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# The Legal 500 Country Comparative Guides

## Switzerland

# INTELLECTUAL PROPERTY

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This country-specific Q&A provides an overview of intellectual property laws and regulations applicable in Switzerland.

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## SWITZERLAND

# INTELLECTUAL PROPERTY



**1. What different types of intellectual property rights exist to protect: (a) Inventions (e.g. patents, supplementary protection certificates, rights in trade secrets, confidential information and/or know-how); (b) Brands (e.g. trade marks, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin, geographical indications, traditional speciality guarantees); (c) Other creations, technology and proprietary interests (e.g. copyright, design rights, semiconductor topography rights, plant varieties, database rights, rights in trade secrets, confidential information and/or know-how).**

- a. **Inventions (e.g. patents, supplementary protection certificates, rights in trade secrets, confidential information and/or know-how);** According to the Federal Act on Patents for Inventions (PatA), patents for inventions are granted for new inventions applicable in industry. Anything that is obvious having regard to the state of the art is not patentable as an invention. Certain inventions are excluded from patentability, such as gene sequences, methods of medical treatment or mere computer programs. In addition, on application and subject to statutory conditions, supplementary protection certificates can be granted for the active ingredients or combination of active ingredients of medicinal products. Under Swiss law, protection of an invention as a utility model is not available and the Federal Council (the Swiss government) recently abandoned its plan to introduce a utility model as part of the partial revision of the PatA that is currently underway. No exclusive intellectual property rights are granted to

trade secrets or other confidential information and know-how. In case of unauthorized disclosure or exploitation of such information, contractual provisions, unfair competition law and/or criminal law may provide protection.

- b. **Brands (e.g. trade marks, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin, geographical indications, traditional speciality guarantees);** According to the Federal Act on the Protection of Trade Marks and Indications of Source (TmPA), distinctive signs may be protected as trademarks, provided they are neither misleading nor contrary to public policy, morality or applicable law. The TmPA also provides for the protection of so-called guarantee marks and collective marks. A guarantee mark is a sign that is used by several undertakings and which serves to guarantee the quality, geographical origin, the method of manufacture or other characteristics common to goods or services of such undertakings. 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.

Finally, the TmPA provides for specific provisions regarding the protection of geographical indications (PGIs) and designations of origin (PDOs).

In addition, under the Federal Act against Unfair Competition (UCA) signs are protected against measures of third parties that may cause confusion or are considered as an act of passing-off.

- c. **Other creations, technology and proprietary interests (e.g. copyright, design rights, semiconductor topography**

**rights, plant varieties, database rights, rights in trade secrets, confidential information and/or know-how).** According to the Federal Act on Copyright and Related Rights (CopA), literary and artistic intellectual creations with individual character may be protected as works by copyright. Computer programs, i.e. software, is mainly protected by copyright in Switzerland. The CopA also provides for protection of related rights, i.e. rights of performers, phonogram and audio-visual fixation producers and broadcasting organisations. According to the Federal Act on the Protection of Designs (DesA), the design of products or parts of products that is characterised, in particular, by the arrangement of lines, surfaces, contours or colours or by the materials used may be protected under the DesA, provided that it is new and has individual character.

Three-dimensional structures in the field of semiconductors can be protected as topographies under the Federal Act on the Protection of Topographies of Semiconductor Products (ToA). Plant varieties and their designations are protected by the Federal Act on the Protection of New Varieties of Plants.

No exclusive intellectual property rights are granted to trade secrets or other confidential information and know-how. In case of unauthorized disclosure or exploitation of such information, contractual provisions, unfair competition law and/or criminal law may provide protection.

**2. What is the duration of each of these intellectual property rights? What procedures exist to extend the life of registered rights in appropriate circumstances?**

Patents are protected for a maximum of 20 years from the filing date of the patent application. The term of protection of a supplementary protection certificate takes effect on expiry of the maximum term of the patent (20 years) for the active ingredient or combination of active ingredients expires, and lasts for up to 5 years. Paediatric supplementary protection certificates are granted for a period of 6 months from the expiry of the longest term of the patent.

Trademarks are protected 10 years from the date of

filing the relevant application. Protection can then be renewed indefinitely for further 10 years periods by filing (i) a respective request to the Federal Institute of Intellectual Property ("IPI") and (ii) payment of the respective renewal fee.

