

National Procedures for Trademark and Patent Registration



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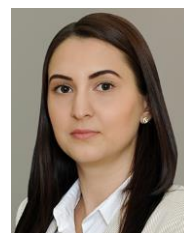
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EXECUTIVE SUMMARY

Welcome to the 2nd Report of the ABL's Young Lawyers Group ("the Group").

Patents and trademarks are valuable intellectual property rights and a vital foundation of economic growth for businesses. As such, the topic of "National Procedures for Patent and Trademark Registration" was enthusiastically chosen by the Group for its next Report given the international work that member firms are involved with.

The Report draws attention to the procedures that are involved when applying for patent registration and trademark registration in each of the countries mentioned. In addition, the Report contains useful links to websites of the relevant authorities in those countries that deal with the applications for these registrations.

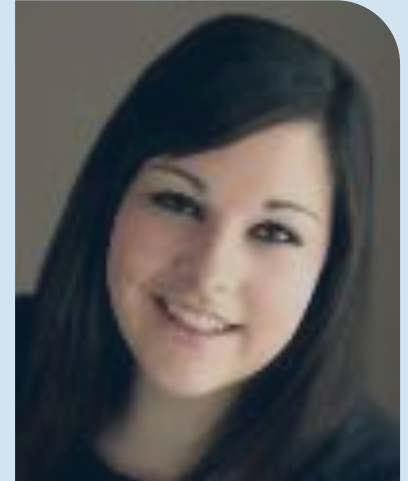
The Report was prepared with contribution from ten members of the Group from the Czech Republic, France, India, Italy, Malta, Romania, Sweden, Switzerland, the UK and the USA. A link to the individuals' biographies can be found on the "List of Contributors" page.

The Group was formed in 2015 to enable young lawyers in ABL member firms to develop and work alongside the senior members of ABL and to contribute towards the continued success of ABL. As such, the Group aims to enable young lawyers to build up their own network of contacts within ABL and to develop their own legal education through the publication of reports on topical issues chosen by the Group's members on ABL's website, members' own firm websites and the ABL Insider.

Claire Rigby

Druces LLP, London

Chair of the Young Lawyers Group





Czech Republic

PATENTS

1. General

- Competent authority: Industrial Property Office – for more information see <http://upv.cz/en/ip-rights/trade-marks.html>
- Persons not having the domicile or headquarters on the territory of the Czech Republic must be represented in the proceedings before the Office by a representative
- Application forms can be filed in person, by post or electronically. The forms are available in Czech only: <http://upv.cz/en/client-services/forms.html>
- By filling the application is the applicant granted by the right of priority - the patent can not be granted to any later applicant for the same invention
- A patent represents the right for the patentee to prevent anybody from using it without preliminary agreement. The right to utilize a patent is granted by a license agreement
- Patent application must include a description of the invention and/or related drawings and so called patent claims (precise definition of the subject-matter)

2. Procedure

- All applications undergo a preliminary examination to eliminate those containing matters evidently non-patentable. An applicant is notified of the result by an official letter. If the invention is patentable it is published in Bulletin after 18 months from filing the application. To gain the patent the applicant must fill the request of a substantive examination within 36 months from the filing date.
- The patent is granted by the IPO CZ only after the substantive examination was carried out and on condition that the invention complies with all requirements on patentability.

3. Fees

Information about fees: <http://upv.cz/en/ip-rights/patents/fees.html>

4. Term of protection

20 years from the filing date of the application. The patent owner must pay maintenance fees to keep the patent valid.

TRADEMARKS

1. General

- Competent authority: Industrial Property Office – for more information see <http://upv.cz/en/ip-rights/trade-marks.html>.
- Persons not having the domicile or headquarters on the territory of the Czech Republic must be represented in the proceedings before the Office by a representative.
- Application forms can be filed in person, by post or electronically. The forms are available in Czech only: <http://upv.cz/en/client-services/forms.html>.
- By filling the application is the applicant granted by the right of priority - the same trademark cannot be registered for any later applicant.
- By registering in the trademark register the owner acquires an exclusive right to use the trademark.
- One application = one trademark.

