

Trademarks - FAQs

Issued by the competent authority, the registered trademark is a protected distinctive sign which distinguishes the goods and services of a business from those of others.

➤ What is the object of the protection?

Protection relates to **registered signs**¹ within the **category/categories of products and/or services (classes)** for which they have been registered².

In general, **all signs capable of graphic representation** may be used as trademarks when they are used to distinguish the products or services of a business from those of the competitors.

Several kinds of individual trademarks¹ exist:

- **Word trademark:** a typewritten trademark (normal font), containing no specific graphic element, that protects the trademark itself, without any figurative element (words, combination of letters or numbers)
- **Semi-figurative or combined trademark:** protects the association of a word element and a visual element (e.g. graphics used to write this trademark, pictogram or logo in association with a name)
- **Figurative trademark:** protects the figurative element (logo)
- **Shape or three dimensional trademark:** protects a three dimensional shape (container, packaging, product)
- **Colour trademark**³: protects one or several colours, independently of the shape or configuration
- **Others**³: sound, olfactory, hologram, slogan, etc

Other categories of trademarks also exist!

- **Collective trademark:** distinguishes the products or services of a group of companies. A regulation identifies the group of companies authorized to use the trademark.
- **Guarantee mark:** sign used by several companies under the control of its owner to ensure that all products or services have certain properties (e.g. quality)

¹ *The categories of the above-mentioned trademarks correspond to legal provisions from numerous countries. However, there exist national differences in the categories of possible protection due to both legal provisions and case law.*

² *In certain countries, there exists a form of protection for the trademarks said to be “famous” which extends beyond the products and/or services similar to those for which they have been registered, and/or a form of protection of the signs which have not been registered.*

³ There exists national differences in the kind of trademarks which can be protected. In particular, three dimensional trademarks, colour trademarks and sound, olfactory, hologram trademarks cannot be protected as trademarks in certain countries. For instance, in Switzerland, olfactory, gustative or tactile trademarks cannot be registered since it is considered that they cannot be represented graphically.

➤ What are the criteria for registration?

To be eligible for registration, a sign must satisfy **the following basic criteria** in the class(es) for which an application has been filed⁴:

- ✓ Have a **distinctive character**
- ✓ Have a **non-descriptive character**
- ✓ Must **not be deceptive**: does not falsely describe the source, geographical origin, content or quality of the goods/services
- ✓ **Absence of conflict** with identical or similar trademarks which have been registered before for identical or similar products and/or services⁵
- ✓ Shall **not be contradictory to public order and morality**
- ✓ Shall **not be contradictory to law in force**

⁴ The above criteria of registration reflect the legal provisions of many countries. However, there are national differences in these legal provisions and in their application.

⁵ Many intellectual property offices (including the Swiss Institute and the OHIM (community trademarks)) do not verify, during examination of the trademark application, whether an identical or similar trademark has already been registered.

➤ What are the effect and extent of protection?

The owner of a trademark has the right to prohibit all third parties from using an identical or similar sign to designate identical or similar products or services if a risk of confusion exists in a country where his trademark has been registered, throughout the duration of the trademark validity⁶.

The **extent of protection** of a registered trademark is defined by **the sign and the list of products and/or services** (except for the “famous” trademarks⁶).

Principle of territoriality: A trademark has an effect only in the country in which it is registered and in force: outside this territory, the trademark is not protected.

⁶ The above rights reflect the legal provisions of many countries. However, there are national differences in these legal provisions and in their application.

In certain circumstances the owner of a trademark can prohibit third parties from using a sign in relation with products and/or services not similar to those for which the trademark has been registered (this is the case for the so-called “famous” trademarks).

➤ What is the duration of protection?

10 years (can be indefinitely extended by period of 10 years).

➤ How to mark the articles?

In most countries, the trademark law does not require that a filed/registered sign exhibits a specific mentioning. However, it is advisable to associate to a sign, the following mentioning:

- ✓ “TM” to indicate that the sign is used “as a trademark”, without necessarily having been the subject of a registration, for information⁷
- ✓ “®” to indicate that the trademark has been registered with the official register of the country where it is used or that it is the subject of an international registration having effect in this country

⁷ There are national differences in the legal value of the “TM” mentioning.

Any attempt to identify, in a country, a sign as being registered, while this is not the case, is punishable by law.

➤ Why protect a trademark?

