



ICLG

The International Comparative Legal Guide to:

Trade Marks 2013

2nd Edition

A practical cross-border insight into trade mark work

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General Chapters:

1	The Race for “Modernity” in Shaping Trade Mark Policy Around the World – 2012 Developments - John Olsen, Edwards Wildman	1
2	Admissibility of Trade Mark Revocation Actions: Discrepancies Between the European and the French Approaches - Frank Valentin, De Gaulle Fleurance & Associés	4

Country Question and Answer Chapters:

3	Albania	Boga & Associates: Renata Leka & Ened Topi	9
4	Australia	Gilbert + Tobin: Lisa Lennon & Lauren Eade	17
5	Austria	Hausmaninger Kletter Attorneys-at-Law: Dr. Leonhard Reis	26
6	Belgium	Baker & McKenzie: Pierre Sculier & Elisabeth Dehareng	34
7	Brazil	Kasznar Leonardos Intellectual Property: Filipe da Cunha Leonardos & Claudio Roberto Barbosa	44
8	Canada	Bereskin & Parr LLP: Daniel R. Bereskin, Q.C. & Cynthia Rowden	54
9	Chile	Beuchat, Barros & Pfenninger: Andrés Melossi	61
10	China	CCPIT Patent and Trademark Law Office: Chumeng (Jessica) Xu	68
11	Cyprus	Papacharalambous & Angelides L.L.C: Eleni Papacharalambous & Coralia Papacharalambous	76
12	Czech Republic	Johnson Šťastný Kramář, advokátní kancelář, s.r.o.: Roman Šťastný & Eva Haisová	84
13	Ecuador	Quevedo & Ponce: Alejandro Ponce Martínez & Roque Albuja Izurieta	93
14	European Union	Bristows: Paul Walsh & David Kemp	99
15	France	Armengaud & Guerlain: Catherine Mateu	107
16	Germany	Hengeler Mueller: Dr. Wolfgang Kellenter & Dr. Andrea Schlaffge	115
17	Greece	Law Offices of Patrinos & Kilimiris: Maria Kilimiris & Manolis Metaxakis	123
18	Hong Kong	Ella Cheong (Hong Kong & Beijing) Limited: Coral Toh & Vincent Oey	131
19	Hungary	Danubia Patent & Law Office: Michael Lantos	139
20	India	Subramaniam, Nataraj & Associates, Patent & Trademark Attorneys: Hari Subramaniam	145
21	Italy	Avvocati Associati Franzosi Dal Negro Setti: Vincenzo Jandoli & Dario Palmas	153
22	Japan	Anderson Mori & Tomotsune: Yasufumi Shiroyama & Ai Nagaoka	161
23	Kosovo	Boga & Associates: Renata Leka & Ened Topi	168
24	Luxembourg	Loyens & Loeff, avocats à la Cour: Véronique Hoffeld	175
25	Macedonia	Pepeljugoski Law Office: Professor Dr. Valentin Pepeljugoski & Ana Pepeljugoska	183
26	Malaysia	Tay & Partners: Su Siew Ling & Joanne Kong	193
27	Mexico	Olivares & Cia.: Alonso Camargo & Daniel Sanchez	202
28	Nigeria	Banwo & Ighodalo: Femi Olubanwo & Chinasa Uwanna	210
29	Philippines	SyCip Salazar Hernandez & Gatmaitan Law Offices: Vida M. Panganiban-Alindogan & Enrique T. Manuel	218
30	Portugal	Abreu Advogados: João Veiga Gomes & João Gonçalves Assunção	226
31	South Africa	DM Kisch Inc.: Andrew Papadopoulos & Derek Momberg	236
32	Spain	ELZABURU: Fernando Ilardia & Luis Baz	243
33	Switzerland	ThomannFischer: Daniel Plüss	253
34	Taiwan	TIPLo Attorneys-at-Law: J. K. Lin & H. G. Chen	260
35	Ukraine	Vasil Kisil & Partners: Oleksandr Mamunya & Yulia Chyzhova	270
36	UAE	Abu Ghazaleh Intellectual Property (AGIP): Amjad El Husseini & Karim El Gebaily	278
37	United Kingdom	Bristows: Paul Walsh & David Kemp	285
38	USA	Edwards Wildman: David I. Greenbaum & H. Straat Tenney	294
39	Vietnam	Pham & Associates: Pham Vu Khanh Toan	301

