Switzerland

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Legal framework

National

The basic principles for trademark protection in Switzerland are laid down in the Federal Act on the Protection of Trademarks and Geographical Indications 1992 and the Trademarks Regulation 1992, which have been repeatedly revised. The legislation is largely in harmony with the EU First Trademarks Directive (89/104/EEC), but as Switzerland is not a member of the European Union, it is not covered by the Community trademark regime.

On November 18 2009 the Federal Council presented the bulletin for the new legislative project named 'Swissness' (which includes protection for 'Made in Switzerland' designations and the Swiss Cross in Switzerland and abroad). The revised law regarding 'Swissness' was finally passed by the Parliament on June 21 2013. The Federal Council now needs to specify the following three topics on the level of an ordinance: criteria for Swiss origin, register for geographical indications and cancellation action due to non-use. The amendment should come into force by the end of 2015.

On November 22 2013 the Federal Institute of Intellectual Property (IGE) celebrated its 125th anniversary. The Federal Administration Court adjudicates appeals against decisions of the IGE. The court's decisions concerning absolute grounds for refusal may be further brought to the Swiss Supreme Court, while opposition decisions are final.

On January 1 2011 the new Criminal and Civil Federal Procedural Act came into force. The act harmonises the 26 cantonal laws on civil and criminal proceedings and merges them into a

single act. While some implementations are still subject to cantonal rules, the procedure itself is now the same in every canton.

As of January 1 2014, the IGE increased its fees for trademark renewals from Sfr550 to Sfr 700 (as before, without additional fees per class).

International

Switzerland has signed most pertinent international agreements, including:

- the Paris Convention for the Protection of Industrial Property (Stockholm version, ratified in 1970);
- the Nice Agreement on the International Classification of Goods and Services (adopted in 1962);
- the Madrid Agreement on the International Registration of Marks (adopted in 1892);
- the Madrid Protocol (adopted in 1997);
- the Agreement on Trade-Related Aspects of Intellectual Property Rights (adopted in 1995); and
- the Trademark Law Treaty (adopted in 1997).

In December 1 2011 Switzerland and the European Union entered into an agreement on the mutual recognition of protected designations of origin and geographical indications for agricultural products and foodstuffs. The agreement protects 22 Swiss designations of origin and geographical indications on the EU market, as well as more than 800 EU designations of origin and geographical indications on the Swiss market.

Unregistered marks

Protection

Unregistered marks may be protected in Switzerland by the Federal Law against Unfair Competition 1986.

Well-known unregistered trademarks may enjoy the protection of Article 6*bis* of the Paris Convention. The Administrative Court has clarified in various decisions that Swiss citizens and/or firms may invoke this protection only if they own a foreign trademark registration.

In a decision of March 22 2010 (HG090045–*Tonwelt*), the Commercial Court of Zurich allowed, based on the Paris Convention, an action of a German company which held no trademark registration for Switzerland, but used its trademark there, to proceed against a trademark that is identical to its name.

In addition, Article 4 of the Trademarks Act protects against the unauthorised registration of trademarks by agents or representatives, according to Article 6*septies* of the Paris Convention. However, such trademarks are not null and void, but rather challengeable. Therefore, only the owner may file a lawsuit for cancellation.

Registered marks

Ownership

Any natural or legal person from any country is entitled to apply for trademark registration in Switzerland. Pursuant to Article 42(1) of the Trademarks Act, foreign applicants must appoint a representative domiciled in Switzerland. Normally, the applicant need not submit any evidence of its existence, such as a certificate of incorporation. There is no requirement of use or intent to use for filing a trademark application. In rare cases a trademark may be refused *ex officio* (B-3036/2011, December 5 2011–*Swissair*). However, relative grounds for refusal are not examined *ex officio*.

Scope of protection

The Trademarks Act allows for the registration of ordinary marks, certification marks and collective marks, which may consist of words, letters, numbers, designs, three-dimensional forms or combinations thereof. The act does not exclude the registration of colours, sounds, moving images, holograms or position marks.

With regard to olfactory marks, the Administrative Court (B-4818/2010, May 23 2011–*almond smell*) has accepted such marks in principle, but denied protection in this case due to a lack of graphical representability.

For all such symbols, whether registrable or not, the Trademarks Act uses the general term 'sign'. Article 2 (in accordance with Articles 6*quinquies* (B)(ii) and (iii) of the Paris Convention) excludes from registration signs that:

- belong to the public domain or are merely descriptive, unless they have acquired secondary meaning;
- are shapes that make up the technical

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essence of the goods or their packaging;
- are deceptive; or
- are contrary to public order, morality or the law.

