

ECJ's reasoning strictly applied in MOTOCORSA Case Switzerland - Meyer Lustenberger

Examination/opposition National procedures

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The Swiss Federal Board of Appeal for Intellectual Property has upheld German automobile manufacturer [Opel Eisenach GmbH](#)'s opposition to the registration in Switzerland of an international application for the word and device mark [MOTOCORSA](#) filed by Czech company [Motoforza spol sro](#) for motorcycles and related parts (Registration IR 807 752, October 19 2005). Opel's opposition was based on its earlier CORSA word mark registration for automobiles.

The opposition board of the Swiss Federal Institute of Intellectual Property dismissed the opposition arguing that the MOTOCORSA trademark was sufficiently distinctive from the word mark CORSA due to its graphic elements. Opel appealed the decision.

The Swiss Federal Board of Appeal first clarified certain aspects of the assessment of similarity of goods and services in the motor vehicles field, holding as follows:

- 'Automobiles' are to be considered similar to 'motorcycles' since there are companies producing both;
- 'Automobiles' should also be considered similar to 'tyres' because (i) a car cannot function without tyres, and (ii) most garages offer tyres as part of their car sales and repair services;
- 'Tyres and their parts' and 'maintenance of means of transportation' should be viewed as similar to 'production of motor vehicles'; and
- The services 'advertising of motorcycles' and 'selling of advertisement space on motorcycles' are not within the scope of similarity of 'motor vehicles'.

Turning to the signs at issue themselves, the board ruled that the word and device mark MOTOCORSA was not sufficiently distinctive from the word mark CORSA to avoid confusion especially as the MOTOCORSA mark could be considered as a sub-brand of Opel's CORSA range of automobiles.

According to established Swiss case law, no new distinctive sign is created by adding additional elements to an earlier trademark unless the additional elements are highly distinctive.

In the case at hand, the board concluded that the additional element 'MOTO' as well as the various graphic elements were generic and accordingly could not be considered. Therefore, it found that Motoforza's mark was likely to cause confusion with Opel's well-known CORSA mark and upheld Opel's opposition.

While this finding may be correct, another general rule of Swiss trademark law exists which indicates that, when assessing the similarity of trademarks, the signs must be considered in their entirety and not by comparing their various elements separately. The board, however, seems to have failed to apply this rule and did not consider the fact that the word 'Corsa' in Motoforza's mark was written together with the term 'Moto' to form '*Motocorsa*', which means 'motorcycle racing' in Italian, one of the official Swiss languages.

The findings of the board are in accordance with the [THOMSON LIFE](#) decision of the European Court of Justice (ECJ). (For discussion of the ECJ's ruling, see [LIFE Case allows ECJ to clear up confusion over composite marks](#).) However, the board appears to have applied a very strict interpretation of the ECJ's reasoning, meaning that it failed to take a number of arguably distinctive elements of the MOTOCORSA mark into consideration.

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