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Switzerland

ThomannFischer

Daniel Plüss



1 Relevant Authorities and Legislation

1.1 What is the relevant Swiss trade mark authority?

The Federal Institute for Intellectual Property (“FIIP”) is the relevant authority.

1.2 What is the relevant Swiss trade mark legislation?

The relevant legislation is:

- Federal Act on the Protection of Trademarks and Indications of Source of 28 August 1992 (“Trademark Act”).
- Ordinance on Trademarks of 23 December 1992.

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

A trade mark is a sign capable of distinguishing the goods or services of one undertaking from those of other undertakings. It may consist, in particular, of words, letters, numerals, graphic representations, three-dimensional shapes or combinations of such elements with each other or with colours.

If they pass the criteria named above, other non-traditional marks such as musical jingles, colours, smells, moving images, or holograms may be registered.

2.2 What cannot be registered as a trade mark?

Signs that are not in conformity with the absolute grounds for refusal cannot be registered. See the answer to question 3.1.

2.3 What information is needed to register a trade mark?

The following information is needed:

- A graphical representation of the mark.
- Details of the goods and services for which protection is claimed.
- If priority is claimed, the details given in the answer to question 2.14 must be provided.
- Name, address and signature of the applicant and his representative if one has been engaged.

2.4 What is the general procedure for trade mark registration?

The FIIP first confirms the receipt of the application. Once the application fee has been paid, it verifies that the application meets the formal requirements and proceeds to examine it under the absolute grounds for refusal (see question 3.1). If the application is found to be in compliance with the law, it is entered into the register and published. A confirmation of registration is issued to the owner. If the FIIP finds absolute grounds for refusal, an objection is issued; where it cannot be overcome, the application is refused (see question 3.2).

2.5 How can a trade mark be adequately graphically represented?

An adequate graphical representation is self-contained, unambiguous, easily accessible, intelligible, durable and objective. For verbal trade marks, it is sufficient to write the printed characters in the application, while for design trade marks, a reproduction conforming to the FIIP’s specifications must be included in the application.

Where this is warranted, the graphical representation must be complemented by a colour claim and, in the case of acoustic and non-traditional marks, with a description of the trade mark type.

2.6 How are goods and services described?

Goods and services are classified according to the Nice Classification system. It is possible to use class headings, and this will be considered as a claim to all goods and services that may be assigned to the headings.

2.7 What territories (including dependents, colonies, etc.) are or can be covered by a Swiss trade mark?

The trade mark is valid in Switzerland.

2.8 Who can own a Swiss trade mark?

Any natural or legal person may own a trade mark.

2.9 Can a trade mark acquire distinctive character through use?

Yes. As a general rule, the FIIP requires evidence for use of the trade mark in all of Switzerland during 10 years before the filing of

the application. The period of prior use may be shorter if extensive use and significant promotional efforts or a continually increasing turnover are demonstrated. The FIIP accepts the submission of demoscopic surveys as a means to prove that the trade mark has acquired a secondary meaning.

2.10 How long on average does registration take?

On average, registration takes 3-6 months; applications that the FIIP considers as obviously unproblematic are registered within a sensibly shorter time period. Where accelerated examination is requested, the FIIP will either register the application or issue an objection within a month; the procedure will be closed within a further 2 months.

2.11 What is the average cost of obtaining a Swiss trade mark?

The basic fee for the registration of a Swiss trade mark presently is CHF 550 (including three classes of goods and services). For each further class, an additional fee of CHF 100 becomes due.

