

Yearbook

2019/2020

A global guide for practitioners

Switzerland

Meisser & Partners AG

Marco Bundi and Benedikt Schmidt

WTR

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We are a team of a dozen professionals (attorneys at law, paralegals, secretaries) fully specialised in trademarks work and related areas.

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Legal framework

National

The basic principles for trademark protection in Switzerland are contained in the Federal Act on the Protection of Trademarks and Indications of Source and the Trademark Protection Ordinance. The latest revisions of the act regarding 'Swissness', providing administrative trademark cancellation proceedings on the grounds of non-use and better protection for Swiss geographical indications, as well as establishing a register for geographical indications for non-agricultural products and a register for geographical marks, entered into force on 1 January 2017.

International

Switzerland has signed most pertinent international agreements, including:

- the Paris Convention for the Protection of Industrial Property;
- the Madrid Agreement on the International Registration of Marks and the Madrid Protocol;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights;

- the Nice Agreement on the International Classification of Goods and Services; and
- the Trademark Law Treaty.

Unregistered marks

Generally, trademark rights are established through entry in the trademark register.

Well-known unregistered trademarks may enjoy protection under Article 6*bis* of the Paris Convention.

The use of unregistered signs may, in individual cases, be protected:

- by the Federal Act against Unfair Competition;
- as moral rights to a name;
- as foreign trade names under the Paris Convention;
- as geographical indications; and
- by the Federal Act on Copyright and Related Rights.

The Federal Act on the Protection of Trademarks and Indications of Source provides the right to continue using a sign to the same extent if a third party subsequently registers an identical or similar mark.

Registered marks

Any natural or legal person can apply for trademark registration in Switzerland (restrictions apply to geographical marks). Foreign applicants must indicate a service address for use in Switzerland. There is no requirement of use or intent to use for filing an application. The current fee is Sfr550 for filing an application in up to three classes. Multi-class applications are available.

Registrability

All signs that are capable of distinguishing the goods and services of one undertaking from those of another are registrable. Provided that they can be represented graphically, marks may be any kind of sign, including:

- words, letters and numerals;
- figurative representations;
- three-dimensional (3D) shapes;
- colours;
- sounds;
- motion marks;
- holograms;
- positions;
- combinations of the above; or
- other non-traditional marks (eg, smell marks).

The Federal Administrative Court has accepted smell marks in principle, but denied protection in a particular case due to a lack of graphical representability.

The Federal Act on the Protection of Trademarks and Indications of Source differentiates between individual, certification, collective and geographical marks.

Article 2 of the act excludes from registration signs that are:

- in the public domain, unless they have acquired secondary meaning;
- shapes constituting the nature of the goods or shapes of the goods or their packaging that are technically necessary;
- misleading; or
- contrary to public policy, morality or applicable law.

The relevant languages for examination are the official languages (French, German, Italian and Rhaeto-Romanic) and basic English, which is considered to be known by the average consumer.

Public domain: Signs that are in the public domain are signs that lack distinctiveness or must be kept free for trade. Signs that lack distinctiveness include:

- single numerals or single letters of the Latin alphabet; however, a single letter may gain secondary meaning if there is no indispensable need to keep it free for trade;
- simple geometrical signs (eg, circles and rectangles);
- descriptive signs – including words, images, slogans or pictograms that describe the quality, quantity, purpose, effect, content, get-up, addressee, geographical origin or other characteristics of the goods or services – for example: KEYTRADER in Class 36; MUFFIN KING in Class 30; NOBLEWOOD in Classes 2, 19 and 27; VIAGGIO in Class 12; COOL ACTION in Class 3; JAZZ in Class 9; GOLD BAND in Class 34; OKTOBERFEST-BIER in Class 32; VERY IMPORTANT PHARMACY in Classes 3, 5 and 44; HYDE PARK in Classes 12 and 28; and SIBIRICA in Classes 10, 20 and 24 (direct geographical indications are registrable if they are



The Federal Administrative Court has accepted smell marks in principle, but denied protection in a particular case due to a lack of graphical representability

registered in the country of origin, provided that the goods and services are limited to said origin); and a red sole for women's shoes (position mark).

- general indications of quality or purely promotional signs (eg, SUPER, MASTER, MASTERPIECE, TOP and ROYAL);
- common or banal signs (eg, ENTERPRISE and NETTO), references to a company form (eg, Ltd), country-code top-level domains and generic top-level domains (eg, '.com' and '.ch'), telephone numbers (eg, 0800) and international non-proprietary names;
- abstract colours are typically considered as aesthetic features and should be kept free for trade (they can acquire secondary meaning if there is no indispensable need to keep them free for trade); and
- common shapes that are expected and used and therefore being banal shapes in the relevant sector – such forms can be registered as 3D marks in case they are combined with distinctive two-dimensional elements that significantly affect the overall impression.