Signs that are considered to belong to the public domain include:
- single characters of the Latin alphabet (however, a single character may gain secondary meaning if there is no indispensable need to keep it free – see Case BGE 134 III 314–M) – but not necessarily foreign characters and combinations of at least two letters and/or numbers;
- simple geometrical signs (eg, circles and rectangles) – but not necessarily combinations of these; and
- descriptive signs – for example, words that may be understood, in a Swiss national language or in English, to describe the quality, quantity, purpose, value, geographical origin or other characteristics of the goods or services, or slogans without a distinctive element. New combinations of words that were not previously used in business may also be found descriptive. For example, the following trademarks were refused protection due to lack of distinctiveness: ON THE BEACH for Class 3, VERY IMPORTANT PHARMACY for Classes 3, 5 and 44, CE'REAL for Class 30, NOBLEWOOD for Classes 2, 19 and 27, MAGNUM for Classes 29 and 32, EXPRESS ADVANTAGE for various classes and VUVUZELA for musical instruments. The Administrative Court also rejected – in contrast to the Office for Harmonisation in the Internal Market – protection for the sign OKTOBERFEST-BIER (B-5169/2011, February 17 2012) as it constituted a mere designation for a sort of beer.

On the other hand, suggestive words that raise no specific expectations or new combinations of descriptive signs that create a distinctive general impression may still be registered.

There are two types of non-distinctive sign:
- If a sign is indispensable to the public – for example, POST for postal services, the colour blue for beverages or MARCHÉ for restaurant and food services – it may not be registered.
- Other non-distinctive signs may acquire secondary meaning and be registered upon evidence of long use in Switzerland (usually 10 years). This period can be shortened in extraordinary circumstances, in particular where the applicant can prove widespread use or popularity through extensive media coverage. The practice of secondary meaning has become stricter and, as such, the IGE requires proof of use in all Swiss territories, usually providing documents in French, Italian and German (BGE 128 III 441, 444–*Appenzeller*). In borderline cases, opinion polls may be required to prove that the sign has acquired secondary meaning.

Names of persons and fictional characters, whether well known or not, may in principle be registered as trademarks, unless they had an extraordinary influence in their field of activity and are frequently cited to describe certain goods or services. According to the IGE's guidelines, signs containing a thematical reference are usually not registrable.

Shape marks can be three-dimensional signs that are additionally applied to goods, such as the star on Mercedes-Benz cars. These marks present no special problems.

More problematic are marks that represent the shape of the goods or their packaging – in general, these marks cannot be

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registered if their features are merely of an aesthetic nature or determined by technical necessities.

A trademark is deceptive if it creates expectations that are not necessarily fulfilled by the goods or services that it represents. Applications for marks that suggest a specific geographical origin (eg, SAN FRANCISCO FORTY NINERS in relation to clothing, AFRI-COLA for beverages not from Africa) may still be registered if the list of goods is restricted to goods of the origin suggested. However, the practice and jurisprudence relating to what is perceived as a geographical name seem inconsistent (while MILANELLO was qualified as geographical indication (to Milan), VICTORIA, SAVANNAH and WILSON were not).

A trademark may consist of distinctive and non-distinctive elements. It is sufficient that one element is distinctive, as the overall impression is decisive. No disclaimers are required for non-distinctive elements.

Signs against public order, morality or Swiss law include religious symbols and the names of prominent individuals without their consent (eg, MOHAMMED for alcoholic beverages).

Procedures

Examination

The IGE will examine a trademark application for formalities and check whether there are absolute grounds for refusal of registration – in particular, those discussed above. There are, however, no substantive examinations concerning relative grounds for exclusion. These may be raised by the relevant owner. The timeframe from application to registration is usually three to six months. If an express examination is requested (for an additional fee of Sfr400), the timeframe is about one month. If the IGE finds grounds for refusal, it will issue a provisional rejection and set a deadline of two months (which may be extended), within which the applicant may try to overcome the rejection.

This procedure also applies to the Swiss portions of international registrations.

Unlike in many other countries, Swiss trademark applications may be amended in any way during the application process (particularly in order to overcome provisional rejections). There are no official fees for such amendments. However, in the case of significant amendments, the application date will change to the date on which these amendments are made.

Opposition

Swiss trademarks are published following registration. Oppositions to a registration may then be filed by the owners of:

- prior Swiss trademark applications and registrations;
- respective international registrations covering Switzerland; and
- trademarks that are well known in Switzerland according to Article 6*bis* of the Paris Convention.