An additional fee of CHF 400 is charged for accelerated examination.

Agent's fees, on average, begin at around CHF 700 and increase in proportion to the application's complexity.

2.12 Is there more than one route to obtaining a registration in Switzerland?

Yes. An international application designating Switzerland will also be recognised as a Swiss trade mark.

2.13 Is a Power of Attorney needed?

The FIIP as a rule does not require a Power of Attorney but reserves the right of requesting one on a case-by-case basis.

2.14 How is priority claimed?

Priority may be claimed in the application or until 30 days after the filing of the trade mark application. The country of first registration and the filing date must be stated. Within 6 months of the filing of the application, a priority declaration in one of the three national languages or in English must be submitted.

2.15 Does Switzerland recognise Collective or Certification marks?

Yes, Collective and Certification marks are accepted in Switzerland.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

Under Article 2 of the Trademark Act, trade mark protection is not available to signs that:

- belong to the public domain or that are descriptive, except where it can be shown that they have acquired a secondary meaning;

- are shapes constituting the technical nature of the goods themselves or their packaging;
- are deceptive; or
- are contrary to public policy, morality or the law.

3.2 What are the ways to overcome an absolute grounds objection?

The examiner must be successfully convinced that there are no absolute grounds for refusal present in the mark. This can be achieved by submitting arguments and/or evidence refuting the objection.

If the objection addresses the claimed goods and services, further specifications in this respect may also lead to the withdrawal of the objection.

Amendments to the list of goods and services are also possible but, if significant, may have the effect of the trade mark's priority date being moved forward to the date the amendments were proposed.

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision rejecting a trade mark application based on absolute grounds for refusal may be appealed by the affected party within 30 days of service.

3.4 What is the route of appeal?

The appeal is to the Federal Administrative Court, then to the Federal Supreme Court. The latter court however - with a few exceptions - rules on points of law only.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

Trade mark protection is unavailable to signs that are:

- identical with an earlier trade mark and intended for the same goods or services as such trade mark;
- identical with an earlier trade mark and intended for similar goods and services and a risk of confusion results therefrom; or
- similar to an earlier trade mark and intended for the same or similar goods or services and a risk of confusion results therefrom (Article 3 [1] of the Trademark Act).

4.2 Are there ways to overcome a relative grounds objection?

The FIIP does not examine trade mark applications in respect of relative grounds and accordingly issues no objections in this respect; see section 5 below regarding opposition.

4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision rejecting a trade mark application based on relative grounds may be appealed in its entirety by the affected party within 30 days of service.

4.4 What is the route of appeal?

The appeal is to the Federal Administrative Court.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

An opposition may be based on the relative grounds for refusal as set out in question 4.1 above.

5.2 Who can oppose the registration of a Swiss trade mark?

Opposition may be filed by the owner of an earlier Swiss trade mark (including international trade marks designating Switzerland) or the owner of an earlier trade mark that is well known in Switzerland within the meaning of Article *6bis* of the Paris Convention.

5.3 What is the procedure for opposition?

An opposition must be filed within the opposition period, which lasts three months from the date of the opposed mark's publication. The opposition fee currently is CHF 800. If the use of the opposing mark or its distinctiveness are not challenged, the procedure as a rule consists of one exchange of written submissions and takes around one year. If the opposed trade mark's owner pleads non-use of the earlier mark, one further exchange of written brief takes place, and the length of the procedure increases proportionally. The FIIP's opposition decisions are published on its website.

6 Registration

6.1 What happens when a trade mark is granted registration?

The trade mark's status in the register is changed to "registered", and the owner receives a confirmation of registration from the FIIP. No further fees become due at this time.

6.2 From which date following application do an applicant's trade mark rights commence?

Trade mark rights become effective on the day of the trade mark's registration. However, regarding matters arising between the filing of the application and the trade mark's registration, damages may be claimed from the time the infringer knew of the trade mark application's existence.

