

TRADEMARKS

Switzerland



Trademarks

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Quick reference guide enabling side-by-side comparison of local insights, including legal framework; registration and use; licensing and assignment; enforcement; and recent trends.

Generated 09 November 2023

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LEGAL FRAMEWORK

Domestic law

What is the primary legislation governing trademarks in your jurisdiction?

The primary legislation governing trademarks is the Federal Act on Trade Mark Protection and Indications of Source accompanied by the Regulation on the Protection of Trademarks and Indications of Source .

Law stated - 01 July 2023

International law

Which international trademark agreements has your jurisdiction signed?

Switzerland is a signatory to the following international trademark agreements:

- the Paris Convention for the Protection of Industrial Property 1883;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994;
- the Madrid Agreement Concerning the International Registration of Marks 1891;
- the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks 1989;
- the Trademark Law Treaty 1994;
- the Nice Agreement concerning the International Classification of Goods and Services 1957;
- the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks 1973;
- the Lugano Convention on Jurisdiction and the Recognition and Enforcement of Judgments in Civil and Commercial Matters 1988; and
- the Geneva Act of the Lisbon Agreement (entered into force with respect to Switzerland, on 1 December 2021).

Law stated - 01 July 2023

Regulators

Which government bodies regulate trademark law?

The Swiss Federal Institute of Intellectual Property is the governmental body responsible for handling trademark applications (domestic as well as international registrations) and opposition proceedings.

Law stated - 01 July 2023

REGISTRATION AND USE

Ownership of marks

Who may apply for registration?

Registration is open to individuals and legal entities domestic or international alike. Applicants that are not domiciled or without a registered office in Switzerland must provide an address for service in Switzerland. Further, certain restrictions as to nationality or registered seat apply to collective marks and geographical marks.

Law stated - 01 July 2023

Scope of trademark

What may and may not be protected and registered as a trademark?

Any sign capable of distinguishing the goods or services of one undertaking from those of other undertakings is in principle registrable as a trademark. Trademarks may, in particular, be words, letters, numerals, figurative representations, three-dimensional shapes or combinations of such elements with each other or with colour. Other forms such as sound marks, movement marks or smells can be registered provided they are capable of being represented graphically. They are comparatively rare, though. For example, there are only 36 active national sound mark registrations.

Further, excluded from trademark protection are the following:

- signs that are in the public domain, except where they have become established as a trademark through use for the goods or services for which they are being claimed ('acquired distinctiveness');
- shapes that constitute the nature of the goods themselves or shapes of the goods or their packaging that are technically necessary;
- misleading signs; and
- signs contrary to public policy, morality or applicable law.

A collective mark represents the goods or services of an association of manufacturing, trading or service companies. Only associations can file a collective mark, individuals are exempt. Regulations set forth by the association and submitted to the Swiss Federal Institute for Intellectual Property determine who is allowed to use the trademark.

A guarantee mark provides a guarantee that goods and services possess specific characteristics such as quality or geographical origin. The holder is responsible for meeting the requirements set out in the regulations submitted to the trademark office. Guarantee marks are open to individuals as well as legal entities. The trademark holder is not permitted to use the trademark nor permitted to have any business affiliation with the users of the mark to avoid a conflict of interest.

Protected designations of origin and geographical indications registered in a federal register can also be registered as geographical marks. Only a representative group is permitted to submit an application for registration of a geographical mark and the regulations set forth for the use of the geographical mark must correspond with the product specification.

Law stated - 01 July 2023

Unregistered trademarks

Can trademark rights be established without registration?

Foreign trademarks are granted similar rights as registered Swiss marks subject to article 6bis of the Paris Convention for the Protection of Industrial Property 1883 (Paris Convention) and the mark qualifying as a well-known mark. To have the status of a well-known mark acknowledged, use in Switzerland is not required but the holder of the alleged well-known mark will have to provide evidence of its notoriety in the Swiss market. Usually, suitable evidence is proof of sales and marketing activities in Switzerland.

Further, Swiss trademark law stipulates a right to continued use meaning that the holder of a trademark may not assert its trademark rights against a person using a mark or sign to the same extent as already previously used prior to the filing of the application of the registered trademark. To be clear, the right to continued use does not mean that the earlier user of the mark or sign in dispute can claim any trademark rights on said mark or sign.

Unregistered marks or signs may also be protected under the Act against Unfair Competition.

