

# World Trademark Review Daily

**Opposition successful even though opponent's goods not sold in Israel**  
**Israel - Gilat, Baret & Co, Reinhold Cohn Group**

**Examination/opposition**  
**National procedures**

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In *Chinoi Gyogyszer es Vegyestzeti Termekek Gyara Rt v Schreiber* (Opposition to the registration of mark No 202248, January 23 2011), the Israeli Trademark Office has upheld an opposition by an affiliate of [Sanofi-Aventis](#) against the registration of the word mark NO-SPA for nutritional supplements.

In 2007 the applicant applied for the registration of the mark NO-SPA (in English and Hebrew lettering) for nutritional supplements to relieve stomach pain and indigestion in Class 5 of the [Nice Classification](#). The opponent, a Hungarian affiliate of multinational pharmaceutical company Sanofi-Aventis, opposed the registration based on its NO-SPA marks (ie, the word marks NO-SPA, NO-SPALGIN and NO-SPA FORTE, and the three-dimensional marks NO-SPA and SPA, as appearing on pills), registered for (spasmolytic and analgesic) pharmaceuticals in Class 5.

The applicant argued, among other things, that:

- the goods at issue were different - the opponent's goods were pharmaceutical preparations in the form of tablets for therapeutic and veterinary use, while the applicant's goods were nutritional supplements in a liquid form (droplets) for regular use by humans;
- the Hebrew lettering in its mark distinguished it from the opponent's marks;
- the applicant's mark, as used in Hebrew on the packaging of its product, included vocalisation dots, which further prevented confusion; and
- the opponent's product was not marketed in Israel and, therefore, the only product known to the Israeli consumers under the name No-Spa was that offered by the applicant.

The opponent adduced:

- an affidavit by its officer testifying to the fact that No-Spa pharmaceuticals are renowned globally, particularly in Russia; and
- a consumer survey demonstrating that immigrants who had arrived in Israel since the 1990s were highly familiar with, and significantly used, No-Spa pharmaceuticals.

The IP adjudicator analysed the similarity of the marks for the purpose of Section 11(9) of the [Trademarks Ordinance](#) (5732-1972), which prohibits the registration of a mark that is identical, or confusingly similar to, another mark registered in respect of the same goods or goods of the same description. The IP adjudicator held that the opposed mark contained in its entirety the opponent's NO-SPA mark, registered since 1975 for spasmolytic preparations in Class 5. In addition, 'No-Spa' was held to constitute the dominant element of the marks NO-SPA FORTE and NO-SPALGIN, registered for spasmolytic preparations in 2004 and 2005, respectively. The IP adjudicator noted that the opponent's use of its marks was irrelevant for the purposes of Section 11(9).

The IP adjudicator further held that medical preparations and nutritional supplements ought to be considered as goods of the same description because they are interchangeable (or at least supplementary), as they are sold primarily in pharmacies and may be used by the same consumers for the same ailments.

Applying the three-fold test of confusing similarity (ie, the visual and phonetic similarity of the marks, the type of goods and potential consumers, and the other circumstances of the case), the IP Adjudicator held as follows:

- The marks were similar visually and phonetically, and the Hebrew lettering was likely to be perceived merely as an adaptation for the Israeli market. The vocalisation dots in the mark as actually used had no implication on the opposed mark, which did not contain any dots.
- Both parties' products were intended to treat the same ailment (stomach pains) and to be sold via the same distribution channels (pharmacies). The fact that the applicant's product was sold over the counter (and, therefore, was freely accessible without professional guidance) contributed to the likelihood of confusion: consumers familiar with the opponent's product were likely to believe that the opponent had started marketing nutritional supplements.
- As to the other circumstances of the case, the IP adjudicator emphasised the importance of preventing confusion between pharmaceuticals and nutritional supplements, which have no therapeutic effect.

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In light of her decision to refuse registration due to the confusing similarity of the marks under Section 11(9) of the ordinance, the IP adjudicator did not proceed to analyse the other grounds of opposition. She did, however, examine the opponent's allegation that the applicant sought to register its mark in bad faith due to:

- the fact that the applicant was aware of the opponent's use of its marks abroad; and
- the similarity of the packages as sold.

The IP adjudicator noted that she could not determine unequivocally that the applicant had applied for registration in bad faith because, among other things, the latter had relied on the acceptance of the mark by the trademark examiner, which was made in error.

Costs of IS8,000 were imposed on the applicant.

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