

# World Trademark Review *Daily*

**Philip Morris loses 'activate' dispute against Japan Tobacco  
Israel - Gilat, Bareket & Co, Reinhold Cohn Group**

**Examination/opposition  
National procedures**

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On January 6 2011 a trademark application was filed by [Philip Morris Products SA](#) for the registration of the stylised trademark L&M ACTIVE 2 IN 1 ACTIVATE FRESH FLAVOUR for "smokers' articles" in Class 34 of the [Nice Classification](#), for use with a brand of cigarette that releases a mint flavour when smoked.

In the subsequent six months, but before Philip Morris' application was granted, [Japan Tobacco Inc](#) applied for the registration of two trademarks. One application was for the stylised mark ACTIVATE FRESHNESS, while the other application was for the word mark ACTIVATE. Both applications covered goods in Class 34, for use with Japan Tobacco's Camel cigarettes, which contain a capsule that changes the flavour.

Since Philip Morris' application was pending when Japan Tobacco applied for the registration of its trademarks, and considering the similarities between the applications and the identity of the goods, the registrar issued a decision under Section 29 of the [Trademarks Ordinance \[New Version\] 5732-1972](#), which refers to rival applications for the same trademark.

According to the registrar's ruling, three aspects should be considered when applying Section 29 of the ordinance:

1. the date of submission of the applications for registration;
2. the extent of use of the mark in Israel prior to the submission of the application, and subsequent to the submission; and
3. the applicants' good faith in choosing the mark at issue.

The registrar noted that, out of the three elements, the last two are the most essential.

The examination of the priority date of the applications indicated that Japan Tobacco's application for registration of the mark ACTIVATE claimed priority from an earlier application filed in Italy a month before Philip Morris' priority application was filed in Switzerland. In light of the negligible time difference, and given the reduced value of the first element, the registrar did not rule in favour of Japan Tobacco, and proceeded to examine the additional aspects.

With regard to the extent of use of the mark in Israel, the registrar determined that, based on the evidence presented by the parties, Philip Morris had made no use of its mark prior to, or after, the submission of the application, neither in Israel nor in other countries. On the contrary, Japan Tobacco proved prior use of its mark on products marketed in many countries outside of Israel. The registrar held that, even though Japan Tobacco had not proved prior use of the mark in Israel, examination of the second element was in favour of Japan Tobacco, since Philip Morris had failed to present data on the use of its mark in Israel or any other country.

The registrar further noted that Philip Morris had requested the registration of the mark L&M ACTIVE 2 IN 1 ACTIVATE FRESH FLAVOUR even though, at the time the application was submitted, it was using a similar, but different mark (ie, FORWARD 2 IN 1 PRESS FOR MENTHOL FLAVOR), indicating that Philip Morris had an alternative mark to compete with Japan Tobacco's mark. In addition, Philip Morris had presented no reasonable explanation as to why it had chosen to register a mark including the word 'activate', rather than the mark it was already using. Consequently, the registrar decided that the third element was, once again, in favour of Japan Tobacco.

Taking all of the above into consideration, the registrar ruled in favour of Japan Tobacco. Therefore, Japan Tobacco's application will be further examined, while Philip Morris' application will be removed.

*David Gilat and Netanel Krief, Gilat Bareket & Co, Reinhold Cohn Group, Tel Aviv*

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