

Registration refused based on reverse passing off considerations

Examination/Opposition
National procedures

Israel - Gilat, Bareket & Co, Reinhold Cohn Group

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The registrar of trademarks has rejected **Rolex SA's** application to register the trademark ROLEX PRINCE on the grounds that there was a likelihood of confusion with the earlier registered trademark PRINCE (February 26 2008).

Rolex applied for the registration of the mark ROLEX PRINCE for goods in Class 14 of the **Nice Classification** (watches and parts thereof) (Application 182596). The application was rejected on the grounds that there was a likelihood of confusion with the earlier mark PRINCE for similar goods.

In a subsequent hearing before the registrar, Rolex claimed that there was no likelihood of confusion with the mark PRINCE based on the following arguments:

- ROLEX is a well-known mark;
- The average consumer will perceive the mark ROLEX PRINCE as describing the Rolex Prince watches;
- 'Prince' is a suggestive word when used in association with luxury goods and is thus entitled to less protection; and
- Rolex has used the PRINCE product mark since the 1920s.

The registrar held that although ROLEX PRINCE combines Rolex's house mark (which is undoubtedly well known) and the product mark PRINCE, the trademark was not eligible for registration since the second part was identical to the registered trademark PRINCE.

The registrar confirmed that the overall impression of the marks must be taken into account in assessing whether there is a likelihood of confusion. However, the registrar emphasized that the addition of a company's house mark to a third party's registered mark does not necessarily prevent confusion among the public. On the contrary, such addition may increase the likelihood of confusion as to the source of goods.

In addition, the registrar held that the combination of a house mark and a registered mark is liable to dilute the common component of the marks and damage the proprietary rights of the owner of the registered trademark. Such use creates the impression that the registered mark is descriptive of the goods covered and reduces its distinctive character.

The registrar also dismissed Rolex's claim that 'prince' is a laudatory word that is entitled to less protection. The registrar noted that where the combination of a house mark and a product mark results in a new or additional meaning, the public may perceive the combination as a single semantic unit. The likelihood of confusion will thus be reduced, as will the likelihood of dilution. The registrar held that while PRINCE may, at most, be

suggestive in respect of the quality and prestige of the goods, it is not suggestive of the essence of the goods and is certainly not descriptive. Therefore, the combination of Rolex's house mark and product mark does not create a new or separate meaning for the word 'prince'.

Finally, the registrar rejected Rolex's claim that it had used the PRINCE product mark since the 1920s, as Rolex had failed to oppose the registration of the trademark PRINCE.

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