2. Applicable Legislation

Applicable legislation in English: <http://www.upv.cz/en/legislation/national/codes.html>.

3. Procedure

- Formal examination – essential requirements of the application Substantive examination.
- In case both examinations are successful, the trademark is published in Bulletin of Trademarks for 3 months. During this period everyone can make an objection against registration if it infringes his registered trademark (similarity). Every objection is solved by IPO CZ.
- No objection/objection rejected – registration of the trademark in the trademark register – applicant granted by the certificate.

4. Fees

Information about fees: <http://upv.cz/en/client-services/fees.html>.

5. Term of Protection

The term of protection: 10 years, can be repeatedly renewed for another 10 years upon request of the trademark owner and payment of the renewal fee.



France

PATENTS

- French registering rules concerning Patents are governed under articles L612-1 and seq. and R612-1 and seq. of the French Intellectual Property Code.
- The filing of a patent registration application grants intellectual property rights on the filing date of the application for a term of 20 years and cannot be renewed or extended, except for pharmaceutical patents, the protection of which can be extended for a specific additional period of time.
- Anyone can register a patent:
 - Individuals and companies or any applicant represented by a French Attorney at Law or a French Industrial Property Counsel.
 - Foreign individuals or companies, as long as (i) they appoint a French Industrial Property Counsel or a French Attorney at Law if they have neither a domicile nor an establishment in France or in the European Union or European Economic Area, and (ii) the foreign country they belong affords reciprocal protection to French patents.
- The patent application has to be filed with the INPI either online (<https://www.inpi.fr/fr/services-et-prestations/depot-de-brevet-en-ligne>) or by sending the following application by registered letter with acknowledgment of receipt or facsimile (https://www.inpi.fr/sites/default/files/db540_0.pdf).
- INPI examines both administrative and technical aspects of the patent registration application.
- The INPI may refuse to grant a patent on different grounds such as:
 - Substantive requirements; for example, the categories excluded from patent protection.
 - Formal requirements; for example, when the claims are not established on the basis of the description.
- The patent registration application is published in the BOPI 18 months after its first filing, by including the preliminary research report if available.
- French patent law does not provide a specific patent opposition procedure. However, third parties can submit observations within three months from the date of publication of the preliminary search report relating to a patent application. The applicant has then three months to reply to these observations or to modify his application.

- The INPI will then issue a definitive research report and a formal patent published to the BOPI.

TRADEMARKS

- French registering rules concerning Trademarks are governed under articles L712-1 and seq. and R712-1 and seq. of the French Intellectual Property Code which result from a transposition of European directives and in particular, the First Council Directive of 21 December 1988 to approximate the laws of the Member States relating to trade marks (89/104/EEC).
- The filing of a trademark registration application grants intellectual property rights on the filing date of the application for a term of 10 years that may be renewed any number of times for periods of equal duration.
- Anyone can register a trademark:
 - French individuals or companies, either filed by the applicant himself or by a French Attorney at Law or a French Industrial Property Counsel.
 - Foreign individuals or companies, as long as (i) they appoint a French Industrial Property Counsel or a French Attorney at Law if they have neither a domicile nor an establishment in France, and (ii) the foreign country they belong affords reciprocal protection to French trademarks.
- The trademark application has to be filed with the National Institute of Industrial Property ("INPI" i.e. French Trademark, Design Patent and Patent Office) either online (<https://www.inpi.fr/fr/services-et-prestations/depot-de-marque-en-ligne>) or by sending the following application by registered letter with acknowledgment of receipt or facsimile (https://www.inpi.fr/sites/default/files/formulaire_depote_marque2015.pdf)
- The application process includes a formal examination and an examination of distinctiveness, but no search for prior trademarks. It takes approximately 4-6 months from first filing to registration. After registration the trademark is published in the weekly "B.O.P.I. marques". The opposition period is 2 months from publication of the trademark application.
- A trademark does not need to be original or new. It must be neither descriptive (of the product or services designated or essential quality of the product or service designated) nor deceptive (not to misrepresent) or contrary to the public order.