The deadline for filing an opposition is three months and cannot be extended. Since July 2010, oppositions may be filed electronically. The official fee for filing an opposition is Sfr800. In relation to Swiss trademarks, the opposition period begins to run on the day of publication at www.swissreg.ch (ie, the opposition period of a trademark published on July 17 2008 ends at midnight on October 17 2008). In relation to the Swiss portions of international trademarks, the opposition period begins on the first day of the month following that of publication by the World

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Intellectual Property Organisation (WIPO). If use is not challenged, such a case usually takes between one and two years to be decided.

Registration

At the end of the examination process and before publication, the accepted trademark is registered for a period of 10 years. Subsequently, the trademark is published.

Removal from register

Revocation: There is no requirement to submit evidence of use to the IGE in order to maintain a trademark registration.

Trademarks that are not used, without legitimate reason, in the five years following their final registration (ie, the date on which the decision granting the registration became final) may be challenged and expunged before the civil courts on the grounds of non-use. Non-use may be invoked by the defendant in opposition proceedings, as well as before the civil courts. At present, only an ordinary court proceeding is available. The proposed amendment will introduce a simplified proceeding to remove unused marks from the Trademarks Register.

As a general rule, the trademark must be used as registered. However, under Article 11(2) of the Trademarks Act, minor variations are still permissible in order to prove genuine use.

Invalidation: The IGE may rectify errors, but it is not entitled to cancel registered trademarks on its own initiative, unless the registration is not timely renewed.

According to Section 3 of the Trademarks Act, the IGE will delete a trademark registration from the register if it has been declared null and void by a final judgment.

Enforcement

Complexity

The owner of an infringed trademark may introduce an opposition, a civil action, a criminal action and/or an action before an arbitration court. Provisional injunctions and customs seizures may also be available.

No time limit is indicated in the Trademarks Act for doing so. Normally, after four to eight years the courts may dismiss an action due to limitation. In case of bad faith, there is usually no limitation (Article 6*bis* of the Paris Convention).

In criminal proceedings it is often difficult to present sufficient evidence of intent. In civil actions, the calculation of damages can likewise prove complex. The damages may be calculated on the basis of:

- diminution of the trademark owner's profits;
- dilution of the trademark and confusion of the public;
- costs of enforcement;
- the illegal profit made by the infringer; or
- sometimes, an adequate licence fee.

Punitive damages are not available.The sums awarded are usually low, frequently ranging from Sfr1,000 to Sfr10,000.

The registered trademark owner enjoys a presumption that its rights are valid. The key questions are usually the risk of confusion between the marks at issue and the similarity of the goods and services claimed.

Diluted or weak trademarks (eg, marks with suggestive content such as CHIC for Class 3, ELLE for women's clothing or NEWCARE for care products) enjoy a narrower scope of protection than characteristic marks, well-known marks and trademarks that constitute part of a series of marks.

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In relation to famous trademarks, Article 15 of the Trademarks Act also allows a trademark owner to take action against use in relation to any goods or services if the distinctiveness of its trademark is jeopardised or if its reputation is exploited or affected. The Supreme Court confirmed that the trademark VOGUE in Class 16 was famous and therefore prohibited the use of ‘Vogue’, ‘Vogue Europe’ and ‘Vogue hommes’ as trademarks for watches in Class 14 (Decision 4A_128/2012).

Specialised courts

There are no specialised ordinary trademark courts in Switzerland (in contrast to the Federal Patent Court, which began to operate on January 1 2012), but the Trademarks Act provides that each canton must designate one sole court for civil actions in trademark cases. This is usually the cantonal court or the commercial court. However, while some cantons have commercial courts, depending on the case it may be helpful to choose the right forum for the lawsuit.

Timeframe

Opposition proceedings are generally decided in one to two years. The prevailing party is usually awarded between Sfr1,000 and Sfr2,000 (plus the official fee of Sfr800 if it was the opposing party). Appeals made to the Federal Administration Court are also usually decided within one to two years. The court fees are generally between Sfr2,500 and Sfr5,000.

The opposition proceeding focuses on the risk of confusion between the marks as registered. Use of the challenged trademark, advertisements or coexistence agreements will not be considered. Therefore, even after confirmation by the Federal Administration Court, decisions in opposition proceedings are not final and the dispute may still be brought before the civil courts.

