



Authors

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Legal framework

National legislation

The following national legislation is relevant for the protection of designs in Switzerland:

- the Designs Act 2001;
- the Designs Ordinance 2002;
- the Unfair Competition Act 1986;
- the Copyright Act 1992; and
- the Trademarks Act 1992.

International legislation

Switzerland is a signatory to the following relevant international treaties:

- the Locarno Agreement 1968 (as amended);
- the Hague Agreement 1925 (as amended), the Geneva Act of the Hague Agreement 1999 and common regulations under these acts;
- the Paris Convention; and
- the Agreement on Trade-Related Aspects of IP Rights.

System

Switzerland provides design protection for configurations of products or parts of products characterised by an arrangement of lines, surfaces, contours or colours or by the materials used (Article 1 of the Designs Act). Design protection requires registration, which can be obtained by applying for either a national design to the Federal Institute of Intellectual Property or an international design under the Hague Agreements designating Switzerland to the World Intellectual Property Organisation (WIPO). The scope of protection and the remedies available are the same regardless of whether the application is filed nationally or internationally (Article 29).

A design right exists once the design is entered in the Designs Register (Article 5). It is valid for five years from the date of filing, which may be extended for four further five-year periods (Articles 5(2) and (3)).

Unregistered designs

Swiss legislation provides no specific protection for unregistered designs. However, an unregistered design may be protected under

the Copyright Act or the Trademarks Act. Further, although Swiss unfair competition law is based on the principle that copying is generally allowed if no IP right is infringed, the Unfair Competition Act may provide protection for designs.

According to Article 3(1)(d) of the act, anyone who takes measures that may cause confusion with the goods, works or business of another is deemed to act unfairly. The item being copied must be distinctive. In most cases, it will be necessary to prove acquired distinctiveness through use. In practice, if the products in question are labelled with clearly different and visible trademarks, the courts tend to reject the likelihood of confusion, even if the products are very similar.

Under Article 2, it is unlawful to exploit the good reputation of a competitor's product if the following exist:

- a reputation of quality connected to the original design;
- an image transfer to the copy; and
- an element of unfairness (which can lie in a systematic approach – for example, if multiple products are copied, copying happens repeatedly and/or further copying is planned).

Article 3(1)(e), which prohibits wrong, misleading, unnecessarily disparaging or parasitic comparisons of products in advertisements, may also be relevant. The mere making public of a product or trade dress may fall under this provision, but the threshold is high.

Registered designs

Ownership

A design right belongs to the first person to file (Article 6 of the Designs Act). However, the priority date may be that of the first filing of the same design in another signatory state to the Paris Convention, provided that the filing in Switzerland takes place within six months of the first filing date (Article 22).

The person entitled to file the design is the creator of the design or his or her successor in title (Article 7(1)). For designs created by an employee during and in performance of an employment contract, the employer has the right to file (Article 332(1) of the Code of Obligations). The applicant can be an individual

or a company; if several people created the design together, they can file jointly (Article 7(2) of the act). Joint ownership can be established even after registration of the design.

Requirements for protection

To be protected, a design must be new and original (Article 2(1) of the Designs Act).

Protection is excluded if:

- the filed item is not a design within the meaning of Article 1;
- the features of the design are dictated solely by technical function;
- the design infringes federal law or international treaties; or
- the design is contrary to public policy or accepted principles of morality (Article 4).

A design lacks originality if its overall impression differs only in minor characteristics from another design that could be known to those active in the relevant field in Switzerland (Article 2(3)). This is done as a design-by-design comparison, not using a mosaic of prior art combining features from different designs.

The novelty and originality of a registered design can be destroyed by prior disclosure, even by the creator or rights holder. However, Article 3 provides for a 12-month grace period after disclosure for the rights holder to file the application. In addition, Article 3(d) provides that disclosure by a third party within the grace period is no obstacle to registration if the disclosure was abusive and to the detriment of the rights holder.

Effects of design registration

A design right enables the rights holder to prevent others from using the design for industrial purposes. This includes manufacturing, storing, offering, putting on the market, importing, exporting and use in transit, as well as possessing products for such purposes (Article 9(1)) or participating in such unauthorised acts (Article 9(2)).

