

World Trademark Review *Daily*

Injunction against use of the word 'sun' held to be overbroad
Israel - Gilat, Bareket & Co, Reinhold Cohn Group

Unfair use
National

February 11 2010

In *GOP Shemesh Investments Ltd v Menashe Naamah* (Civil Appeal 7836/09, December 13 2009), the Supreme Court has partially revoked a decision of the Tel Aviv District Court in which the latter had enjoined the defendant from using the word '*Shemesh*' (Hebrew for 'sun') for restaurant and catering services.

The plaintiff-respondent operates two grilled-meat restaurants under the name Shemesh. It owns two device marks consisting of the words '*Shemesh*' and '*Shemesh Delicatessen*' in a yellow and red circle, as well as the word mark SHEMESH SHAWARMA, all registered for restaurants, food sale and catering services in Class 43 of the [Nice Classification](#).

The defendant-appellant opened a grilled-meat restaurant in Tel Aviv under the name Shemesh Restaurant. It used a round sign containing the word '*Shemesh*' in large fonts. Following the plaintiff's application for an interim injunction, the defendant changed its sign to '*Shemesh* Restaurant Tasty Grill'. The word '*Shemesh*' differed in size, shape and colour.

The district court held that the plaintiff had successfully showed that it had acquired goodwill in the name Shemesh in the restaurant business. Moreover, the court found that the defendant's sign, in its original form, was confusingly similar to the plaintiff's device marks, and that confusion was liable to persist despite the fact that the sign had been changed. The court thus issued an injunction prohibiting the defendant from using the word '*Shemesh*' in signs, menus and advertising.

On appeal, the Supreme Court reiterated the rule that the scope of protection afforded to a trade name depends on its position on the scale of distinctiveness (from generic to arbitrary). The court held that certain names cannot, despite their lack of connection to a particular field, be deemed to be arbitrary because a "hint of universality" is attached to them. In *SA Ferromat Trade and Services (1994) Ltd v AS Snir Ltd*, the court had held that the word 'gold' was a laudatory term and was thus unlikely to be entitled to significant protection (for further details please see "[Passing off established in GOLD marks case](#)"). In the present case, the court held that the word 'sun' is not customarily used to denote quality, but noted that its 'universal' meaning should be taken into account in determining the scope of protection of the plaintiff's marks, especially by way of interim relief. The court agreed with the district court's determination that the plaintiff had established goodwill, but concluded that an injunction preventing use of the word 'sun' was overbroad, given the universal - if not descriptive - nature of the word.

Therefore, the court partially revoked the injunction and allowed the use of the word '*Shemesh*' within the combination '*Shemesh* Tasty Grill', provided that the word did not differ from the others in size or colour.

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