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Federal Act on the Protection of Trade Marks and Indications of Source

(Trade Mark Protection Act, TmPA)

of 28 August 1992 (Status as of 1 July 2011)

The Federal Assembly of the Swiss Confederation,

on the basis of Articles 64 and 64^{bis} of the Federal Constitution¹, ²and having considered the Dispatch of the Federal Council dated 21 November 1990³,

decrees:

First Title: Trade Marks

Chapter 1: General Provisions

Section 1: Trade Mark Protection

Art. 1 Definition

¹ A trade mark is a sign capable of distinguishing the goods or services of one undertaking from those of other undertakings.

² Trade marks may, in particular, be words, letters, numerals, figurative representations, three-dimensional shapes or combinations of such elements with each other or with colours.

Art. 2 Absolute grounds for refusal

Excluded from trade mark protection are:

- a. signs that are in the public domain, except where they have become established as a trade mark through use for the goods or services for which they are being claimed.
- b. shapes that constitute the nature of the goods themselves or shapes of the goods or their packaging that are technically necessary.

AS **1993** 274

¹ [BS 1 3]. The provisions referred to now correspond to Art. 122 and 123 of the Federal Constitution of 18 April 1999 (SR **101**).

² Amended by Annex No 10 of the Civil Jurisdiction Act of 24 March 2000, in force since 1 Jan. 2001 (AS **2000** 2355; BBl **1999** 2829).

³ BBl **1991** I 1

- c. misleading signs;
- d. signs contrary to public policy, morality or applicable law.

Art. 3 Relative grounds for refusal

¹ Also excluded from trade mark protection are signs that are:

- a. identical to an earlier trade mark and are intended for the same goods or services;
- b. identical to an earlier trade mark and intended for similar goods or services such that a likelihood of confusion results.
- c. similar to an earlier trade mark and intended for the same or similar goods or services such that a likelihood of confusion results.

² An earlier trade mark is:

- a. a filed or registered trade mark that gives rise to a right of priority under this Act (Art. 6-8).
- b. a trade mark that is well known in Switzerland within the meaning of Article 6^{bis} of the Paris Convention for the Protection of Industrial Property of 20 March 1883 (Paris Convention)⁴ at the time of filing the sign referred to in paragraph 1.

³ The grounds for refusal under this Article may only be invoked by the proprietor of the earlier trade mark.

Art. 4 Registration in favour of the authorised user

Trade marks registered in the name of agents, representatives or other authorised users without the consent of the proprietor, or trade marks which remain entered in the Register after the withdrawal of such consent, are also not protected.

Section 2: Establishment of a Trade Mark Right; Priority**Art. 5** Establishment of a trade mark right

A trade mark right is established on entry in the Register.

Art. 6 Right of Priority

A trade mark right belongs to the person who first files the trade mark.

⁴ SR 0.232.01/.04

Art. 7 Priority under the Paris Convention

¹ Where a trade mark is first duly filed in another Member State of the Paris Convention⁵ or with effect in such a Member State, the applicant or successor in title may claim the date of the first filing for the filing of the same trade mark in Switzerland, provided the filing in Switzerland takes place within six months of the date of the first filing.

² The first filing in a state that grants reciprocity to Switzerland has the same effect as the first filing in a Member State of the Paris Convention.

Art. 8 Exhibition priority

Any person who exhibits goods or services bearing a trade mark at an official or officially recognised exhibition under the Convention of 22 November 1928⁶ Relating to International Exhibitions in a Member State of the Paris Convention⁷, may claim the opening date of the exhibition for filing the application provided that the trade mark is filed within six months of this date.

Art. 9 Declaration of priority

¹ Any person who claims priority under the Paris Convention⁸ or exhibition priority must file a declaration of priority and a priority document with the application.

² The claim is forfeited if the time limits and formal requirements laid down by the Ordinance are not complied with.

³ Registration of priority is merely a presumption in favour of the proprietor of the trade mark.

Section 3: Existence of a Trade Mark Right**Art. 10** Term of validity and renewal of registration

¹ A registration is valid for 10 years from the date of filing the application.

² A registration will be renewed for further periods of ten years if an application for renewal is submitted and the fees as set out in the Ordinance are paid.⁹

³ The application for renewal must be submitted to the Swiss Federal Institute of Intellectual Property (the IPI)¹⁰ within the last 12 months prior to the expiry of the term of validity, but not later than six months after its expiry.¹¹

⁵ SR 0.232.01/04

⁶ SR 0.945.11

⁷ SR 0.232.01/04

⁸ SR 0.232.01/04

⁹ Amended by Annex No 2 of the Federal Act of 24 March 1995 on the Statue and Tasks of the Swiss Federal Institute of Intellectual Property, in force since 1 Jan. 1996 (AS 1995 5050; BBl 1994 III 964).

4 ...¹²

Art. 11 Use of the trade mark

¹ A trade mark is protected if it is used in relation to the goods or services for which it is claimed.

² Use in a manner not significantly different from the registered trade mark and use for export purposes also constitute use of the trade mark.

³ Use of the trade mark with the consent of the proprietor is considered to be use by the proprietor himself.

