

World Trademark Review Daily

Class 25 goods held to be dissimilar as parties target different clienteles **Examination/opposition**
Israel - Gilat, Baretet & Co., Reinhold Cohn Group **National procedures**

March 15 2012

In *Upcoming TM SA v European Sports Merchandising BV* (MCA 49831-01-11 (TA Distr), February 21 2012), the Tel Aviv District Court has reversed a decision of the trademark registrar to refuse the registration of the mark KILLAH, holding that it was sufficiently different from the registered mark KILLY.

In December 2010 the registrar [upheld an opposition](#) by French sportswear retailer European Sports Merchandising BV, the owner of the registered mark KILLY for clothing, footwear and headgear in Class 25 of the [Nice Classification](#), against the registration of the mark KILLAH (an extension of the Miss Sixty brand) by Upcoming TM SA, an Italian fashion retailer, for clothing, footwear and headgear in Class 25. The registrar found that the mark applied for was confusingly similar to the registered mark.

The applicant had registered KILLAH in Class 18 before the opponent had registered its KILLY marks in Classes 18 and 25.

Applying the three-pronged test of confusing similarity, the registrar had concluded that the marks were visually and phonetically similar due to their dominant element 'kill'. Moreover, the registrar had dismissed the applicant's argument that its goods (women's clothing) were dissimilar to the opponent's goods (skiing sportswear), holding that:

- the likelihood of confusion must be examined in respect of the list of goods covered by each registration (which were identical), rather than actual use, which may subsequently expand; and
- the customers may be the same.

On appeal, the Tel Aviv District Court reversed the registrar's decision, finding that substantial points of difference between the marks negated the likelihood of confusion.

Applying the three-pronged test of confusing similarity, the court held that the different length and ending of the marks counteracted the visual similarity of the shared beginning. It further held that the phonetic similarity was affected by the fact that KILLY - based on the name of French skier Jean-Claude Killy - is pronounced like a French word, and thus has a different stress pattern than the English slang word 'killah'. The court dismissed the opponent's argument that confusion may result from mistaken pronunciation, holding that consumers of skiing accessories of an - allegedly - well-known mark would recognise the name of the Olympic skier.

In addition, the court held that the registrar had erred in holding that 'kill' was the dominant element of the marks, given the evidence that 'killah' is a laudatory term in American slang.

Having regard to the differences in the visual appearance of the marks, including on each party's website (even though the mark applied for and the registered mark were both word marks), the court held that they were not confusingly similar visually.



Noting that the examination of confusing similarity is qualitative rather than quantitative, and focusing on the initial impression of consumers, the court concluded that the marks were not so similar as to confuse.

Further, noting that the list of goods in the registration is the starting point for examining whether goods are "of the same description", the court held that, in the circumstances of the case, the opponent's goods (skiing clothing and accessories sold in specialised stores) were substantively different from the applicant's goods (clothing for young women sold in malls). The court further held that the parties targeted different clienteles; the opponent's clientele consisted of a narrow and sophisticated segment, which may be expected to be acquainted with the name of the sportsman after whom the KILLY brand was named. The court noted that the opponent had brought no evidence regarding its intention to expand its range of goods to cater to the general public.

The court concluded that the marks could coexist on the register, as they coexist elsewhere in the world

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and in Israel in Class 18. The opposition was thus dismissed, and the mark KILLAH was allowed for registration.

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