event of a rejection of the IPI following the opposition proceedings, for example, the opposing party still has the option of initiating regular court proceedings before a civil court. If the opposition is upheld by the IPI, the other party has the option 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 Counterfeiting and Bootlegging

Since counterfeits have enormous potential to cause damages to owners of IP, Swiss trade mark and copyright laws explicitly prohibit any manufacture and/or sale of counterfeits. The Swiss Trade Mark Protection Act prohibits not only the unauthorised imitation of protected products (by trade mark law) and the trade of these counterfeits, but also their import, export or transit through Switzerland.

The Swiss Customs Administration has been given the appropriate powers to enforce these regulations. 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 then has the possibility to take civil action against any person who tried to bring a counterfeit of such goods into Switzerland, based on trade mark law, including private individuals.

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.

Swiss trade mark and copyright laws specifically include several provisions concerning criminal offences in connection with the use of trade marks or copyright protected works. For example, upon the complaint of an 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
- place goods on the market or provide services, or offer, import, export, carry in transit, store for the purpose of placing on the market, or advertise such goods or services under the appropriated, counterfeited or imitated trade mark.

Copyright and trade mark infringements for commercial gain are subject to much higher penalties, up to a maximum of five years' imprisonment or a fine. Infringements committed by private individuals are exempt from trade mark offences, but copyright offences do apply.

8. Litigating Trade Mark and Copyright Claims

8.1 Special Procedural Provisions for Trade Mark or Copyright Proceedings

There are no jury decisions within court proceedings or any other administrative law-based proceedings. In principle, court proceedings with respect to IP disputes follow the same rules and principles of regular civil procedure law. However, the Swiss Trade Mark Protection Act and the Copyright Act (as well as related ordinance law) regulate the civil procedure with respect to IP 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 and consumer organisations to file suit;
- the confiscation and destruction of objects in civil proceedings;
- the initiation of precautionary measures; and
- the publication of civil court judgments.

While Switzerland provides a Federal Patents Court that exclusively handles patent disputes as a first instance, trade mark and copyright disputes are handled by the respective cantonal courts, usually the cantonal commercial courts, as a first instance. The decision bodies usually consist of three judges: a legal judge presiding and two technical judges.

The composition of the chambers can only be influenced if members of the court are suspected of bias. If a party fears bias on the part of a court member, it must explicitly request exclu-

sion of the judge pursuant to Article 49 of the Swiss Civil Procedure Code.

8.2 Effect of Registration

Although the registration of a trade mark is mandatory 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.

Copyright registrations do not exist in Switzerland.

Non-use after expiration of the five-year grace period does not affect a trade mark's validity *ipso iure* and is not considered by courts in infringement proceedings *ex officio*. However, after expiration of the grace period, the trade mark becomes vulnerable to invalidity attacks. Invalidity due to non-use can particularly be claimed by third parties as a counterclaim in infringement proceedings.

8.3 Costs of Litigating Infringement Actions

The costs of a trade mark or copyright lawsuit include court costs (*Gerichtskosten*), which depend on the value of the matter and usually start 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. Defences and Exceptions to Infringement

9.1 Defences to Trade Mark Infringement

Swiss trade mark law provides numerous defences against infringement proceedings. The following defences can be considered total bars to liability.

- Trade marks only grant the exclusive right to use the mark to identify goods and services (Article 13(1) of the Swiss Trade Mark Protection Act). Consequently, descriptive use can serve as a defence against copyright claims.
- Unlike many other jurisdictions, Switzerland provides a right to continue prior use. Under Article 14 of the Swiss Trade Mark Protection Act, the proprietor of a trade mark may not prohibit another person from continuing to use a sign to the same extent as used prior to the filing of the application. Such self-use is not covered by the trade mark protection rights of the owner of the later registered trade mark, but 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 goods, rebranding with the same mark, etc).

- Non-use can be used as a counterclaim in infringement proceedings, once the grace period of the mark has expired.
- Correspondingly, all absolute grounds for refusal can be invoked as a counterclaim – eg, bad faith registrations.
- A licence can justify use.
- While there is no fair use defence under Swiss trade mark law, parody/satire can justify trade mark use by invoking human rights such as the freedom of expression and artistic freedom granted by the Swiss Constitution (not yet confirmed by the Swiss Supreme Court).
- There is no statutory own-name defence under Swiss trade mark law, but corresponding cases can be subject to the right to continue prior use (see above).

9.2 Defences to Copyright Infringement (Fair Use/Fair Dealing)

Swiss law does not provide a general clause that restricts copyright; in particular, there is no exception that permits “fair use”. In contrary, like EU law, for example, the Swiss Copyright Act provides an exhaustive list of specific exceptions (Articles 19–28).

