## Trade mark basics

### What is a trade mark?

Legally, a trade mark is a protected sign that distinguishes a company's products or services from those of other companies. In principle, all graphical representations of a sign can be a trade mark within the meaning of the law. For example, words (e.g. Victorinox), combinations of letters (e.g. ABB), numbers (e.g. 501), graphic images (e.g. the SBB logo), three-dimensional forms (e.g. the Mercedes star), slogans (e.g. “Cats would buy Whiskas”), combinations of these elements or even sound trade marks, which are made up of a sequence of musical notes (e.g. the Ricola jingle).

### Why protect a trade mark?

Trade marks are an essential distinguishing feature of goods and services. A lot of time and money is often invested in creating and maintaining them. Trade marks are therefore valuable capital because with a brand, you stand out from your competitors. By registering them, you mark your product as being your intellectual property and as a result, protect yourself from free riders.

**How to strategically protect your trade mark:**

- Developing a filing strategy
- National or international protection?

### What are the tangible benefits of a trade mark?

Trade marks are registered on a first come first served basis. So apply to register your trade mark as soon as possible to stop somebody else pre-empting you and making it impossible for you to continue your business activities. Only a registered trade mark gives you optimum protection. Trade mark protection grants the owner the exclusive right to use their trade mark for labelling goods and services. This right can be passed on, for example through licensing or sale. The trade mark owner can prevent others from using a similar or identical sign for similar or identical goods or services.

Good to know

It is often wrongly assumed that a company name, i.e. the name of a business, is automatically protected as a trade mark. A company name can be registered as a trade mark and consequently be protected if it meets the requirements for protection. You are not obliged to use the registered trade mark symbol (®); neither does using it make any difference to the rights of the trade mark owner in Switzerland. However, it can alert other people to the fact that the trade mark is registered and at least prevent cases of infringement. Nevertheless, using the registered trade mark symbol without having actually registered a trade mark makes you liable for prosecution.

It is also possible to label your own goods or services without trade mark protection. However, it is extremely difficult to prevent others from using your sign without it.

What can be protected as a trade mark?

The Trade Mark Protection Act gives a broad definition of the term ‘trade mark’. In principle, any sign that is capable of being represented graphically can be a trade mark within the meaning of the law, provided that the sign is used to distinguish goods or services from those of a competitor. When assessing the distinctive character of a trade mark, it is the overall impression it makes that is relevant.

More information on the various categories and types of trade mark.

• Categories of trade mark
• Types of trade mark
### What can't be protected as a trade mark?

Simple signs, abbreviations, indications and coats of arms can't be protected as a trade mark. In addition, your trade mark must not be descriptive or deceptive, nor be contrary to public policy.

### Term of protection and fees

A trade mark is protected from the date of filing for ten years. Protection can then be renewed indefinitely for 10 years at a time. The filling fee (in Switzerland) is CHF 550. The renewal fee (for 10 years) costs CHF 700.

### How do I protect a trade mark?

A trade mark is only protected if it has been registered in the **Swiss trade mark register Swissreg**.

### Research first, then register

Before you apply to register a trade mark, you should clarify a few things first. **Because the IPI does not check to see whether your trade mark already exists in an identical or similar form.** If your trade mark conflicts with a sign already registered, your IP right could be revoked or become the subject of civil or criminal proceedings at a later point in time. We therefore strongly recommend that you have a search carried out for identical or similar trade marks and company names before you apply to register your trade mark. [Detailed information on trade mark searches.](#)

### Map out your filing strategy
Think about how you want to protect and defend your trade mark in the long term. Weigh up the costs and benefits and define an IP strategy. Decide what and how you want to protect, in which countries and for how long, whether and how you'll monitor your trade mark, how you can defend it, and possibly how you want to exploit it (e.g. sell it or licence it).

When registering your trade mark, there are a number of important and fundamental points that you should consider.

Registering in Switzerland

Do you want to register your trade mark? You can apply to register it online at https://e-trademark.ige.ch. The application consists of a list of goods and/or services for which the trade mark is intended to be used as well as a representation of the trade mark. Following its registration, the trade mark is then published online at swissreg.

Detailed information on applying to register a trade mark in Switzerland.

Protection in other countries

Several options are available for registering a trade mark internationally:

• **Registering directly in a specific country**
  Bear in mind that the legal framework, application formalities and examination and decision-making procedures vary from country to country.

• **Madrid System**
  This application procedure makes it possible to extend trade mark protection granted under Swiss law to other contracting states or organisations. You must apply for international extension of protection through us.

