

Statutory damages for passing off awarded in fight over MIG mark

Unfair use
Passing off

Israel - Gilat, Bareket & Co, Reinhold Cohn Group

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In *Geil v Migdor* (Case 001373/02, April 26 2009), the Tel Aviv District Court has awarded statutory damages to the owner of the trademark MIG for publication of a newspaper under the name MIG by a third party before the mark was registered, but refused to award compensation for infringement of the mark after its registration, as it was no longer in use for newspapers.

The plaintiff, a small publisher, used the trademark MIG (in Cyrillic characters) for complimentary newspapers through 1999 and, sporadically, until 2006. In 2000 it applied for the registration of the MIG mark after the defendant, a large publishing company, started to publish a newspaper under the name MIG (in Cyrillic characters). The plaintiff sued the defendant for trademark infringement and passing off, among other things.

In its defence, the defendant claimed that the name MIG was the abbreviation of 'Media International Group'. The court found that the defendant was liable for:

- passing off for the period preceding the registration of the plaintiff's mark; and
- trademark infringement for the period following the registration of the mark.

However, the court refused to grant a permanent injunction for trademark infringement on the grounds that:

- the list of goods for which the mark was originally registered had since been modified; and
- by the time of the hearing, the registration no longer covered "newspapers, newsletters and magazines".

The court also refused to grant an injunction for passing off, as the mark was no longer in use for newspapers and the plaintiff no longer had goodwill in the mark (the court nevertheless noted that use of the name MIG by the defendant might have been instrumental in reducing the plaintiff's goodwill).

In addition, the court refused to award damages for trademark infringement on the grounds that the plaintiff had failed to prove that its losses had been caused by the infringement. Therefore, the plaintiff's losses were not compensable under Section 59 of the [Israeli Trademarks Ordinance 1972 \(New Version\)](#). The court also held that statutory damages for passing off under the Commercial Torts Law (5759/1999) could not apply to trademark infringement claims.

However, the court awarded statutory damages for passing off under Section 13 of the Commercial Torts Law, which provides for damages of up to IS100,000 (approximately €18,200). The court considered that the publication of each issue of the defendant's newspaper before the registration of the mark constituted a separate tort and awarded

IS50,000 in statutory damages for each of the six infringing issues (ie, a total of IS300,000), as well as IS40,000 in attorneys' fees.

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