Ownership changes and rights transfers

Swiss trademark applications and registrations may be assigned with or without the goodwill of the business, for all goods and services claimed, or only for specific goods and services. The legal basis for an assignment can be inheritance, a court judgment, a compulsory auction or a written agreement. In order to have an assignment recorded, a deed of assignment is usually submitted to the IGE, but other documentation, such as purchase agreements or evidence of a merger, may also be accepted. Signatures need no notarisation.

Assignments (and licences) of certification marks and collective marks must be recorded; other assignments are directly effective between the parties.

Related rights

Trademark rights can overlap with other rights, particularly copyright, designs, rights in one’s own name, special laws on the protection of geographical indications and unfair competition law.

The Trademarks Act protects against the use of confusingly similar marks in connection with related goods and services (including advertising). Other types of use, such as comparisons with a competitor’s products, imitations of trade dress and denigration, are covered by the Unfair Competition Law. In practice, both acts are often simultaneously invoked.

Online issues

The Trademarks Act and the Unfair Competition Act deal with online issues arising in connection

with trademarks.

The Unfair Competition Act may allow proceedings to be brought against unfair acts (including the use of a trademark in metatags). In addition, several municipalities (Montana, Lucerne, Frick and St Moritz) have successfully challenged domain names that included their geographical names before the civil courts, based on the Unfair Competition Law and their right of name. In a decision of May 4 2009, the Cantonal Court of Grisons confirmed that it had jurisdiction over a '.com' domain name containing a Swiss geographical indication (Decision ZFE 08 3, following Supreme Court Decision 4C.341/2005, March 3 2007).

Disputes over domain names may also be decided and settled by a WIPO panel pursuant to the Rules of Procedure for Dispute Resolution Proceedings for '.ch' and '.li' domain names ('.li' being the top-level domain for Liechtenstein), which have been adopted by SWITCH (the '.ch' and '.li' registry). Pursuant to Paragraph 24(c) of the rules, the panellist shall grant the cancellation request if the registration or use of the domain name constitutes a clear infringement of a right in a distinctive sign that the claimant owns under the law of Switzerland or Liechtenstein. In regard to domain names, rights to a trademark, rights under the Law against Unfair Competition and rights to a name or business name may be invoked. In 2013, 12 decisions were issued in favour of the complainant, whereas only two cases were dismissed. WTR

Examination/registration

Representative requires a power of attorney when filing? Legalised/notarised?	Examination for relative grounds for refusal based on earlier rights?	Non-traditional marks registrable?
No/No	No	3D; acoustic; colour; device; hologram; movement; position.

Unregistered rights

Protection for unregistered rights?	Specific/increased protection for well-known marks?
Yes	Yes

Opposition

Can a registration be removed for non-use? Term and start date?
Yes: three months.

Removal from register

Can a registration be removed for non-use? Term and start date?	Are proceedings available to remove a mark that has become generic?	Are proceedings available to remove a mark that was incorrectly registered?
Yes: five years after lapse of opposition term or decision of opposition proceedings.	Yes	Yes

Enforcement

Specialist IP/trademark court?	Punitive damages available?	Interim injunctions available? Time limit?
No	No	Yes/No: but delay lessens chance of success.

Ownership changes

Mandatory registration for assignment/licensing documents?
No

Online issues

National anti-cybersquatting provisions?	National alternative dispute resolution policy (DRP) for local ccTLD available?
No	Yes: SWITCH.ch Policy.

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J David Meisser founded Meisser & Partners in 1979, a full-service law firm that has specialised in international trademark protection and litigation. Dr Meisser graduated from the University of Zurich as a doctor of law and was admitted to the Bar in 1976. He is a member of honour, as former editor-in-chief, of the International Association for the Protection of Intellectual Property, and has written extensively on IP issues, including a comprehensive commentary on the Swiss and international law of geographical indications. He also contributes regularly to *World Trademark Review* Daily.



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Marco Bundi studied law in Zurich. He was admitted to the Bar in Switzerland in 2005 and subsequently became a member of the Swiss Bar Association. After practising law before the cantonal courts, he obtained his LLM degree at the University of Bern. He joined Meisser & Partners in 2006, after having worked for the United Nations at the Special Court in Sierra Leone. Up to now, he has written several articles on various aspects of trademark law; he is also a regular contributor to *World Trademark Review* Daily. He graduated in 2008 from the University of Berne as a doctor of law. His practice includes enforcement of IP rights, domain disputes, protection against unfair competition and copyrights and managing trademark proceedings before national authorities and courts.