

## Decision shows retroactive effect of mark pending at date of proceedings

Israel - **Gilat, Bareket & Co, Reinhold Cohn Group**

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Confusion  
Passing off

In *Odem Pop-Shop Ltd v Nurieli Brothers Ltd* (CC 1595-04, January 31 2010), the Tel Aviv District Court has held that the plaintiff's registered device mark, which included the image of the so-called 'Lipstick Girl', was infringed by the defendant's mark.

Odem Pop-Shop Ltd operates fashion retail stores under the name Odem (Hebrew for 'lipstick'). In 2002 Odem applied for the registration of a device mark consisting of a drawing of a girl and the stylized word 'Odem' for services in Class 35 of the [Nice Classification](#) ("gifts, pop accessories, leisure and fashion shops"). The mark was registered in April 2004. Odem subsequently applied for the registration of the mark with respect to goods in Class 25 ("clothing, footwear, headgear"), among others.

In March 2004 it came to Odem's knowledge that the defendant, Nurieli Brothers Ltd, was making use of a device mark similar to the 'Lipstick Girl' mark on goods such as hats and footwear. The defendant's mark did not contain the word 'Odem', had a different background and used different colours.

Odem brought an action for passing off, trademark infringement and unjust enrichment on April 28 2004, two weeks after its service mark was registered in Class 35 (the other trademark applications were still pending).

The Tel Aviv District Court held that the defendant's mark was confusingly similar to Odem's mark, even though there were differences between them. Therefore, use of the defendant's mark on hats and footwear infringed Odem's trademark in Class 25, despite the fact that the trademark was registered in Class 25 only after the lawsuit was brought.

The court further held that the defendant's goods in Class 25 and Odem's services in Class 35 were of the same description, and that Odem's service mark had already been registered by the time the action was filed.

The court also found for Odem with regard to passing off. The court recognized that, in order to prove goodwill, Odem did not necessarily have to submit consumer surveys. It held that Odem had demonstrated goodwill by submitting witness testimonies showing that some of the defendants' goods had been returned at Odem's stores.

However, the unjust enrichment claim was rejected due to, among other things, Odem's failure to show that it had invested effort and money in creating its product.

The court nevertheless awarded damages in the amount of IS60,000 to Odem.

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