Art. 12 Consequences of non-use

¹ Where the proprietor has not used the trade mark 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, he may no longer assert his right to the trade mark, unless there are proper reasons for non-use.

² If use of the trade mark is commenced or resumed after more than five years, the right to the trade mark is restored with effect from the original priority date, unless non-use of the trade mark has been invoked under paragraph 1 prior to its commencement or resumption of use.

³ Any person who invokes non-use of a trade mark is required to substantiate his claim; evidence of use is required to be provided by the proprietor of the trade mark.

Section 4: Rights Conferred by a Registered Trade Mark

Art. 13 Exclusive right

¹ A trade mark right confers on the proprietor the exclusive right to use the trade mark to identify the goods or services for which it is claimed and to dispose of it.

² The proprietor of a trade mark may prohibit others from using a sign that is excluded from trade mark protection under Article 3 paragraph 1, in particular, from:

- a. affixing the sign to goods or their packaging;
- b. offering goods, placing them on the market or stocking them for such purposes under the sign;
- c. offering or providing services under the sign;

¹⁰ The name of the administrative unit has been modified in application of Art. 16 para. 3 of the Publications Ordinance of 17 Nov. 2004 (SR **170.512.2**). This amendment has been applied throughout the text.

¹¹ Amended by No I of the Federal Act of 4 Oct. 1996, in force since 1 May 1997 (AS **1997** 1028; BBl **1996** II 1425).

¹² Repealed by Annex No 2 of the Federal Act of 24 March 1995 on the Statute und Tasks of the Swiss Federal Institute of Intellectual Property (AS **1995** 5050; BBl **1994** III 964).

- d. importing, exporting or carrying in transit goods under the sign;¹³
- e. using the sign on business papers, in advertising, or otherwise in the course of trade.

^{2bis} The proprietor of the trade mark may also assert the rights under paragraph 2 letter d if the import, export or transit of commercially manufactured goods is carried out for private purposes.¹⁴

³ The proprietor of the trade mark may also assert the rights under this Article against authorised users in terms of Article 4.¹⁵

Art. 14 Limitation concerning previously used signs

¹ The proprietor of a trade mark may not prohibit another person from continuing to use a sign to the same extent as already previously used prior to the filing of the application.

² This right to continued use may only be assigned together with the undertaking.

Art. 15 Famous trade marks

¹ The proprietor of a famous trade mark may prohibit others from using his trade mark for any type of goods or services if such use threatens the distinctiveness of the trade mark or exploits or damages its reputation.

² Rights acquired before the trade mark became famous remain unaffected.

Art. 16 Reproduction of trade marks in dictionaries and other reference works

Where a registered trade mark is reproduced in a dictionary, in another reference work or in a similar work without reference to its registration, the proprietor of the trade mark may require that the publisher, editor or distributor of the work include a corresponding reference, at the latest in a reprint.

Section 5: Modifications concerning Trade Mark Rights

Art. 17 Assignment

¹ The proprietor may assign his trade mark in whole or in part for the goods or services for which it has been claimed.

² The assignment is only valid if evidenced in writing. It is only effective in relation to third parties who are acting in good faith once it has been entered in the Register.

¹³ Amended by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BBl 2006 1).

¹⁴ Inserted by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BBl 2006 1).

¹⁵ Amended by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BBl 2006 1).

³ Actions under this Act may be brought against the previous proprietor up to the entry of the assignment in the Register.

⁴ Unless otherwise agreed, the assignment of an undertaking also includes the assignment of its trade marks.

Art. 17a¹⁶ Division of an application or registration

¹ The proprietor of a mark may at any time make a written request for the division of a registration or an application for registration.

² The goods and services are divided between the divisional applications or divisional registrations.

³ Divisional applications or registrations retain the filing date and priority date of the original application or original registration.

Art. 18 Licencing

¹ The proprietor of a trade mark may permit others to use the trade mark for the goods or services for which it is claimed, in whole or in part, and for the whole territory or a part of Switzerland only.

² The licence shall be entered in the Register at the request of one of the parties. It then becomes binding on any rights to the trade mark subsequently acquired.

Art. 19 Usufruct and pledge; compulsory enforcement

¹ A trade mark may be subject to usufruct, pledge or compulsory enforcement measures.

² Usufruct and pledges only have effect against third parties acting in good faith if they are entered in the Register.

Section 6: International Treaties

Art. 20

¹ ...¹⁷

² Where international treaties binding on Switzerland grant more extensive rights than this Act, such rights also apply to Swiss nationals.

¹⁶ Inserted by No 1 of the Federal Act of 4 Oct. 1996, in force since 1 May 1997 (AS **1997** 1028; BBl **1996** II 1425).

¹⁷ Repealed by No II 11 of the Federal Act of 20 March 2008 on the Formal Revision of Federal Legislation, with effect since 1 August 2008 (AS **2008** 3437; BBl **2007** 6121).

Chapter 2: Guarantee Marks and Collective Marks

Art. 21 Guarantee marks

¹ A guarantee mark is a sign that is used by several undertakings under the supervision of the proprietor of the mark and which serves to guarantee the quality, geographical origin, the method of manufacture or other characteristics common to goods or services of such undertakings.

