

World Trademark Review *Daily*

**Mark refused in Class 25 despite being registered in Class 18
Israel - Gilat, Bareket & Co, Reinhold Cohn Group**

**Examination/opposition
National procedures**

February 25 2011

In *Upcoming TM SA v European Sports Merchandising BV* (Opposition to the registration of mark 189564, December 27 2010), the registrar has accepted a sportswear retailer's opposition against an application to register the mark KILLAH in Class 25 of the [Nice Classification](#) on the grounds that it was confusingly similar to the trademark KILLY, which is registered in the same class.

The applicant, [European Sports Merchandising BV](#), is engaged in the marketing of young women's clothing and footwear worldwide under the mark KILLAH (an extension of the Miss Sixty brand). In April 2006 it applied to register the word mark KILLAH in Class 25 for clothing, footwear and headgear; the mark was accepted and published for opposition in July 2007. The applicant has held a registration for the same mark for leather goods in Class 18 since 2004.

The opponent, *Upcoming TM SA*, is engaged in the marketing of sportswear. It holds registrations for the mark KILLY in Class 25 for clothing, footwear and headgear (applied for in March 2006 and registered in March 2007) and in Class 18 for leather goods (registered in 2006).

In examining whether the mark applied for was confusingly similar to an earlier registered mark "for the same goods or goods of the same description", as required under Section 11(9) of the [Trademarks Ordinance \(New Version\) \(5732/1972\)](#), the registrar applied the three-pronged test of confusing similarity, which examines the visual and phonetic similarities between the marks, the type of goods and the relevant customers.

The registrar emphasised that the 'visual and phonetic similarity' prong was the central element of the test - the marks must be examined in their entirety, bearing in mind the initial impression and the imperfect recollection of consumers. The registrar held that the marks at issue were:

- visually similar, as they shared the dominant element 'kill'; and
- phonetically similar, as the different endings were likely to be mispronounced or swallowed.

With regard to the type of goods covered by each mark and the target customers, the applicant attempted to argue that its goods - women's clothing - were dissimilar to the opponent's goods - skiing sportswear. The applicant in effect suggested that the list of goods covered by the earlier mark should be given a narrow interpretation so as to reflect actual use. The registrar rejected this argument, holding that the marks should be examined based on the list of goods set forth in the registration (which was identical to the list of goods in the application). Furthermore, he noted that a broad list of goods allows the registered owner to expand its operation to other goods covered by the list, beyond the goods for which the mark is actually used. The registrar also noted that customers buying skiing sportswear and those buying casual women's clothing may be the same.

In addition, the registrar refused to infer that there was a lack of conflict between the marks in Class 25 due to the coexistence of the applicant's mark KILLAH (since 2004, without opposition by the opponent) and the opponent's mark KILLY (since 2006) on the Register in Class 18.

The registrar thus upheld the opposition and refused to register the KILLAH mark.

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