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Registration of HILDA device mark limited due to conflict with well-known BARILLA mark

Israel - [Gilat, Bareket & Co, Reinhold Cohn Group](#)

- Barilla petitioned to cancel the registration of the stylised mark HILDA on the grounds that it was confusingly similar to the well-known BARILLA mark
- The IP adjudicator found that the HILDA mark was confusingly similar to the BARILLA mark when used in the same red-and-white colour combination
- Such confusing similarity was neutralised once the registration was limited to exclude the red-and white colour combination

The Israel Trademark Office has held that the registered stylised mark HILDA, which consisted of an oval design with lettering in italics, was confusingly similar to Barilla's well-known BARILLA mark if used in the same red-and-white colour combination, but was not confusingly similar in a different colour combination. It thus ordered that the registration be limited to exclude the red-and-white combination (*Barilla G e R Fratelli SPA v RS Food Import and Manufacturing Company* (proceedings for the cancellation of the stylised mark No 288045 (HILDA), 31 October 2020)).

The IP adjudicator of the Israel Trademark Office refused the petition of Italian pasta manufacturer Barilla G e R Fratelli SPA to strike the registration of a stylised trademark registered in the name of a local company, RS Food Import and Manufacturing Company ('Rejuan'), on the grounds that it was confusingly similar to Barilla's registered mark. It was held that confusing similarity existed only when the red-and-white version of the trademark was used, and was neutralised once the registration was limited so as to exclude such colour combination.

Background

Rejuan, a local company which has been active in the Israeli market since 1929, registered the mark HILDA in 2018 (Registration No 288045) for a variety of foodstuffs including spices, coffee, tea, sauces, baking powder and flour in Classes 29 and 30, without limitation as to colour, in the following form:



According to Rejuan, over the years it has used the mark PREMIUM in red and white, as shown below:



In 2008 it commissioned the design of the HILDA mark, which it used - in red and white, as well as in brown and white - to market its newly-launched line of sauces.

After narrowly missing the opposition deadline, Barilla petitioned to strike the registration on the grounds that it was confusingly similar to Barilla's mark (in contravention of Section 11(9) of the Trademarks Ordinance (New Version) 1972) and that it caused unfair competition (in contravention of Section 11(6) of the ordinance).

According to Barilla, its mark has been in use since 1969 and has been registered in Israel (Registration No 65255) since 1991 for a variety of foodstuffs including coffee, tea, sauces, flour, cereal products, bread and baking powder in Class 30, as follows:



Barilla also claimed that its mark was well known, meaning that there was a ground for cancellation due to a likelihood of association under Section 11(14) of the ordinance.

Decision

The IP adjudicator compared Rejuan's mark in its red-and-white form to Barilla's mark, using the three-pronged test of confusing similarity and noting that the marks should be examined having regard to the imperfect recollection of the relevant consumer.

It was held that the marks possessed sufficient visual similarity, as they both included two red ovals and word elements of a similar length, written in cursive Latin font in white against a red background:



The aural dissimilarity was of a lesser weight as the goods at issue were off-the-shelf products.

The adjudicator noted that, despite such similarity, the combination of colours played a dominant role and, where the mark HILDA was used in black and white or in brown and white, the visual similarity significantly decreased.

It was further held that the marks covered products of the same description - analysed in accordance with the list of goods for which each mark was registered, even though the actual products marketed by each party differed at this stage - and that such products were sold through similar distribution channels. The adjudicator dismissed Rejuan's argument that Barilla's products were higher-end and marketed in major supermarket chains, while Rejuan's products were marketed to institutions and specific segments of the population.

As to the criterion of "common sense and other circumstances of the case", the adjudicator did not accept Rejuan's claim that the HILDA mark had a conceptual connection with its older PREMIUM mark. While accepting that the graphical elements (an ellipse containing white lettering against a red background) was not unique or exclusive to Barilla, the adjudicator held that other third-party marks using the same graphic elements were more different than similar - unlike BARILLA and HILDA.

The adjudicator concluded that there was confusing similarity between the HILDA mark in its red-and-white form (which was included in the scope of the registration and used in practice) and the BARILLA mark. However, instead of being struck off the register under Section 38 of the ordinance on the ground that it was ineligible for registration, the registration was limited, in accordance with the registrar's powers under Section 9, to exclude the red-and white colour combination.

Having regard to the cancellation ground of a likelihood of association with a registered well-known mark, the adjudicator held in *dictum* that the BARILLA mark was indeed well known, but that this additional cancellation ground was rendered moot due to the conclusion that the HILDA mark was ineligible for registration in its red-and-white variation.

In light of the parties' oral hearings, the IP adjudicator awarded Barilla costs in the amount of NIS15,000.

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