
Intellectual Property—Trade Marks—Israel

Consent for registration of a mark by the proprietor of an earlier, similar trademark is not always sufficient

I. Summary

In a decision of the Intellectual Property Adjudicator (Hearing Officer) dated December 7, 2004, given in connection with Israel trademark application No. 152627 for “CHUNKY” (stylized), in class 30 (“**the ‘CHUNKY’ trademark application**”), it was held that the consent given by the proprietor of an earlier trademark is not sufficient to enable registration of a similar mark where there exists a likelihood of confusion between the two marks.

II. The Factual Background

During the examination of the “CHUNKY” trademark application, the Israeli Trade Marks Office objected to its registration, *inter alia*, due to the existence of an earlier registered trademark for “CHUNKY” (word mark) (“**the earlier ‘CHUNKY’ trademark**”). The Israeli Trade Marks Office was vehement in its refusal to register the “CHUNKY” trademark application, despite the submission of a letter consenting to such registration on behalf of the proprietor of the earlier “CHUNKY” trademark. At the applicant’s request, a hearing was held before the Intellectual Property Adjudicator.

III. The Adjudicator’s Decision

The Adjudicator held that the consent of a proprietor of an earlier trademark to the registration of a later mark may be considered only as an indication with respect to the existence/absence of likelihood of confusion. However, such consent, *per se*, does not unequivocally prove the absence of any likelihood of confusion. Considerations such as the public interest and the “integrity” of the Registry—which do not always accord with the interests of a proprietor of an earlier trademark—should also be taken into account. In light of the above, the Adjudicator held that the “CHUNKY” trademark application will be accepted for publication and thereafter registered (subject to oppositions proceedings, if initiated by third parties), provided that a disclaimer is given for the word “CHUNKY” and that a new specification of goods will be provided, in which the goods appearing in the earlier “CHUNKY” trademark will be deleted. Such conditions were

designed to remove any likelihood of confusion with the earlier "CHUNKY" trademark. The decision was not appealed.

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