Names of persons and characters may be registered, unless they are frequently cited to describe the goods or services or must be kept free for trade (eg, MOZART in Class 9 and RAPUNZEL in Classes 9, 14, 16, 20, 21, 28 and 41).

A trademark may consist of distinctive and non-distinctive elements and is registrable if one significant element is distinctive.

Disclaimers are neither required nor permissible for non-distinctive elements.

Signs that must be kept free for trade are those which are indispensable to that trade (eg, the colour blue for beverages, POST for postal and MARCHÉ for restaurant and food services). Signs that are not absolutely indispensable for trade but initially lack distinctiveness may acquire secondary meaning and be registered on evidence of extensive use in Switzerland. The Federal Institute of Intellectual Property (IPI) typically requires proof of use over several years (usually 10 years) in all Swiss territories (French, Italian and German speaking parts) as a trademark (eg, not as a company name), in relation to the designated goods or services and to a

significant extent. Documents or surveys are accepted as evidence.

Shape marks: Shape marks that are 3D signs additionally applied to goods (ie, the star on Mercedes-Benz cars) are examined by the IPI based on whether they are in the public domain. However, shape marks that represent the shape of the goods or their packaging cannot be registered if they are in the public domain, if their features correspond to the nature of the goods (eg, a ring) or which are determined by technical necessities. Such shapes cannot acquire secondary meaning.

Misleading signs: A trademark is misleading if it creates expectations that are not fulfilled by the goods or services marked (eg, CAFÉ for coffee substitutes). The most relevant cases in this field are geographical indications that mislead as to the origin of the designated goods or services. The IPI is strict when it comes to geographical indications and holds that a sign consisting of or containing a geographical term evokes the expectation that the designated goods originate in that location. This presumption is rebuttable if:

- the place is unknown;
- the sign has a clear and direct symbolic meaning;
- the place is obviously unsuitable for production or commerce of the goods claimed;
- the sign is a designation of type;
- the sign has acquired secondary meaning;
- the sign has degenerated into a denomination of a genus (eg, Hamburger for food products); or
- the overall impression does not evoke the expectation of any geographical origin (eg, the geographical term in the mark rather refers to the point of sale, the place of an event, the content or the owner of the mark – DEUTSCHER FUSSBALL-BUND in Class 29 and THE HARLEM GOSPEL SINGERS in Class 25).

Applications for marks that evoke a geographical origin may still be registered if the goods or services are restricted to the

respective origin (eg, AFRI-COLA for African beverages). A foreign indication should meet the statutory requirements of the country concerned, subject to misleading Swiss consumers. A Swiss indication is considered being of Swiss origin if:

- products are grown and harvested in Switzerland (natural products);
- 80% of the raw material weight is of Swiss origin and the processing step that gives the product its essential characteristics is carried out in Switzerland (foodstuffs); or
- 60% of the manufacturing costs are accumulated in Switzerland and the processing step that gives the product its essential characteristics is carried out in Switzerland (industrial products).

Public policy: Signs against public policy or morality include racist, religiously hostile or sexually offensive signs or names of prominent individuals (without their consent) (eg, BUDDHA BAR in Classes 9 and 41; MADONNA in various classes and MINDFUCK in Classes 21, 25, 35 and 41). Signs against applicable law include those containing protected names, coats of arms and emblems (Swiss national legislation goes beyond Article 6^{ter} of the Paris Convention) and any other signs that are prohibited by law (eg, 'mild' for tobacco products).

Geographical marks: The new law established a register for geographical indications for non-agricultural products and a register



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Marco Bundi studied law in Zurich. He was admitted to the Bar in 2005 and subsequently joined the Swiss Bar Association. He practised law before the cantonal courts before obtaining his LLM (University of Bern). He joined Meisser & Partners AG in 2006, after working at the UN Special Court in Sierra Leone. He writes on various aspects of trademark law and regularly contributes to the *World Trademark Review*.

He obtained his doctorate from the University of Bern in 2008 and became a notary public in 2014. His practice covers IP rights enforcement, including domain disputes, unfair competition issues (including counterfeiting and passing off) and proceedings before national authorities and courts. He became a partner in 2012.



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Mr Schmidt has written several articles on various aspects of trademark law. His practice includes counselling on registrability and enforcement of IP rights – mainly trademarks, design patents and copyrights – including anti-counterfeiting, customs measures, domain disputes and protection against unfair competition. He is a member of the Swiss Bar Association, INGRES, the International Trademark Association and the Pharmaceutical Trademarks Group.



