

# Switzerland - a review of the newly introduced administrative non-use revocation action

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An administrative non-use revocation action has been available in Switzerland since January 1<sup>st</sup>, 2017. This action can be filed before the Swiss Trademark Office (IPI) against both National Swiss Trademark Registrations and Swiss designations of International Trademark Registrations.

Earlier this year, the IPI published a first statistical report regarding the newly introduced procedure: 61 revocation actions have been filed since January 1<sup>st</sup>, 2017. By the end of March 2018, 14 formal decisions and only 2 material decisions had been rendered.

Here are the three main outcomes of these material decisions.

## **1. Evidence required for establishing a likelihood of non-use**

A condition of the new non-use revocation procedure is that the claimant must provide evidence establishing a likelihood of non-use of the defendant's mark.

Non-use is a negative fact that is difficult, and sometimes impossible, to prove. The IPI has therefore acknowledged that indirect evidence was acceptable and that it will take into account circumstantial/corroborating evidence.

In case "HW-Regale AG/MARCEGAGLIA BUILDTECH S.R.L." (proceedings No.

100021), the claimant had only filed one piece of evidence in support of its action, namely, an in-use investigation report conducted by an external search provider. The IPI decided that this single piece of evidence was sufficient to support the likelihood of non-use. The IPI argued that such a report includes several pieces of information that are altogether seen as sufficient (information on the mark itself, on its owner, Internet checks, and – crucially here – the report of a telephone conversation with an employee of the defendant, as well as with a long time employee of a company that sells the defendant’s products in Switzerland).

Consistently, the new Trademark Directives published by the IPI, which shall come into effect in January 2019, expressly states that reports made by search providers are accepted as evidence of non-use in revocation actions.

The Directives also mention the following examples of accepted pieces of evidence:

- extracts of the Company Register (in combination with other evidences);
- searches on the web (for instance on search engines), including searches in the web archives (for instance via the “Internet Archive Wayback Machine” tool – <https://archive.org/web>).

## **2. Response to a non-use revocation action**

When facing a non-use revocation action, the defendant has three options:

- to simply challenge the likelihood of non-use by arguing that evidence of non-use is not convincing; in such a case, the defendant will have no opportunity to present arguments and evidences at a later stage (particularly, evidence of use of its mark);
- to show use of the mark;
- and/or to show legitimate grounds for non-use.

In both of the material decisions rendered, the defendants did not respond to the revocation action at all. The IPI therefore acknowledged that non-use had been validly shown and, on that basis, it revoked the defendants’ registrations.

It is therefore too early to tell which criteria the IPI will be applying when examining use material submitted by the defendant. But it is highly likely that the set of rules will be the same as the ones that have been developed and applied in opposition proceedings (since 1993), where use of the opponent’s mark can be

challenged. However, taking into account that the non-use revocation action leads to the cancellation of the defendant's right, while non-use is only raised as an exception in the opposition procedure, the IPI might soften its practice.

### **3. Costs award**

In the case "HW-Regale AG / MARCEGAGLIA BUILDTECH S.R.L.", the claimant was awarded a total compensation of CHF 2'830, consisting of CHF 800 for the official fee, CHF 1'200 for the professional fees of the claimant's representative (NB this amount is capped at CHF 1'200) and CHF 830 for the cost of the external search report (used to evidence non-use).

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Here is the link to the non-use revocation decisions rendered so far :  
<https://www.ige.ch/en/protecting-your-ip/trade-marks/post-registration/use-your-trade-mark/cancellation-procedure-for-trade-marks-on-the-grounds-of-non-use.html>.