India

PATENTS

- The office of Controller General of Patent, Design and Trademark (“CGPDTM”) is in charge of registration of patents in India. The official CGPDTM website can be accessed at: <http://www.ipindia.nic.in/>.
- The Indian patent office is situated at four locations, namely, Kolkata, Mumbai, New Delhi and Chennai. These locations have territorial jurisdiction and patent applications are accordingly filed based on location/ office/ residential address of the applicant.
- As per the provisions of the Patents Act, any inventor, his/ her assignee, or legal representative of the deceased person, who before his death was either an inventor or assignee, can apply for a patent at any of the offices mentioned above depending on the jurisdiction, which is ascertained by the applicant/ inventor’s address. In case of a foreign applicant, the application can be filed at the appropriate office in whose jurisdiction the address for service or patent attorney’s office is situated.
- A patent is valid for a period of twenty (20) years and this period runs from the date of filing the first application. It is also important that the proper renewal fees are paid every year by the applicant of such patent application to keep it in active status. Non-payment of such fees in a timely manner will lead to the loss of patent rights. It is also important that the applicant complies with the yearly requirement of working of patents, by filing the requisite forms before the jurisdictional patent office.
- All details pertaining to the forms and fees can be accessed at: <http://www.ipindia.nic.in/form-and-fees.htm>.

TRADEMARKS

- The office of Controller General of Patent, Design and Trademark (“CGPDTM”) is in charge of registration of trademarks in India as well. The official CGPDTM website can be accessed at the <http://www.ipindia.nic.in/>.
- The Indian Trademarks office is situated at five (5) locations namely, Ahmedabad, Kolkata, Mumbai, New Delhi and Chennai. These locations have territorial jurisdiction and trademark applications are accordingly filed based on location/ office/ residential address of the applicant.
- Any person or an entity who claims to be the proprietor of a Trademark, can file a Trademark application in respect of the desired specification of goods and/or services. An application for

registration of Trademarks is received at the head office or a branch office of the Trade Marks Registry within whose territorial limits the Principal place of business of the applicant is situated. The administrative steps involved in processing a Trademark application can be found at the following website link: <http://www.ipindia.nic.in/administrative-steps-involved.html>.

- The Indian trademark system follows the NICE classification of goods or services. There are 45 classes under which a trademark can be filed, with 1-34 being product based classes and 35-45 being services based only.
- Once granted, a trademark is valid for a period of ten (10) years from the date of the filing of the trademark application. A trademark can be renewed for a further period of ten (10) years upon payment of the requisite renewal fees.



Italy

PATENTS

- **Principle of priority** - (the so-called "first to file") which ensures that it is the rightful owner who is the first to proceed with filing the application. It is not possible to request a provisional patent.
- **Procedure** - application, a title and summary, a description, one or more claims and designs, if it is necessary.
- **Application** - to be made on the appropriate form and filed with any Chamber of Commerce or sent directly to the IPTO, containing general information about the invention title, the filing data, the priority date and the inventors' master data. Before to file a patent application may be proper ensure that the patent is complied with all legal requirements and execute a clarence search on the existing state of art.
- **Title** - provides indications on the invention or on the model; expresses in brief, but precisely, the characters and purpose. [Art. 52 IPC]
- **Description** - must signal the goal of invention or model and the technical problem that intends to resolve.
- **Claims** - indicate what is meant to form the subject of the patent. The limits of the protection are determined by the claims.
- **Design** - by it, the inventor may show technical details and features of the invention, inserted in the description.
- **Examination** - applications are examined by the Patent office according to the chronological protocol order, to verify that they satisfy all of the administrative and legal requirements. The examiner also verifies the essential validity requirements of the patent. It is possible an integration of the missing documents, both by the applicant before receiving the notice from the Office and upon request by IPTO within 2 months from the date of notice of the need to provide the integration. The substantive examination, instead, makes sure that the patent application responds to all the patentability requirements. If the examination procedure is successful, the IPTO grants the relative certificate. **The exclusive rights referred to in the Code are conferred with the grant of the patent.** [Art. 53 IPC]
- Patent application is accessible 18 months after first filing. Patent owner can request advance publication (not before 90 days from filing). **Withdrawal** → Permitted during the period between the submission of the application and the issue of the relative certificate.