Domain names are to be renewed annually (without maximum limits) by paying the registration fee.

Designs are protected 5 years from the date of filing the relevant application. Protection can then be renewed for further 4 periods of 5 years each (total possible protection period for designs is 25 years) by filing (i) a respective request to the Federal Institute of Intellectual Property ("IPI") and (ii) payment of the respective renewal fee.

Creations are protected under the CopA as soon as they are created (regardless of their physical fixation). The protection of works expires 70 years after the death of the author (exceptions: software, which expires 50 years after the death of the author and photographic depictions and depictions of three-dimensional objects produced by a process similar to that of photography if the depictions do not have individual character; which expires 50 years after production). In the case of joint ownership and to the extent that the contributions cannot be separated, the death of the last surviving co-author is the relevant date. If the author is unknown, protection expires 70 years after the publication of the work or, if it was published in parts, 70 years after the publication of the last part.

A topography is registered if the application documents are correct and the application fee is paid. The term of protection for a registered topography is then usually 10 years. In addition, topographies are automatically protected for two years after the day on which the topography was first distributed independent of a registration.

After the granting of the right, the plant variety protection is valid for 30 years for vines and tree species, and for 25 years for all other species, provided that the annual fees are paid.

**3. Who is the first owner of each of these intellectual property rights and is this different for rights created in the course of employment or under a commission?**

Provided that the respective requirements for protection are met, the first authorized owner is usually the person creating the intellectual property right, e.g. the creator (copyright), the inventor (patent) or the designer

(designer). Regarding trademarks and domain names ownership is established by registration.

The following applies in the employment relationship:

- The copyright belongs to the employee who created the work, but is transferred to the employer to the extent covered by the specific purpose of the employment contract. In case a computer program has been created under an employment contract in the course of discharging professional duties or fulfilling contractual obligations, the employee is entitled to ownership, but the employer alone shall be entitled to exercise the exclusive rights of use.
- Inventions and designs produced by the employee alone or in collaboration with others in the course of his work for the employer and in performance of his contractual obligations belong to the employer, whether or not they may be protected. Furthermore, the employer may reserve the right to acquire inventions and designs produced by the employee in the course of his work but not in performance of his contractual obligations (the employee who produces such an invention or design must notify the employer thereof in writing) by written agreement. In this case, the employer must pay the employee a separate, appropriate remuneration.

#### 4. Which of the intellectual property rights described above are registered rights?

Patents, supplementary protection certificates, designs, trademarks, topography rights (not in every case, cf. question 2 above), plant varieties, PDOs/PGIs and domain names.

#### 5. Who can apply for registration of these intellectual property rights and, briefly, what is the procedure for registration?

In principle, any natural or legal person may apply for registration of IP rights (exceptions regarding PDOs/PGIs and .swiss-domains are set out below).

To register a patent, the applicant must file a patent application with the IPI, which includes a patent claim, technical drawings, an abstract and the technical documents. The IPI first checks whether the formal requirements are met. If there are deficiencies, the applicant is given a period of time to remedy them. If he does not remedy the deficiencies, the application is

rejected. The patent application is published 18 months after filing or, if applicable, after the priority date. The IPI conducts a formal examination, during which patent experts examine the technical content of the application and point out possible deficiencies to the owner. The novelty and inventive step of the invention are not examined by the IPI. If there are no deficiencies or if they have been remedied within a certain period, the patent is granted. In addition, supplementary protection certificates for patented and approved products can be applied for within 6 months after approval for marketing in Switzerland as a medicinal product or after grant of the patent (if later than first approval).

A design is considered filed when an application for registration is submitted to the IPI. The application must contain a request for registration and an illustration suitable for reproduction. Collective applications are also possible. If the IPI acts on the application for deposit, the fees must be paid and the IPI performs a formal examination. In particular, it does not examine whether the design meets the protection requirements of novelty and individual character or whether the features of the design are exclusively technical.