Law stated - 01 July 2023

Famous foreign trademarks

Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What proof is required? What protection is provided?

Swiss law does not grant any specific protection to famous foreign trademarks. Rather, in application of article 6bis of the Paris Convention, it sets forth that the proprietor of a famous trademark may prohibit others from using the trademark for any type of goods or services if such use threatens the distinctiveness of the trademark or exploits or damages its reputation.

Also, rights acquired before the trademark became famous remain unaffected.

To have the status of a well-known mark acknowledged, use in Switzerland is not required but the holder of the alleged well-known mark will have to provide evidence of its notoriety on the Swiss market. Usually, suitable evidence are proof of sales and marketing activities in Switzerland in connection with the claimed goods and services. The level of proof is very high.

Law stated - 01 July 2023

The benefits of registration

What are the benefits of registration?

Registration is required to enjoy the rights granted under Swiss trademark law. A trademark registration confers the exclusive right to use the trademark to identify the goods or services for which it is claimed and to dispose of it. The trademark holder may prohibit others from using a sign that creating a likelihood of confusion with the registered trademark, including the right to prohibit the importing, exporting or carrying in transit goods under the sign. Accordingly, the holder profits from border enforcement mechanisms to prevent the importing or carrying in transit goods under the sign, even if such activity is carried out for private purposes.

Law stated - 01 July 2023

Filing procedure and documentation

What documentation is needed to file a trademark application? What rules govern the representation of the mark in the application? Is electronic filing available? Are trademark searches available or required before filing? If so, what procedures and fees apply?

There is only very little documentation required to file a trademark application, the most important being the representation of the mark in the application. Upon filing an application no power of attorney is required, the filing of any subsequent amendments to the original filing, however, a power of attorney is necessary. Electronic filing is available and procedural communication with the Swiss Federal Institute of Intellectual Property is possible via a dedicated email address. Since 2022, the Swiss Federal Institute for Intellectual Property no longer offers trademark searches as part of their services but it provides a list of trademark search service providers. Trademark searches are not required before filing but recommended.

Law stated - 01 July 2023

Registration time frame and cost

How long does it typically take, and how much does it typically cost, to obtain a trademark registration? When does registration formally come into effect? What circumstances would increase the estimated time and cost of filing a trademark application and receiving a registration?

Currently, it typically takes six to eight months for an application to be processed. The official filing fees are 450 Swiss francs for up to three classes irrespective of the form or category of the mark. If the application is filed via the institute's e-tool, there is a 100 Swiss franc discount. For both paper and e-filing, each additional class adds 100 Swiss francs. Against payment of a 400 Swiss francs surcharge, the application process can be expedited reducing the time frame to approximately two months. Attorney's fees vary depending on the complexity of the application and the list of goods and services.

Law stated - 01 July 2023

Classification system

What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed? Are multi-class applications available and what are the estimated cost savings?

The International Classification System is followed. Multi-class applications are available and the cost savings are substantial because when applying a single-class application strategy in Switzerland, the basic fee of 550 Swiss francs is applied for each filing.

Law stated - 01 July 2023

Examination procedure

What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? Are letters of consent accepted to overcome an objection based on a third-party mark? May applicants respond to rejections by the trademark office?

The Swiss Federal Institute for Intellectual Property first determines whether the formal filing requirements are met. If they are met, the invoice is issued and upon receipt of the filing fees the trademark office will assign a trademark examiner to proceed with the assessment of the admissibility of the filed mark for registration. Applications are not examined for potential conflicts with other trademarks. If a rejection is issued for non-conformity of the list of goods and services with the trademark office's practice or on the basis of absolute grounds, the Swiss Federal Institute for Intellectual Property will notify the applicant inviting the applicant to submit arguments to overcome the grounds for refusal.

Law stated - 01 July 2023

Use of a trademark and registration

Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

Use of a trademark does not have to be claimed before registration is granted or issued. Also, for renewals, no proof of use is required. Proof of use only has to be submitted for marks that were found inadmissible for lack of distinctiveness and the applicant claims acquired distinctiveness.

Where the trademark holder (or its licensee) has not used the trademark in relation to the goods or services for which it is claimed for an uninterrupted period of five years following the expiry of the opposition period with no opposition having been filed or upon conclusion of opposition proceedings, the rights to the trademark may no longer be asserted, unless there are valid reasons for non-use.

If the 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 of the trademark has been invoked by a third party prior to its commencement or resumption of use.