Article 11(3) of the Swiss Copyright Act provides an exception to copyright based on parody and satire, which are defined by case law as humorous expressions of opinion based on the original work.

There is no general exception to Swiss copyright based on human rights such as the right to free speech, but such general principles are substantiated by the legislature in the exhaustive list of exceptions – eg, in the exceptions for quotation (Article 25 of the Swiss Copyright Act) or reporting on current events (Article 28 of the Swiss Copyright Act).

9.3 Exhaustion

A trade mark is a means of distinction and is not intended to secure distribution systems. A trade mark right is therefore deemed to have been exhausted as soon as the specific marked product has been placed on the market with the consent of the trade mark owner. Exhaustion is not stipulated by law but is recognised by jurisdiction. According to case law, the principle of international (worldwide) exhaustion applies to trade mark law.

The principle of international exhaustion applies to copyright as well, as stipulated by Article 12(1) of the Swiss Copyright Act. As in trade mark law, the copyright in a specific (physical) work copy is exhausted when it is placed on the market with the consent of the rights-holder.

Article 12(2) of the Swiss Copyright Act specifically confirms this principle for physical copies of computer programs. The question of digital exhaustion is unresolved in Switzerland and not explicitly stipulated by statute. While digital exhaustion has been confirmed by a lower court in accordance with the CJEU jurisdiction *UsedSoft* (C-128/11), the decision has not been confirmed by the Swiss Federal Supreme Court. However, the legal literature holds that the *Zug* decision indicates conformity between Swiss and EU law regarding digital exhaustion.

10. Remedies

10.1 Injunctive Remedies

Under Swiss copyright and trade mark law, several forms of injunctive relief besides the “usual” permanent injunctions are available.

Preliminary Injunctions

A trade mark may be enforced through a 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;
- the infringement threatens to cause a prejudice that cannot be easily remedied;
- there is some urgency; and
- the party requesting the preliminary injunction has sufficient interest in legal protection.

Ex Parte Preliminary injunctions

See **10.4 Ex Parte Relief**. In cases of special urgency, the court may issue injunctions immediately without hearing the other party. The conditions for special urgency are that:

- a delay to the injunction would likely cause irreparable harm to the claimant;
- the claimant acts immediately without delay after acquiring knowledge of the infringement (generally within a few days); or
- the claim/enforcement might be frustrated if the opposing party is notified.

Other Preliminary Measures

Any person requesting preliminary measures 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 the freezing of assets such as bank accounts

The Swiss Civil Procedure Code (Articles 261–262) grants extensive discretion to the judge in

deciding on the specific measure, the scope of the measure and the option granted to the opponent to prevent the preliminary measures by providing a security deposit.

10.2 Monetary Remedies

Different remedies can alternatively be awarded to trade mark and copyright owners in main infringement proceedings. Unlike in preliminary proceedings, judges do not have discretion in ordering remedies but are strictly bound to the procedural claims invoked by the claimant. The following options exist.

- Trade mark or copyright owners may claim actual damages in terms of the amount of involuntary reduction in net capital caused by the infringement (eg, lost profit). The damage is determined by comparing the actual and the hypothetical economic position without infringement. Such damage is hard to prove.
- The infringer's actual profits generated by the unjust use of the claimant's intellectual property can be claimed as damage.
- A hypothetical licence/reasonable royalty fee can be awarded as damages. Such claims require proof of past licence agreements conducted by the claimant regarding the trade mark or copyright in question.
- Swiss law does not provide for enhanced damages for wilful acts or punitive damages. However, in case of wilful acts, statutory criminal offences may apply.

Copyright is an informal, unregistered right in Switzerland, and therefore no registration is required to claim damages. Unregistered trade mark rights do not exist in Switzerland, so in this case registration is a prerequisite for the existence of the right itself and therefore for claims for damages.

10.3 Attorneys' Fees and Costs

The costs for litigation consist of attorneys' 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 and the parties on a 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 (eg, the claim is partially unsuccessful), the court will split these costs and fees accordingly between the parties.

10.4 Ex Parte Relief

In general, notice is required. In cases of special urgency only, 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). Special urgency may be considered given, in particular, if there is a risk that the opposing party will make it impossible for the claimant to realise its 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.

Also see **10.1 Injunctive Remedies**.

10.5 Customs Seizures of Counterfeits or Parallel Imports

The Federal Customs Administration is authorised to withhold infringing goods upon request of the trade mark owner or on its 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 from a civil court or a seizure order from a criminal prosecution authority, or must obtain the approval of the goods' owner for the destruction of the withheld goods.

11. Appeal

11.1 Appellate Procedure

Swiss law does not provide any special provisions concerning the appellate procedure for civil trade mark proceedings and, therefore, such proceedings follow the regular civil procedure rules. Decisions of civil courts on trade mark or copyright infringements (sole cantonal instances are appointed as first instance in both cases) can be appealed to the Swiss Federal Supreme Court. Consequently, Switzerland provides only two instances in civil IP proceedings.

