

World Trademark Review Daily

Owner of lion's head device fails to obtain interim injunction
Israel - Gilat, Bareket & Co., Reinhold Cohn Group

Confusion
Passing off

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In *Yatir Winery Ltd v Asher Bentulila* (CC (Jer Distr) 40943-11-11, December 14 2011), the Jerusalem District Court has rejected a motion for interim injunction filed by the owner of a lion's head device mark, registered for wines in Class 33 of the [Nice Classification](#), against use of a lion's head device for liqueurs.

[Yatir Winery Ltd](#), a subsidiary of Carmel Wines Ltd, is the owner of a registered device mark (Registration 197786) depicting a lion's head surrounded by a circle, in respect of wines in Class 33:



The trademark was registered in 2007 and is used on wine bottles.

Yatir sued Lavie Winery Ltd on the grounds of trademark infringement, passing off and misappropriation of goodwill, seeking a permanent injunction, accounting and damages. It also petitioned for an interim injunction and recall order *ex parte*.

The petitioner brought suit after it discovered that the respondent marketed liqueur in bottles bearing the respondent's logo together with a lion's head device. The petitioner claimed that other wineries use marks depicting a lion, but not a lion's head.

The respondent argued, among other things, that the petition was barred by laches, as the allegedly infringing use began in 2010 and, in any event, the petitioner had had knowledge of the allegedly infringing use for over three months before bringing suit in 2011.

The court reiterated that a decision as to whether to grant an interim injunction weighs the plaintiff's *prima facie* right, that is, the chances of success of its claim, the need for an interim order to preserve the *status quo*, and the balance of convenience and damage to each party from the grant or non-grant of the order, whether the plaintiff's damage is compensable, and considerations of equity.

Examining the petitioner's *prima facie* right and the chances of success of the trademark infringement claim, the court held that, although there was a certain degree of visual similarity resulting from the fact that both marks depict a front view of a lion's head, the similarity was not such as to warrant an interim injunction. In this regard, the court held that the marks as actually used on the bottle labels were sufficiently different in their design to create a totally different visual impression (the petitioner's mark is a black lion's head on a white background within a black circle, which is small in size and appears next to the petitioner's name; the respondent's mark is a white lion's head on a black background within a square, which takes up the majority of the label). Noting the widespread use of the image of a lion on wine bottles by various manufacturers, the court concluded that the conceptual message was not unique to the petitioner.

The court further noted that, prior to adopting its present mark in 2010, the respondent had, for a period of about nine years, made use of a lion's head device that was more similar to the petitioner's mark, but to which no objection was raised. Finally, the court considered the differences between the products (ie, wine and liqueurs), holding that the potential for confusion between them was small and that the target consumers were not necessarily the same.

Accordingly, the court held that an interim injunction could not be granted on the grounds of passing off and misappropriation of goodwill - even assuming that the petitioner had acquired goodwill among the relevant consumers, it had failed to show a *prima facie* likelihood of confusion.

The court held that the balance of convenience tilted in favour of the respondent, as any damage caused to it as a result of an injunction and recall would be unjustified; in contrast, the damage to the petitioner was compensable. Moreover, as the allegedly infringing mark had been used for two years in its current form,

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continued use until the hearing of the main proceedings would not cause irrevocable damage. The fact that the petitioner had been aware of the alleged infringement for three months before filing a petition was also seen as evidence of a lack of urgency.

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