² A guarantee mark may not be used for goods or services of the proprietor of the mark or of an undertaking with which he has close economic ties.

³ In return for equitable remuneration, the proprietor of the guarantee mark must allow any person to use it for goods or services that possess the common characteristics guaranteed under the regulations governing the use of the mark.

Art. 22 Collective marks

A collective mark is a sign of an association of manufacturing, trading or service undertakings which serves to distinguish the goods or services of the members of the association from those of other undertakings.

Art. 23 Regulations governing the use of guarantee/collective marks

¹ The applicant of a guarantee or collective mark must file regulations governing the use of the mark with the IPI¹⁸.

² The regulations for guarantee marks shall designate the common characteristics of the goods or services which the mark is intended to guarantee; they shall also provide for an effective control of the use of the mark and for appropriate sanctions.

³ The regulations for collective marks shall designate those undertakings that are entitled to use the mark.

⁴ The regulations may not be contrary to public policy, morality or applicable law.

Art. 24 Approval of the regulations

The regulations must be approved by the IPI. Approval will be granted if the requirements under Article 23 are fulfilled.

Art. 25 Unlawful regulations

Where the regulations do not fulfil or no longer fulfil the requirements of Article 23 and the proprietor of the mark does not remedy the situation within the time limit determined by the court, the registration of the mark becomes null and void on expiry of this time limit.

¹⁸ Term in accordance with No I of the Federal Act of 4 Oct. 1996, in force since 1 May 1997(AS 1997 1028; BBl 1996 II 1425). Account has been taken of this term throughout the text of this Act.

Art. 26 Use in contravention of the regulations

Where the proprietor of the mark tolerates repeated use of a guarantee or collective mark that infringes the main provisions of the regulations and he does not remedy the situation within the time limit determined by the court, the registration of the mark becomes null and void on expiry of this time limit.

Art. 27 Assignment and licencing

The assignment of a guarantee or collective mark and the grant of licences with respect to collective marks are only valid if entered in the Register.

Chapter 3: Registration of Trade Marks**Section 1: Registration Procedure****Art. 28** Filing

¹ Any person may file a trade mark application.

² When filing an application with the IPI, the following must be submitted:

- a. an application for registration with details of the name or company name of the applicant;
- b. a representation of the trade mark;
- c. a list of goods or services for which the trade mark is to be claimed.

³ When filing an application, the relevant fees prescribed in the Ordinance must be paid.¹⁹

⁴ ...20

Art. 29 Date of filing

¹ A trade mark is considered to have been filed once the documents referred to in Article 28 paragraph 2 have been submitted.

² If, after filing an application, a trade mark is replaced or essential elements of it are modified or if the list of goods or services is extended, then the date of filing is considered to be the day on which those modifications were submitted.

¹⁹ Amended by Annex No 2 of the Federal Act of 24 March 1995 on the Statute and Tasks of the Swiss Federal Institute of Intellectual Property, in force since 1 Jan. 1996 (AS 1995 5050; BBl 1994 III 964).

²⁰ Repealed by Annex No 2 of the Federal Act of 24 March 1995 on the Statute und Tasks of the Swiss Federal Institute of Intellectual Property 1996 (AS 1995 5050; BBl 1994 III 964).

Art. 30 Decision and registration

¹ The IPI shall dismiss an application for registration if it does not fulfil the requirements of Article 28 paragraph 2.

² It shall reject the application for registration if:

- a. it does not fulfil the formal requirements laid down in this Act or in the Ordinance;
- b. the prescribed fees have not been paid;
- c. absolute grounds for refusal exist;
- d. the guarantee or collective mark does not fulfil the requirements of Articles 21-23.

³ It shall register the trade mark if no grounds for refusal exist.

Section 2: Opposition Proceedings**Art. 31** Opposition

¹ The proprietor of an earlier trade mark may file an opposition to a registration on the basis of Article 3 paragraph 1.

² The opposition must be submitted in writing to the IPI with a statement of reasons within three months of publication of the registration. The opposition fee must also be paid within this time limit.

Art. 32 Providing *prima facie* evidence of use

If the applicant claims non-use of the earlier mark under Article 12 paragraph 1, the opposing party must provide *prima facie* evidence of the use of his trade mark or proper reasons for non-use.

Art. 33 Decision on opposition

If the opposition is justified, the registration shall be revoked in whole or in part; if this is not the case, the opposition shall be rejected.

Art. 34 Costs

With its decision on the opposition, the IPI shall determine whether and to what extent the costs of the successful party shall be compensated by the unsuccessful party.

Section 3: Cancellation of the Registration

Art. 35

The IPI shall cancel a trade mark registration in whole or in part if:

- a. the proprietor requests the cancellation;
- b. the registration has not been renewed;
- d. the registration has been declared null and void in a final court decision.

Section 4: ...

Art. 36²¹

Section 5: Register, Publications and Electronic Administrative Communication²²

Art. 37 Maintenance of the Register

The IPI shall maintain the Trade Mark Register.

Art. 38 Publications

¹ The IPI shall publish:

- a. the registration of trade marks (Art. 30 para. 3);
- b. the renewal of trade mark registrations (Art. 10 para. 2);
- c. the revocation of trade mark registrations (Art. 33);
- d. the cancellation of trade mark registrations (Art. 35);

² The Federal Council shall determine which additional entries in the Register are to be published.

