

World Trademark Review Daily

Opposition upheld based on likelihood of implied connection
Israel - Gilat, Bareket & Co, Reinhold Cohn Group

Examination/opposition
National procedures

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In *Israel National Lottery v Starwood Hotels & Resorts Worldwide Inc* (January 11 2010), the registrar of trademarks has upheld the [Israel National Lottery's](#) opposition against [Starwood Hotels & Resorts Worldwide Inc's](#) application for the registration of a shooting star device.

Starwood applied to register a shooting star device as a trademark for hotel and restaurant services in Class 43 of the [Nice Classification](#). Another application for entertainment services, including casino and gaming, in Class 41 was abandoned. Starwood had formerly held registrations for an identical device for hotel services in Class 42, and casino and gaming services in Class 41, which had been cancelled for non-payment.

The National Lottery holds several registrations for composite marks containing a shooting star in respect of lottery and gaming services. However, none of the marks consists of a shooting star device on its own. The National Lottery's affiant testified that, while the National Lottery did not engage in hotel or casino services, it intended to expand its operations in the near future.

The registrar of trademarks first held that the National Lottery had demonstrated that it had used its marks, with slight graphic variations, for many years. The registrar further found that the shooting star device was a well-known mark of the National Lottery.

Moreover, the registrar held that under the usual similarity tests, Starwood's mark was similar to the National Lottery's registered marks. From a visual point of view, the registrar found that:

- the shooting star was the dominant element of the National Lottery's well-known marks; and
- based on the imperfect recollection of consumers, the difference between the shooting star element in the National Lottery's marks and Starwood's shooting star device was minor.

The registrar noted that the services of both parties targeted the same customers, and that hotel services and lottery services were related.

The registrar thus applied Section 11(14) of the [Israeli Trademarks Ordinance 1972 \(New Version\)](#), which precludes the registration of a sign that is similar to a well-known registered mark, even if the goods or services concerned are of a different description, where consumers are likely to make connection between the sign and the trademark owner, thereby causing harm to the latter.

Given that the services were related and that the National Lottery intended to expand its services, the registrar held that there was a likelihood of implied connection, the threshold for which is lower than for a finding of likelihood of confusion (for further details please see "[Nike kicks out HIKE from register](#)"). The registrar concluded that Starwood had failed to prove that the marks could coexist in Israel without causing confusion.

Finally, the registrar noted that, alternatively, the opposition could have been upheld based on the 'family of marks' doctrine, which provides that a recurring motif in a number of marks may create an association between the goods and a common source.

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