

Curriculum Vitae – BERNARD VOLKEN



Attorney-at-Law, Partner, Fuhrer Marbach & Partners
Konsumstrasse 16 A, 3007 Bern – Switzerland, volken@fmp-law.ch

Nationality: Swiss

STUDIES

1986-1991	University of Fribourg (Switzerland), licentiatus iuris (Master of Laws)
1994	Zurich, Attorney-at-Law, admitted to all Courts of Switzerland

LECTURING /TEACHING ACTIVITIES

Since 2007	WIPO expert speaker for Design- and Trademark Law
2011-2015	Zurich University of Applied Sciences, trademark and design law, in the field of a MAS Master of Advanced Studies in Intellectual Property Rights
Since 2017	Professional School of Advanced Training St. Gall, Course Visual Design, copyright, trademark and design law
Expert speaker	Acts regularly as expert speaker at IP congresses worldwide

PROFESSIONAL ACTIVITIES

1991-1993	Clerk to the District Court of Pfäffikon ZH
1994-1997	Legal Assistant to the Legal Section for patents and designs at the Swiss Federal Institute of Intellectual Property (IPI)
1994-1997	Head of a trademark examination section IPI

1997-1999	Head of the opposition proceedings section IPI
Since 2000	Partner at the Law firm Fuhrer Marbach & Partners

MEMBERSHIP

ECTA	European Trademark Association, Chair of the Design Committee
Marques	Trademark Owners Association, Member of the Ant counterfeiting Committee
INTA	International Trademark Association
INGRES	Swiss Association of IP Attorneys
SAV	Swiss Bar Association

EXPERT ACTIVITIES

Examination expert for Swiss Patent Attorneys

Since 2000 contributing editor to the Journal for Intellectual Property Law, Information Law and Competition Law «sic!»

PUBLICATIONS

Basler Kommentar zum Markenschutz- und Wappenschutzgesetz, Kommentierung der Artikel 10-12, 31-34 MSchG, Vorbem. zu Art. 70-72h MSchG, Art. 70-72h MSchG, Helbling Lichtenhahn Verlag, 2017

„Anmelde- und Durchsetzungsstrategien im Designrecht“, Weblaw Juni 2016

«Die Markenrechtsverletzung», in «Schweizer IP Handbuch», Helbing Lichtenhahn Verlag, 2013

«Der allgemeine Gleichheitssatz im Markenprüfungsverfahren bei Gemeinschaftsmarken der EU sowie im deutschen und im schweizerischen Markenprüfungsverfahren» von Philipp Dannacher, besprochen in sic! 2013 642

Besprechung des Urteils des Oberlandgerichtshofes München vom 14. Mai 2009
 «Designschutz Geländewagen», in «Designschutz in Europa», Band 4,
 Carl Heymanns Verlag 2012

«Marke und Tourismus. Widerspruch oder Schlüssel zum Erfolg?», in «Gedanken zum Schutz von geographischen Zeichen», Festschrift für J. David Meisser, Stämpfli Verlag 2012

«Designschutz in Europa, Bd. 3», von Dr. Henning Hartwig, besprochen in sic! 2010 69 und Zeitschrift «Hochparterre» 2009-07-08

«Kommentar zum Bundesgesetz vom 5. Oktober 2001 über den Schutz von Design (Designgesetz DesG)», Stutz/Beutler/Künzi, besprochen sic! 2006 916

«Parallelimporte patentrechtlich geschützter Güter – missbräuchliche Zustimmungsverweigerung des Schutzrechtsinhabers», Dr. Fredy Guyer, besprochen zusammen mit Dr. Donatella Fiala in sic! 2006 449

«Der rechtliche Schutz von Domainnamen», in «Marketingerfolg im Internet», Orell Füssli Verlag, 2003

«Das urheberrechtlich geschützte Werk als Zeichen für Waren und Dienstleistungen», von Dr. Markus Ineichen, besprochen in sic! 2003 474

«Der strafrechtliche Schutz der Marke unter besonderer Berücksichtigung der Piraterie», von Dr. Corsin Blumenthal, besprochen in sic! 2003 88

Patentrecht – Wiedereinsetzung in den früheren Stand
(Art. 47 Pat6); Wegfall des Hindernisses: AJP 9/96, p. 1166 ff.