³ The IPI shall determine the organ of publication.²³

Art. 39 Access to the Register; inspection of the files

¹ Any person may inspect the Register, obtain information on its contents and request extracts from it.

²¹ Repealed by Annex No 21 of the Federal Administrative Court Act of 17 June 2005, with effect from 1 Jan. 2007 (AS **2006** 2197; BBl **2001** 4202).

²² Amended by Annex No 4 of the Federal Act of 19 Dec. 2003 on Electronic Signatures, in force since 1 Jan. 2005 (AS **2004** 5085; BBl **2001** 5679).

²³ Amended by Annex No II 3 of the Designs Act of 5 Oct. 2001, in force since 1 July 2002 (AS **2002** 1456; BBl **2000** 2729).

² In addition, any person may inspect the files of a registered trade mark.

³ The Federal Council shall regulate the cases in which inspection of the dossier is permitted prior to the registration of a trade mark.

Art. 40²⁴ Electronic administrative communication

¹ The Federal Council may authorise the IPI to regulate electronic communication in accordance with the general provisions on the administration of federal justice.

² The dossier and the files may be maintained and stored in electronic form.

³ The Trade Mark Register may be maintained in electronic form.

⁴ The IPI may make its database accessible, particularly online, to third parties; it may demand remuneration for this service.

⁵ The IPI's publications may be produced in electronic form; the electronic version, however, is only authoritative if the data is exclusively published in electronic form.

Section 6: Further Processing for Missed Time Limits

Art. 41

¹ If the applicant or the rights holder fails to observe a time limit required by the IPI, he may file a request with the latter for further processing. Article 24 paragraph 1 of the Federal Act of 20 December 1968²⁵ on Administrative Procedure remains reserved.²⁶

² The request must be filed within two months of the applicant receiving notice of the expiry of the time limit, and at the latest within six months of expiry of the said time limit; within this time limit, the omitted act must be carried out in full and the fees as set out in the Ordinance paid.²⁷

³ If the request is approved, this will have the effect of restoring the situation that would have resulted from carrying out the act within the time limit.

⁴ Further processing is ruled out in the case of failure to observe:

- a. time limits for filing a request for further processing (para. 2);
- b. time limits for claiming priority under Articles 7 and 8;
- c. the time limit for filing opposition under Article 31 paragraph 2;

²⁴ Amended by Annex No 4 of the Federal Act of 19 Dec. 2003 on Electronic Signatures, in force since 1 Jan. 2005 (AS **2004** 5085, BBI **2001** 5679).

²⁵ SR **172.021**

²⁶ Amended by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS **2008** 2551; BBI **2006** 1).

²⁷ Amended by Annex No 2 of the Federal Act of 24 March 1995 on the Statute and Tasks of the Swiss Federal Institute of Intellectual Property, in force since 1 Jan. 1996 (AS **1995** 5050; BBI **1994** III 964).

d.²⁸ the time limit for filing an application for renewal under Article 10 paragraph 3.

Section 7: Representation

Art. 42²⁹

Any person who is party to an administrative procedure under this Act but is not domiciled or does not have a registered office in Switzerland must designate an address for service in Switzerland.

Section 8: Fees

Art. 43

¹ In addition to the cases referred to in this Act, fees are payable for official actions in response to specific requests.

² ...³⁰

Chapter 4:31 International Registration of Trade Marks

Art. 44 Applicable law

¹ This Chapter applies to international registrations under the Madrid Agreement Concerning the International Registration of Marks of 14 July 1967³² (the Madrid Agreement) and the Protocol of 27 June 1989³³ Relating to the Madrid Agreement Concerning the International Registration of Marks (the Madrid Protocol) that are done through the intermediary of the IPI or which have effect in Switzerland.

² The other provisions of this Act apply except where the Madrid Agreement, the Madrid Protocol or this Chapter provide otherwise.

Art. 45 Application for registration in the International Register

¹ It is possible to request the following through the intermediary of the IPI:

²⁸ Inserted by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BB1 2006 I).

²⁹ Amended by Annex No 1 of the Patent Attorney Act of 20 March 2009, in force since 1 July 2011 (AS 2011 2259; BB1 2008 407).

³⁰ Repealed by Annex No 1 of the Federal Act of 24 March 1995 on the Statute and Tasks of the Swiss Federal Institute of Intellectual Property (AS 1995 5050; BB1 1994 III 964).

³¹ Amended by No I of the Federal Act of 4 Oct. 1996, in force since 1 May 1997 (AS 1997 1028; BB1 1996 II 1425).

³² SR 0.232.112.3

³³ SR 0.232.112.4

- a. the international registration of a trade mark provided that Switzerland is the country of origin in accordance with Article 1 paragraph 3 of the Madrid Agreement³⁴, or Article 2 paragraph 1 of the Madrid Protocol³⁵;
- b. the modification of an international registration provided that Switzerland is the country of the proprietor of the trade mark in accordance with the Madrid Agreement or the Madrid Protocol;
- c. the international registration of an application provided that Switzerland is the country of origin in accordance with Article 2 paragraph 1 of the Madrid Protocol.

