

# GUIDELINES

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## Trademark Protection

**A strong brand is what enables businesses to create a unique feature that is recognizable everywhere, which is a valuable asset at the same time. Trademark protection is therefore an indispensable part of building a strong corporate identity. The term trademark encompasses in this context all marks that serve the purpose of giving the company a name on the market and to identify it. The focus of the following discussion is on registered trademarks, but also deals with company name, domain name, and social media appearances at its conclusion. The information provided refers to the legal situation under Swiss law.**

### 1. Trademark Protection

#### 1.1. The Basics

A trademark is a registered sign the purpose of which is to attribute certain goods or services to a particular company and distinguish them from goods or services of other companies.

Based on its trademark, a company can prohibit third parties from using identical or confusingly similar names for the same goods or services. Another option is granting a right of use in the form of a license.

Trademark protection is geographically limited to those countries where the trademark is registered.

As a rule, the “first-come-first-served” principle applies, which means that the person who first registered the trademark enjoys the title to it. To avoid that the trademark must be withdrawn from the market because of existing registrations, it is therefore advisable to use the trademark only after it has been applied for. The date as of which protection under the law starts is the date of receipt of the trademark application by the Institute of Intellectual Property in Bern, Switzerland (“IPI”). The application must be filed in writing and may be forwarded by mail, fax or online.

#### 1.2. The Various Forms of a Trademark

A trademark may be registered in various forms. The most common forms are word marks, combined word and figurative marks and pure figurative marks. There are still other reproducible forms—but much less common—such as acoustic marks (e.g., advertising jingles), color marks, three-dimensional marks (e.g., bottle shapes), movement marks (e.g., a rotating logo such as that of Swisscom) or position marks (such as stripes on sneakers as used by K-Swiss). Thus, a trademark may consist of words, letters, numbers, graphic representations, three-dimensional forms, or a combination of all of these elements. Trademarks can be registered without color or with a specific color as part of the trademark. The latter may make sense if certain colors are a central component of the trademark.

#### 1.3. Registration Requirements

A sign must comply with the Swiss Trademark Protection Act to have the trademark registered. Excluded from trademark protection are signs that are in the public domain and shapes that constitute the nature of the goods. In the public domain are signs that are descriptive and can be freely used by the general public. Whether or not a sign is in the public domain must always be assessed based on the goods and services, for which the trademark registration is sought. As an example, the term “ap-

ple" is descriptive and thus in the public domain describing apples but not computers. Also excluded from trademark protection are misleading signs and signs contrary to public policy, morality, or applicable law. A sign is characterized as misleading if it leads to a false expectation on the part of the general public, for example about the nature or origin of the goods. If, for example, a trademark for jewelry contains the word "gold", it cannot be registered for jewelry made of silver. The registration of a trademark "Golden Star" for restaurant services, on the other hand, would be possible. A trademark with the component "Swiss" may be registered and used only for goods or services of Swiss origin.

#### 1.4. Goods and Services

The goods and services, for which a trademark can be registered are based on the so-called Nice Classification. The Nice Classification subdivides all goods and services into one of 45 classes in total. An overview of the allocation of goods and services to these 45 classes can be found on the IPI website in German, French and Italian, and in English on the website of the World Intellectual Property Office (WIPO) <https://www.wipo.int/classifications/nice/en/>.

A trademark can be registered for any number of classes as well as goods and services, where the number of classes will affect the amount of the application fee. The current official application fee of CHF 550.00 includes three classes, each additional class will cost another CHF 100.00.

The goods and/or services should be described with great precision in the trademark application for two reasons. On the one hand, this will ensure the best possible protection of the trademark, and on the other, it helps setting it apart from potentially conflicting earlier trademarks. What is more, proper and thorough drafting of the list of goods and services is of great significance because the list of goods and services cannot be supplemented once the trademark has been registered. Limitations and deletions may, however, be made later.

