

Rival applications for COSABELLA and COCABELLA allowed to proceed Examination/Opposition
National procedures

Israel - Reinhold Cohn Group

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In proceedings involving rival trademark applications under Section 29 of the [Trademarks Ordinance 1972](#), the registrar of trademarks has allowed the word mark COSABELLA and the stylized mark COCABELLA to proceed to examination (December 25 2008).

In September 2004 [Luemme Inc](#), a multinational fashion and lingerie company, applied to register the trademark COSABELLA for clothing in Class 25 of the [Nice Classification](#) (Application 174521). In February 2005 Bella Kokaraev, a local manufacturer of clothing for teenagers, applied to register the stylized mark COCABELLA for clothing (Application 178831).

Luemme claimed goodwill in its mark, which is registered in many countries, and submitted evidence of its volume of sales and advertising efforts worldwide. Luemme further argued that its mark, albeit unregistered in Israel, was well known in that country. Therefore, the registration of a similar mark for goods of the same description was precluded.

Kokaraev argued that her mark, which had been in use since 2003 and derived from her first and last name, was stylized and was thus not similar to COSABELLA. Kokaraev also claimed that she had achieved a large volume of sales in Israel (as opposed to Luemme's low volume of sales in this country) and argued that goodwill abroad was irrelevant for the purposes of registration in Israel.

The registrar dismissed Kokaraev's claim as to the dissimilarity of the marks, holding that the marks were confusingly similar from a phonetic and visual point of view. The registrar also concluded that the marks covered goods of the same description. Therefore, proceedings under Section 29 of the ordinance (rival applications for identical or confusingly similar marks) were appropriate.

In addition, the registrar dismissed Luemme's argument that its mark was well known, holding that it had failed to prove that COSABELLA was well known in Israel.

Applying the criteria set forth in Section 29, the registrar was satisfied that both applicants used the marks in good faith. However, in *obiter*, the registrar held that had one of the rival marks been well known, the fact that the later mark was based on the applicant's name would not have availed.

The registrar also examined the scope and nature of the use made of the marks in Israel. The registrar noted that Luemme had primarily submitted evidence of use of the mark abroad. With regard to Israel, Luemme showed that its goods had been sold in a single store from 2004 to 2005 in two small-scale shipments. Therefore, the registrar concluded that Luemme's mark did not have goodwill in Israel. The registrar distinguished the present case from the earlier case of *Yekutieli v Virgin Enterprises*, in which it was held that the

foreign applicant's mark was well known worldwide and that the Israeli public had been exposed to it (for further details please see "[Commissioner applies 'family of marks' doctrine](#)").

The registrar also found that Luemme did not make extensive use of the mark in Israel, as it had sold its products in a single store.

In addition, the registrar gave minimum weight to the six-month period between the parties' applications. The registrar noted that Section 30 of the ordinance permits registration of similar marks for goods of the same description where both applicants have made honest concurrent use of the marks. Finally, the registrar held that due to the differences between the quality of the goods and the target consumers (ie, luxury lingerie for women versus inexpensive clothing for teenage girls), there was no likelihood of confusion among the public.

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