² The fees as set out in the Madrid Agreement, the Madrid Protocol and in the Ordinance must be paid for the international registration of a trade mark, an application for registration or the modification of an international registration.

Art. 46 Effect of international registration in Switzerland

¹ An international registration with effect in Switzerland has the same effect as the filing of an application with the IPI and registration in the Swiss Register.

² Such effect does not arise if and to the extent the internationally registered trade mark has been refused protection in Switzerland.

Art. 46a Conversion of an international registration into a national application for registration

¹ An international registration may be converted into a national application for registration if:

- a. the application is submitted to the IPI within three months of cancelling the international registration;
- b. the international registration and the national application for registration concern the same trade mark;
- c. the goods and services indicated in the application were also the actual goods and services covered by the international registration having effect in Switzerland;
- d. the national application for registration fulfils the other requirements laid down in this Act.

² Objections raised against the registration of trade marks filed in accordance with paragraph 1 are inadmissible.

³⁴ SR 0.232.112.3

³⁵ SR 0.232.141.4

Second Title: Indications of Source**Art. 47** Principle

¹ Indications of source are direct or indirect references to the geographical origin of goods or services, including references to their properties or the quality associated with their origin.

² Geographical names and signs that are not understood by the relevant public as indicating a certain origin of the goods or services are not considered indications of source within the meaning of paragraph 1.

³ It is prohibited to use:

- a. incorrect indications of source;
- b. designations that may be confused with an incorrect indication of source;
- c. a name, an address or a trade mark associated with goods or services of a different origin where this could be misleading.

⁴ Regional or local indications of source for services are considered to be correct if such services satisfy the criteria of origin for the country concerned as a whole.

Art. 48 Origin of goods

¹ The origin of goods is determined by the place of manufacture or by the origin of the base materials and components used.

² The fulfilment of additional conditions may also be required, namely compliance with the manufacturing principles or quality requirements that are customary or prescribed in the place concerned.

³ The criteria are determined in each individual case on the basis of their influence on the reputation of the goods concerned; where an indication of source corresponds to usage, it is presumed to be correct.

Art. 49 Origin of services

¹ The origin of services is determined by:

- a. the registered office of the person providing the service;
- b. the nationality of the persons exercising actual control over the business policy and management of the undertaking; or
- c. the domicile of the persons exercising actual control over the business policy and management of the undertaking.

² The fulfilment of additional conditions may also be required, namely compliance with the principles that are customary or prescribed for providing the service in question or the traditional ties of the person providing the service in question with the country of origin.

³ The criteria shall be determined in each individual case on the basis of their influence on the reputation of the services concerned; where an indication of source corresponds to usage, it is presumed to be correct.

Art. 50 Special provisions

Where the general interests of the economy or of individual sectors so require, the Federal Council may define in greater detail the requirements under which a Swiss indication of source may be used for specific goods or services. It shall first hear the Cantons and interested professional and trade associations.

Art. 51 Producer identification mark

Where the interests of a business sector so require, the Federal Council may prescribe that a producer identification mark be affixed to goods of that economic sector.

Third Title: Legal Protection

Chapter 1: Protection under Civil Law

Art. 52 Action for declaratory judgment

Any person who can demonstrate a legal interest may apply to the court for a declaratory judgement as to whether a right or legal relationship governed by this Act does or does not exist.

Art. 53 Action for assignment of a trade mark

¹ The plaintiff may bring an action for the assignment of the trade mark instead of a declaration of nullity of the trade mark registration if the defendant has usurped the trade mark.

² This right shall lapse two years after publication of the registration or after withdrawal of the proprietor's consent under Article 4.

³ If the court orders the assignment, then licences or other rights granted to third parties in the intervening period lapse; however, if they have used the trade mark commercially in Switzerland in good faith or have made special preparations for this purpose, these third parties are entitled to be granted a non-exclusive licence.³⁶

⁴ Any claims for damages remain reserved.³⁷

³⁶ Inserted by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BBl 2006 1).

³⁷ Inserted by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BBl 2006 1).

Art. 54 Notification of judgments

The courts shall provide the IPI with full official copies of the final judgments free of charge.³⁸

Art. 55 Action for performance

¹ Any person whose right to a trade mark or an indication of source is infringed or threatened may request the court:

- a. to prohibit an imminent infringement;
- b. to remedy an existing infringement;
- c.³⁹ to require the defendant to provide information on the origin and quantity of items in his possession that unlawfully bear the trade mark or the indication of source and to name the recipients and disclose the extent of any distribution to commercial and industrial customers.

² Actions brought under the Code of Obligations⁴⁰ for damages, satisfaction and handing over of profits in accordance with the provisions concerning agency without authority remain reserved.

^{2bis} An action for performance may be instituted only after the entry of the trade mark in the Register. Claims for damages may be made retroactively from the time at which the defendant obtained knowledge of the content of the application for registration.⁴¹

³ The use of a guarantee or collective mark contrary to the applicable regulations also constitutes an infringement of trade mark rights.