Law stated - 01 July 2023

Markings

What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

The use of the ™ symbol is not subject to any specific regulation. Prevailing doctrine, however, stipulates that it should only be used with a trademark in an ongoing application process. A registered trademark can be marked with the ® symbol. The use of the ® symbol for an unregistered mark or a mark in the application stage is a violation of the Act against Unfair Competition. Marking is not mandatory but common as it has the benefit of signalling trademark protection in the market and hence having a deterrent effect. Also, the use of the ® symbol may prevent dilution or trademark generification. To avoid such generification, the Swiss Act on Trademark Protection sets forth that where a registered trademark is reproduced in a dictionary, in another reference work or in a similar work without reference to its registration, the proprietor of the trademark may require that the publisher, editor or distributor of the work include a corresponding reference such as the ® symbol.

Law stated - 01 July 2023

Appealing a denied application

Is there an appeal process if the application is denied?

If a provisional refusal cannot be overcome the Swiss Federal Institute for Intellectual Property will issue an appealable refusal for registration. There is no administrative appeal procedure. The refusal for registration can be appealed before the Federal Administrative Court within 30 days of the notification of the refusal. The judgment of the Federal Administrative Court is open to an appeal to the Federal Supreme Court, again within 30 days from the notification of the decision. Both the Swiss Federal Institute for Intellectual Property and the applicant can appeal the Federal Administrative Court's judgment and the appeal to the Federal Supreme Court is the last judicial appellate procedure.

Third-party opposition

Are applications published for opposition? May a third party oppose an application prior to registration, or seek cancellation of a trademark or service mark after registration? What are the primary bases of such challenges, and what are the procedures? May a brand owner oppose a bad-faith application for its mark in a jurisdiction in which it does not have protection? What is the typical range of costs associated with a third-party opposition or cancellation proceeding?

Applications are published for opposition. A third party cannot oppose an application prior to registration. They may file an opposition but the proceedings will not be commenced until the Swiss Federal Institute for Intellectual Property has ruled on the mark's admissibility for registration. Upon publication of the registration, the three-month opposition period begins within which third parties may oppose the registration by initiating the administrative opposition proceedings. The opposition fee is 800 Swiss francs and must be paid in full within the three-month deadline. The attorney's fees depend on the complexity of the case and are typically in the range of 1,200 Swiss francs to 4,000 Swiss francs. In the administrative opposition proceedings, the only basis for a claim is the likelihood of confusion with a prior trademark owned by the opposing party. Prior to initiating opposition proceedings, it is recommended to send a cease-and-desist letter to the applicant and request the withdrawal of the application. If the applicant has been sent a cease-and-desist letter and subsequently only withdraws the application upon the filing of an opposition, the opposing party will be able to recover some of the costs from the applicant.

After registration and lapse of the opposition period, a third party may seek cancellation of a trademark by initiating judicial proceedings before the respective cantonal court. The basis for a cancellation claim can be likelihood of confusion with a prior trademark or a bad faith application. For the latter, the threshold for providing proof of bad faith is fairly high and poses a challenge. Further, any person who has a legitimate interest can request cancellation of a trademark on the basis of absolute grounds of invalidity.

Alternatively, any person can file a cancellation request with the Swiss Federal Institute for Intellectual Property on the grounds of non-use five years after expiry of the opposition period or dismissal of the opposition. The request is granted where credible non-use is shown and the trademark owner has not shown credible use of the mark or proper reasons for its non-use.

Law stated - 01 July 2023

Duration and maintenance of registration

How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?

A registration remains in effect for a period of 10 years without any specific requirements to maintain a registration. Subsequently, it can be renewed for further 10-year periods against payment of the renewal fee, which to date is 700 Swiss francs (irrespective of the number of classes claimed).

Law stated - 01 July 2023

Surrender

What is the procedure for surrendering a trademark registration?

A simple request for withdrawal or cancellation is required. The Swiss Federal Institute for Intellectual Property does not charge fees for such a withdrawal or cancellation. In the case of a withdrawal of an application, however, the fees already paid are not refundable.

Law stated - 01 July 2023

Related IP rights

Can trademarks be protected under other IP rights?

Trademarks can be protected under other IP rights, provided the requirements for that IP right are met.

Law stated - 01 July 2023

Trademarks online and domain names

What regime governs the protection of trademarks online and domain names?

