

World Trademark Review *Daily*

**Supreme Court overturns refusal to register mark due to reverse confusion Examination/opposition
Israel - Gilat, Bareket & Co, Reinhold Cohn Group National procedures**

October 22 2010

In *Rolex SA v Deputy Registrar of Trademarks* (CA 2746/08, June 2 2010, unpublished), the Supreme Court has overturned a decision of the registrar of trademarks in which the latter had refused to register the trademark ROLEX PRINCE based on 'reverse confusion' concerns.

[Rolex SA](#) applied for the registration of the trademark ROLEX PRINCE for watches in Class 14 of the [Nice Classification](#).

On February 26 2008 the deputy registrar, acting in his capacity as IP adjudicator, refused to register the mark on the grounds that it was confusingly similar to the mark PRINCE, registered for goods in the same class.

In particular, the deputy registrar noted that the addition of the name Rolex to the mark PRINCE would not necessarily prevent confusion and may even aggravate the likelihood of confusion as to the source of goods, as the combination 'Rolex Prince' did not result in a different meaning. Reverse confusion could thus occur (for further details please see "[Registration refused based on reverse passing off considerations](#)").

On appeal, the Supreme Court held that the facts before the deputy registrar did not unequivocally demonstrate that the mark ROLEX PRINCE was liable to mislead the public - rather, the facts supported the conditional acceptance of the application and its publication for opposition. Third parties may then oppose the application if they find that the registration of the mark would cause confusion.

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

World Trademark Review (www.worldtrademarkreview.com) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.