

# World Trademark Review Daily

Marks containing variants of same name for cigarettes held to be dissimilar

Examination/opposition  
National procedures

Israel - Gilat, Bareket & Co, Reinhold Cohn Group

June 11 2010

In *Philip Morris Products SA v Bulgartabac Holding* (opposition to registration of mark 196741, April 25 2010), the deputy registrar has allowed the registration by [Bulgartabac Holding](#) of the device mark SLIMS EVA for cigarettes and tobacco products, notwithstanding the existence of two EVE device marks registered in the name of [Philip Morris Products SA](#) for identical goods.

Bulgartabac applied for the registration of a device mark consisting of the stylized words 'Slims Eva' (the letter 'V' being represented as a heart) and the image of a flower for tobacco, cigarettes and other related products in Class 34 of the [Nice Classification](#). Philip Morris opposed the registration, alleging that:

- the mark was confusingly similar to its two registered device marks (which contained the word 'Eve' and a floral design) for cigarettes in Class 34; and
- Bulgartabac's mark had been chosen in bad faith.

Neither party adduced evidence. Bulgartabac sought to establish that Philip Morris had abandoned the opposition under Regulation 39 of the Trademark Regulations 1940, which provides that, "[w]here the opponent fails to adduce evidence, [it] is deemed to have abandoned [the] opposition, unless the registrar rules otherwise". Philip Morris indicated that it had not adduced evidence due to the nature of its argument (namely, that the mark applied for was confusingly similar to its own marks), and the deputy registrar refused to hold that Philip Morris had abandoned the opposition.

The deputy registrar then proceeded to examine whether the SLIMS EVA mark was confusingly similar to Philip Morris' registered marks, noting that, in the absence of evidence, he could not take into account certain factors that may reduce the likelihood of confusion (eg, customer loyalty and manner of purchase).

From a visual point of view, the deputy registrar found that the marks were not confusingly similar due to the heart design of the letter 'V' in the SLIMS EVA mark, the difference between the verbal elements 'Eve' and 'Eva', and the difference between the floral designs. Taking judicial notice of the fact that cigarettes are usually purchased over the counter, the deputy registrar held that the main test was whether the marks were phonetically similar. The deputy registrar found that the SLIMS EVA mark and the registered EVE marks were not confusingly similar, given the difference in pronunciation between 'Eve' and 'Eva'. The deputy registrar also noted that the word 'slims' should be disregarded, as it would not be pronounced at the time of purchase.

The deputy registrar further held that there was a conceptual similarity between the marks, as they both included variants of the biblical name Eve. However, in the absence of proof that such similarity was likely to result in confusion or misattribution, only the phonetic similarities between the marks could be taken into account. Finally, the deputy registry found that, as there was no likelihood of confusion between the marks, Bulgartabac could not be held to have chosen its mark in bad faith.

Costs of IS7,500 were awarded against Philip Morris.

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