There is no specific regime governing the protection of trademarks online and domain names. As regards domain names, the terms and conditions of the respective registrar govern the registration and the Internet Corporation for Assigned Names and Numbers Uniform Dispute Rules apply.

Law stated - 01 July 2023

LICENSING AND ASSIGNMENT

Licences

May a licence be recorded against a mark in the jurisdiction? How? Are there any benefits to doing so or detriments to not doing so? What provisions are typically included in a licensing agreement?

A licence may be recorded against a mark in Switzerland but is not mandatory for its validity, with the exception of collective trademarks. A request for the recording of the licence in the register has to be submitted to the Swiss Federal Institute for Intellectual Property by either the licensor or the licensee with the other party having to confirm the registration to the trademark office. The recording of the licence is in the interest of the licensee because recording the licence makes it effective against subsequently acquired rights in the trademark.

Law stated - 01 July 2023

Assignment

What can be assigned?

A trademark can be assigned fully or partially and usually includes goodwill. No other business assets must be assigned to make it a valid transaction.

Law stated - 01 July 2023

Assignment documentation

What documents are required for assignment and what form must they take? What procedures apply?

The agreement regarding the assignment obligation is not subject to any form requirement. The assignment transaction, however, must be in writing but notarisation is not necessary. Such assignment transaction document must clearly indicate the parties to the transaction and specify the assigned trademarks for the document to be accepted for the recording of the assignment in the trademark register.

Law stated - 01 July 2023

Validity of assignment

Must the assignment be recorded for purposes of its validity?

The assignment must not be recorded for purposes of its validity but it is highly recommended to record the assignment to avoid the risk of a good faith acquisition of the mark by a third party.

Law stated - 01 July 2023

Security interests

Are security interests recognised and what form must they take? Must the security interest be recorded for purposes of its validity or enforceability?

Security interests are recognised and must not be notarised. For purposes of its validity or enforceability, the security interest must not be recorded but such recording is highly recommended to avoid good faith acquisition of the mark by a third party.

Law stated - 01 July 2023

ENFORCEMENT

Trademark enforcement proceedings

What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

There are no administrative proceedings available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from the opposition proceedings before the trademark office.

There are no specialist courts or tribunals but whereas normal civil judicial proceedings set forth proceedings through four or three instances (justice of the peace, lower cantonal court, cantonal high court and Federal Court) in intellectual property matters – including trademark matters – each canton has one single designated court for handling intellectual property proceedings with a possibility to appeal such court's decision to the Federal Court. Civil legal action is open to any trademark owner claiming trademark infringement. Dilution claims require the existence of a famous trademark.

The Federal Act on Trademark Protection contains provisions declaring the wilful infringement of a trademark a criminal offence subject to a custodial sentence of up to one year or a monetary penalty and up to five years in prison if the offender acts for commercial gain. Criminal proceedings are instituted by the cantonal criminal prosecution authorities.

Further, trademark holders can authorise the Federal Customs Administrations to withhold infringing goods at customs. The trademark holder will be notified of and given a 10-day (extendible) deadline to obtain an injunction by a civil court, a seizure order by a criminal prosecution authority or obtain the intended recipient's consent to agree to the destruction of the withheld goods. There is no private use exemption for infringing goods.

Law stated - 01 July 2023

Procedural format and timing

What is the format of the infringement proceeding?

The format of the infringement proceeding varies depending on the actual claim. In ordinary proceedings, the plaintiff will file the statement of claims within which the claimant has to substantiate the claims and provide evidence. Evidence can be provided by means of documents, witness testimony or expert testimony. The court will then ask the defendant to submit its response. Depending on the specific court's practice – which varies from canton to canton – it will then either invite the parties for settlement negotiations guided by the court or order a second round of statements to be submitted by the parties. If the parties cannot agree on a settlement, the court will reach a verdict that is appealable to the Federal Court. The duration of such proceedings strongly depends on the complexity of the matter but typically lasts between 12 to 36 months and if appealed to the Federal Court even longer.

The criminal enforcement mechanism also varies from canton to canton as the cantonal or communal criminal enforcement agencies are responsible for instituting the proceedings, which typically begin with collecting evidence by interrogating the alleged offender.

Law stated - 01 July 2023

Burden of proof

What is the burden of proof to establish infringement or dilution?

The burden of proof to establish infringement or dilution in judicial proceedings lies with the plaintiff. As a rule, strict proof is required to the extent that there is sufficient concrete (not circumstantial) evidence to convince the judge of the facts with only negligible reasons for doubt remaining.