Utility of a registered trademark:

- ✓ Allows to **distinguish the products and services** relative to those of competitors (provides visibility and supports a distinctive image)
- ✓ Provides a **tool for negotiation** with trading partners
- ✓ Constitutes a property right that can be transferred (assignment or licensing) Specific conditions apply to the registration of the new holder in certain protection systems (e.g. international filing)
- ✓ Is a **potential source of revenue** via licenses

➤ What is the difference a trademark, a business name and a domain name?

Business names (company names) and domain names are des **distinctive signs** like trademarks.

The company name is registered to the national (or Cantonal like in Switzerland) Trade Register, but its registration:

- ✓ Does not warrant that an earlier identical or similar trademark does not exist
- ✓ Provides geographically limited protection
- ✓ Offers a protection relatively limited against homonyms, notably in case of additions of figurative elements
- ✓ Requires lower level of distinctiveness as compared to trademarks.

The domain name is registered through accredited registrars (for example <http://www.switch.ch/>, for « .ch »), but the registration:

- ✓ Does not warrant that an earlier identical or similar trademark does not exist

- ✓ Offers a protection relatively limited against homonyms, notably in case of additions of figurative elements
 - ✓ **The content of the website is not always determining**
 - ✓ **Can rely on the principle « first come first served » only in limited circumstances and a transfer of domain name may be requested in case of conflict.**

The registration of the name as a trademark in parallel to the registrations of the corresponding domain name and/or the company name (if it fulfils the registration requirements) is highly recommended to benefit from a supplementary/complementary protection as a trademark, for preventing as much as possible any possible future conflicts.

➤ **How to file a first request for trademark registration ?**

A first request for trademark registration (so called « basic mark » or « priority founding ») needs to be filed at the qualified Intellectual Property Office for the chosen territory.

The choice of the Office for this first filing will depend on several criteria like the geographic use of the mark, the further filing strategy, the budget of the owner etc...

Since the existence of earlier registered identical or similar trademarks is not examined in some countries (including Switzerland and the European Community), **an availability search, before the filing of a priority founding trademark**, is recommended and will allow to define a strategy of protection and an optimized drafting of the list of products and services (see « Trademark searches »).

It is important that the owner accurately defines the products and/or services for in relation with which the trademark will be used. In order to ensure not only a scope of protection sufficiently large but also to reduce the costs associated to objections and potentially arising conflicts, the list of products and services should be drafted with utmost care. **An Intellectual Property Counsel** will be able to assist you in those steps of drafting and filing (see « What is the role for an Intellectual Property Counsel ? »).

➤ **How to extend protection in other countries ?**

Before the expiry of the six month period from the date of filing the basic trademark application, the owner has the possibility to extend the geographic protection **of the trademark**.

Various routes of protection are possible and certain examples (non-comprehensive) are represented on the attached **schemes**.

- ✓ **Fist filing of a Swiss application** ⁸ or a Community application (does not cover Switzerland);
- ✓ **« Extension » filings within six month period from the date of filing the first trademark application** though the filing of one or more request(s) national or regional for registration (for ex. France, Italy, Community or United States etc..) and/or an International application⁸ (covering 97 states on 15.04.2016).

Later designations of territories or a filing after the expiry of the priority date are still possible.

⁸ In a case where a geographic extension of the protection is envisioned through the filing of an international application, a basic filing in from an office of origin being part of the Madrid system is necessary. The Office of Origin is defined depending on whether the country where a protection is wished is a contracting party of the Protocol and/or Arrangement of Madrid. However, for any applicant with an effective and serious industrial or commercial establishment on the Swiss territory, an international application can be made on the basis of a Swiss basic trademark.

➤ When to file a trademark registration request ?

The choice of the appropriate moment for filing is important in the design of the protection strategy for the following reasons:

- ✓ **One should avoid a competitor registering** an identical company name/domain name that may acquire rapidly recognition or a trademark name identical or similar for the same classes of services or products, or that the sign becomes a common generic expression in the public domain and then loses its distinctive character;

BUT also

- ✓ **Measuring the impact of a premature filing** which would expose the sign to a risk of cancellation for non-use after the expiry of the grace period for non-use.

Due to the complexity of the procedures and the various possible routes of protection, it is advisable to seek assistance of an **Intellectual Property Counsel**, already in the initial phases of company/web site internet creation and business communication in relation with a sign, in order to put in place a solid and consistent strategy of protection.

➤ What are the criteria for maintaining the trademark registration ?

