
Intellectual Property—Trademarks—Israel

Allergan v. B4U—Trademark Infringement

I. Summary

In a decision of the Israeli District Court dated January 12, 2005, in the framework of provisional proceedings in the matter of C.A. 2332/04, MCA 20294/04 *Allergan, Inc. et al., v. B4U Ltd. et al.* (not yet published), it was held, *inter alia*, that respondents' use of the marks "BOTO EFFECT" and "BOTO RELAX" infringe Allergan Inc.'s well-known trademark "BOTOX".

II. The Factual Background

Applicant No. 1, Allergan, Inc. ("**Allergan**"), is the owner of the well-known trademark "BOTOX" ("**the BOTOX Mark**"), which is also registered in Israel in class 5 with respect to, *inter alia*, pharmaceutical preparations for the treatment of wrinkles. The BOTOX Mark is used, *inter alia*, to indicate the cosmetic use of the "BOTOX" preparation (a preparation containing Botulinum toxin which is injected by doctors to patients in order to reduce the appearance of wrinkles). The respondents, B4U and the Cosmetician Centre, marketed in Israel a cosmetic preparation (an anti-wrinkle cream), for external use, under the marks "BOTO EFFECT" and "BOTO RELAX", respectively. Allergan and its Israeli distributor filed a claim, as well as an application for provisional orders, against the respondents, on the grounds of infringement of the BOTOX Mark (as well as on other grounds, including passing-off, dilution of trademark, unlawful enrichment, *etc.*).

III. The District Court's Decision

The District Court accepted Allergan's application for provisional orders and ruled, *inter alia*, as follows:

- (1) The marks resemble one another when carrying out both the visual and phonetic tests. In view of the identical "BOTO" prefix, the suffixes "EFFECT" and "RELAX" do not distinguish between the marks and thus may be construed as additional products amongst the "BOTOX" range of products or as an improved version of "BOTOX".

- (2) In view of the results of similarity obtained from the main visual and phonetic tests, the respondents' arguments regarding the differences in customers, prices and marketing channels of the products are marginal, particularly since the marks identify products aimed for the identical purpose (reducing wrinkles).
- (3) The judge held that, at this stage of an application for provisional orders, the assumption is that the trademark registration is valid and stated further that he does not believe the term "BOTOX" to be descriptive and certainly not generic, as argued by the respondents. At most, the BOTOX Mark may be seen as a suggestive mark and, thus, entitled to enhanced protection.
- (4) If indeed the BOTOX Mark is used by the public to represent anti-wrinkle treatment (as alleged by the respondents and which allegation will need to be proved in the main action), then it seems that the BOTOX Mark has acquired secondary meaning and thus worthy of protection.
- (5) Allergan has presented sufficient evidence to prove that the BOTOX Mark is a well known trademark.
- (6) The court doubted the respondents' argument that the marks are not of the same description (pharmaceutical preparations as opposed to cosmetic preparations), but did not rule on this matter since it held that it is sufficient that the BOTOX Mark is well-known in order for the protection afforded to it to extend to additional areas whereby there exists a connection in the customer's awareness between the marks.
- (7) The respondents' argument that the term "BOTOX" is generic and/or descriptive implies an admission that the BOTOX Mark is well-known to those members of the public interested in wrinkle treatment and Allergan's affidavit is sufficient to determine same. Furthermore, the fact that the respondent chose the mark "BOTO EFFECT" even though its product does not contain Botulinum toxin, indicates that the purpose of the respondents was to benefit from Allergan's goodwill in the BOTOX Mark.
- (8) The proceedings outside Israel regarding "BOTO RELAX" are irrelevant.
- (9) The court rejected the argument that Allergan does not enforce its rights against other infringers and ruled that Allergan implements

different measures in and outside Israel in order to protect its trademarks which measures constitute sufficient proof that Allergan does not waive its rights with respect thereto.

- (10) In view of the court's conclusion with regard to the issue of trademark infringement, it did not discuss the additional grounds on which the applicants based their claim.
- (11) The court ruled that the balance of convenience lies in favour of the applicants and, accordingly, granted a temporary restraining order preventing the respondents from using the marks "BOTO EFFECT" and "BOTO RELAX". The court also ordered the respondents to remove the infringing marks from all products and advertising materials and to recall all products and advertising materials from which the marks cannot be removed.

The applicants were represented in the above case by the undersigned.

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