In the case of dilution, the holder must provide sufficient proof that the trademark qualifies as a famous mark.

Law stated - 01 July 2023

Standing

Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

A remedy for an alleged trademark violation may be sought by the trademark owner and its exclusive licensee (unless prohibited under the respective licence agreement). The same applies to bringing a criminal complaint. If it is established that the offender acts for commercial gain, prosecution is pursued ex officio by the cantonal criminal prosecution authorities.

Further, any person with a legally protected interest can ask the competent court to decide on the existence or non-existence of trademark rights. It is generally accepted that there is an interest in keeping the register free of inactive or invalid trademarks and therefore any person may claim nullity of a trademark based on non-use.

With respect to collective and guarantee marks, certain parties such as consumer associations, have standing to bring claims against guarantee and collective trademarks.

Law stated - 01 July 2023

Border enforcement and foreign activities

What border enforcement measures are available to halt the import and export of infringing goods? Can activities that take place outside the country of registration support a charge of infringement or dilution?

The trademark holder can request the customs authorities to withhold infringing goods. The trademark holder will be notified of and given a 10-day (extendible) deadline to obtain an injunction by a civil court, a seizure order by a criminal prosecution authority or obtain the intended recipient's consent to agree to the destruction of the withheld goods. There is no private use exemption for infringing goods.

Foreign activities are generally not considered for the support of infringement or dilution claims. As per the principle of impact, however, activities outside of Switzerland that have an impact in Switzerland may constitute an infringement of Swiss trademark rights.

Law stated - 01 July 2023

Discovery

What discovery or disclosure devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

A plaintiff may request the competent court to take evidence if the plaintiff can demonstrate a legitimate interest or that evidence is at risk. The court will apply summary proceedings to determine whether it will grant or reject the request for evidence. The Swiss Act on Trademark Protection sets forth that the holder whose trademarks are infringed has a specific claim to information on the infringing goods and their distribution channels and the quantities sold or in circulation.

In pending civil proceedings, the court may conduct evidentiary hearings obtaining statements from the parties, witnesses and experts.

Law stated - 01 July 2023

Timing

What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?

The time frame strongly depends on the complexity of the case but in ordinary civil proceedings it in general ranges from 12 to 36 months plus a further 12 months in the case of an appeal to the Federal Supreme Court.

In preliminary cases, the time frame also depends on the circumstances of the case. Ex parte injunctions may be rendered in a time frame of a couple of days, in clear cases even on the same day. Proceedings for preliminary

injunctions where both parties are heard typically take less than a few months.

Law stated - 01 July 2023

Limitation period

What is the limitation period for filing an infringement action?

There is no limitation period as such but in civil proceedings, there is a relative one-year and an absolute 10-year limitation period for claiming damages. Further, failing to file or delaying the filing of an infringement action for a substantial period of time may lead to the court finding the rights of the plaintiff to be forfeited. Forfeiture is not assumed lightly and will depend on the specific circumstances of the case and will generally only be assumed in the case of a forfeiture period of four to eight years, in exceptional cases the Federal Supreme Court has accepted a forfeiture period of two years.

There is also the option to seek preliminary relief by means of a preliminary injunction. A preliminary action requires a prima facie case of infringement and validity and the substantial risk of irreparable harm.

Again, if the applicant waits for a substantial period of time before requesting preliminary relief, in general, it will be denied.

Law stated - 01 July 2023

Litigation costs

What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

The court tariffs vary from canton to canton and are determined based on the amount in dispute (namely, value in litigation). The minimum legal costs typically range from 30,000 Swiss francs to 40,000 Swiss francs for trial preparation and trial. In complex matters, they can double or triple. The court fees depend on the amount in dispute. For trademark matters, case law stipulates a minimum amount in dispute of 100,000 Swiss francs. The federal Code of Civil Procedure sets forth rules on the recovery of costs by a successful plaintiff as well as a successful defendant. The recoverable costs are determined by the respective court tariff. Normally, the actual legal costs exceed the recoverable costs meaning that a successful plaintiff or successful defendant will almost always have to bear some part of the costs incurred.

Law stated - 01 July 2023

Appeals

What avenues of appeal are available?

In intellectual property matters – including trademark matters – each canton has one single designated court for handling intellectual property proceedings with a possibility to appeal such court's decision to the Federal Supreme Court.

