

## No BIG DEAL? Supreme Court confirms likelihood of confusion between marks as used

June 25 , 2018

**IP adjudicator found no likelihood of confusion between word mark BIG DEAL and stylised mark BIG DEAL**

**District court held that adjudicator should have examined similarity between marks as used by parties**

**Supreme Court agreed that likelihood of confusion was obvious when comparing marks as used**

In a motion for leave to appeal from a district court judgment, the Israeli Supreme Court has upheld the district court's finding of a likelihood of confusion between the trademark BIG DEAL (registered as a word mark), used by the opponent with respect to a retail business, and the trademark BIG DEAL (stylised), used by the applicant to offer merchandise for sale over the Internet.

In *Yediot Internet v HAB Trading Ltd* (RLA 8545/17), Supreme Court Justice M Mazuz upheld a district court judgment reversing a Trademark Office decision finding that there was no likelihood of confusion despite the similarity of the marks (depicted below).



### Trademark Office decision

In a decision issued by the IP adjudicator in opposition proceedings, the Trademark Office held that the opponent's BIG DEAL mark, registered in uppercase letters, and the applicant's BIG DEAL stylised mark were mutually distinctive and that, under the circumstances, less weight was to be attributed to the fact that both marks shared the word combination 'big deal'. The IP adjudicator added that, although there was an overlap in the target audiences, the fact that the opponent used the mark for retail stores, while the applicant used it on the Internet to offer deals in fields such as tourism, lenses and optics, and health and sport products, was sufficient to eliminate a risk of confusion. The IP adjudicator concluded that the rival marks did not cover goods of the same description, and added that the 'common sense' test indicated that no confusion could occur. In this regard, the adjudicator pointed to a survey conducted by the applicant which showed that its own mark had acquired secondary meaning in connection with the online promotion

and sale of coupons and products.

### **District court decision**

The opponent filed a request to appeal the IP adjudicator's decision to the Tel Aviv District Court, which accepted the appeal. The district court held that the adjudicator was supposed to examine the similarity between the marks as used by the parties, namely:



Such comparison, it was held, would have led to the conclusion that “there was a considerable similarity between the trademarks and that, under the circumstances, confusion may occur”. It was also held that, nowadays, the general public is accustomed to seeing various commercial companies operating both in physical shops and on the Internet; therefore, the fact that the parties differed in this respect did not give rise to a different perception among consumers.

The applicant filed a request to appeal the district court's judgment with the Supreme Court. It contended that the district court had erred in comparing its device mark and a particular device mark (one of many)

used by the opponent, as it was necessary to compare the propounded mark to the trademark as registered. The opponent argued that the protection provided by its word mark was broad and covered any device marks that included the word combination 'big deal'; therefore, the applicant's mark fell under the scope of the registered mark.

### **Supreme Court decision**

While noting that the Supreme Court would generally refrain from intervening in a “second appeal”, Justice Mazuz found that the case did not introduce a new test for establishing confusing similarity but, rather, merely implemented the general parameters according to which likelihood of confusion is determined.

Nonetheless, the Supreme Court opined, in an obiter dictum, that while the authority is that protection afforded to a word mark is broad since it covers any representation of the word, it could not give broad protection to a trademark that included a common word combination such as 'big deal' outside of the context of the mark as actually used. As the district court's judgment was not based on the broad scope of protection to be afforded to a word mark, there was no need to decide the matter. The Supreme Court noted that, when comparing the trademarks as used side-by-side, the likelihood of confusion was indeed apparent.

**This article first appeared on WTR Daily, part of World Trademark Review, in May 2018. For further information, please go to [www.worldtrademarkreview.com](http://www.worldtrademarkreview.com)**

**David Gilat**

Adv., Patent Attorney, Senior Partner



David Gilat , attorney at law and patent attorney, is a senior partner at Gilat, Bareket & Co.

---

These newsletters are provided for general information only. It is not intended as legal advice or opinion and cannot be relied upon as such.