

Why a multifaceted approach is key to protecting jewellery designs in Switzerland

The jewellery market is one of the fastest growing sectors in the luxury goods industry. Designers regularly introduce new design lines to keep up with customer expectations. However, with greater competition comes the greater threat of being copied, particularly in a sector where the line between inspiration and imitation is fine. It is therefore crucial to have a strong protection strategy in place.

In the case of parasitism, brand owners can rely on the Swiss Federal Act against Unfair Competition to claim that the reputation of their design has been unfairly exploited. Another valuable legal recourse is to obtain exclusive IP rights in order to deter infringers and combat copies.

Copyright protection

There is no copyright registration in Switzerland. The copyrights to a design exist as soon as it is created, so keeping proof of the date of creation and authorship is recommended. Copyrights last for 70 years after the death of the author. To claim these, the design must be an artistic and intellectual creation. Originality is required and is referred to as “individual character” under the Swiss Copyright Act. The individual character requirement is met when the design creates a different visual impression from pre-existing known shapes as clarified by the Federal Supreme Court in a decision of 13 December 2017 (FSC 143 II 373). However, this is interpreted on a case-by-case basis, which has created some legal uncertainty.

It is worth examining ownership in anticipation of a creator claiming copyrights in their design. Swiss law makes it clear that the author is the creator. Tacit consent is deemed to be given for so-called ‘commissioned works’ (ie, where an employee produces creative works for their employer as part of their duties). That said, parties should consider adding a copyright transfer clause to the employment contract. When it comes to independent designers, a copyright assignment is advised.

Design protection

Designs can be protected for up to 25 years (ie, a five-year protection period that is renewable four times). Design rights prevent against the registration and use of any other design that conveys the same overall impression among informed users on the basis of the dominant characteristics of each design.

In contrast to EU rules, the Swiss Design Act does not protect unregistered designs. Registration is therefore key.

The criteria for protection is:

novelty;

individual character;

respect of public policy or morality; and

the absence of being solely dictated by the technical function of the product.

Although no substantive examination is performed, the fulfilment of these requirements is recommended in case of a boomerang invalidation action at the time of enforcement. In this event, the burden of proving the lack of novelty lies with the claimant.

A design is considered to be new if there is no identical design that could be known to those in the relevant sector in Switzerland and that has been made available to the public prior to the filing or priority date. Here, there is a 12-month grace period. Novelty is not destroyed if the disclosure happened within one year maximum before the application was filed.

A design has individual character if the overall impression produced by non-immaterial features differs from any design that could be known to those in the relevant sector. In other words, the significant features must clearly differ from those of existing designs. The Federal Supreme Court (DFT 134 III) denied design protection to a ring because the differences were found to be secondary features and consequently, the general impression to not differ from that of existing rings. The degree of freedom of the designer is taken into account and the more this is restricted, the more the differences are regarded as important.

A design will be rejected if all features and their combination are purely functional.

There is no limitation with respect to the number of variants of a design. Thus, all variants can be filed through a single multiple design application on the condition that they fall into the same product class under the Locarno Agreement. Bracelets, brooches, earrings and necklaces all belong to Class 11. In addition, different representations can be combined, each being counted as a separate variant. Graphical reproductions (ie, formal line drawings) should focus on the main aspects claimed for protection. Photographs allow to depict specific details (eg, colours) and better capture the overall impression.

Partial designs are admitted. The disclaimed parts should be depicted in dotted or dashed lines, while shading is accepted for photographs. This means that the distinctive element on its own (if new) can be protected. Should this element become a recurring feature in future designs, it can be disclaimed later on.

To best depict the design, seven views (ie, from all sides) should ideally be submitted. A description of the features may also be added.

Publication can be deferred for up to 30 months from the filing or priority date. A good practice is to file the design once it has been created and to keep it confidential until the launch. Publication can be requested at any time.

3D trademark protection

A 3D trademark may also be considered. Trademarks can be renewed indefinitely. Another advantage is the wider scope of protection, since they allow owners to defend against confusingly similar signs from the perspective of the relevant consumer (who has less attention than an informed user). However, 3D trademark rights are difficult to obtain. The Swiss Trademark Act excludes the shapes of goods from protection if they are technically necessary. With regard to distinctive character, the applicant must demonstrate that consumers recognize the design as a source identifier. The wide variety of jewellery shapes makes it extremely difficult to establish a significant difference between those in the marketplace. For example, no distinctive character was found for the watch strap of Swatch Group as held by the Federal Administrative Court in a decision of 24 February 2004 (ATF 130 III 328).

Overall, these instruments complement each other well. Design rights are a good way to protect the artistic value of jewellery designs, and thereby preserve their commercial value. A jewel is unique not only for its owner but for its designer too; it is better to keep it so.

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