

World Trademark Review Daily

No injunction against use of 'Soho' for commercial centre despite SOHO mark for design stores
Israel - Gilat, Baret & Co, Reinhold Cohn Group

Confusion
Passing off

April 10 2014

In *Collection Soho Limited Partnership v Electra Real Estate Ltd* (OM (TA Distr) 13408-02-14, March 9 2014), the Tel Aviv District Court has refused to enjoin a building developer from using the name Soho for a commercial centre at the request of the registered owner of the SOHO mark for a chain of home design stores. However, it restricted the developer's use of the name.

The petitioner, [Collection Soho Limited Partnership](#), has been operating a chain of design stores under the name Soho since 2003; it offers furniture, kitchenware, handbags, jewellery and fashion accessories in several cities in Israel, including Tel Aviv and Jerusalem. In 2013 it registered, without opposition, the word mark SOHO in Class 35 of the [Nice Classification](#) in respect of shops for the sale of designer goods, including tableware, kitchenware, home décor, office supplies, diaries, planners, calendars, baby products, greeting cards, bath products and furniture.

In 2011 the respondents, Electra Real Estate Ltd and a contractor, commenced building a business/shopping centre in the city of Netanya in central Israel, which is to be called 'SO HO' (with the letters 'HO' written underneath the letters 'SO') and is referred to by that name while under construction.

The parties' respective marks are shown below (the petitioner's mark is on the left, while the respondents' sign is on the right):



The petitioner, however, alleged that the respondents also made use of the name Soho written horizontally as a single word.

The petitioner brought an action against the respondents seeking to enjoin their use of the word 'Soho'. The petitioner claimed that it had acquired goodwill in the word 'Soho', which had become associated, in the eyes of the consumer public, with high-end home design stores. It sought to prevent the respondents' use of the name based on its trademark registration, as well as the tort of passing off.

In their defence, the respondents argued that the protection afforded to the petitioner's mark SOHO should be limited to the operation of stores, and that neither the petitioner's registered mark nor its rights based on the tort of passing off sufficed to prevent the establishment and operation of a commercial centre under a similar name.

The court first analysed the extent of protection to be afforded to the petitioner's registered mark. The court held that the popularity of the word 'Soho' derives from the name of the Soho district in London and of SoHo in Manhattan, New York, which, according to the court, have acquired an aura as districts combining bohemian features and a variety of activities in fashion, art, cinema, theatre and lifestyle. The judge cited dictionaries and encyclopedias on the history of the London district of Soho and the use of its name, including its literary, artistic, bohemian, fashion and nightlife associations.

The court briefly reviewed the criteria for a likelihood of confusion, and addressed the issue of whether the geographical name Soho had a "hint of a universal meaning". In this respect, the court cited the *Shemesh* case, where the Supreme Court held that certain non-descriptive words possessing a "hint of universality", such as the word 'sun', could not be deemed to be arbitrary and could not be monopolised and taken out of the public realm.

In this case, the district court held that the petitioner had successfully showed that it had acquired goodwill in the name Soho for its chain of design stores. Nonetheless, relying on the *Shemesh* ruling, the court held that Soho is the name of a geographical district possessing a special cultural aura, and is chosen for trade

World Trademark Review *Daily*

purposes in order to praise the trader's goods/services or to capture the public's attention. Therefore, it should not be easy for a party to monopolise that word. The judge proceeded to examine whether the petitioner's rights in the name Soho sufficed to prevent the establishment, under the same name, of a commercial centre offering a wide variety of services and businesses.

It was held that the difference between the parties' goods and services alone – a chain of design stores serving individual customers versus a commercial centre hosting a variety of business, offices and traders – was sufficient to create a distinction and prevent confusion.

The court held that there was no likelihood of confusion and that the name Soho had a "universal flavour". The court supported its conclusion by pointing out the use of the name Soho by third parties in similar fields, without objection on the petitioner's part.

Accordingly, the court dismissed the petitioner's claim, subject to the restriction that the respondents refrain from using the font used by the petitioner in respect of its mark, and from using the word 'design' in proximity to the word 'Soho', whether written vertically or horizontally. As the parties had agreed on an efficient procedural approach, the court ordered the petitioner to pay a lower amount of costs (IS34,000).

David Gilat, Orit Gonen and Sonia Shnyder, Gilat, Bareket & Co., Reinhold Cohn Group, Tel Aviv

World Trademark Review (www.worldtrademarkreview.com) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.