The new cancellation procedure in the Trade Mark Protection Act

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On 1 January 2017 the new regulations on the cancellation procedure entered into force (art. 35a – 35c of the Trade Mark Protection Act "TmPA"). Now any person can file a request for the cancellation of a trade mark on the grounds of non-use (art. 12 para. 1 TmPA).

1. The previous cancellation procedure

Previously, the Swiss Federal Institute of Intellectual Property ("IPI") cancelled a trade mark registration in whole or in part from the register if (i) the owner requested the cancellation, (ii) the registration was not renewed or (iii) the registration was declared null and void by a final court decision (art. 35 former TmPA).

Third parties had no opportunity to file a request with the IPI for the cancellation of a registered but unused trade mark. To achieve the cancellation of such a trade mark, an action for cancellation had to be filed before a civil court.

2. The new cancellation procedure

As of 1 January 2017, anyone has the possility to file a request for the cancellation of a trade mark in whole or in part on the grounds of non-use pursuant to art. 12 para. 1 TmPA with the IPI. Such unused trade marks remain formally registered in the trade mark register without having an actual legal basis.

1. In this context, "non-use" (cf. art. 12 para. 1 TmPA) means that a trade mark owner may no longer assert his right to the trade mark if he 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 follow-ing the expiry of the unclaimed opposition period or upon conclusion of opposition proceedings, i.e. during the grace period, for the identification and individualisa-tion of his products in commercial trade, unless he can assert important grounds for such non-use (art. 35a TmPA).

2. The new cancellation procedure is an administrative procedure that entails less effort and above all lower costs than an action for cancellation before a civil court. Now third parties

can challenge such trade marks through a relatively simple administrative procedure before the IPI and, if they successfully and credibly assert the non-use of these trade marks, cause them to be cancelled in the trade mark register.

3. The request may be filed at the earliest, if no opposition has been filed, five years following the expiry of the opposition period or in the event of opposition proceedings, five years after the conclusion of these opposition proceedings (art. 35a para. 2 TmPA). Special proof of interest, i.e. the assertion of an interest worthy of protection, is not required. The applicant must show credible non-use of the trade mark (art. 35b para. 1 lit. a TmPA) for which suitable evidence must be submitted to the IPI. In view of the summary nature of the proceedings such evidence has to be provided in written form. The standard of evidence for "credibility" is achieved if the fact to be shown as credible appears probable.

4. On the other side, a trade mark owner may defend his trade mark by challenging the grounds and the evidence submitted by the applicant on the non-use of his trade mark. However, as the success of such a course of action cannot be foreseen, the trade mark owner should, first and foremost, credibly show that the challenged trade mark is used in a right-preserving way or provide important reasons for non-use (e.g. government regulations, import regulations) to ensure that the request for cancellation is rejected. To achieve the protection of the trade mark for the goods or services for which registration is sought, the trade mark owner must be able to credibly show – with the aid of the evidence presented (labelled products, advertising material, sector surveys etc.) – that he actually used his trade mark in relation to the goods or services for which registration is sought.

5. The request for the cancellation of a trade mark is considered filed only once the respective fee has been paid (art. 35a para. 3 TmPA). As this is supposed to be an inexpensive procedure, the fee currently amounts to CHF 800. Consequently, the costs are much lower compared with the previous cancellation procedures before the civil courts. If the trade mark is completely cancelled, i.e. if the trade mark owner loses the case completely, he must reimburse the fee for the cancellation to the applicant. It is also possible that a party’s lawyer’s fees are awarded in this procedure.

6. Details of the procedure (e.g. form/content of the request, written correspondence) are defined in the new provisions of the Trade Mark Protection Ordinance, Art. 24a -24e.

3. Recommendations for trade mark owners

It is assumed that trade marks will be challenged more frequently on account of the new, simpler administrative procedure, particularly in view of the fact that costs and duration of the procedure will probably no longer represent an obstacle. After the expiry of the grace period of five years granted to the trade mark owners, those are thus under greater pressure to actually use the trade marks entered in the trade mark register in a right-preserving way, especially in connection with the goods and services for which these were claimed or, if neces-sary, to adjust the trade marks. This should already be taken into account when registering a trade mark and describing the list of goods and services. Therefore, only goods and services should be registered that are actually offered and identified by the trade mark owner. In addition, we recommend that from the time of registration, respectively from the first use onwards, the use of the trade mark is documented, respectively evidence is collected.

Löschungsverfahren Marken 2017

- **Since 1 January 2017 there is a new cancellation procedure for registered but unused trademarks.**
- **Now anyone can request the cancellation of such a trademark with the IPI.**
- **Owners of earlier trademarks should consider how they can use their trademarks in a right-preserving way.**

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