TRADEMARKS

- The registration of company trademark can be obtained by those using it or propose to use it in manufacturing or trade of products or in the performance of services of own company or controlled companies or that use it with its consent. [Art. 19 of Industrial Property Code]
- **Applicant** - Natural person or a legal entity.
- **Application**- To be made on a specific form and to be filed at a Chamber of Commerce, or, alternatively, sent by email to the Italian Patent and Trademark Office (IPTO) at the Ministry of Economic Development.
- **Registration process**- Admissibility, formal examination, technical examination, publication and administrative objection.
 - Primarily, the Office checks if the application meets the following conditions: applicant identifiable, reproduction of trademark, list of products and/or services. [Art. 149 IPC]
 - The formal examination verifies that the application contains the content prescribed by the art. 156 of IPC and the technical examination makes sure that there are no impediments to the registration. [Art. 156 IPC and Art. 170 IPC]
 - After the IPTO examinations, the application is immediately reported in the Patent Bulletin for inventions, model and trademarks, published by IPTO monthly.
 - Any concerned can send to IPTO written comments or intervene with the objection procedure methods, explaining why the trademark should be excluded from the registration. In addition, owners of a prior right can oppose the registration within 3 months from its publication. [Art. 176 IPC]
 - After 6 months from the application, the trademark is registered. If the applicant is no longer interested, during the period between the application and the registration may file the request for withdrawal.
- Registration can be submitted at any time and the protection lasts for a period of 10 years, renewable for another 10 years.
- For further information see: <http://www.uibm.gov.it/index.php/inglese>.



Malta

PATENTS

- Over the years, Malta has established itself as a viable option for individuals and businesses wishing to register or safeguard their intellectual property rights. Due to its popularity as a hub for ICT, financial services and iGaming, providing a robust legal framework for intellectual property was a necessity and has resulted in the country becoming an attractive jurisdiction for IP matters.
- In 2007 Malta joined the European Patent Convention and the Patent Cooperation and brought the countries IP legislation in line with EU laws through ratification of the Trademarks Act, the Patents and Designs Act, the Copyright Act and the Enforcement of Intellectual Property Rights Act.
- An invention can be called a patent if it can be considered as novel and can find applicability in the industrial sector. Biological inventions can also be patented if certain moral requirements are met. Patents are valid for 20 years from the application date and they are only liable for maintenance fees after the third year. Anyone that owns a Maltese patent can use it exclusively and it can only be used by third parties with the owner's explicit authorisation. To apply for a patent, one must provide the following documents:
 - Application form;
 - Description of the invention;
 - Solicitation for approval of the patent;
 - One (or more) utilisations;
 - Drawings/diagrams representing the utilisation of the patent; and
 - An abstract of the patent.
- A benefit of registering IP in Malta is the option of setting up an Intellectual Property Holding Company to benefit from a corporate tax rate of as low as 5% (in some cases) due to Malta's favourable tax refund and full imputation system with regards to income and profits derived from the Malta company. Furthermore, Malta offers a unique fiscal regime for royalty income in that royalty income derived from patents, copyrights and trademarks can be exempt from tax.

TRADEMARKS

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property was a necessity and has resulted in the country becoming an attractive jurisdiction for IP matters.