#### 1.5. Risk of Interference with Existing Signs

Proprietors of earlier trademarks may oppose the registration of new trademarks that are identical or similar to theirs and thus create a likelihood of confusion, or demand cancellation from the trademark register by means of an action for cancellation. It is thus advisable to clarify before filing a trademark application whether earlier trademarks are registered to ensure that the requested trademark is not already used in an identical or confusingly similar fashion. All the IPI examines is whether the requested trademark complies with the statutory

requirements but will not check whether there is interference with an earlier trademark. It is thus the responsibility of the trademark applicant to clarify in advance whether there are earlier trademarks, or, as applicable, the responsibility of the proprietor of the earlier trademark to monitor whether new trademarks are being applied for that infringe that proprietor's earlier trademark rights. Initial clarifications can be carried out through publicly accessible databases. The trademarks registered in the Swiss National Trademark Register can be viewed at [www.swissreg.ch](http://www.swissreg.ch). International registrations are accessible on the WIPO website <https://www.wipo.int/madrid/monitor/en/>, and WIPO also provides a global trademark database at <https://www.wipo.int/branddb/en/>. One should keep in mind that the research options in these freely accessible databases are limited and cannot replace the more precise results of a professional trademark search. It is in any event worthwhile to carry out these preliminary clarifications, or have them carried out, to avoid that a relatively inexpensive trademark application suddenly turns into an expensive legal dispute.

#### 1.6. Trademark Maintenance After Registration

The procedure from application to registration normally takes 6–12 months (accelerated examination is available for an extra fee). Once the trademark is entered in the register, its protection spans over 10 years and the trademark protection may be renewed from that point for any number of additional 10-year periods. After its registration, the trademark should be properly maintained to ensure that it is preserved, and its protection is not lost or limited.

Trademark maintenance includes:

- Monitoring new trademark registrations by third parties to prevent the dilution of one's own trademark. If third parties register identical or confusingly similar trademarks and this fact remains undetected, the trademark will lose its uniqueness and the effect of its protection is weakened.
- Marking the trademark as a registered trademark. This is usually done by adding the reference ® for "registered trademark" to the registered trademark. This reference may be used only for trademarks whose registration has been approved by the trademark office but not for trademarks with a pending application. Unauthorized use of ® violates the Act Against Unfair Competition. The symbol ™ may be used until registration.
- Regular updating of the entry in the register in the event of a change of company name, change of address, or change of proprietor.
- Regular review on whether the registered goods and services align with the actual use of the trademark. During the first 5 years, there is a so-



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called grace period on the use, i.e., the trademark need not be used for all registered goods or services. Thereafter, third parties may contest the protection of the trademark over those goods or services, for which the trademark is not used. The proprietor of the trademark can have individual goods or services deleted from the existing trademark registration at any time. Yet new goods or services cannot be added, instead, a new trademark must be applied for with regard to these new goods or services.

- Use of the trademark in the form entered in the register. Any use of the trademark that deviates from the registration may cause the loss of protection of the trademark. As a result, if any changes are made to the trademark, the question of whether these changes substantially alter the appearance of the trademark must always be examined. If this is the case, the trademark must be re-applied for in its new form since the sign as filed cannot be modified in the register.
- Documentation of use to provide an essentially seamless proof of use of the trademark in the event of a dispute. Advertisements, catalogs, invoices, and so on, are suitable evidence of use.

### 1.7. International Trademark Protection

Trademark protection is either national or regional (e. g., EU or Africa). Based on a Swiss trademark registration, a so-called international extension can be implemented on the basis of an international trademark agreement ("Madrid Agreement"). Trademark protection can be extended to other countries with a single application to the Institute of Intellectual

Property. If this extension occurs within six months of the filing date for the Swiss basic trademark, the international trademark is also protected as of the date of protection of the Swiss application (so-called priority date). If the application for the international trademark is filed after these six months, the later filing date is considered to be the relevant date of protection.

Worldwide trademark protection is close to illusory and involves steep costs. Trademark proprietors should align international trademark protection with their main markets. Even though several countries are covered by one international application, each national trademark office will examine the application under national or regional trademark laws as part of the international registration. If the countries to which the international trademark is to be extended to is clear at the time of filing a Swiss trademark application, the relevant national features could be considered at that point, for example in the drafting of the list of goods and services, thereby avoiding additional administrative costs.

The application for countries who are not signatories to the Madrid Agreement must be filed directly with the national trademark office.

## 2. Company Name and Other Signs

### 2.1. Company Name

While the trademark identifies goods and services of a business, the company name identifies the company as such. Besides the essential content

