

WATCHING YOUR TRADEMARK

You have filed your trademark in Switzerland and the Federal Institute of Intellectual Property (FIIP) has registered it. Each application is examined in accordance with the criteria laid down by law.

No checks are made as regards prior trademarks, with the result that if a third party files a registration application for the same trademark for similar products or services, the FIIP will also register that trademark despite your prior right.

Thus it is possible for **two identical trademarks** to be registered, without their respective owners being informed of the existence of the other trademark.

In order to reduce the drawbacks arising from this lack of check, the FIIP has provided a simple and relatively inexpensive opposition procedure for revoking or limiting the scope of protection of subsequent trademarks. In order to benefit from this procedure, steps must imperatively be taken within a time period of three months from the date of publication of the contentious trademark.

Given that the **duty to watch lies with the trademark owners**, it is important to set up a watch to be able to benefit from the opposition procedure that is open for only **3 months**.

Why watch your trademark?

Your trademark has been duly registered and you have used resources to get it known. Filing gives you an exclusive right to use the protected name, for the products and services associated with the name. You do not wish a third party to steal your rights and benefit from your commercial efforts and your renown to divert clients for his own profit, by playing on a likelihood of confusion with your company.

Enforcing your rights of course means you must be informed of actions that might affect them.

Who watches your trademark?

It is important first of all to note that trademark law can be infringed by the use of names in different forms, particularly in the form of:

- a corporate name
- a business sign
- an Internet domain name



- a distinctive sign affixed to a product.

A **corporate name** can infringe a trademark, because when a new company is registered at the Registry of Commerce, the search covers only corporate names and not trademarks. It is however possible to have a corporate name changed if it affects an existing trademark.

The use of a **business sign** or any other unregistered **distinctive sign** can also affect the trademark. Given that use is not subject to registration, the trademark owner is generally informed of any such infringement by his clientele or members of his distribution network.

When Internet **domain names** are registered, the registration agencies accept a new name if no strictly identical prior domain name exists. They do not, therefore, check for the existence of prior trademarks which the new domain name could harm.

In all of the aforementioned cases, failure to act within a determined short time period in no way alters the possibility of fighting trademark imitation. Detailed and frequent watching is not absolutely indispensable since it is possible to act at practically any time. The owner, his clients and his distribution network usually carry out this type of watching.

What should you do when you detect an infringement of your trademark rights?

The type of name (corporate name, domain name, ...) that conflicts with your trademark determines the type of action to be taken. If the trademark infringement consists of another filed trademark, two possible actions can be envisaged, depending upon the time period within which the infringement is spotted.

If the "offence" is spotted within three months of the date of publication of the contentious trademark, it is possible to file an **opposition** with the FIIP. This procedure is open solely to prior trademark owners and takes place entirely before the Institute. It is generally relatively quick and inexpensive.

The second possibility, which is accessible whatever the time period in which the offence is spotted, consists in instituting ordinary jurisdiction proceedings. These proceedings can be instituted at any time, independently of a prior opposition filing and, where appropriate, independently of the result of the opposition procedure. The major drawbacks of this solution are its cost and length, which are generally considerably greater than those of the opposition procedure.

In order to take advantage of the possibility of filing an opposition, it is therefore imperative to be informed of **trademark publications** that might raise a problem, within **three months** of their publication date. Thus, only watching can ensure that this time period is respected.

How much does trademark watching cost?

We can provide an estimate on request for watching in Switzerland or in other countries.



The trademarks identified are periodically transmitted, at a maximum frequency of once a month. We will let you know by means of a form which trademarks may give rise to a likelihood of confusion.

When you wish, you can ask us for a precise analysis of the chances of success of an opposition, for which we will provide an estimate on a case-by-case basis. Naturally, the decision to file an opposition is yours.

The expenses generated by any opposition are not included in the amounts indicated above.

We can also watch for you Internet domain names or business or corporate names.