6.3 What is the term of a trade mark?

The term of a trade mark is 10 years.

6.4 How is a trade mark renewed?

A trade mark is renewed by payment of the renewal fee, which is currently CHF 550, before it expires. Around 6 months before expiration, the FIIP will send an invoice in this respect to the trade mark owner or his representative, respectively.

If this deadline is missed, there is a 6-month grace period after expiry during which the renewal may be made; however, an additional fee will become due.

7 Registrable Transactions

7.1 Can an individual register the assignment of a trade mark?

Yes, by filing an assignment request with the FIIP. Forms are provided on the FIIP's website, but their use is not compulsory. The assignor's written agreement must be submitted to the FIIP.

7.2 Are there different types of assignment?

Yes, a trade mark may be assigned in whole or in part, i.e. in respect of certain goods and services.

7.3 Can an individual register the licensing of a trade mark?

Yes, by submitting a request for the registration of a licence. Forms are provided on the FIIP's website, but their use is not compulsory. The request must enclose a written declaration by the trade mark owner from which the grant of the licence emerges.

7.4 Are there different types of licence?

Different types of licences are recognised in Switzerland, including non-exclusive and exclusive licences.

7.5 Can a trade mark licensee sue for infringement?

Only exclusive licensees may - irrespective of whether the licence is registered - sue for infringement, unless this has been explicitly excluded in the licence agreement. All licensees have the right to join an infringement suit for the damage directly incurred by them.

7.6 Are quality control clauses necessary in a licence?

No, quality control clauses are not mandatory.

7.7 Can an individual register a security interest under a trade mark?

Yes, by submitting a request for registration of such a right to the FIIP. The request must either be signed by the trade mark owner or be accompanied by a copy of the relevant document containing the transaction and the trade mark owner's agreement.

7.8 Are there different types of security interest?

Yes, the Trademark Act names usufruct and pledges.

8 Revocation

8.1 What are the grounds for revocation of a trade mark?

While there is a requirement to use the trade mark in Switzerland, no evidence for use must be submitted to the FIIP in order to maintain the registration. The FIIP may correct errors but not otherwise modify trade mark registrations of its own initiative (saving cases of non-renewal or cancellations due to requests by the owner). Only a final judgment by a civil court ordering the trade mark's cancellation allows the FIIP to take such action. For this

reason, the distinction between revocation and invalidity of a trade mark is largely theoretical: if successful, both have the effect that the attacked trade mark is cancelled by declaratory judgment, and both actions must be brought before the civil courts. Such actions are generally designated as invalidity claims and reference is therefore made to question 9.1 below.

8.2 What is the procedure for revocation of a trade mark?

As set out in question 8.1 above, there is no distinct procedure for the revocation of a trade mark; see question 9.2 below.

8.3 Who can commence revocation proceedings?

See question 9.3 below.

8.4 What grounds of defence can be raised to a revocation action?

See question 9.4 below.

8.5 What is the route of appeal from a decision of revocation?

See question 9.5 below.

9 Invalidity

9.1 What are the grounds for invalidity of a trade mark?

- A trade mark may be declared invalid on absolute grounds for refusal (see question 3.1) or relative grounds for refusal (see question 4.1).
- A trade mark may be declared invalid if it has been registered in the name of agents, representatives or other authorised users without the consent of the owner or which remain registered after withdrawal of the consent.
- A trade mark may further be declared invalid for non-use. Genuine use of the trade mark in connection with the registered goods and services must be taken up within 5 years of its registration. Unless legitimate reasons for non-use exist, the trade mark may be challenged before the civil courts and its non-use may be invoked by defendants in opposition proceedings. If use is commenced or resumed before non-use is claimed by a third party, the rights in the trade mark will be restored with effect from the original priority date.