For trademarks, the applicant must file an application with the IPI containing mainly a representation of the sign, the goods and/or services designated, the name of the owner. In addition, an application fee must be paid. Collective marks can only be registered by an association of production, trade or service companies. Likewise, only a representative group can register a geographical mark. After payment of the registration fee by the applicant, the IPI examines formal requirements and whether absolute grounds for refusal exist. If the IPI considers the requirements to be fulfilled, the trademark is registered. If the application shows deficiencies, it issues an objection and grants the applicant an extendable period to reply to the objection. If the applicant is unable to remedy the objection, the IPI will (totally or partially) reject the application.

PDOs and PGIs can only be registered by a representative group of producers. The application is submitted to the IPI for non-agricultural products and to the Federal Office for Agriculture for agricultural products and must include, among other things, a product specification defining the product and its method of manufacture.

For the registration of topographies, the only requirement is to submit an application with the necessary information, in addition to which documents identifying the topography must be submitted and the relevant protection fees must be paid. The examination is purely formal. The topography itself is not examined.

Whoever wishes to obtain protection of a plant variety must submit an application to the Plant Variety Protection Office, as part of the Federal Office for Agriculture, in the prescribed form and with the required information and documents, and pay the application fees.

Only the following are entitled to be granted a .swiss-domain name: (i) Swiss public corporations or organizations under public law; (ii) entities entered in the Swiss Commercial Register that have their registered office as well as a physical administrative seat in Switzerland; (iii) associations and foundations not entered in the Swiss Commercial Register that have their registered office as well as a physical administrative seat in Switzerland.

## 6. How long does the registration procedure usually take?

The duration of the application procedure varies from IP right to IP right.

The registration procedure of a patent usually takes several years. The applicant can file a request for an accelerated procedure. In this case, substantive examination begins immediately upon receipt of the application (instead of approximately 3 years after filing).

In trademark cases, it takes about 4-5 months after payment of the application fee until registration, provided that the IPI does not object to the registration of the sign. Upon payment of an express fee of CHF 400, an accelerated application can be requested (examination within a maximum of one month after payment of the fee, subject to objections and payment).

The registration of a .ch-domain name can be done immediately by purchasing the domain online via a registrar. The registration of a .swiss-domain name usually takes a couple of weeks.

Both a design and a topography registration, if done properly, can be completed within a few days or weeks (usually less than one month), as the IPI only examines the formal requirements without conducting a substantive examination of the design.

Likewise, applications for plant variety protection are also only checked for completeness by the Plant Variety Protection Office and the publication therefore takes place quickly (new registrations are published every two months in the Plant Variety Protection Gazette). The duration of the subsequent technical examination depends on the variety to be assessed. Protection of the

variety is only granted after this, provided that all the requirements for the examination have been met.

The registration for PDOs and PGIs usually takes about 2 years. The procedure includes, among other things, an examination of the representativeness of the applicant group and the product specification. In addition, the Federal Office for Agriculture must obtain the opinion of the Commission for Designations of Origin and Geographical Indications and must ask the competent cantonal and federal authorities for their opinion before granting protection to PDOs and PGIs.

## 7. Do third parties have the right to take part in or comment on the registration process?

Third parties are excluded from the registration procedure at the IPI. However, at least the trademark law provides for the possibility of an opposition procedure for owners of earlier trademarks, which is available for three months from the publication of the later trademark. Likewise, third parties may raise objections to the plant variety applied for within three months from the date of publication of an application.

For the registration for PDOs and PGIs, see above section 6.

## 8. What (if any) steps can the applicant take if registration is refused?

A decision refusing the registration can be appealed within 30 days to the Federal Administrative Tribunal. Based on a limited set of legal grounds, the decision of the Federal Administrative Tribunal can then be appealed to the Federal Supreme Court. This does not apply to domain names as their registration is a mere private contractual matter with the domain registrar.

## 9. What are the current application and renewal fees for each of these intellectual property rights?

The fee for application, examination and grant of a Swiss patent is CHF 700 (CHF 200 for the application and CHF 500 for the examination) and CHF 500 for an optional search. A renewal fee of CHF 100 is requested for the 4th year, after which the fee increases annually by CHF 20 respectively CHF 40 as of the 8th year. The application fee for a supplementary registration certificate (SPC) is CHF 2500, with an annual renewal fee of CHF 1060 for the first year, increasing annually by



CHF 100 for all further years.