A geographical mark is not vulnerable in case of non-use; it cannot be licensed or transferred, and no opposition based on a geographical mark can be filed

for geographical marks. It is now possible to register geographical indications (both agricultural and non-agricultural), wine designations recognised by the cantons and indications of source that are the subject of a Federal Council ordinance (eg, for watches) as geographical marks. The applicant of a geographical mark must be a representative group and must file regulations governing the use of the mark. Anyone who fulfils the conditions is entitled to use the geographical mark. A geographical mark is not vulnerable in case of non-use; it cannot be licensed or transferred, and no opposition based on a geographical mark can be filed.

Maintenance

Declarations or evidence of use need not be submitted to the IPI in order to maintain a trademark registration. Trademarks that are not used for an uninterrupted five-year period (starting from the expiry of the opposition period for national marks, the declaration of grant of protection for international marks or a final decision in case of a refusal or opposition) may be challenged on the grounds of non-use before the IPI or civil courts, unless proper reasons for non-use exist. Non-use may be invoked by the defendant in opposition proceedings and before civil courts.

If use of the trademark is commenced or resumed after more than five years, the right to the trademark is restored with effect from the original priority date, unless non-use has been invoked prior to the commencement or resumption of use.

Generally, the trademark must be used as registered. However, minor variations are permissible in order to prove genuine use, as long as the distinctive core of the mark is

maintained. Omitting (distinctive) elements is generally more critical than adding. The decision in *P&C* highlights the importance of carefully examining the use, as the mark as used was found to be different (FAC B-6251/2013 – P&C).

Procedures

Examination

The IPI examines applications on absolute grounds only. Relative grounds may be raised by holders of earlier rights within opposition or civil proceedings. The timeframe from application to examination or registration is usually 10 days to six months. Accelerated examination can be requested for Sfr400. The IPI will then examine the application within four weeks. Swiss trademark applications (unlike international applications designating Switzerland) may be amended during the application process. However, in case of significant amendments, the application date will shift to the date on which the amendments were filed. IPI decisions can be appealed to the Federal Administrative Court and thereafter to the Supreme Court.

Opposition

Oppositions to a registration may be filed by the owners of:

- prior Swiss national trademark applications or registrations;
- prior international registrations designating Switzerland; and
- trademarks that are well known in Switzerland under Article 6bis of the Paris Convention.

The non-extendable three-month opposition period starts from the registration and

publication date (for national registrations) or the first day of the month following publication in the *World Intellectual Property Organisation Gazette* (for international registrations). The official fee is Sfr800. Compensation awarded to the prevailing party will be between Sfr1,200 and Sfr2,400. If use of the prior mark is not challenged, proceedings usually take one to two years. IPI opposition decisions can be appealed to the Federal Administrative Court, whose decision is final.

Registration and duration

The trademark is protected as of the application date for a 10-year period and can be renewed for further 10-year periods. The renewal fees are Sfr700, irrespective of the number of classes. A six-month grace period exists for late renewal (against an additional Sfr50 fee).

The use of the ® symbol is not mandatory. Its use for a mark that is not registered may be considered as an act of unfair competition.

Removal from register

The IPI may not cancel registered trademarks *ex officio*. Third parties may particularly request removal based on absolute or relative grounds, abusive registration or non-use before civil courts. As of 1 January 2017, it is possible to request cancellation before the IPI due to non-use through a simplified administrative proceeding. The requesting party must show *prima facie* evidence of non-use, while the owner of the mark must provide *prima facie* evidence of use. An in-use search provided by a service provider may be considered as sufficient evidence before the IPI. The official fee for administrative proceedings is Sfr800. Party compensation is between Sfr1,200 and Sfr2,400, plus compensation of expenses for in-use searches may be awarded to the prevailing party.

Enforcement

Grounds of infringement and proceedings

The owner of an earlier mark may prohibit others from using an identical or similar mark for identical or similar goods and services in case likelihood of confusion results. The scope of protection covers any use of the mark as a distinctive sign in the course of trade,

including in import, export or transit (eg, as company or domain name). The owner of an earlier mark may particularly introduce an opposition, civil action, criminal action and/or customs measures. Preliminary measures are available.

The Federal Act on the Protection of Trademarks and Indications of Source indicates no time limit for civil actions. Generally, after four to eight years, the civil courts may dismiss an action due to forfeiture. In case of bad faith, there is usually no forfeiture. Provisional injunctions should be brought before the court within approximately four months. Criminal complaints must be submitted within three months after the offender has become known. If the offender acts for commercial gain, he or she will be prosecuted *ex officio*.

As a general rule, the burden of proof lies with the party deriving rights from an alleged fact. This party bears the consequences of lack of evidence. The registered trademark owner enjoys a presumption that its rights are valid. In criminal proceedings it is often difficult to present sufficient evidence of wilful infringement. In civil actions, the calculation of damages can likewise prove complex. Punitive damages are unavailable.