9.2 What is the procedure for invalidation of a trade mark?

An action before the competent civil court must be initiated. The rules of civil procedure apply, with the particularity that only one court in every Canton has jurisdiction to handle trade mark procedures. These courts are either courts of appeal or commerce courts.

9.3 Who can commence invalidation proceedings?

Any natural or legal person may commence invalidation proceedings.

If the action is based on absolute and/or relative grounds for refusal, the plaintiff must show a legitimate interest in the attacked trade mark's invalidation. Where non-use is invoked, the public interest in keeping the register free of unused marks will usually suffice.

9.4 What grounds of defence can be raised to an invalidation action?

If the invalidation action is based on absolute grounds for refusal (see question 3.1), it can be argued that such grounds are not present in the trade mark and/or that it has become distinctive through use (see question 2.9).

In an invalidation action based on relative grounds for refusal (see question 4.1), non-use could be invoked if circumstances indicating this are present. If the plaintiff knew of the attacked trade mark's existence for a significant period of time before the filing of his claim, a dismissal based on bad faith could be sought (see question 10.7 below). All arguments admissible in opposition proceedings could also be used.

An invalidity action based on non-use would have to be countered by showing genuine use in the 5 years preceding the invalidity action.

9.5 What is the route of appeal from a decision of invalidity?

The court of first instance's judgment can be appealed to the Federal Supreme Court, which - with a few exceptions - rules on points of law only.

10 Trade Mark Enforcement

10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Trade mark rights are enforced mainly by court action. Jurisdiction over such disputes resides exclusively with one court in every one of Switzerland's 26 Cantons. These courts are either courts of appeal or commerce courts.

As the infringement of a trade mark also constitutes a criminal offence, the trade mark owner may file a criminal complaint against the infringer as well.

10.2 What are the pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Infringement proceedings begin with the filing of a statement of claim by the plaintiff. The defendant is then requested by the court to submit a statement of defence, usually within two to three months. The defendant may file a counterclaim. At the court's discretion, either a second exchange of written briefs or a hearing of instruction is then ordered.

Depending on the complexity of the case and the extent of the exchange of written briefs, the time until the first hearing lies between 6 and 18 months.

10.3 Are (i) preliminary and (ii) final injunctions available and if so on what basis in each case?

Yes, preliminary and final injunctions are available.

Preliminary injunctions may be obtained by the petitioner if he can make a *prima facie* case that:

- his trade mark rights are violated by the defendant or that he has cause to fear the violation of his rights;
- such violation threatens to cause him not-easily-repairable harm; or

- he has acted within a reasonable time since becoming aware of the threat posed by the defendant.

In cases of special urgency, the court may be asked to issue an *ex parte* preliminary injunction. Following such an *ex parte* injunction, the court must either summon the parties to a hearing without delay or set the defendant a deadline to file comments. Once such comments have been submitted, the court will either confirm, amend or lift the injunction.

The court may make the provisional measure conditional on the payment of security by the petitioner if the injunction is feared to cause damage to the defendant. If the defendant offers appropriate security, the court may abstain from ordering preliminary injunctions or revoke such injunctions.

Preliminary injunctions must be prosecuted by a main action, and the court will order the petitioner to file a statement of claim - usually within 30 days - on pain of the injunction becoming ineffective in case of default.

To obtain final injunctions, the plaintiff must initiate a main action against the infringer and prove actual or pending infringement of his rights.

10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

No pre-trial discovery proceedings exist in Switzerland. However, the parties have a duty to cooperate in the taking of evidence; in particular, they must produce requested documents unless they can claim a right of refusal. If a party refuses to cooperate without valid reasons, the court will take this into account when appraising the evidence. Third parties may also be compelled to produce evidence relevant to the lawsuit.

Since the infringing commercial activities of the defendant are normally not known in any detail, it is difficult for the plaintiff to quantify damages when filing the claim. Swiss law therefore allows the plaintiff to bring an unquantified financial claim. The claim must be quantified only once the defendant has furnished the evidence required for this purpose.