The filing fee for protecting a trademark in 1 up to 3 classes of products or services for 10 years is CHF 550. A fee of CHF 100 is requested for each additional class of products or services. For expedited trademark examination, an additional fee of CHF 400 is requested. The renewal fee for an extension of protection for another 10 years (indefinitely renewable) is CHF 700, irrespective of the number of classes.

For domains names the fees depend on the chosen registrar (the current market prices for a .swiss-domain range CHF 100 and 170 at the moment).

The basic fee for protecting a design for 5 years is CHF 200. An additional fee of CHF 100 is added up for each additional design submitted within the same application, up to a maximum amount of CHF 700 (six designs or more). The basic fee includes the publication of one image, each additional image costing CHF 20. The renewal fee for 5 additional years of protection is the same as the basic filing fee (e.g. CHF 200 for one design).

The filing fee of a PGI/POA for non-agricultural products with the IPI is CHF 4000. There is no fix filing fee for PGI/POA related to agricultural products with the Federal Office for Agriculture.

The filing fee for the protection of a topography is CHF 450.

The filing fee for the protection of a plant variety is CHF 300 or CHF 400 depending on whether one already makes a proposal for the variety denomination with the application.

### **10. What are the consequences of a failure to pay any renewal fees and what (if any) steps can be taken to remedy a failure to pay renewal fees?**

The renewal application including payment of the renewal fee must generally be submitted before the expiry of the validity period, however, for a surcharge of CHF 50, a renewal can also be submitted up to 6 months after the expiry of the validity period for patents, designs and trademarks. If payment is not made within the extension period, the right expires. When patents are renewed, rights may be restored upon request if the patent applicant can show that he was prevented from complying with the time limit through no fault of his own.

Those who do not pay the fee for renewal of plant variety protection will be reminded. If the fee is not paid

even then, the plant variety protection expires.

This does not apply to domains where the terms and conditions of the registrar set forth the consequences for failing to pay the annual fees.

### **11. What are the requirements to assign ownership of each of the intellectual property rights described above?**

The full or partial assignment of patents, trademarks and designs requires a corresponding commitment and disposition transaction and is only valid if it is agreed in writing. The entry in the register is not a requirement for the validity of an assignment (exception: guarantee and collective marks, see next question) but is recommended (see below section 12).

There is no formal requirement for the assignment of copyrights; it can also be concluded orally. However, for evidentiary purposes, it is advisable to conclude a written agreement. Moral rights are generally not assignable. However, the author may allow a third party to exercise certain of his moral rights.

Topography and plant variety rights are also fully assignable.

To the extent that IP rights are transferred as part of a corporate transaction, such transactions often require a written agreement and a detailed list of the rights to be transferred.

PGIs and PDOs may be used by all producers who meet the conditions set out in the specifications and submit to the controls provided for. PDOs and PGIs are linked to products and not to companies, which is why they cannot be transferred as such.

The assignment of domains is subject to the terms and conditions of the registrar.

### **12. Is there a requirement to register an assignment of any of these intellectual property rights and, if so, what is the consequence of failing to register?**

The assignment of the guarantee or collective mark are valid only if they are entered in the register. Otherwise, the entry of the assignment in the register is not a requirement for the validity of an assignment. However, an assignment is only effective vis-à-vis third parties acting in good faith if it is entered in the register.

### **13. What are the requirements to licence a third party to use each of the intellectual property rights described above?**

Licenses are not subject to any special formal requirements, i.e. license agreements can also be concluded orally. However, for evidentiary purposes, a written agreement is advisable.

### **14. Is there a requirement to register a licence of any of these intellectual property rights and, if so, what is the consequence of failing to register?**

Licenses to collective marks are valid only if they are entered in the register. Otherwise, the entry of the assignment in the register is not a requirement for the validity of a licence. However, a registered license can only be enforced against third parties acting in good faith if it is entered in the register.

### **15. Are exclusive and non-exclusive licensees given different rights in respect of the enforcement of the licensed IP, and if so, how do those rights differ?**

Only the exclusive licensee is independently entitled to bring an action, regardless of the entry of the license in the register, unless this has been expressly excluded in the license agreement. Furthermore, all licensees, including non-exclusive licensees, may join an infringement action brought by the trademark owner to claim their own damages even without the owner's consent.