  Detailed information on filing an application.

• **Several countries with one application**
  You can protect your trade mark in the entire EU territory with a community trade mark by filing one single trade mark application with the European Union Intellectual Property Office (EUIPO in Alicante, Spain). You can also apply to extend protection to EU countries under the Madrid System.

  We recommend that you discuss trade mark protection abroad and the best filing
strategie with a specialist.

Detailed information on international procedures.

Frequently asked questions

Here you can find the most frequently asked questions we receive from our customers about trade marks.

FAQs on trade mark basics

What is a trade mark?

A trade mark is foremost a sign or logo that can be used to distinguish the products and services of one company from those of another company. Imagine what it would be like if all of the products in a supermarket had no names. A trade mark is always connected to a particular product or service. Well-known trade marks include COCA COLA and TOBLERONE.

Who can register a trade mark?

In principle, any person or company can register a trade mark. If the person (or company) is domiciled abroad, an agent who is domiciled in Switzerland must be appointed to represent the trade mark applicant.

Can any sign be registered?

Basically, yes. At the time of the trade mark examination, the IPI decides whether a sign is suitable as a trade mark and whether it can be registered.

How can names/trade marks be protected?
Trade marks are signs that are suitable for differentiating the goods or services of one business from those of other businesses. Trade marks can be words, letters, numbers, icons or 3-D signs as well as combinations of elements or colour. Acoustic marks (jingles) are also possible. Registration is valid for ten years after the date of registration, and can be renewed every ten years indefinitely.

Why should I register my logo as a trade mark?

A trade mark is valuable capital and a lot of money and time is often invested in building up its market presence. No one should be able to imitate your trade mark: your trade mark advertises your products and services and distinguishes you from your competitors. The first person to register a trade mark has the legal advantage. If a competitor is ahead of you in trade mark registration, your marketing activities can be heavily limited or even ruled out. As the owner of a registered trade mark, you can license the trade mark, lease it or sell it. Trade marks such as SCHWEPPES and NIVEA are worth a lot of money.

What kind of trade marks can't be protected?

Simple and commonplace signs such as numbers and letters, indications for objects and descriptive elements, signs offensive to public laws of decency or misleading or illegal signs are all excluded from trade mark protection. National insignia and other official signs are also excluded. The confusability of a newly registered trade mark with an older trade mark belonging to a third party must be determined by the responsible court, not by the IPI.

How much does a trade mark cost?

The basic cost of protecting a trade mark in Switzerland is CHF 550. The protection is valid for ten years and can be renewed as often as you like. In other words, it costs CHF 55 per year. Additional costs can arise depending on how many different classes of products or services are included in the protection and if expedited processing is required (another CHF 400 for the "express fee").
<table>
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<th><strong>What is a company name?</strong></th>
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<tr>
<td>A company name is the title under which one or more persons conduct business. The company name gives a business its identity. Companies are registered in the Commercial Registry.</td>
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<th><strong>Since my company is registered in the Commercial Registry, does that also mean that I can register it as a trade mark?</strong></th>
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<td>No it doesn't. The Commercial Registry examination depends on other criteria than those used for trade mark examination. An entry in the Commercial Registry is no guarantee for the registerability of a trade mark.</td>
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<th><strong>Why should a company name also be protected as a trade mark?</strong></th>
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| • By entering a company name in the Commercial Registry, you can prohibit someone else from registering the same name for his company. The , however, only partially protects you from other people using your company name as a name for their **products**. In this case, trade mark protection is a sensible supplement to registration in the Commercial Registry.  
• If someone else registers your company name as a trade mark, you risk only being able to use it for your own products under restricted conditions. Early trade mark protection can prevent this situation from arising.  
• The geographic scope of protection is dependent on the form of the company. Trade mark protection is for all of Switzerland.  
• A commercial registration only protects the company name, not the graphic representation of it. Trade mark protection can also be used for logos. Further information on conflicting marks and which rights are usually the stronger can be found in our info sheet on conflicting marks in "Which sign has priority in the event of a conflict?" (in **German**, **French** and **Italian**)". |
When can the protected registration symbol ® be used in Switzerland?

The symbol of trade mark registration ® may only be applied to a trade mark if it has been legally registered as such in Switzerland, i.e. entered into the Swiss trade mark register. It is not obligatory to use the registered trade mark sign ® and in Switzerland it makes no difference to the owner's rights. However, it can alert other people to the fact that the trade mark is registered and prevent infringement cases. If someone uses the protected registration symbol for a trade mark that is not registered, they are liable for prosecution under the Unfair Competition Act.