The Federal Supreme Court primarily judges violations of the law. A review of the determination of the facts is only possible in exceptional cases, which means that the lower court's determination of the facts is binding for 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.

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.

11.2 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, all 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 and three years to obtain a judgment before the cantonal court.

12. Additional Considerations

12.1 Emerging Issues

AI

While Swiss practice, industries and jurisprudence are highly interested in AI developments, no judgments on the topic have yet been issued. This is not uncommon in Switzerland, as many core legal questions remain unresolved by courts due to the low number of cases. Swiss courts, however, consider international developments and particularly EU judgments or judgments in member states, especially German verdicts. Developments in the EU can therefore provide an indication of future developments in Switzerland.

In Switzerland, as in most other countries, there is currently no copyright protection for non-human-created content that is generated by AI without human intervention. AI output can infringe copyright if it falls within the scope of protection of a work; the general rules apply. Legal literature deems that the use of content for AI training can constitute infringement if such content is copyright protected (if not solely done for research purposes).

On 13 December 2024, the Federal Council adopted the updated Digital Switzerland Strategy for 2025 and defined new focus topics, including extensive regulations on AI. In line with the EU's AI Act, these rules focus on regulatory aspects and, for example, promoting the use of AI in the federal administration. As far as is known, no specific IP rules are currently being considered.

Legislative Copyright Revision 2019

The Swiss Copyright Act was revised in 2019, introducing the following changes, among others.

- To prevent the unauthorised use of protected content, the revised law introduces a new obligation for hosting providers (Article 39d). This provision comes into effect after the hosting provider has been notified of unauthorised content being uploaded and has removed it in accordance with the general rules (take-down). Under the new stay-down and keep-down obligation of Article 39d, hosting providers must ensure that protected content does not become illegally accessible again through their platform.
- A neighbouring right has been introduced for the protection of photographs that do not fulfil the originality criterion (snapshot-protection).
- The term of protection of related rights for performances by performers and producers of phonograms and videograms is extended from 50 to 70 years (Article 39(1)). This brings Swiss law into line with EU law and will be of particular benefit to bands covering music from the 50s and 60s.
- The revised law provides that authors are entitled to remuneration for the exploitation of audiovisual works via online platforms (Article 13a). A similar provision is also included for

performing artists (Article 35), with compulsory collective management for the assertion of corresponding claims.

- An express exception from copyright protection for text and data mining for scientific purposes has been introduced in Article 24d.

Landmark Judgments

The Swiss legal system produces a relatively small amount of case law. Consequently, the following judgments have had significant impact.

- In 2022, the Swiss Federal Supreme Court confirmed copyright protection for a Barbecue-Grill (so-called “Feuerring”) as a work of applied art, considering inter alia a “surprising effect” the design communicates to the observer.
- The Berne Commercial Court confirmed copyright protection for a musical instrument (so-called “Hang”) as a work of applied art, considering inter alia questions of technical determination and prior art.
- The Swiss Federal Supreme Court confirmed trade mark protection of two three-dimensional marks depicting the “Lindt Gold Bunny” and granted injunctive relief against a similar chocolate gold bunny despite several differences in design.
- The Swiss Federal Supreme Court held that the customisation of originals of high-quality branded watches (Rolex case) does not constitute trade mark infringement if the modified product is provided to the contractor by the customer. The placing of modified goods on the market, on the other hand, constitutes trade mark infringement.

Influence of Foreign Case Law on Swiss Court Decisions

As mentioned before, Swiss courts rely heavily on jurisdiction in the EU and its member states, particularly Germany, to assess unclarified legal questions in Switzerland. The legislature’s reasonings provided alongside IP statutory law regularly declare alignment with EU law as an explicit objective of Swiss legislation. This can be considered a legal basis for the application of European judgments in Switzerland when assessing statutory law, its meaning and its objectives.

12.2 Trade Mark and Copyright Use on the Internet

Marketing products on the internet, in general, follows the same rules as every other sales platform. If trade mark rights or copyrights are violated, the owner has the right to prohibit such use by invoking trade mark and copyright law.

Unlike many other jurisdictions, such as Germany, the Swiss private use exception allows the downloading of copyright protected content under Article 19 of the Swiss Copyright Act. So-called “illegal streaming” by privates therefore does not constitute copyright infringement in Switzerland.

The 2019 copyright reform introduced a stay-down obligation for hosting providers (Article 39d of the Swiss Copyright Act); see **12.1 Emerging Issues**. This rule applies exclusively to copyright and is not (directly or by analogy) applicable to trade mark law.

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