### **16. Are there criminal sanctions for infringement of any intellectual property rights, and if so, what are they and how are they invoked?**

The infringement of patents, designs, trademarks, copyrights, topography and plant variety rights is subject to criminal sanctions. Any person wilfully committing such act is, upon complaint by the injured party, liable to a custodial sentence not exceeding one year or to a monetary penalty. If the offender acts for commercial gain (i.e. the offender performs the criminal activity in the manner of a profession in order to earn a living) he shall be prosecuted ex officio, and the penalty shall be a custodial sentence not exceeding five years or a monetary penalty.

Complaints in criminal proceedings are to be filed with the competent cantonal criminal prosecution authorities. A complaint may be filed either orally or in writing.

### **17. What other enforcement options are available for each of the intellectual property rights described above? For example, civil court proceedings, intellectual property office proceedings, administrative proceedings, alternative dispute resolution.**

Holders of intellectual property rights can enforce their rights in civil court proceedings. For example, they may apply to the court for a declaratory judgement, or request the court to prohibit an imminent infringement. If the relevant statutory requirements are met, a preliminary measure may be taken prior or simultaneously with a claim on the merits, for example, to secure evidence, or to preserve the existing state of affairs. In case of special urgency, the court may order ex parte preliminary injunctions, i.e. immediately without first hearing the opposing party.

Further, IP holders may enforce their rights through administrative law actions (e.g., simplified/expedited cancellation of a trademark on the grounds of non-use, or opposition proceedings against the registration of a trademark or patent).

### **18. What is the length and cost of such procedures?**

The length of legal procedures depends on many factors, including the complexity of the dispute, the number and length of submissions and evidence submitted by the parties, the number of hearings held by the court, and the court's workload. Furthermore, the length depends on whether an appeal is filed against a decision or not.

In this context, it should be noted that in Switzerland there are only two instances available for the conduct of civil intellectual property disputes (one cantonal instance and the Federal Supreme Court as an appeal instance). Usually, it takes from a few days to a few weeks to obtain a preliminary injunction (if the opposing party is heard and can comment). It usually takes between 1 and 3 years to obtain an ordinary proceeding-judgment in cantonal proceedings (first instance). The appeal proceedings before the Federal Supreme Court usually take only 6 months to 1 year, as there is usually no oral hearing.

Depending on the several factors mentioned above, the

costs of infringement proceedings (including court and attorney fees) in cantonal proceedings vary significantly. However, they can be roughly estimated between CHF 30,000 and CHF 150,000 for proceedings before the first instance. The court will usually request the claimant to deposit a security for the court costs. Under certain conditions, the defendant may require the claimant to deposit security for the defendant's attorney fees. The amount of court fees depends on the value in dispute. The losing party pays the court fees and is usually required to bear the cost of the successful party's attorney fees (in principle, a lump sum based on the amount in dispute). Usually, the costs of appeal proceedings before the Federal Supreme Court are lower than in cantonal proceedings.

The length of administrative proceedings is in principle relatively short, but may be greatly extended depending on the workload of the competent registry authority and the extensions of time granted to the parties. The fees in administrative proceedings are based on the relevant legal provisions. The fee for filing an opposition against a trademark, or the cancellation of a trademark, for example, is currently CHF 800. The attorney fees for such a cancellation request or trademark opposition depend on the complexity of the case. In a relatively straightforward matter, they can be estimated between CHF 3,000 and CHF 5,000.

**19. Where court action is available, please provide details of which court(s) have jurisdiction, how to start proceedings, the basics of the procedure, the time to trial, the format of the trial, the time to judgment and award of relief and whether any appeal is available.**

Based on the Swiss Civil Procedure Code, each of the 26 Swiss cantons has designated a court to handle IP disputes as the sole instance (in the cantons of Zurich, Bern, Aargau and St. Gallen, the so-called "commercial courts" have jurisdiction). This does not include patent disputes regarding validity, infringement or grant of licenses, all of which are handled by the Federal Patent Court.