A key question is usually whether there is likelihood of confusion in the relevant trade circles. The main factors for likelihood of confusion are the similarity of signs, the similarity of goods and services and the distinctiveness of the earlier mark. Weak or diluted trademarks or trademark elements (eg, CHIC for Class 3; ELLE for women's clothing; FM for broadcasting; or NEWCARE for care products) enjoy a narrower scope of protection, while well-known marks enjoy a broader scope.

Article 15 of the act also allows a rights holder of a famous trademark to take action against use in relation to any goods or services if the distinctiveness of its trademark is jeopardised (dilution) or its reputation is exploited or affected.

Customs may suspend the import, export or transit of suspicious goods *ex officio* or on application. The applicant must then obtain preliminary measures before the court. Simplified proceedings are available. For



In criminal proceedings it is often difficult to present sufficient evidence of wilful infringement. In civil actions, the calculation of damages can likewise prove complex

example, the consent of the declarant, holder or owner is deemed to be given if it does not expressly object to destruction.

Defences and remedies

Defences may include:

- no likelihood of confusion or non-infringement;
- earlier mark is void or not enforceable due to non-use;
- prior rights or prior use and the right to continued use;
- private, non-commercial use (however, private import, export or transit can be stopped);
- fair (ie, descriptive/informative/decorative) use;
- exhaustion of rights; and
- forfeiture.

Remedies may include:

- securing evidence;
- injunctions or prohibition and remedy;
- declaratory judgment;
- assignment of a mark;
- disclosure of information to the origin and quantity of goods;
- damages/redress/surrender of profits;
- publication of judgment;
- destruction of infringing goods;
- criminal penalties (eg, imprisonment or fine); and
- customs measures.

Specialised courts

No specialised trademark courts exist in Switzerland, but civil cases are judged by the higher cantonal or commercial courts. Decisions of these first-instance courts can be appealed to the Supreme Court.

Ownership changes and rights transfers

Swiss trademark applications and registrations may be totally or partially assigned (except geographical marks). The assignment must be in writing and usually includes goodwill. The recordal in the register is not constitutive, but a recorded assignment is effective towards third parties acting in good faith.

Licences may be recorded in the register, but such recordal is not mandatory (except for collective marks). The recordal may be in the interest of the licensee, since the licence becomes binding on any rights to the trademark subsequently acquired. Use by a licensee is attributed to the owner in case a valid licence can be shown.

Security interests in trademarks are possible. While the recordal in the register is not constitutive, only recorded rights have effect against third parties acting in good faith.

Related rights

Trademark rights can overlap with other rights, particularly copyrights, designs, moral rights (eg, rights in one's own name), rights to a company name and rights under geographical indications and unfair competition laws.

The Federal Act on the Protection of Trademarks and Indications of Source protects owners against the use of confusingly similar marks in connection with similar goods or services as an identifier of commercial origin. Other types of use (eg, comparisons with a competitor's products, imitations of trade dress or denigration) may be pursued under the Unfair Competition Act, the Design Protection Act if there is a registered design or the Copyright Act if the mark qualifies as an artwork under

the act. In practice, these acts are often invoked simultaneously.

Online issues

Generally, all laws apply in virtual life as they do in real life. The Federal Act on the Protection of Trademarks and Indications of Source, the Unfair Competition Act and laws on the protection of moral rights and company names typically apply in online trademark issues. Although trademark infringement may be established only where a website involves similar goods or services, other laws may apply in case of an inactive site or a site offering dissimilar goods or services.

The Unfair Competition Act may allow proceedings against unfair behaviour, including hindering and blocking, unnecessary imitation and exploitation of reputation or creation of a risk of confusion. In addition, several municipalities (ie, 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 Act and their right to a name.

Disputes over domain names may also be decided by a World Intellectual Property

Organisation panel under 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). Under Paragraph 24(c) of the rules, the panellist will grant a 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. **WTR**



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Examination/registration

Representative requires a power of attorney when filing? Legalised/notarised?

No



Examination for relative grounds for refusal based on earlier rights?

No



Non-traditional marks registrable?

3D; colours; sounds; motion marks; holograms; and positions.



Unregistered rights

Protection for unregistered rights?

Yes



Specific/increased protection for well-known marks?

Yes



Opposition

Opposition procedure available? Term from publication?

Yes: three months.



Removal from register

Can a registration be removed for non-use? Term and start date?

Yes: five years after expiry of opposition period/declaration of grant of protection or final decision.

Are proceedings available to remove a mark that has become generic?

Yes



Are proceedings available to remove a mark that was incorrectly registered?

Yes



Enforcement

Specialist IP/trademark court?

No



Punitive damages available?

No



Interim injunctions available? Time limit?

Yes: approximately four months.



Ownership changes

Is registration mandatory for assignment/ licensing documents?

No



Online issues

National anti-cybersquatting provisions?

No



National alternative dispute resolution policy (DRP) for local ccTLD available?

Yes