Use of the trademark⁹ : After the expiry of a grace period (5 years in the case of Switzerland)¹⁰, the owner has to use the registered trademark for the registered products and services, in the territory where the trademark is registered¹¹.

In absence of use of the trademark after this deadline, the owner is exposed to a possible **action in nullity by third parties on the ground of lack of use after the expiry of the grace period¹⁰**, potentially leading to the cancellation of the registration.

⁹The use requirements exposed above are legal provisions which are common to a lot of countries. Some national differences exist in the requirements regarding the use and the corresponding necessary proofs of use, though.

¹⁰ In many countries, including Switzerland the European Community, this grace period is of **five years** from the registration of the trademark. However, national differences exist in the legal provisions regarding the grace period.

¹¹ **Concerning the Community Trademark, the use of the trademark in only one country may be sufficient to satisfy the use requirements.**

Renewal of Registration : A trademark registration runs for a period of ten years from the filing date. In order to extend the registration (from 10 years to 1 years) one has to file a request of extension with payment of corresponding taxes¹².

¹²*In some countries, for example the United States, it is necessary to furnish proof of use of the trademark (or eventually acceptable reasons justifying the lack of use of the trademark de la marque) in order to extend the registration.*

➤ **Why the monitoring of a trademark is advisable ?**

In many countries, including Switzerland and the European Community, there is no examination of the registrability of a trademark in view of existing marks and this leads to the possible consequence of having two identical signs being registered for identical or similar products or services.

Most countries have legal provisions for an opposition procedure¹³, according to which the registration of a trademark is open to opposition from third parties during short period¹⁴ (for a Swiss or a Community Trademark, the opposition deadline is 3 months from the publication of the trademark). In general, the opponent needs to be the owner of earlier rights on a mark or another business sign

¹³.

If an opposition is formed, the opposition procedure can lead to¹³:

- ✓ the confirmation of the registration;
- ✓ a limitation of the list of the products and services ; or
- ✓ partial or entire revocation of the registration.

Therefore, the opposition procedure is a relatively simple and cost-efficient way to revoke or to limit the scope of protection of marks later filed, with which there is a possible risk of confusion or conflict.

¹³*The above provisions are common to many countries. However, there are national differences in those legal provisions and in their enforcement. Among others, in some countries, opposition is not possible.*

¹⁴*In many countries, the opposition deadline is from 1 to 3 months, from the publication of the mark, and this opposition period can occur (a) either following the end of the examination procedure by the competent authority – but before the registration of the mark (this is the case for a community trademark) – or (b) directly after the registration of the mark (this is the case in Switzerland). However, there are national differences in the procedures of opposition.*

It is the role and responsibility of the owner to monitor and defend its trademark vis-à-vis unlawful use by third parties. It is advisable to put in place a watching system for the regular monitoring of the newly registered trademarks or filed and a survey of the business activities in the field.

Since the deadline of lodging an opposition is short (three months in Switzerland) it is necessary to be informed of the publications of the trademarks that would be potentially problematic. This is why a regular monitoring is essential.

If the infringement of a mark by another later filed trademark is only noticed after the expiry of the opposition deadline, it remains the possibility to take a legal action

in front of an ordinary court¹⁵. The major drawbacks of this procedure are the costs rather high and the length of the procedure.

¹⁵ *There are national differences in the legal provisions and their enforcement.*

➤ **What is the role of an Intellectual Property Counsel ?**

His/her profile:

- ✓ Scientific/technical and legal training (qualification exam)
- ✓ Internal (Industry)/External (Private practice)
- ✓ Interacts with a network of national attorneys all over the world and with lawyers

His/her role:

- ✓ Informs and advises on Intellectual Property rights
- ✓ Guides clients to an appropriate protection (patent, trademark, design, etc.) and advises on a protection strategy
- ✓ Analyses the patentability of the invention, the state of the art and rights of third parties (freedom to operate)
- ✓ Drafts and files patent applications, as well as applications for registration of trademarks and designs, etc.
- ✓ Represents and advises the applicant on steps to take to obtain, defend and/or attack an Intellectual Property right (interaction with the competent Offices, foreign agents, and lawyers in case of litigation)
- ✓ Is in charge of the administrative management of the portfolio of filed/granted rights
- ✓ Play a part with assignments, licenses, due diligence, infringement, etc.

reuteler & cie SA

Patent and Trademark Attorneys

www.reuteler.net