- In 2007 Malta joined the European Patent Convention and the Patent Cooperation and brought the countries IP legislation in line with EU laws through ratification of the Trademarks Act, the Patents and Designs Act, the Copyright Act and the Enforcement of Intellectual Property Rights Act.
- A trademark is recognised as a graphic sign that is intended to distinguish a product or service from another and any word, letter, number, colour, shape, or combination of such can be considered as a trademark. The trademark must be classified under one, or more of 45 specified classes and can be registered in Malta, or as a Community (EU) Trade Mark which provides protection in all 28 Member States. To apply for the registration of a trademark, the following documents must be provided:
 - Application form;
 - JPEG of the trademark not exceeding 1MB and in RGB colour format (either on a CD or submitted through the online portal); and
 - A detailed description of the goods/services falling within the class per the International Classification of Goods and Services.
- A benefit of registering IP in Malta is the option of setting up an Intellectual Property Holding Company to benefit from a corporate tax rate of as low as 5% (in some cases) due to Malta's favourable tax refund and full imputation system with regards to income and profits derived from the Malta company. Furthermore, Malta offers a unique fiscal regime for royalty income in that royalty income derived from patents, copyrights and trademarks can be exempt from tax.



Romania

PATENTS

- **Definition** - Patent is a set of exclusive rights granted to an inventor for any invention concerning a product or a process, in all areas of technology, provided that it is new, involves an inventive step and is susceptible of industrial application.
- **Main national laws and regulations:**
 - Law no. 64/1991 on patents;
 - Regulations implementing the Law no. 64/1991 on patents; and
 - Government Ordinance no. 41/1998 on the fees in the industrial property protection field and the conditions for use.
- **Applicant** -
 - Romanian individuals or legal entities;
 - Foreign individuals or legal entities having their domicile/headquarters in Romania;
 - Foreign individuals or legal entities having their domicile/headquarters outside Romania, based on the Patent Cooperation Treaty or mutual agreements.
- **National protection** - Registration of an application with the State Office for Inventions and Trademarks ("Oficiul de Stat pentru Inventii si Marci" - OSIM - www.osim.ro).
- **EU protection** - The application shall be filed directly with the European Patent Office (EPO – www.epo.org) or with OSIM.
- **International protection** - OSIM, which is the receiving office for the international applications of Romanian applicants, shall receive, check and transmit the applications to the World Intellectual Property Organization (WIPO - www.wipo.int).
- **Protection period** - 20 years, starting with the filing date, due to payment of annual fees. Failure to pay such fees leads to the loss of the rights on patent.
- **Possibility of patenting a software** - Inventions covering software are excluded from patentability. However, computer-related inventions which involve the use of a computer, a computer network or other programmable appliances are patentable. Nevertheless, computer programs are protected by copyright, for which the author of the program shall file an application with the Romanian Copyright Office (ORDA – www.orda.ro).

TRADEMARKS

- **Definition** - Trademark is a sign capable of being represented graphically, such as: words, letters, three-dimensional shapes, particularly, the shape of goods or of packaging thereof, which is capable of distinguishing goods and services of one enterprise from those of another.
- **Main national laws and regulations**
 - Law no. 84/1998 on trademarks and geographical indications;
 - Regulations implementing the Law no. 84/1998 on trademarks and geographical indications; and
 - Government Ordinance no. 41/1998 on the fees in the industrial property protection field and the conditions for use.
- **Applicant** - Any individual or legal entity can apply for the registration of a trademark in Romania.
- **National protection-** Registration of an application with the State Office for Inventions and Trademarks ("Oficiul de Stat pentru Inventii si Marci"- OSIM - www.osim.ro).
- **EU protection-** The application can be filed with OSIM, which shall forward it to the European Union Intellectual Property Office (EUIPO) without any examination or it can be filed directly with EUIPO (www.euipo.europa.eu).
- **International protection-** Registration of an application with OSIM, which shall transmit it to the World Intellectual Property Organization (WIPO), only after obtaining protection of the trademark in Romania (www.wipo.int).
- **Protection period-** 10-year period, starting with the filing date. It can be renewed as many times, subject to payment of the applicable fees.



SWEDEN

PATENTS

- Except for being the authority with which to file a national Swedish patent application, PRV is also an international authority, which means the client can use PRV if they want to pursue a patent in other countries as well.
- Advantages of filing a Swedish patent application:
 - The filing fee is low, internationally.
 - Client gets an early report on the patentability of the invention.
 - Full procedure can be done in English.
 - Easy to continue internationally (has to be done within 12 months).
- If the client wants to apply for a patent outside of Sweden, there are three different routes:
 - International application (PCT).
 - European patent application (EP).
 - Foreign application (national or regional).
- For more information, visit <https://www.prv.se/en/patents/>.