If the petitioner is able to credibly show that evidence is at risk, and if all other prerequisites are met (see question 10.3 above), a request for preliminary injunctions may be filed to secure such evidence. The defendant may also be ordered by way of preliminary injunction to provide information on the origins of the infringing goods.

10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Submissions are mainly presented in writing although oral arguments in hearings are possible as well. Documentary evidence must be submitted physically. Witnesses are examined by the court; cross-examination is not admitted.

10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Validity claims fall under the exclusive jurisdiction of the civil courts (see question 10.1 above); the FIIP, as an administrative body, is not competent to decide on the invalidity of a trade mark.

In Switzerland, it is possible for the defendant to raise a plea of

invalidity in infringement proceedings, and where this is done, the invalidity question is decided first. Counterclaims are rare for this reason, but, as a rule, the question of infringement would be decided only after a final ruling on invalidity had been issued.

10.7 After what period is a claim for trade mark infringement time-barred?

Claims for monetary relief become time-barred after one year from the time the plaintiff learns of the damage as well as of the infringer. After a maximum of 10 years since the damage was caused, such claims become definitely time-barred.

If a civil claim for damages is based on an act that also qualifies as a criminal offence, the penal statute of limitations will apply to the claim if it is longer than the civil statute of limitations. This rule is of advantage to the claimant, since a trade mark infringement constitutes a criminal offence that only becomes time-barred 7 years after the incriminating acts were performed.

The right to request an injunction against an infringer is not subject to a time bar. However, if the trade mark owner tolerates infringement, opposition to the use of the trade mark by the infringer will no longer be possible. For tolerance to occur, the infringer must:

- in good faith assume that the rights' owner noticed (or should have noticed) the infringement and tolerates it; and
- have built a market position by infringing the rights, so that it would appear unfair to have him renounce it.

There is no fixed period of time for the effects of tolerance to take place, because its effects depend on the principle of good faith and the infringer's obtaining a valuable market position.

10.8 Are there criminal liabilities for trade mark infringement?

Yes, infringements of trade marks are criminally sanctioned.

10.9 If so, who can pursue a criminal prosecution?

Only the party that suffers a prejudice from the infringement can initiate a criminal prosecution by filing a criminal complaint.

10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

If they attain a certain level of intensity, unauthorised threats may qualify as acts of unfair competition.

11 Defences to Infringement

11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

A defendant could argue that there is no likelihood of confusion.

11.2 What grounds of defence can be raised in addition to non-infringement?

One defence would be to claim non-use of the trade mark, in particular that no commercial use of the trade mark was made, or that use was made only for unregistered goods and services, or for an unregistered form. A plea of invalidity could be raised or a counterclaim for invalidity filed. The facts of the case permitting,

exhaustion of the trade mark rights could be argued, as could acquiescence (see question 10.7 above). Furthermore, use of the trade mark in good faith by the defendant prior to registration could also constitute a defence.

12 Relief

12.1 What remedies are available for trade mark infringement?

The following forms of relief are available:

- injunction to cease use of the trade mark;
- confiscation and destruction of infringing goods;
- disclosure of the origin of the infringing goods;
- reparation of the prejudice suffered including a delivery of accounts; and
- publication of the decision at the defendant's expense.

12.2 Are costs recoverable from the losing party and if so what proportion of the actual expense can be recovered?

Yes, the losing party has to bear all costs. As the amount in dispute, the complexity of the case, the number of briefs and hearings are used to determine both judicial costs and attorneys' fees, it is not possible to abstractly determine what proportion of the costs actually incurred may be recovered. In addition, the official schedules used to calculate costs afford the courts a wide power of discretion. As a general rule, low amounts in dispute will not permit a winning party to recover its attorney's fees; where medium to high dispute amounts are involved, this is more likely to be the case.

