



# Intellectual Property Newsletter Switzerland

## Procedure for cancellation of a trademark due to non-use

From 1 January 2017, it is possible to apply to the Federal Institute for Intellectual Property ("FIIP"), through a simplified procedure, for the cancellation of a trade mark that is not being used commercially and therefore is not worth protecting. Until the beginning of this year, such cancellation had to be pronounced by law by a civil court following a long and costly legal procedure. This alternative simplified procedure, which is regulated in the Trade Mark Protection Ordinance, offers the possibility of settling manifest cases of non-use of a trade mark.

### 1 Background

The background to this regulation is article 12 of the Swiss Trademark Act (TMA) which provides that trademark rights may no longer be asserted if the trademark has not been in use for an uninterrupted period of five years, unless there is good cause for that non-use. In accordance with the law applicable until end of 2016, costly and complex court proceedings had to be initiated, even in clear-cut cases, in order to have even a substantially perished trademark removed from the register. As per 1 January 2017, a simplified cancellation procedure has been instituted by the FIIP. Hence, any person may file a petition with the FIIP for deletion of a trademark that is vulnerable to cancellation due to non-use against a modest fee.

### 2 Requirements

On the part of the applicant, he or she must assert the non-use of the trademark and provide suitable evidence.

- The standard of proof is met with credible evidence which makes the non-use of the trademark seem likely.
- In the event that the non-use of the trademark seems likely based on an objective consideration of the evidence submitted, the FIIP will approve the request and cancel the trademark

from the register to the extent that the non-use has need credibly shown.

As regards the trademark owner, the legal position is different:

- On the part of the trademark owner, he or she must show that the trademark is genuinely in use in order for a sufficiently substantiated cancellation request to be rejected. For this purpose, the trademark owner can provide copies of invoices, advertisement documentation, etc. It is not sufficient for the trademark owner to merely object to the cancellation request and allege that the trademark has been used.
- There is, however, an additional defense argument according to which the trademark owner may claim good cause for non-use, i.e. any circumstances occurring independently from the trademark owner's will and constituting an impediment to the use of the trademark. Nevertheless, this exemption clause is applied rather restrictively.

As a result, it is advisable for a trademark owner to regularly examine and optimise the use of its own trademark and to make any persons involved aware of the issue in order to safeguard the existence of one's own trademark rights.

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This newsletter is available on our website [www.thouvenin.com](http://www.thouvenin.com).

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