

World Trademark Review Daily

Russian word for 'Baltic' refused registration based on earlier BALTICA mark

Examination/opposition
National procedures

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

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In *Baltika Breweries v S&G Intertrade Ltd* (Opposition to registration of mark 180842, March 28 2012), the Israeli Trademark Office has upheld an opposition by the owner of the registered mark BALTICA for beer against an application by a former distributor to register a device mark including the Russian word transcribed as 'Baltiyskoe' for beer and soft drinks.

In May 2005 the applicant, a company engaged in the manufacturing and retail of beer, applied for the registration of a device mark including the Russian word transcribed as 'Baltiyskoe' (meaning 'Baltic' in Russian) for beer and other drinks in Class 32 of the [Nice Classification](#):



The applicant targets a Russian-speaking audience, and claims to market beer produced in the Baltic region.

The application was opposed by Russian beer manufacturer [Baltika Breweries](#), which markets beer under several trademarks, including the mark BALTICA, which, according to the opponent, was well-known abroad and in Israel.

The opponent relied on three of its registrations, which included the word 'Baltika' in English and Russian:

- its stylised name, registered since 1999:



- two other marks applied for in August 2005 and registered in 2006:

BALTICA

БЛТИКА

The applicant was a former distributor of the opponent's products in Israel.

In the opposition proceedings, the opponent argued that the dominant element of the applicant's mark was similar to the opponent's marks and conveyed the same meaning (ie, that the products originated from the Baltic region).

Considering whether the opponent's BALTICA mark was well-known, the IP adjudicator noted that, under

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Section 1 of the [Trademarks Ordinance \(New Version\) 5732-1972](#) and the applicable case law, it must be demonstrated that the mark is well known in Israel; proof of fame in other countries does not suffice. However, she observed that, under the law, the notoriety of a mark in other countries may play a role in the determination of whether the mark is well known in Israel, due to the exposure of the Israeli public to foreign media.

The IP adjudicator held that the opponent had proved that:

- its BALTICA mark was well known and well reputed in Russia and Europe; and
- the mark was well-known in Israel, at least among the Russian-speaking public, in light of:
 - extensive advertising on Russian television channels broadcast in Israel, to which the Russian-speaking Israelis were exposed, and in Israeli media and advertising venues; and
 - considerable sales of the opponent's products in Israel.

Turning to the similarity between the marks, the IP adjudicator held that:

- the word 'Baltiyskoe' (in Russian) was the dominant element of the applicant's mark; and
- while the applicant's mark was not confusingly similar to the opponent's marks from a visual point of view, it created a likelihood of confusion from a phonetic point of view, especially given the consumers' propensity to request orally, rather than select visually, the relevant products.

The likelihood of confusion was not negated by the distinguishing element between the marks, which consisted merely of an inflectional suffix.

While the opponent had failed to establish actual confusion among consumers, it succeeded in proving that there was an objective basis for confusion. Accordingly, the applicant's mark was held to be ineligible for registration on the grounds that it was confusingly similar to a registered mark covering the same goods or goods of the same description.

It was further held that the applicant's mark was ineligible for registration on the grounds that it encouraged unfair competition. In coming to this conclusion, the IP adjudicator had regard to:

- the applicant's failure to explain its choice of mark and design;
- the similarities between the labels on the applicant's product and those of the opponent; and
- the fact that the applicant was aware of the opponent's marks and products due to the prior business relations between the parties.

Legal costs were awarded against the applicant.

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