The proceedings are initiated by filing a (written) claim with the competent court. The court will then issue an order setting a deadline for the advance payment of the court fees. Then, the claim is served on the defendant, with a deadline of 30 days to 3 months to file a response. In complex matters, the court may order and the claimant may request a second or even third exchange of submissions. Each party has an unrestricted

right to respond to the other party's arguments. Subsequently, the court schedules a hearing. In complex cases, the first hearing (so-called "instruction hearing") serves to prepare for the main hearing. In simpler cases, the instruction hearing is immediately followed (within the same session) by the main hearing, in which evidence is taken. The time to judgment depends on various factors, such as the complexity of the case, the number and length of submissions and evidence submitted by the parties, the number of hearings conducted by the court, and the court's workload.

The decisions of the courts with cantonal jurisdiction in intellectual property matters or of the Federal Patent Court may be appealed to the Federal Supreme Court.

**20. What customs procedures are available to stop the import and/or export of infringing goods?**

The Customs Administration is entitled to withhold goods on its own initiative if there is a suspicion that the import, export, or transit of goods infringes an intellectual property right in Switzerland. In addition, the right holder may request the Customs Administration to seize allegedly infringing goods. In this case, the right holder shall provide the Customs Administration in advance with all information required to decide on the seizure.

If there are reasonable grounds to suspect that the goods are counterfeit, the Customs Administration shall seize such goods and inform the right holder and the owner of the infringing goods. Goods may be withheld for a maximum of 10 working days. Within this period, the rights holder must obtain a preliminary injunction from the competent judge or close the matter by settlement with the receiver of the goods. Within the same period, the owner of the infringing goods must object to the destruction of the goods if this was requested by the rights holder. In this regard, a revision of the law is pending, with the intention of introducing a simplified procedure for the destruction of counterfeits in small consignments.

**21. Are any non-court enforcement options or dispute resolution mechanisms mandatory in respect of intellectual property disputes in any circumstances? If so, please provide details.**

Not unless the dispute is based on a contractual matter where the contract provides for pre-agreed non-enforcement options and/or dispute resolution



mechanisms before resorting to state courts or arbitration.

## 22. What options are available to settle intellectual property disputes?

Judicial conciliation and/or mediation may be requested by the parties or recommended by the competent judge at any stage of the civil proceedings. Out-of-court settlements are also possible at any time.

## 23. What is required to establish infringement of each of the intellectual property rights described above? What evidence is necessary in this context?

To establish a patent infringement, the claimant must prove the existing patent claims and then compare the established claims with the product that allegedly infringes the patent.

To establish a trademark infringement in administrative proceedings (e.g., opposition proceedings), the claimant must prove that the disputed sign is (i) identical to an earlier trademark and is intended for identical goods or services, (ii) identical to an earlier trademark and intended for similar goods or services such that a likelihood of confusion results, or (iii) similar to an earlier trademark and intended for the same or similar goods or services such that a likelihood of confusion results. Where the proprietor has not used the trademark in relation to the goods or services for which it is claimed for an uninterrupted period of five years, the proprietor may no longer assert his or her right to the trademark, unless there are proper reasons for non-use. In addition, it is possible to invalidate or cancel a trademark in civil law proceedings with broader arguments (e.g., bad faith, famous trademark, etc.).

To establish a design infringement, the right holder must prove that the disputed design has the same essential features and thus produce the same overall impression as the design already registered.

To establish a copyright infringement, the right holder must prove that the infringer is using his or her work without authorization and in a manner reserved to the right holder. In a specific case, it is necessary to assess (i) which elements are common to both works and to what extent, (ii) whether they cover the essential part of the work, and (iii) whether these elements (alone or in combination) meet the requirements for copyright protection.

Owners of PGI/POA must show that the PGI/POA is used

without meeting the relevant requirements set out in the product specification. Topography right owners must show that there is an unauthorized reproduction of the topography by the infringer. Plant variety right owners must show that unauthorized production or reproduction of the propagating material of the variety or conditioning for the purpose of propagation is taking place, or that unauthorized materials of the protected variety are sold and marketed.

## 24. How does the court acquire any necessary information (fact or technical) and in what circumstances does it do so? In particular a) Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the parties, and/or parties' expert witness evidence? b) What mechanisms are available for compelling the obtaining and protecting of evidence? Is disclosure or discovery available?