Numerous articles such as book reviews and summaries
of court judgements

SELECTED IP LAW PRESENTATIONS

Germany/Hamburg, ECTA Hamburg “Filing strategies: tricks and pitfalls, underlined with newest case law”, 10 – 13 June 2015

Lithuania/Vilnius, Seminar “How to Protect your Designs Abroad?”, 24 April 2015

India (Kolkata and Ahmedabad), Public Awareness Building on the Madrid System for the International Registration of Marks, “Experiences of Using the Madrid System”, November 2014

China (Hangzhou, Ningbo, Jinhua, Taizhou, Zhejiang), “Roving Seminar on the Effective Use of the Madrid System for the International Registration of Marks Experiences of Using the Madrid System”, July 2014

Russia/Moscow, International Conference WIPO-ROSPATENT “Industrial Designs: Past, Present and Future”, 24 April 2014

Switzerland/ Zurich, LES-CH Fachtagung 2014: Kauf statt Lizenz „Due Diligence: Vorbereitung eines Schutzrechtskaufs bzw. – verkaufs“, 3. April 2014

University St. Gallen, «Gebrauchsabsicht bei Marken(-anmeldungen)», 14 June 2013

Germany/Hamburg, PTMG Conference, «Clearing Pharmaceutical trademarks: parameters and pitfalls», 18/19 March 2013

Philippines/Cebu, «Philippines, «Advantages and Benefits of the Hague System for Various Stakeholders», December 20, 2012

China/Shunde City, «Protection of Industrial Design and International Registration System - «Design Strategies in Business Development», November 13, 2012

Paris, «Spécificités du droit des marques Suisse – ce qu'il faut savoir!» 14 December 11

Kuwait City, Advantages of the Hague System from the Users' Point of View: Choice, Protection and Use. A Swiss Perspective" 25 Oktober 11

Switzerland/Bern, «Marken-, Patent- und Designregistrierung sind gut – deren erfolgreiche Durchsetzung noch besser», 11 May 11

Switzerland/Zurich, «Die neuen sachlichen Zuständigkeiten» (Art. 5 udn 6 ZPO, Art. 26 PatGG), 25. November 10

Tunisia/Tunis, «Advantages of the Hague System from the Users' Point of View: Choice, Protection and Use. A Swiss Perspective», 29/30 June 10

Switzerland/Genf: «L'arrêt L'Oréal de la CJCE: bonnes nouvelles pour la protection des marques de haute renommée?», 6 Mai 10

Switzerland/Bern, «Markenstrategien», 2 March 10

Bulgaria/Sofia, «Practical cases in Trademark Litigation», 25 November 09

Bulgaria/Sofia, «The Protection of Trademarks rights: The point of view of a Trademark Attorney», 25 November 09

Switzerland/Rigi, LES, «Due Diligence and IP Transactions», together with Dr. Markus Ineichen, 19 September 09

Switzerland/Spiez, VSP, «Designschutz an der Grenze zum Patentschutz», 21 August 09

Switzerland/Baden, AIPPI, «Unterschätzte Trümpfe des Designrechts», 6 May 09

Germany/Munich, «Domain-Namen Streitigkeiten aus Sicht des Prozessanwalts», 6 November 08

Germany/Berlin, INTA, «Trademark Similarity in a Global Context – Switzerland's Perspective», 19 May 08

Lituania/Vilnius: «Advantages of the Hague System from the User's Point of View», 7 May 08

Lituania/Vilnius: «The Role of Trademarks in World Trade and their effective protection», 6 May 08

RATINGS

Mr Volken has been praised as “outstanding in terms of professionalism” (*Client Choice International 2014*); “to the point and an excellent adviser... with a very pragmatic and business-oriented approach” (*Chambers Europe 2015*); “an expert on all aspects of trademark law, approachable, flexible and efficient” (*Who's Who Legal 2014*); “a terribly bright litigator with incredible experience in prosecution also” (*WTR 1000 2015*); a “solution-oriented and skillful lawyer” (*Chambers Europe 2016*); having a “quick grasp of complex issues” (*Who's Who Legal 2015*); and being “diligent and personable” (*WTR 1000 2016*). “He is a terrific, pragmatic and solutions-oriented all-rounder, although he is perhaps best known for his contentious prowess. He is brilliant on the courtroom floor. He is persuasive and extremely good at client handling – quite extraordinary” (*WTR 1000 2017*).

AWARDS

Winner of the ILO (InternationalLawOffice.com)
Client Choice Award 2011 for Switzerland in der category «Intellectual Property»

Winner of the ILO (InternationalLawOffice.com)
Client Choice Award 2014 for Switzerland in der category «Intellectual Property»

LANGUAGES

Native language: German

Fluent in English and French

Good knowledge of Italian