TRADEMARKS

- PRV handles Swedish trademark applications as well.
- **To consider:**
 - Swedish trademarks are only protected in Sweden.
 - Using the e-service eliminates all formal barriers.
 - The day the application is submitted it becomes a public document.
- **For wider protection:**
 - For EU protection file with EUIPO.
 - For international protection in accordance with the Madrid protocol, after filing for national protection, client also files for international protection with PRV who in turn will forward said application to WIPO in Geneva.



SWITZERLAND

PATENTS

- Technical inventions (products or processes) can be protected in Switzerland and in Liechtenstein through the Swiss Federal Intellectual Property Institute (IPI). When filling the application, the invention must be described as accurately as possible so that a person skilled in the field could reproduce the invention.
- To be registered, an invention must be new, non-obvious to a person skilled in the art and be commercially useful, implementable and reproducible. Therefore, an invention which has been made public anywhere in any form before the first filing is no longer patentable. Furthermore, the invention must not be derived from the prior art in an obvious way. For example, invented products must contain unexpected characteristics and processes have unexpected effects or the invention should fulfill a pre-existing need.
- Scientific theories, mathematical methods, ideas or hypotheses as well as game rules, teaching methods, etc. cannot be registered as inventions. It is the same with computer programs, unless the invention itself is used with a software, for example in an electronic control system. Inventions whose exploitation is contrary to human dignity or contrary to public policy or morality are not patentable. This includes processes for cloning human beings and the clones, processes for forming hybrid organisms by using human germ cells, unmodified human embryonic stem cells, the use of human embryos for non-medical purposes, etc. It is also not possible to protect surgery, therapy or diagnostic methods, plant varieties and animal varieties or biological processes for the production of plants or animals. However, microbiological or other technical processes and the products obtained thereby can be protected provided that their application is not technically confined to a single plant or animal variety.
- The material examination for a patent usually takes place three to four years after a patent has been applied for, but an accelerated procedure is available for extra cost. The priority deadline begins as of the date of filing.
- Patents give their owners the right to prevent others from commercially using their invention (production, application, selling, importing). The patent owner is entitled to transfer the right to another owner either through selling the patent or licensing it.
- Fees for a patent are CHF 200 for filing and CHF 500 for the examination. After 4 years, a yearly renewal fees of CHF 100 applies, which increases by CHF 50 for each subsequent year (CHF 150 for the 5th year, CHF 200 for the 6th year, etc. up to CHF 900 for the 20th year).
- Swiss registered patents can be found on www.swissreg.ch.

TRADEMARKS

- In Switzerland, trademarks can be registered through the Swiss Federal Intellectual Property Institute (IPI - www.ige.ch) for a protection in Switzerland and in other countries and regions as far as trademarks are concerned. Swiss registered trademarks can be found on www.swisreg.ch.
- All graphical signs can be used as trademarks in the legal sense as long as they distinguish a good or service from that of a competitor's, including word trademarks, or a combination of letters or numbers, graphic images, three-dimensional trademarks, slogans, series of tones (acoustic trademark), or a color trademark. In addition trademarks can also be registered as collective marks, identifying the products of an association of businesses, or as guarantee marks, signifying that the products are guaranteed to have certain properties or qualities.
- The trademark registration fees are CHF 550 for three classes of goods and services for a period of 10 years, which can be renewed indefinitely. The fee for every additional goods and services class is CHF 100.
- If there are no apparent problems, a trademark is examined within a few weeks and registered within a period of three months after payment of the fees if no opposition is raised. An early examination and registration can be requested for an additional cost of CHF 400.
- When it receives an application, the IPI does not search for other identical or similar trademarks already registered. However, the owner of such trademarks can raise an opposition within a delay of three months after the publication of a new trademark. Later, it has the possibility to start legal proceedings.
- When filling an application, Swiss nationals and residents as well as companies established in Switzerland have the opportunity to ask the IPI for an international extension of the protection through the World Intellectual Property Organization (WIPO) in Geneva, which can cover up to 97 states or regional entities including EU, most of the European countries, the USA, Russia, China, Japan or Australia, on the basis of the Swiss application.