FAQs on before you apply to register a trade mark

Can any sign be registered?

Basically, yes. At the time of the trade mark examination, the IPI decides whether a sign is suitable as a trade mark and whether it can be registered.

What are the necessary formalities for trade mark registration?

For registering a trade mark, an application, the mark itself and a list of the goods and services it represents must be submitted. It is then examined for admissability.

Who can register a trade mark?

In principle, any person or company can register a trade mark. If the person (or company) is domiciled abroad, an agent who is domiciled in Switzerland must be
Can I file a trade mark registration myself or do I need to have it done through a trade mark specialist?

As long as you are domiciled in Switzerland, you are not obligated to retain an agent or trade mark consultant. However, protecting a trade mark is usually a complicated and demanding process which is why we recommend retaining a specialist. A trade mark consultant is even more necessary when a conflict with another trademark arises (i.e., opposition proceedings).

Which signs are common property?

Signs which cannot identify products or services and which cannot be used to infer a particular originating producer by the public are considered common property. This includes signs such as numbers and letters as well as descriptive and advertising words. For example, SUPER cannot be used for a car trademark or IMPERMEABLE as a trademark for a raincoat.

When is it not possible to protect a sign?

When the name of the product or service, or their respective properties, are directly described by the mark (e.g., TOMATO for tomatoes), the mark cannot be registered for protection. The mark may also not be misleading in regards to the origins of the product. The name "Swiss" or some similar word that would indicate Switzerland, for example, can only be used in trademarks for products from Switzerland. The mark must also not be offensive to the general public: for instance, the name MOHAMED is not allowed for an alcoholic beverage.

Can I register a coat of arms?

Only public bodies may use the Swiss coat of arms. As a private individual, you
are not allowed to use it. For further information, please see the answer to the question "Can the Swiss coat of arms be used under the same conditions as those for the Swiss cross?" under the FAQs for indications of source.

Can I register the name of a country or region?

Geographical indications can principally not be registered alone as a trade mark. For example, the term SWISS cannot be registered for cheese because the name describes the origin of the cheese. Geographical indications, however, can be registered for protection if they are part of another mark which is eligible for protection, as long as the product or service for which it is registered actually originates from the indicated geographical area. Marks which include reference to a geographical area in a symbolic sense when considered with the product or service represented (such as BERMUDA POOLS for swimming pools) can be registered.

Read also FAQ - Indications of source.

Can musical melodies be registered as trade marks?

Entire songs or symphonies cannot be protected as trademarks. However, short tunes, so-called advertising jingles, may be registered at the Institute using the graphical representation of the tunes on paper (i.e., the musical notation). An example of a protected melody is the Olympic hymn.

Why do I need to have a trade mark search done? Doesn't the IPI automatically examine whether an identical or similar mark has already been registered at the time of application?

No. The Swiss Trade Mark Protection Act does not authorize the Institute to do such searches. We recommend that trade mark applicants protect themselves by having such a search done before they apply. Otherwise, the same mark can be registered over and over. It is up to the owner of these rights to assert them.
We recommend that you have a search done before you apply for trade mark registration in order to determine whether a similar or identical sign has already been applied for or registered. Such search services are offered by various specialists.

FAQs on applying to register a trade mark and the trade mark examination at the IPI

What is a national trade mark?

National marks are signs which are only registered in their country of origin and thus have no protection outside of that country. Swiss national trademarks are included in search results.

Is the IPI's decision regarding a trade mark final?

No. You can contest a negative decision with the Federal Board of Appeal for Intellectual Property. The IPI's decision is not binding for the judge. The court is completely free to examine the registerability of a mark if a third party has requested its annulment.

Once I've filled out the registration form, does that mean my mark is protected?

As soon as the correctly filled-out form is received by the IPI, your mark is under so-called provisional filing protection which lasts until it successfully passes the examination and is actually registered as a trade mark. In cases of a trade mark conflict, the decisive date is that of the application and not the actual registration.
How can a trade mark be registered abroad?

There are two possibilities:
* The first is to directly apply to the trade mark office in the country in which you wish to register. This usually requires a representative who is domiciled in the country. To register a European Union trade mark for protection in all of the member states of the EU, a Swiss applicant can go directly to the European Union Intellectual Property Office (EUIPO) in Alicante, Spain. However, an acceptable representative must be chosen before going to the EUIPO.
* The second possibility is to apply for an international registration. Switzerland is a member of the Madrid System for trademarks. By filing a single application with the Institute, you can extend trade mark protection to all of the Contracting Parties of the system through the World Intellectual Property Organization (WIPO). The Madrid System currently (as of March, 2016) counts 97 members. They include the United States of America and the European Union. Thus Swiss trade mark applicants also have the possibility to extend protection for their trademarks to the European Union using the Madrid System.

