

World Trademark Review *Daily*

Disclaimer does not affect likelihood of confusion assessment
Israel - Gilat, Baret & Co., Reinhold Cohn Group

Examination/opposition
National procedures

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In *Gizeh Raucherbedarf GmbH v Greek Cooperative Cigarette Manufacturing Company SA - SEKAP SA* (Opposition to the registration of marks 175808 and 175809, February 6 2012), the registrar of trademarks has refused to register two device marks that included the word 'Cooper' in respect of cigarettes, holding that the marks were confusingly similar to an earlier mark consisting of the stylised word 'Cooper', registered in respect of tobacco, smokers' articles and cigarette papers.

The applicant, [Greek Cooperative Cigarette Manufacturing Company SA - SEKAP SA](#), sought to register the stylised marks COOPER 25S INTERNATIONAL AMERICAN BLEND and COOPER 25S INTERNATIONAL AMERICAN BLEND LIGHTS for cigarettes in Class 34 of the [Nice Classification](#):



The applicant consented to disclaim each individual word contained in the marks and to limit each mark to the colours of the device as filed.

The opponent, Gizeh Raucherbedarf GmbH, holds a registration for the stylised mark COOPER in respect of "tobacco; smokers' articles; cigarette papers and sleeves; matches; and lighters" in Class 34:

COOPER

The opponent's registration disclaimed the exclusive use of the word 'Cooper'.

The opponent opposed the registration on the following grounds:

- the mark applied for was confusingly similar to its registered mark, which had allegedly become well-known in Israel due to its use since 1997;
- unfair competition; and
- public deception.

Each party alleged bad faith on the part of the other party because they had cooperated in manufacturing and distributing products in the past.

The applicant asserted that it had developed the opponent's mark (chosen as part of the name 'COOPERative') and argued, among other things, that the disclaimer served to "neutralise" the disclaimed element ('Cooper') for the purpose of comparing the marks.

The registrar applied the three-pronged test of confusing similarity - namely:

- the visual and phonetic similarities between the marks;
- the comparison of the goods and the consumers; and
- the other circumstances of the case, as well as the independent test of common sense.

The registrar found that there were considerable visual similarities between the marks. 'Cooper' was held to be the dominant element in the applicant's marks, as it appeared in a significantly larger font than the other words and was centrally positioned within the device. The registrar further held that, while the opponent disclaimed the exclusive use of the word 'Cooper', the disclaimer did not affect the likelihood of confusion. The stylised form of the opponent's mark (interlinked 'O's) was found to be insufficient to negate the similarity between the marks, as a reasonable consumer would perceive the word 'Cooper' as the central concept of the mark, regardless of whether it was stylised, especially as the consumer is exposed to each

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mark separately and relies on his/her imperfect recollection. Given the nature of cigarettes as off-the-shelf products, the phonetic similarity was held to be of secondary importance.

As to the type of goods, while the list of goods covered by the opponent's mark did not specifically include cigarettes, both parties' goods were held to be "of the same description". Further, the registrar did not see fit, absent evidence to the contrary, to divide the target consumers into those buying ready-made cigarettes and those making their own cigarettes.

Among the other circumstances to be considered, the registrar had regard to the parties' dispute over the rights in the name Cooper and the fact that the applicant makes use abroad of the mark registered in the opponent's name. The registrar held that, even though the opponent admitted that it was aware of the applicant's use of the mark COOPER elsewhere, the applicant had failed to prove bad faith.

The registrar concluded that:

- the opponent had shown that there was a likelihood of confusion; and
- despite selling its goods in Israel since 2004, the applicant had failed to bring evidence of a lack of confusion among the relevant public.

The other grounds of opposition (confusing similarity with a well-known mark, unfair competition and deception of the public) were dismissed, as the opponent had failed to prove the reputation of its products in Israel.

The registrar thus refused to register the applicant's mark.

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