UNITED KINGDOM

PATENTS

- Applications to register IP in the UK should be made to the Intellectual Property Office (IPO): <https://www.gov.uk/government/organisations/intellectual-property-office>.
- Inventions can be patented to give the patent holder the right to take legal action against anyone who makes, uses, sells or imports it without permission.
- The invention must be something that can be made or used, is new, and is inventive (rather than a simple modification to something that already exists). Certain inventions cannot be patented, such as literary, musical or artistic works, methods of medical treatment, scientific theories, and some computer programs.
- Patents are difficult and time-consuming to obtain. Only 1 in 20 applicants succeed in getting a patent without professional help and the process usually takes around 5 years. Patent holders must also pay to renew their patents each year.
- After an application is submitted the IPO will provide a search report, usually within 6 months, to identify similar patents. The application will be published 18 months after it is filed, and the applicant can then request a substantive examination within 6 months of publication. The application will then be granted or refused (although this may be several years after the initial application is filed).
- UK patent applications can also be filed through the WIPO and the EPO (European Patent Office).

TRADEMARKS

- Applications to register IP in the UK should be made to the Intellectual Property Office (IPO): <https://www.gov.uk/government/organisations/intellectual-property-office>.
- Registering a trade mark gives the owner the statutory right to the exclusive use of the mark in connection with the goods or services for which it is registered.
- Trade marks must be unique and can include words, sounds, logos, colours or any combination of these. It cannot be offensive, describe the goods or services (e.g. "cotton"), be misleading (e.g. "organic" if it is not), be a three dimensional shape, be too common and non-distinctive, or look too similar to state symbols or flags.

- Applicants should search the trademarks database before sending in an application to check that an identical or similar trade mark has not been registered. Applicants can ask the holder of an existing trade mark for permission to enter their own. The applicant will need to lodge a letter of consent from the holder with their application.
- The standard online application fee is £170 plus £50 for each additional class. The IPO offers the "Right Start" service which allows the applicant to check that the application meets the rules for registration. The fee is £100 upfront, plus £25 for each additional class. The applicant will then receive a report explaining whether the application meets the rules. If the applicant proceeds, there is a further fee payable of £100, plus £25 for each additional class. Paper applications cost £200 plus £50 for each additional class.
- The IPO will issue an examination report within 20 days of submission of the application and the applicant will have 2 months to resolve any problems. If the examiner does not raise any objections the application will be published in the trade marks journal for 2 months, during which time anyone can oppose it. The trade mark will be registered once any objections are resolved.
- The trade mark will last 10 years, after which time it can be renewed.
- For protection throughout the EU applicants should apply for a European Union Trade Mark.



UNITED STATES OF AMERICA

TRADEMARKS

- A trademark may be obtained in the US pursuant to a foreign registration under Section 44(e) of the Lanham Act. This section is used for a trademark application where the person or company filing the application already owns a trademark registration in another country. The benefit of using Section 44(e) is that the applicant does not need to use the trademark in the US before the trademark can be registered. Ordinarily, a trademark registration cannot be obtained in the US unless proof is submitted that the trademark is being used in interstate commerce. However, under Section 44(e), all that is required is a good faith intent to use the trademark in the US. To do so, the following conditions must be met: (1) the applicant must be the owner of the valid trademark registration in another country that is a party to a trademark treaty with the US; (2) the applicant must verify that it has a good faith intent to use the trademark in commerce in the US.
- It is important to note that registrations issued under Section 44(e) are vulnerable to petitions for cancellation on the grounds of abandonment if another company wants the mark and can demonstrate that the registrant has no intention to use the mark in commerce. This is usually done (if at all) after three consecutive years of non-use.
- Once the trademark application is filed, it will go through the formal review process by the US Patent and Trademark Office. The whole process usually takes between 9 months and a year, if there are no issues with the application.



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