

World Trademark Review Daily

Opponent's mark held to be entitled to narrow protection due to "crowded" field

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Examination/opposition
National procedures

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In *Millennium Marketing - Intertrade (1999) Ltd v Farm Chalk Investment Ltd* (Opposition to the registration of stylised trademark 234114, March 12 2014), the registrar of trademarks has dismissed an opposition by the owner of the registered stylised mark CLICK & FRESH for kitchen utensils in Class 21 of the [Nice Classification](#) against the registration of the stylised mark CLIP FRESH BY FARM CHALK, also for kitchen utensils in Class 21. The registrar allowed the mark to proceed to registration, noting the narrow protection of similar marks in a "crowded" field.

In 2010 a BVI company, Farm Chalk Investment Ltd (an affiliate of a Hong Kong-based multinational manufacturer), applied for the registration of the stylised trademark CLIP FRESH BY FARM CHALK in Class 21 for "household or kitchen utensils and containers; food storage containers; glassware, porcelain and earthenware not included in other classes":



After its acceptance was advertised, the mark was opposed by a local company, Millennium Marketing - Intertrade (1999) Ltd, which has held a registration for the stylised mark CLICK & FRESH for "household or kitchen utensils and containers" in Class 21 since 2007:



The opponent, which is engaged in the importation and marketing of kitchenware and home design articles, asserted that it had made use of its mark since 2007 and had acquired a reputation for its products, which are marketed nationwide in Israel. It opposed the registration of the CLIP FRESH mark, arguing that it:

- was confusingly similar to its CLICK & FRESH mark, both in its entirety and in its individual elements; and
- conveyed the same conceptual message of a container tightly closed to ensure freshness.

The opponent argued that the mark applied for was liable to cause public confusion. The opponent relied on several grounds listed in the [Trademarks Ordinance \[New Version\], 5732-1972](#), namely:

- unfair competition and public confusion under Section 11(6);
- confusing similarity to a registered mark under Section 11(9); and
- confusing similarity to a well-known registered mark under Section 11(13).

The opponent alleged that the applicant's choice of a mark similar to that of the opponent was in bad faith.

In response, the applicant argued that its mark had been chosen without knowledge of the opponent's mark and used since 2011 for the relevant goods, which were widely marketed and advertised worldwide and had acquired a reputation that made it unnecessary for the applicant to free ride on that of anyone else. It further argued that the marks were sufficiently dissimilar and that its mark was suggestive of storage containers that are clipped closed. The applicant argued that the market for storage containers was saturated with containers that close with a clicking sound and make use of the words 'click' and 'fresh'; in this respect, it noted that the opponent had disclaimed exclusive rights to the words 'click' and 'fresh'.

Examining whether the marks were confusingly similar under Section 11(9) of the ordinance, the registrar applied the relevant three-fold test (visual and phonetic similarity, type of customers and goods, and the rest of the circumstances), as well as the test of common sense, and held that the marks were not confusingly similar.

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With regard to visual and phonetic similarity, the registrar concluded that the marks, viewed in their entirety, were graphically different. Moreover, as they were used for off-the-shelf products, the visual aspect was more important than the phonetic aspect.

Noting that both marks related to the same type of goods and targeted the same customers, the registrar held that the 'fresh' and 'click' elements of the opponent's mark were descriptive of the products' features and were thus "weak" in terms of likelihood of confusion. Further, he cited with approval McCarthy on the relative weakness of each mark in a "crowded" field of lookalike marks to prevent use of another similar mark, and thus the relatively narrow protection of marks in such a "crowded" field.

As to the similarity of the conceptual message, the registrar held that, unlike the opponent's mark, the mark applied for was dominated by its graphic elements; the central dark ellipse would impress itself on the consumers' mind.

Finally, the registrar dismissed the unfair competition and public deception claim under Section 11(6) of the ordinance, noting that such ground of opposition requires a showing that the opponent has acquired goodwill in its mark, which the applicant is allegedly trying to free-ride. The registrar concluded that, even though the opponent was the first party to apply for the registration of its mark, it had failed to show by evidence that it had acquired goodwill protectable under the unfair competition ground.

The mark was accordingly allowed for registration.

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