Limitations

If a design right is exhausted, it can no longer be enforced. The Designs Act does not state whether national or international exhaustion applies, but the prevailing opinion supports international exhaustion.

Article 12 of the act provides for a right of continued use. Accordingly, the rights holder may not prevent third parties from continuing their previous use of a design to the extent that it was used in good faith in Switzerland before the filing or priority date or during the deferred publication period. In addition, Article 13 provides for a right of parallel use for persons who have used the design commercially in good faith or have taken steps in preparation for that purpose in Switzerland between the last day of the period for payment of a renewal fee and the day on which an application for further treatment according to Article 31 of the act is received. Such right of parallel use is subject to the payment of adequate remuneration to the rights holder.

The rights holder cannot enforce its rights against a person who uses the design only for private purposes. However, design rights can be invoked against private imports and exports of counterfeit products that were commercially produced.

Scope of protection

According to Article 8 of the Designs Act, the scope of protection includes designs that have the same material characteristics and thus produce the same overall impression as the registered design. The overall look and feel of the products is relevant. According to the Federal Supreme Court, such comparison is made on the basis of the short-term memory of the average consumer. The court compares what the designs have in common, rather than looking for differences. The potentially infringing object must be compared to the representation of the design in the register, not as actually used.

Costs

The fees for national registrations and renewals are as follows:

- Basic fee for one design – Sfr200.
- Basic fee for each further design in the same application – Sfr100, up to a maximum of Sfr700.
- Publication fee for each representation to be published (excluding the first representation, which is included in the basic fee) – Sfr20.
- Renewal fees – same as filing fees, plus Sfr50

if the renewal fee is paid after expiry of the protection period.

Fees for international applications and renewals designating Switzerland are available on the WIPO website.

Procedures

Application process

The applicant may file the application itself or through a representative. In the case of joint applicants, the institute requires one joint representative (Article 4 of the Designs Ordinance). It may require a power of attorney (Article 5). If the applicant does not have a seat in Switzerland, it must appoint a domicile in Switzerland (Article 18 of the Designs Act). The application may be filed either electronically or by ordinary mail.

Switzerland allows for the collective filing of various designs, provided that they belong to the same product class under the Locarno Agreement (Article 20 of the act). The number of designs covered by a collective filing is unlimited, but the application (including representations) may not exceed 5 kilograms or 30 centimetres in any direction (Article 10 of the ordinance).

The applicant may request that publication be deferred for up to 30 months from the filing or priority date (Article 26 of the act). In such case, the institute will keep the registered design secret until expiry of the deferral period. If the application is withdrawn before expiry of the deferral period, secrecy will be maintained indefinitely. During the period of deferral, the rights holder may request immediate publication at any time.

Examination

The institute conducts a formal examination (Article 15 of the ordinance) and a limited examination on substantive grounds to assess only whether the design qualifies as a design in terms of Article 1 of the act and whether it infringes the law or is contrary to public policy or to accepted principles of morality (Article 16 of the ordinance). The institute does not examine whether the design is new and original.

Registration

The examination usually takes only a few days. If there are no grounds for refusal, the institute will

register the design and will publish it unless the applicant has requested deferral of publication.

Renewals

The registration must be renewed every five years. The request for renewal can be made within the 12 months preceding the end of a protection period, and no later than six months after protection has expired (Article 21(1) of the ordinance). The renewal fee must be paid within the same timeframe. Usually, the institute sends a reminder before the expiry of protection.

Removal from register

Under Article 28 of the act, the institute will remove a registration from the register in the following cases:

- at the request of the rights holder;
- for non-renewal;
- for non-payment of prescribed fees;
- upon a final court decision declaring the registration invalid;
- upon expiry of the maximum protection period; or
- where no representations are submitted in connection with a deferred publication (Article 34(3)(c) of the ordinance).