⁴ Any person who holds an exclusive licence is entitled to bring a separate action irrespective of the registration of the licence in the Register unless this is expressly excluded in the licence agreement. Any licensees may join an infringement action in order to claim for their own damages.⁴²

Art. 56 Right to bring action by associations and consumer organisations

¹ Actions under Article 52 and Article 55 paragraph 1 concerning the protection of indications of source may also be brought by:

- a. professional and trade associations authorised by their statutes to safeguard the economic interests of their members;

³⁸ Amended by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BB1 2006 1).

³⁹ Amended by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BB1 2006 1).

⁴⁰ **SR 220**

⁴¹ Inserted by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BB1 2006 1).

⁴² Inserted by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BB1 2006 1).

- b. organisations of national or regional importance dedicated by statute to the protection of consumers;

² Such associations and organisations are entitled to bring actions under Article 52 with respect to a guarantee or collective mark.

Art. 57 Forfeiture in civil proceedings

¹ The court may order the forfeiture of items which unlawfully bear a trade mark or an indication of source or of equipment, devices and other means that primarily serve their manufacture.⁴³

² The court decides whether the trade mark or indication of source is to be made unrecognisable or whether the items are to be rendered unusable, to be destroyed or to be used in a specific way.

Art. 58⁴⁴

Art. 59⁴⁵ Preliminary measures

¹ Any person requesting preliminary measures may, in particular, request that the court orders measures to:

- a. secure evidence;
- b. establish the origin of items unlawfully bearing a trade mark or indication of source;
- c. preserve the existing state of affairs;
- d. provisionally enforce claims for injunctive relief and remedy.

Art. 60 Publication of the judgment

The court may order, at the request of the successful party, that the judgment be published at the expense of the other party. The court determines the form and extent of publication.

⁴³ Amended by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS **2008** 2551; BBl **2006** 1).

⁴⁴ Repealed by Annex 1 No II 10 of the Civil Procedure Code of 19 December 2008, with effect from 1 Jan. 2011 (AS **2010** 1739; BBl **2006** 7221).

⁴⁵ Amended by Annex 1 No II 10 of the Civil Procedure Code of 19 December 2008, in force since 1 Jan. 2011 (AS **2010** 1739; BBl **2006** 7221).

Chapter 2: Criminal Provisions

Art. 61⁴⁶ Infringement of a trade mark right

¹ On complaint of the injured party, any person who wilfully infringes the trade mark right of another is liable to a custodial sentence not exceeding one year or a monetary penalty, if he:

- a. appropriates, counterfeits or imitates the trade mark of the other person;
- b. places goods on the market or provides services, or offers, imports, exports, carries in transit or advertises such goods or services under the appropriated, counterfeited or imitated trade mark.

² On complaint of the injured party, any person who refuses to provide information on the origin or quantity of the items in his possession that unlawfully bear the trade mark and to name the recipients and disclose the extent of distribution to commercial and industrial customers is also liable to the same penalties.

³ If the offender acts for commercial gain, he shall be prosecuted *ex officio*. The penalty is a custodial sentence not exceeding five years or a monetary penalty. The custodial sentence shall be combined with a monetary penalty.

Art. 62 Fraudulent use of trade marks

¹ On complaint of the injured party, any person who commits any of the following acts is liable to a custodial sentence not exceeding one year or a monetary penalty:⁴⁷

- a. unlawfully labels goods or services with the trade mark of another person in order to mislead and thereby give the impression that the goods or services are original goods or services;
- b. offers or places goods or services on the market as original goods or services, or offers or provides original services that unlawfully bear the trade mark of another;

² If the offender acts for commercial gain, he shall be prosecuted *ex officio*. The penalty is a custodial sentence not exceeding five years or a monetary penalty. The custodial sentence shall be combined with a monetary penalty.⁴⁸

³ Any person who imports, exports, carries in transit or stocks goods that he knows are intended for fraudulent use in the course of trade is liable, on complaint of the injured party, to a fine of up to 40,000 francs.⁴⁹

⁴⁶ Amended by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BBl 2006 1).

⁴⁷ Amended by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BBl 2006 1).

⁴⁸ Amended by Annex No 3 Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BBl 2006 1).

⁴⁹ Amended by Annex No 3 Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BBl 2006 1).

Art. 63 Use of a guarantee or collective mark contrary to the regulations

¹ On complaint of the injured party, any person who wilfully uses a guarantee or collective mark in a manner contrary to the regulations is liable to a custodial sentence not exceeding one year or a monetary penalty.⁵⁰

² On complaint of the injured party, any person who refuses to provide information on the origin of items in his possession that bear a guarantee or collective mark contrary to the regulations, is also liable to the same penalties.

³ Where only minor regulation provisions are concerned, a penalty may be dispensed with.

⁴ If the offender acts for commercial gain, he shall be prosecuted *ex officio*. The penalty is a custodial sentence not exceeding five years or a monetary penalty. The custodial sentence shall be combined with a monetary penalty.⁵¹

Art. 64 Use of incorrect indications of source

¹ On complaint of the injured party, any person who wilfully commits any of the following acts is liable to a custodial sentence not exceeding one year or a monetary penalty:⁵²

- a. uses an incorrect indication of source;
- b. uses a designation that can be confused with an incorrect indication of source;
- c. creates a risk of deception by using a name, an address or a trade mark associated with goods or services of a different origin.