Law stated - 01 July 2023

Defences

What defences are available to a charge of infringement or dilution, or any related action?

Depending on the actual claims and circumstances of the case the defendant can dispute a likelihood of confusion, non-use of nullity of the plaintiff's trademark or that due to a delay in bringing forth the charges, the trademark holder has forfeited the claims. With respect to dilution claims the defendant can dispute the fame of the trademark or claim generification of the trademark.

Law stated - 01 July 2023

Remedies

What remedies are available to a successful party in an action for infringement or dilution, etc?
What criminal remedies exist?

Remedies in civil law infringement and dilution action consist of damages, surrender of profits or restitution of unjustified enrichment. Other remedies are the destruction of infringing goods, the assignment of a trademark or domain name or where damages in the reputation of the trademark holder occurred, the publication of the judgment.

In preliminary injunctions, special remedies can be sought such as the preservation of evidence or determining the origin of the infringing products.

Remedies in criminal proceedings consist of monetary penalties and custodial sentences.

Law stated - 01 July 2023

ADR

Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?

ADR techniques are available in the form of mediation and arbitration but there are no specific mechanisms available for trademarks. ADR techniques are commonly used in the form of the Uniform Domain-Name Dispute-Resolution Policy proceedings for domains. The general benefits of ADR techniques are confidentiality and in most cases a speedier handling of the proceedings than before a state court.

Law stated - 01 July 2023

UPDATE AND TRENDS

Key developments of the past year

Are there any emerging trends, notable court rulings, or hot topics in the law of trademark infringement or dilution in your jurisdiction?

New examination practice from 1 July 2023

The institute has revised its guidelines to reflect the harmonisation on the legislative level between the Trademark Act, the Patent Act and the Design Act. Further, the institute has also partially revised its trade mark guidelines ('International trade mark registration', 'Substantive trade mark examination', 'Opposition proceedings' and 'Cancellation proceedings due to non-use').

Landmark case before the Swiss Federal Supreme Court

In its first judgment in an administrative cancellation procedure, in the case of *Universal Geneve v Beau HLB*, the Federal Tribunal also had to consider for the first time the use of a trademark in connection with exports (Case 4A_509/2021 of the Federal Tribunal of 3 November 2022). The case concerned cancellation proceedings brought against the trademarks U UNIVERSAL GENEVE (fig) (Swiss trademark No. 329720) and UNIVERSAL GENEVE (Swiss trademark No. 410354). The former was registered in 1984 for 'watches of all kinds and parts thereof, jewellery' and the latter in 1994 for 'watches and watch parts'. The applicant based its claims for cancellation on the argument that 'using the mark for export', as referred to in article 11(2) of the Trademark Act (which reads: 'Use in a manner not materially different from that of the registered mark and use for export purposes also constitute use of the mark'), which could be considered sufficient use of the mark under Swiss law, did not apply to the contested marks because they had previously been marketed in Switzerland and were therefore not used exclusively for export purposes. The defendant's argument was that article 11(2) of the Trademark Act relieves trademark owners who are active in the export market by not requiring them to distribute the trademarked goods in Switzerland. Simultaneous use of the trademark in Switzerland and for export is not prohibited.

Law stated - 01 July 2023

Jurisdictions

	Angola	RCF – Protecting Innovation
	Australia	Holding Redlich
	Brazil	Bhering Advogados
	Canada	Bereskin & Parr LLP
	China	Jones & Co
	Colombia	OlarteMoure
	Denmark	Accura Advokatpartnerselskab
	European Union	Noerr PartGmbH
	France	Simmons & Simmons
	Germany	Meissner Bolte
	India	ANA Law Group
	Indonesia	Affa Intellectual Property Rights
	Israel	Reinhold Cohn Group
	Italy	Spheriens
	Japan	Anderson Mōri & Tomotsune
	Macau	RCF – Protecting Innovation
	Malta	Ganado Advocates
	New Zealand	PIPERS
	Portugal	RCF – Protecting Innovation
	Romania	Cabinet M Oproiu Patent & Trademark Attorneys
	Saint Lucia	Goddard-Dorville Legal
	Singapore	Ella Cheong LLC
	South Africa	Spoor & Fisher
	South Korea	Bae, Kim & Lee LLC
	Sweden	Mannheimer Swartling

 United Kingdom	AA Thornton IP LLP
 USA	Kilpatrick Townsend & Stockton LLP
 Vietnam	Bizconsult Law Firm