Enforcement

Civil action

The owner of a registered design has the following causes of action against infringers:

- an action for a declaratory judgment (Article 33 of the Designs Act);
- an action for an injunction against imminent infringement (Article 35(1)(a));
- an action to eradicate an existing infringement (Article 35(1)(b));
- an action for an order to state the origin and number of unlawfully produced goods in the defendant's possession and the number of goods passed on to commercial customers (Article 35(1)(c));
- an action for compensation of damages (Article 35(2));
- an action for reparation (Article 35(2));
- an action for accounts of profits (Article 35(2));
- an action for confiscation (Article 36); and
- an action for publication of the judgment (Article 39).

Further, anyone who claims a better right to

a design may bring an action against the rights holder for assignment of the right (Article 34).

In practice, actions for injunction are more frequent than actions for financial redress. This is mainly because the Swiss courts are not very generous in granting financial redress.

One court per canton is competent for design right disputes, and decisions may be appealed to the Federal Supreme Court. Generally, proceedings before the first-instance court take one to two years. The rights holder may request preliminary measures (*ex parte* in urgent cases).

Border measures

The rights holder may file a written request with Customs to refuse the release of potentially infringing goods for import, export or transit. This may be combined with a request to destroy the infringing goods (Article 48c of the act). The rights holder must show specific grounds for believing that the goods were unlawfully produced (Article 47(1)). Customs will retain the goods for up to 10 working days so that the requesting party can obtain interim relief (Article 48(2)). The rights holder may request samples in order to examine the products (Article 48a).

Criminal penalties

Any person who intentionally infringes a design by using the design unlawfully or participating in such use can be sentenced to imprisonment for up to one year or a fine of up to Sfr100,000 (Article 41). For infringing acts with a commercial purpose, the sentence may be up to five years in prison. The criminal authorities can confiscate the infringing goods (Article 44).

Ownership changes and rights transfers

Assignments

A design right can be transferred in whole or in part (Article 14(1)). The contractual obligation to transfer a design right need not meet any formal requirements. However, to be effective, the transfer itself must be in writing. Recordal is not required, but the assignment will be effective against third parties in good faith only once it is entered in the register (Articles 14(2) and (3)). A request for recordal must contain a declaration of the former rights holder or another document showing that the design

right has been transferred, as well as the name and address of the acquirer and its Swiss domicile for service (Article 27 of the Designs Ordinance).

Licences

Design rights may be licensed either exclusively or non-exclusively (Article 15(1) of the act). There are no formal requirements for a licence. The licence can be recorded in the register, in which case it will be enforceable against any subsequently acquired right in the design (Article 15(2)).

Exclusive licensees can bring actions against infringers, provided that this is not expressly excluded by the licence agreement, but non-exclusive licensees cannot. All licensees may intervene in an action for infringement in order to claim for damages that they have suffered (Article 35(4)).

Usufruct and pledge

Design rights may be the subject of a usufruct or pledge. The usufruct or pledge may be asserted only against good-faith acquirers and licensees of the design right once recorded in the register (Article 16).

Related rights

There may be an overlap between design rights and other rights. The Federal Supreme Court has explicitly denied any hierarchy of IP rights.

Trademarks

If a design is capable of distinguishing goods or services, it can be protected and registered as a trademark under Article 1 of the Trademarks Act. The design element to be protected must not constitute the essential nature of the goods; and the product shape or packaging must not be technically necessary (Articles 2(a) and (b)). Further, the design must have inherent or acquired distinctiveness.

Copyright

Article 2(2)(f) of the Copyright Act provides for the protection of works of applied art. To be protected under the act, a design must have individual character – in practice, the Swiss courts rarely find this to be the case for industrial designs. The infringing design need not be identical, but merely recognisable in the

older copyright-protected work (Article 3(1)). It is unclear whether copyright infringement requires the infringer to have knowledge of the protected work, but the prevailing opinion is that no knowledge is required.

Patents

Purely aesthetic designs are not patentable, as they lack technical effect. However, a mixture of technical and non-technical features may be patentable. Article 4(c) of the Designs Act excludes from protection features that have an exclusively technical function; however, cumulative protection is available in cases of combinations. [WTR](#)

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Chambers Europe regularly ranks him as a leader in the field of intellectual property. In *Legal 500 2012*, he was recommended as "a great strategist with a no-nonsense approach".