What is WIPO?


WIPO is the acronym for the World Intellectual Property Organization in Geneva.

What are EU European Union trade mark?

EU European Union trade mark are registered with the European Union Intellectual Property Office (EUIPO) in Alicante, Spain with effect in all countries of the European Union.
FAQs on post registration

What should I do when someone else wants to register the same trade mark as I do?

If the same mark is registered for the same or similar products and/or services, you can file an opposition at the Institute within three months from the date when the publication of the registration appears (e.g., at Swissreg or in the WIPO Gazette of International Marks). After the three months, you can file a claim at a civil court at any time to have the more recent mark annulled.

What should I do if I am accused of infringing someone else’s "older" trade mark and ordered to rescind mine?

First of all, you should request an extract of the trade mark register showing the trade mark of the party accusing you of infringement. The extract will clearly show the mark in question and you can more precisely judge the extent of infringement. Principally, you should retain a trade mark attorney who can inform you of the legal steps involved in such a challenge.

Should I monitor the trade mark register? How can I do this?

We recommend monitoring trademark registrations in order to be prepared to prevent another person from registering an identical or similar sign for a product that is the same or similar to yours. You can do this by consulting our database at www.swissreg.ch where new trademark registrations are regularly published. Domestic and international trademark monitoring searches can be ordered from a specialist.
Opposition proceedings are designed to provide a simple and cost-efficient way to quickly clear up questions of confusion between two trade marks. Three points need to be kept in mind: first, opposition must be filed within a certain time limit. Secondly, the fee of CHF 800 must also be paid within this time limit. Thirdly, the reason for the opposition must be briefly stated.

When is there a danger of two trade marks being considered confusing?

Most important is always the general impression of the marks: If both trademarks create the impression of belonging to the same company there is a risk of confusion. The risk is compounded if both are registered for the same or for similar goods and services classes.

Can a trade mark infringe with a corporate name?

Yes! Company names and trade marks can indeed overlap. That's why we recommend determining whether similar firms are already registered in the Commercial Registry. This search can be requested at the Federal Office of the Commercial Registry or from a search specialist.

What happens if I win the opposition proceedings?

When your trade mark is given priority in opposition proceedings, the registration of the more recent mark is annulled. The losing party is usually responsible for the proceeding costs (CHF 800) and for paying damages to you as the winning party. These damages are usually in the CHF 1,000 - 2,000 range.
Does the IPI give out information regarding the scope of protection for registered trade marks?

No. The IPI can only tell you if a sign is already registered as a trade mark. We cannot say anything about the scope of protection because, in case of opposition proceedings, the IPI has the final decision and can thus not take sides. Such questions are best dealt with by consulting a trade mark consultant.

If you are the owner of a trade mark for spirits products, what are you allowed to do with your trade mark, particularly with regard to advertising?

Using registered trade marks in advertisements for spirits is subject to the rules on advertising in the Alcohol Act (AlCa; SR 680) (available as PDF in German, French and Italian only). Registering a trade mark therefore does not entitle the owner to use the trade mark freely for marketing purposes. Article 42b AlCa states, in particular, that advertisements for spirits and spirit-containing beverages may only contain indications and representations that are directly related to the product and its properties. In addition, it is prohibited to use a spirit’s brand on packaging and consumer goods that do not contain any spirits or do not have any connection with them. You can find detailed information on the Alcohol Act's rules on advertising on the website of the Swiss Alcohol Board (SAB). It is possible to have your advertising projects checked prior to publication by the SAB free of charge.

The ten-year term of validity for my trade mark registration will soon expire. Can I renew protection?

Yes. Trade mark registration can be indefinitely renewed for ten-year periods. Renewal may be requested before the expiration date at the earliest, or, at the latest, six months after that date (late fee levied) using the renewal request form. You will be billed according to the schedule of fees. If a trade mark owner is not domiciled (privately or business) in Switzerland, the request must be
submitted through a representative residing in Switzerland.

DO DOCUMENTS & LINKS

Pocket Guide

Guide for Innovative Minds

Courses

Trade mark searches

"Swissness"

Indications of source

EUIPO

WIPO

Swissreg

Electronic application system "e-trademark"