² If the offender acts for commercial gain, he will be prosecuted *ex officio*. The penalty is a custodial sentence not exceeding five years or a monetary penalty. The custodial sentence shall be combined with a monetary penalty.⁵³

Art. 65 Offences concerning the producer identification mark

Any person who wilfully infringes the regulations concerning the producer identification mark shall be liable to a fine of up to 20,000 francs.

Art. 65a⁵⁴ Non-punishable acts

Acts under Article 13 paragraph 2^{bis} are not punishable.

⁵⁰ Amended by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BBl 2006 1).

⁵¹ Amended by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BBl 2006 1).

⁵² Amended by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BBl 2006 1).

⁵³ Amended by Annex No 3 Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BBl 2006 1).

⁵⁴ Inserted by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BBl 2006 1).

Art. 66 Suspension of proceedings

¹ The court may suspend criminal proceedings if the person under investigation institutes civil proceedings for the nullity of the trade mark registration.

² If the person under investigation pleads the nullity of the trade mark registration in criminal proceedings, the court may set an appropriate time limit for him to assert such nullity in civil proceedings.

³ The limitation period for prosecution is suspended during the stay of proceedings.

Art. 67 Offences committed within a business

Articles 6 and 7 of the Federal Act of 22 March 1974⁵⁵ on Administrative Criminal Law apply to offences committed within a business by subordinates, agents or representatives.

Art. 68⁵⁶ Forfeiture in criminal proceedings

Article 69 of the Swiss Criminal Code⁵⁷ applies; the court can order the forfeiture of an item which unlawfully bears a trade mark or an indication of source in its entirety.

Art. 69 Competence of the cantonal authorities

Criminal prosecution is a matter for the cantonal authorities.

Chapter 3: Assistance provided by the Customs Administration**Art. 70**⁵⁸ Notification of suspicious consignments

¹ The Customs Administration is authorised to notify the proprietor of the trade mark, the person entitled to use an indication of source or a professional or trade association entitled to institute proceedings under Article 56 if there is any suspicion of the imminent import, export or transit of goods that unlawfully bear a trade mark or an indication of source.

² In such cases, the Customs Administration is authorised to withhold the goods for three working days, in order that the proprietor of the trade mark, the person entitled to use the indication of source or a professional or trade association entitled to institute proceedings under Article 56 may file an application under Article 71.

⁵⁵ SR 313.0

⁵⁶ Amended by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BBl 2006 1).

⁵⁷ SR 311.0

⁵⁸ Amended by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BBl 2006 1).

Art. 71 Application for assistance

¹ If the proprietor of the trade mark, the licensee entitled to institute proceedings, the person entitled to use the indication of source or a professional or trade association entitled to institute proceedings under Article 56 has clear indications of the imminent import, export or transit of goods that unlawfully bear a trade mark or an indication of source, they may request the Customs Administration in writing to refuse the release of the goods.⁵⁹

² The applicant must provide all the information available to him that is necessary for the Customs Administration's decision; this includes a precise description of the goods.

³ The Customs Administration shall make the final decision on the application. It may charge a fee to cover the administrative costs.

Art. 72⁶⁰ Withholding of goods

¹ If the Customs Administration, as a result of an application under Article 71 paragraph 1, has reasonable grounds to suspect that certain goods intended for import, export or transit unlawfully bear a trade mark or an indication of source, then it shall notify the applicant and the declarant, holder or owner of the goods accordingly.

² It shall withhold the goods for a maximum of ten working days from the time of notification pursuant to paragraph 1, so that the applicant may obtain preliminary measures.

³ Where justified by circumstances, it may withhold the goods for a maximum of ten additional working days.

Art. 72a⁶¹ Samples

¹ While the goods are being withheld, the Customs Administration is authorised to hand over or deliver to the applicant, on request, samples for examination or to permit the applicant to inspect the goods being withheld.

² The samples are collected and delivered at the expense of the applicant.

³ They must be returned after the examination has been carried out, if this is reasonable. If samples are retained by the applicant, they are subject to the provisions of customs legislation.

⁵⁹ Amended by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BBl 2006 1).

⁶⁰ Amended by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BBl 2006 1).

⁶¹ Inserted by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BBl 2006 1).

Art. 72b⁶² Safeguarding of manufacturing and trade secrets

¹ At the same time as notification is made in accordance with Article 72 paragraph 1, the Customs Administration shall inform the declarant, holder or owner of the goods of the possible handover of samples or the opportunity to inspect them in accordance with Article 72a paragraph 1.

² The declarant, holder or owner may request to be present at the inspection in order to safeguard his manufacturing or trade secrets.

³ The Customs Administration may refuse to hand over samples on reasoned request from the declarant, holder or owner.

Art. 72c⁶³ Application for destruction of the goods

¹ When making an application under Article 71 paragraph 1, the applicant may submit a written request to the Customs Administration to destroy the goods.

² If an application for destruction is made, the Customs Administration shall notify the declarant, holder or owner of the goods accordingly as part of the notification made under Article 72 paragraph 1.

³ The application for destruction does not result in the time limits for obtaining preliminary measures under Article 72 paragraphs 2 and 3 being extended.