### a. Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the parties, and/or parties' expert witness evidence?

Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the parties, and/or parties' expert witness evidence? In principle, there are no technical judges. The burden is on the parties to prove any factual or technical information, for example, by submitting physical records and written statements, requesting witness testimony and inspection, submitting expert opinions, and requesting that the court appoint an expert witness. The court may ask a witness questions about his or her assessment of the facts of the case if the witness has special (e.g. technical) expertise. If the complexity of the matter makes it necessary, the court may also obtain the opinion of one or more experts ex officio. However, since the court is required to apply the law ("*iura novit curia*"), assessments on Swiss law are not to be examined by external experts, outside ex officio proceedings.

In deviation from the principle, the commercial courts in the cantons of Zurich, Bern, Aargau and St. Gallen have so-called "commercial judges" or "subject matter judges" who are external, part-time judges

with special knowledge in a particular area of business (e.g., IT or life science). In general, two to three regular judges and/or two to three commercial/subject matter judges assess regular proceedings. The Federal Patent Court is composed of judges with legal training and judges with technical training. As a rule, the court decides in a three-member body, of which at least one member must have technical training.

- b. **What mechanisms are available for compelling the obtaining and protecting of evidence? Is disclosure or discovery available?** The Swiss Civil Procedure Code does not foresee a pre-trial discovery. The competent court orders a precautionary taking of evidence only in limited cases, i.e. usually when there is a credible risk of loss of evidence for later proceedings. The parties are obliged to cooperate in the taking of evidence, e.g. to produce the physical records requested by the other party if ordered to do so by the court. The competent judge may sanction the party's non-compliance with this obligation. However, cooperation may be refused or restricted if information would have to be provided that is protected by the attorney-client privilege or other secrets, provided that the interest in secrecy outweighs the interest in ascertaining the truth.

## **25. How is information and evidence submitted to the court scrutinised? For example, is cross-examination available and if so, how frequently is it employed in practice?**

According to the Swiss Civil Procedure Code, the court forms its opinion based on its free assessment of the evidence taken. The parties must offer evidence for each of their claims. Such evidence may include physical records, testimony, or questioning of the parties. Witnesses and parties are generally questioned by the court or by the party who requested their testimony/questioning, and only in relation to the specific allegations on which their testimony/questioning was requested. Cross-examination may occur indirectly when the counterparty addresses the court with additional questions deemed necessary and the court then presents those additional questions to the witnesses/parties.

## **26. What defences to infringement are available?**

Available defences include, but are not limited to, non-infringement (e.g., no likelihood of confusion in trademark matters), prior use (to registration), non-use, invalidity of IP rights, exhaustion of IP rights, forfeiture of rights, compulsory licenses (including, e.g., FRAND licenses), special privileges, private use.

## **27. Who can challenge each of the intellectual property rights described above?**

For civil action, any person who can demonstrate a legal interest may challenge the intellectual property rights described in section A.

The legal situation is different in the case of administrative proceedings, such as opposition or cancellation proceedings in trademark law. An opposition can only be filed by the owner of an earlier trademark, whereas a cancellation can be requested by anyone. Anyone can also raise objections to a published patent or to a plant variety. Likewise, any person who can demonstrate a legal interest can oppose the registration of a PGI/POA.

## **28. When may a challenge to these intellectual property rights be made (e.g. during any registration process or at any time during the subsistence of the right)?**

In principle, IP rights cannot be challenged in civil proceedings during the registration process. Following registration, actions for cancellation and nullity can be brought before the civil court at any time during the subsistence of the right. After a certain period, a claim may be considered time-barred.

There are different deadlines for challenging intellectual property rights in administrative opposition proceedings. The opposition to a patent must be filed within nine months from the date of publication of the patent registration. Opposition to the registration of a trademark, a plant variety or a PGI/POA must be filed within 3 months from the date of publication of the registration.

There is no time limit for filling interim measures. However, such a request is subject to the condition of urgency, which obliges the applicant to act immediately after discovery of the infringement.

Claims for damages in connection with IP infringement are subject to a limitation period of 3 years from the date on which the claimant became aware of the damage and the identity of the infringer, and in any event 10 years from the date on which the damage occurred.

### **29. Briefly, what is the forum and the procedure for challenging each of these intellectual property rights and what are the grounds for a finding of invalidity of each of these intellectual property rights?**

The forum for challenging patents, trademarks, topography and non-agricultural PGI/POA in administrative proceedings is the IPI in Berne. The forum for challenging the registration of an agricultural PGI/POA and a plant variety is the Federal Office of Agriculture in Berne.