13 Appeal

13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

A judgment rendered on trade mark matters may be appealed to the Federal Supreme Court. Except for obvious mistakes committed by the court of first instance, only questions of law will be reviewed by the Federal Supreme Court.

13.2 In what circumstances can new evidence be added at the appeal stage?

No new evidence is allowed at the appeal stage.

14 Border Control Measures

14.1 What is the mechanism for seizing or preventing the importation of infringing goods or services and if so how quickly are such measures resolved?

The trade mark owner or the exclusive licensee may request the customs authorities to seize counterfeit goods at the border. The application to the customs authorities has to include a description of the items in question, and the right holder has to provide contact details. If a seizure is made, the right holder and the owner of the goods will be notified that the goods will be released unless a preliminary injunction is obtained within 10 days of the seizure.

If the customs authorities suspect that counterfeit goods are

imported or exported, they may temporarily retain the goods of their own initiative. The right holder will be notified and accorded a deadline to file a request for seizure within 3 days.

15 Other Related Rights

15.1 To what extent are unregistered trade mark rights enforceable in Switzerland?

Well-known trade marks protected under Article 6bis of the Paris Convention may be enforced in Switzerland. In all other respects, unregistered trade marks are unenforceable under trade mark law. However, such signs may be protected under copyright, design or trade name legislation, laws on the protection of geographical indications, unfair competition law or the right to one's own name.

15.2 To what extent does a company name offer protection from use by a third party?

A company name in theory is exclusive to its owner. The geographical extent of the exclusivity is defined by the form of incorporation (if any), either for all of Switzerland (corporations, limited liability companies, cooperatives) or at least for the part of the country where the main activities take place (registered sole proprietorships, general partnerships, limited partnerships). If a danger of confusion is caused by the third party's use of the company name, such use may be enjoined based on trade name and, depending on the facts of the case, unfair competition law. Compared to the rights conferred by a trade mark registration, a company name grants its owner only a limited scope of protection.

15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

There exists no legislation that specifically protects book title and film title rights. However, copyright protection may possibly be available.

16 Domain Names

16.1 Who can own a domain name?

Any natural or legal person may own a domain name.

16.2 How is a domain name registered?

A domain name is registered by filing a request with "SWITCH" (www.nic.ch), the competent TLD registrar for Switzerland.

16.3 What protection does a domain name afford *per se*?

A domain name does not afford protection *per se*.

However, the registration and use of an identical or highly similar domain name may infringe *inter alia* on trade mark rights or constitute an act of unfair competition. There have been numerous procedures in which domain names were challenged on such grounds, resulting in cancellation or assignment of the disputed domain name to the plaintiff.

In disputes regarding domain names, the plaintiff may also take his claim to a WIPO Dispute Resolution Panel. The panellist will grant

a claim to cancel or transfer a domain name if it is found to constitute a clear infringement of a right in a distinctive sign (which includes the application of unfair competition law).

17 Current Developments

17.1 What have been the significant developments in relation to trade marks in the last year?

There have been no significant developments in the last year.

17.2 Are there any significant developments expected in the next year?

The Federal Parliament is presently debating amendments to the Trademark Act and the Coat of Arms Protection Act with the aim of creating a more comprehensive legal framework for geographic indications of source. As the proposed legislation introduces new or revised rules on when goods and services may be designated as “Swiss Made” or “Made in Switzerland”, it is highly controversial in this respect.

One of the less noted (and not contentious) proposed amendments to the Trademark Act would allow for the revocation of non-used trade marks by the FIIP. The details of this administrative procedure will only be framed once the entire amendment has passed the legislative process, but according to the proposed law any natural or legal person would have the right to commence revocation proceedings.

It is unclear when the proposed law will be passed as the legislative process is still ongoing. Given the importance of the legislation to producers across all sectors of the economy, there could be sufficient pressure for parliamentary ratification to take place this year.

17.3 Are there any general practice or enforcement trends that have become apparent in Switzerland over the last year or so?

No such trends have become apparent.



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