Art. 72d⁶⁴ Consent

¹ The destruction of the goods requires the consent of the declarant, holder or owner.

² Consent is deemed to be given if the declarant, holder or owner does not expressly object to the destruction within the time limits under Article 72 paragraphs 2 and 3.

Art. 72e⁶⁵ Evidence

Before the destruction of the goods, the Customs Administration shall remove samples and hold them in safekeeping as evidence in any actions for damages.

Art. 72f⁶⁶ Damages

¹ If the destruction of the goods proves to be unjustified, the applicant is exclusively liable for the resultant loss.

⁶² Inserted by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BB1 2006 1).

⁶³ Inserted by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BB1 2006 1).

⁶⁴ Inserted by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BB1 2006 1).

⁶⁵ Inserted by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BB1 2006 1).

⁶⁶ Inserted by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BB1 2006 1).

² If the declarant, holder or owner has given express written consent for the destruction, no claims for damages may be made against the applicant if the destruction later proves to be unjustified.

Art. 72g⁶⁷ Costs

¹ The destruction of the goods is carried out at the expense of the applicant.

² The decision about the costs of collecting and safekeeping samples under Article 72e are decided by the court in connection with the assessment of claims for damages in accordance with Article 72f paragraph 1.

Art. 72h⁶⁸ Accountability statement and damages

¹ If it is anticipated that withholding the goods may lead to a loss being incurred, the Customs Administration may make the withholding of the goods dependent on the applicant providing them with an accountability statement. As an alternative to this statement and where justified by circumstances, the Customs Administration may request the applicant to provide appropriate security.

² The applicant is liable for any losses incurred from withholding the goods and from collecting the samples if preliminary measures are not ordered or prove to be unjustified.

Fourth Title: Final Provisions

Chapter 1: Implementation

Art. 73

The Federal Council shall enact the implementation provisions.

Chapter 2: Repeal and Amendment of Federal Law

Art. 74 Repeal of current legislation

The Federal Act of 26 September 1890⁶⁹ on the Protection of Factory and Trade Marks, Indications of Source of Goods and Industrial Labelling is repealed. However, Article 16bis paragraph 2 remains applicable until the entry into force of Article 36 of this Act.

⁶⁷ Inserted by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BBl 2006 1).

⁶⁸ Inserted by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS 2008 2551; BBl 2006 1).

⁶⁹ [BS 2 845; AS 1951 903 Art. 1, 1971 1617, 1998 1776 Annex No I let. e]

Art. 75 Amendment of current legislation

1. and 2. ...⁷⁰

3. The expressions “factory and trade marks” shall be replaced by “trade marks” in all enactments; the exception shall be Articles 1 and 2 of the Federal Act of 5 June 1931⁷¹ on the Protection of Public Coats of Arms and other Public Signs. The enactments affected shall be amended at the next possible opportunity.

Chapter 3: Transitional Provisions**Art. 76** Filed or registered trade marks

¹ Trade marks that have already been filed or registered upon entry into force of this Act are subject to the new law from that date.

² By way of derogation from paragraph 1, the following provisions apply:

- a. priority is governed by the previous law.
- b. grounds for refusing applications for registration, with the exception of absolute grounds for refusal, are governed by the previous law.
- c. oppositions to the registration of trade marks already filed on entry into force of this Act are not admissible;
- d. the validity of a registration terminates on expiry of the time limit applicable under the previous law; up to such time, it may be renewed at any time.
- e. the first renewal of the registration of a collective mark is subject to the same formal requirements as those for filing.

Art. 77 Trade marks previously not registrable

If, on entry into force of this Act, applications are pending for the registration of trade marks excluded from registration under the previous law, but not under the new law, the date of entry into force shall be considered the filing date.

Art. 78 Priority of use

¹ Any person who first used a trade mark prior to the entry into force of this Act on goods or their packaging or to identify services, has priority over the first applicant on condition that he files the mark within two years of entry into force of this Act and at the same time states the date on which use of the trade mark commenced.

² ...⁷²

⁷⁰ These amendments may be consulted under AS **1993** 274.

⁷¹ SR **232.21**

⁷² Repealed by No II 11 of the Federal Act of 20 March 2008 on the Formal Revision of Federal Legislation, with effect since 1 August 2008 (AS **2008** 3437; BBl **2007** 6121).

Art. 78a⁷³ Right to bring action by licensee

Article 55 paragraph 4 and Article 59 paragraph 5 only apply to licence agreements that have been concluded or confirmed after the Amendment to this Act dated 22 June 2007 enters into force.

Chapter 4: Referendum and Commencement

Art. 79

¹ This Act is subject to an optional referendum.

² The Federal Council shall determine the commencement date.

Commencement date: all provisions with the exception of Art. 36: 1 April 1993⁷⁴

Art. 36: 1 January 1994⁷⁵

⁷³ Inserted by Annex No 3 of the Federal Act of 22 June 2007, in force since 1 July 2008 (AS **2008** 2551; BBl **2006** 1).

⁷⁴ Federal Council Decree of 23 Dec. 1992

⁷⁵ Ordinance of 26 April 1993 (AS **1993** 1839)