The forum for civil law disputes concerning patents is at the Federal Patent Court in St. Gallen. In all other civil law proceedings, the forum depends on whether the case at hand is a Swiss domestic dispute or an international dispute. In Swiss domestic infringement cases, the claimant can potentially file his or her claim in the following venues: his or her own domicile or registered office, the defendant's domicile or registered office, and the place where the infringing act occurred or had its effects. In the case of international disputes, the claimant may assert his or her claim in various venues depending on the applicable agreements (for example Lugano Convention).

Grounds for a finding of invalidity include, but are not limited to, prior rights, failure to meet the statutory requirements for registration (e.g. relative or absolute grounds for refusal in the case of trademarks or lack of novelty in the case of patents), non-use, or expiry.

### **30. Are there any other methods to remove or limit the effect of any of the intellectual property rights described above, for example, declaratory relief or licences of right?**

Declaratory reliefs, i.e., a court judgment that determines the rights of the parties without ordering anything or awarding damages, is available under Swiss law if no other forms of claim are available to the claimant.

Compulsory licenses may be granted to a patent in certain cases where the applicant's efforts to obtain a

contractual license on reasonable market terms within a reasonable period have been unsuccessful. Compulsory licenses may also arise from competition law constraints, e.g. if an intellectual property owner has a dominant position in the market (standard-essential patents) and is suspected of abusing its position. In such cases, compulsory licenses must be granted under fair, reasonable and non-discriminatory conditions (FRAND licenses).

The copyright law grants a compulsory license in return for payment to producers of phonograms. In addition, Swiss copyright law permits the decompilation and reverse engineering of copyrighted software code if this proves necessary to achieve interoperability with other software or software systems that are in legal use.

In the case of plant variety rights, a compulsory license may be granted to a person whose license application has been rejected without sufficient cause, provided that there is a public interest.

### **31. What remedies (both interim and final) are available for infringement of each of the intellectual property rights described above?**

Remedies available include (i) preliminary and final injunctions, (ii) declaratory judgments, (iii) assignment of IP rights, (iv) order to disclose the origin and quantity of the infringing goods in the defendant's possession and to disclose the identity of the recipients, (v) order to disclose the extent of any distribution to commercial recipients and amounts received therefore, (vi) rendering of accounts, (vii) damages, (viii) publication of the judgment, and/or (ix) destruction of the infringing goods and their removal from the market.

### **32. What are the costs of enforcement proceedings and is any kind of costs recovery available for successful parties? Is there a procedural mechanism enabling or requiring security for costs?**

The costs of the enforcement proceedings depend on many factors, in particular, the complexity of the case and the forum as the 26 cantonal courts each have their own court tariff system.

As a rule, the court requires the claimant to deposit security in the amount of the expected court costs. Under certain conditions, the claimant must also provide security for the party costs at the request of the defendant.

As a rule, the court decides on the procedural costs in its final decision. Where an interim decision is made, the procedural costs incurred up to that point may be allocated but it may also be deferred until the final decision on the merits. The parties may submit a statement of costs, but the court costs are determined and allocated ex officio, and party costs are awarded according to the tariffs.

As a rule, the costs are charged to the unsuccessful party. If an action is not admitted by the court or if it is withdrawn, the claimant is deemed to be the unsuccessful party; in case of acceptance of the claim it is the defendant. If no party entirely is successful, the costs are allocated in accordance with the outcome of the case. The court may diverge from these general principles of allocation and allocate the costs at its own discretion. If a case is settled in court, the costs are

charged to the parties according to the terms of the settlement.

### **33. Has the COVID-19 pandemic caused any changes (temporary or permanent) to the protection or enforcement of intellectual property? For example, changes to deadlines, filing or evidence requirements or court processes.**

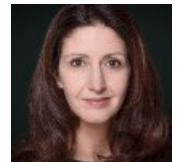
Most of the measures introduced due to the coronavirus in early 2020 (e.g. suspension of deadlines, adjournment of court hearings, etc.) have been lifted. Court proceedings are running normally again, taking into account and complying with the recommendations of the Federal Office of Public Health (FOPH) and the Federal Council.

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