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Court considers use of descriptive mark as Google AdWord
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Confusion
Keywords
Passing off

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In *Lametayel Travel Center Ltd v KKSH Ltd* (48058-07-11, September 3 2012), the Tel Aviv District Court has held that use of the mark ODAFIM LAMETAYEL (meaning 'outlet for the traveller') for an online store infringed the well-known registered mark LAMETAYEL (meaning 'for the traveller'), which belongs to a nationwide chain of stores selling camping gear.

The plaintiff, Lametayel Travel Center Ltd, operates a nationwide chain of stores selling camping gear, travel books and maps under the mark LAMETAYEL, including outlets under the name Lametayel Odafim ('For the Traveller Outlet'). The plaintiff maintains a website at 'www.lametayel.co.il', which contains content relating to, among other things, tourism, travel and nature.

The defendant, KKSH Ltd, operates a store called KKSH - Center for the Traveller and Soldier, and markets its merchandise via its website at 'www.kksh.co.il'. In late 2010 the defendant launched an additional website at 'www.odafim-lametayel.co.il' ('Odafim Lametayel' being the transliteration of the Hebrew for 'Outlet for the Traveller'); the Hebrew combination appeared on the website itself.

The plaintiff sued KKSH Ltd on the grounds of:

- trademark infringement in violation of the [Trademarks Ordinance \[New Version\] 5732-1972](#) (for creating the 'odafim-lametayel' website and purchasing [Google AdWords](#));
- passing off;
- unfair interference with access to the plaintiff's business (for diverting business from the plaintiff); and
- false commercial description (for non-disclosure of the actual name of the business) in violation of the Commercial Torts Law of 1999.

The court first considered the claim of trademark infringement. With regard to the use of ODAFIM LAMETAYEL on the website, the district court, while noting that a descriptive word will always remain a weak mark and that even a relatively minor change may suffice to escape trademark infringement, found that the differences in use of the two marks on each party's website did not suffice to counteract the likelihood of confusion, especially in light of the fact that the defendant's actual business name or place of business was absent from the website.

Further, the court noted the differences between the two websites (the defendant's website being an online store selling camping gear, while the plaintiff's website was a content website devoted to travel), but held that both belonged to the same commercial family and dealt with goods of the same description.

Finally, the court held that the defendant's choice of the name Odafim Lametayel had not been made in good faith, given the plaintiff's long-time reputation for camping gear, and given the defendant's failure to distinguish itself by using its own (or any other) name. Therefore, the defendant could not benefit from the disclaimer present in the plaintiff's trademark registration. The court concluded that the defendant's use of the name Odafim Lametayel in respect of its website infringed the plaintiff's registered mark.

With regard to the use of the plaintiff's mark as a Google AdWord, the court distinguished the circumstances of this case from an earlier district court decision (*Matim Li*), in which it was held that use of another's trademark as a Google AdWord did not amount to infringement. The court noted that, while in *Matim Li* the use of the mark did not cause confusion between the trademark owner's business and that of the unauthorised user of the mark, in the present case an internet user would not be able to distinguish between the two parties.

The court then turned to the claims of unfair interference with access to a business and false commercial description. The court cited the earlier district court ruling in *Magnetics*, according to which internet access fell within the scope of the tort of unfair interference with access to a business, and held that the defendant's use of the plaintiff's trademark in its domain name interfered with customers' access to the plaintiff's business. The court also referred to its earlier ruling in the *Congress Center* case (regarding the duty of fairness incumbent on a private company engaged in free competition), ruling that the defendant in this case had acted unfairly and had committed the tort of unfair interference with access to a business. The court also found that the defendant had knowingly made a false commercial description by choosing a similar name to operate in the same field and omitting its own business name.

The court granted a permanent injunction, as well as the maximum statutory damages under the

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Commercial Torts Law.

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