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Two recent rulings released by the Swiss Supreme Court in trademark law

The Swiss Supreme Court has recently rendered two cases in the field of trademark law, whose main holdings are summarized below:

4A_97/2020 Centralized attack

Let us first recall that the so-called Madrid system allows an entity to file a trademark in a country of origin (known as a basic trademark), and then to benefit from this registration in order to file an international registration in countries that have adhered to the Madrid Agreement or its Protocol.

The validity of the marks registered in the different countries through the international filing is then linked to the validity of the basic mark during the five years following the date of the international registration (art. 6 of the Agreement and art. 6 of the Protocol). In other words, assuming that the basic mark is subject to a cancellation action in the country of origin and that this action leads to its cancellation, all marks registered in the different countries as a result of the international registration will be cancelled. This is referred to as a centralized attack, since the attack, central and directed against the basic mark, leads to the invalidity of all the international registrations resulting therefrom.

In this decision, the Swiss Supreme Court ruled, in our opinion quite logically, that even if a plaintiff is not seated in Switzerland and does not carry out any activity in Switzerland, it should be recognized as having an interest in the sense of Art. 52 of the Swiss Trademark Law to file a cancellation against the basic trademark (in the event that it is registered in Switzerland) as long as the aforementioned five-year period has not expired, since the cancellation of the basic trademark will trigger the cancellation of all international registrations resulting therefrom; however, the plaintiff must also demonstrate that it carries out an activity in at least one of the countries where the international registration has been extended, which was the case in the present case.

4A_297/2020 Action for Assignment of a Trademark Application

The Swiss Supreme Court first ruled that, as long as the defendant does not recognize the merits of the plaintiff's claims, in this case a trademark infringement, the latter still has an interest to file a claim pursuant to art. 55 para. 1 lit. a of the Swiss Trademark Act, notwithstanding the defendant's change of corporate name during the course of the proceedings.

In line with the unanimous scholarly opinion, the Swiss Supreme Court further ruled that the trademark assignment action anchored in art. 53 of the Swiss Trademark Act can not only be filed against a registered trademark, but also against a simple application, notwithstanding the literal construction of Art. 53 of the Swiss Trademark Act.

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