



GLOBAL LEADERS

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INTERVIEWS WITH THE PINNACLE
OF THE TRADEMARK PROFESSION

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Jürg Simon

WTR says: Jürg Simon is “one of the most effective and skilled lawyers in Switzerland, but is also humble and down-to-earth in his manner.” He has a rich knowledge of trademark law and secures excellent results for clients as both a litigator and transactional lawyer.

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Biography

Prof Dr Jürg Simon is a leading expert in IP and competition law, advisory, litigation and transactional matters, with a specific focus on trademarks, designs, licensing, selective distribution systems, IT, media and geographical indications. He is also involved in significant patent litigation in the IT and food industries. Prof Dr Simon was a director at the Swiss IP Institute and is a professor of intellectual property at the University of St. Gallen.



You are a past and acting president of two Consorzi in the Swiss dairy industry and a member of the board of directors of IP-intensive companies. How has this experience contributed to your professional development?

Any IP-related hands-on experience is important and valuable for professional development. Such functions especially enable a very deep insight into strategic considerations related to intellectual property. They lead away from case-by-case thinking towards a long-term view of intellectual property. In the long run, IP portfolios are usually more relevant for companies than a single case, and the experience gained in these activities naturally enriches the advisory and litigation practice.

Which three key characteristics would you say are necessary to create an outstanding IP practice?

As banal as it sounds, you first have to master the regulatory environment. In a small country like Switzerland with an important export industry, you should also know the regulatory environment of the most vital trading partners. Second, it is essential to understand the clients' business in order to be able to advise competently. Competence, in this context, means the ability to not only have an individual case in mind, but a long-term view. And third, it takes a lot of good and efficient work. Good work always produces more good work.

How can rights holders use different IP rights (eg, trademarks, design rights) to protect their brands in Switzerland?

Swiss court practice recognises that an object, for example a trademark, may fall within the scope of protection of several property rights. If the protection requirements of a law, for example the design or copyright law, are fulfilled, then these laws are also

cumulatively applicable. Such overlaps are not a problem for the trademark owners, but an advantage. It is also an advantage that, irrespective of register rights, the Unfair Competition Act can also always apply if its protection requirements are met. This is particularly important for signs that are not registered as trademarks, which are known in the market and used like trademarks.

The Swiss Federal Institute of Intellectual Property has recently relaxed its practice concerning trademarks containing a geographic indication of origin. Is this a welcome development, and do you have any advice for owners of such trademarks in light of the new practice?

Yes, this very welcome development was overdue. It is based on making practice more flexible to accommodate service marks, which has now been transferred to trademarks for goods. For the owners of such trademarks, the development means that they no longer have to develop special solutions for Switzerland and that these trademarks can be protected in the same way as they are in most other countries.

Major companies are already engaging in the metaverse. What would you say are the three most critical steps that brand owners should take right now in this developing space?

The metaverse is no reason to fundamentally question or change established brand strategies. However, there is an increased risk of infringement by third parties. Therefore: first, regular monitoring; second, policing; and third, if necessary, complement the trademark claims if new forms of offer come into question or if these complements can facilitate the enforcement of rights.