

Israel: Refusal of a co-existence agreement

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In Israel, the submission of a co-existence agreement is not always sufficient in order to allow the registration of two similar trademarks in the registry. The Registrar is actually not bound to withdraw citations of prior marks or to cancel contentious proceedings between similar trademark applications, upon submission of co-existence agreements or letters of consent. He will refuse to do so mostly in cases in which he would believe that the concurrent registration of the marks is likely to lead to public confusion.

Biosensors Europe SA is the Swiss branch of a Singapore international group dealing with cardiologic products. Biosensors filed on July 31, 2011 two applications for registration of the marks "**Biomatrix Flex**" and "**Biomatrix**", both for "*Medical devices, in particular, stents and drug-eluting stents*" in class 10. The applications were accepted and published for opposition on July 31, 2012.

On August 1, 2012, the Israeli company Biometrix Ltd., which deals with development, production and marketing of innovative medical equipment, filed two applications for registration of the mark "**Biometrix**" (wordmark and logo) in class 10, for different cardiologic products such as catheters, monitoring or drainage systems, angiography accessories and other devices, while specifically excluding stents from the lists of goods.

Biometrix requested expedited examination of the applications, while attaching an affidavit specifying the grounds for the request as required by article 22(c) of the Israeli Trademark Regulations. In this affidavit, the president of the company claimed that urgent registration of the marks is required since it came to his knowledge that medical products bearing a similar mark are upon to enter the Israeli market.

The examiner responded to Biometrix request for expedited examination by informing them of the recent publication of Biosensors' marks "**Biomatrix Flex**" and "**Biomatrix**" and advising that, failing an opposition to registration of these marks, he would be obliged to cite them against registration of the "**Biometrix**" marks pursuant to article 11(9) of the Israeli Trademark Ordinance. Biometrix followed the examiner's suggestion and filed an opposition to Biosensors' marks.

At the same time, Biometrix and Biosensor initiated negotiations for co-existence of the marks in Israel. They reached an agreement in this regard and filed it with the Patent Office on March 24, 2013 together with a request for deletion of the term "*Medical devices*" from the lists of goods included in "**Biomatrix**" marks.

The Adjudicator requested the parties to file their evidences and arguments showing that the concurrent registration of the marks "**Biomatrix**" and "**Biometrix**" would not lead to public confusion.


Biosensors explained in its affidavit that the mark "**Biomatrix**" is exclusively aimed to stents, namely, medical devices which are implanted in patients' body through a cardiologic invasive process (catheterization), while Biometrix products are medical devices which are not implanted. Biosensors' devices are used only by medical teams in the field of cardiology and are marketed only to

professionals. Biosensors further stated that there was never any confusion in the consumers' public between the respective products of the parties.

Biometrix stated in its affidavit that its mark is used for innovative medical products aimed for intensive care or surgery units, and that it never marketed stents. Biometrix added that both marks co-exist on the Israeli market for 5 years and that they never received any request from a consumer for goods belonging to Biosensors.

After having reviewed the evidences, the Adjudicator rendered her decision on February 23, 2014. In this decision, she explained that the concurrent registration of similar trademarks is allowed by article 30(a) of the Israeli Trademark Ordinance, which reads as follows: *"Where it appears to the Registrar that there is a concurrent use in good faith, or where there are other special circumstances which in his opinion justify the registration of identical or similar trademarks for the same goods or description of goods by more than one proprietor, the Registrar may permit such registration subject to such conditions and limitations, if any, as he may think appropriate."*

The good faith element in concurrent use being critical, the Adjudicator stated that the parties did not act in bad faith in the present case.

The Adjudicator then analysed the differences between the marks, by stating that the only difference between the "**Biomatrix**" and "**Biometrix**" marks is the "e" and "a", while the prefix "bio" is descriptive. In her opinion, the addition of the descriptive element "**Flex**" to the "**Biomatrix**" mark and the minimal design of the "**Biometrix**" logo  have a little influence of the similar meaning of the marks.

Moreover, the Adjudicator noted that the products concerned are not sufficiently different and that the consumers are likely to believe that they have the same origin. The Adjudicator cited in support to her contentions the affidavit filed by Biometrix for the expedited examination of its marks, stating that we are concerned by products in class 10, which are all medical goods aimed to save life and that the use of a similar mark on such products is likely to cause heavy damages to the applicant. It is interesting to see how the Adjudicator is using the own arguments of Biometrix in the expedited examination matter within the frame of the subsequent opposition procedure.

In her decision, the Adjudicator added that the products concerned are similar, that they are sold through similar marketing channels to a similar public of consumers (medical professionals).

In addition, the parties did not show that the marks were registered in parallel in any other jurisdiction. The adjudicator further added that since Biometrix did not bring any evidence regarding the use of its mark, she could not consider the argument that the marks are co-existing on the Israeli market for already 5 years without any confusion between consumers.

Therefore, the Adjudicator was not convinced that the concurrent registration of the marks "**Biomatrix**" and "**Biometrix**" would not lead to public confusion and requested Biosensors to file its response notice so that the opposition procedure could proceed.

This decision is in line with the Israeli trademark practice, pursuant to which the Registrar is not bound to accept concurrent registration of confusingly similar trademarks, especially when such registration is likely to lead to public confusion. In such case, protection of the public interest is given higher priority than a binding agreement between private parties.

For more information, please contact:



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Irene Ezratty-Farhi was born in France and has been living in Israel for more than 20 years. She is an expert in trademarks, having acquired her extensive experience in the largest and most prominent Israeli law firms in the field of intellectual property. After having obtained her LL.M. in International Private Law at the University of Paris 1 - Pantheon-Sorbonne, Ms. Ezratty-Farhi practiced in Paris as Deputy Counsel at the Secretariat of the International Court of Arbitration of the International Chamber of Commerce (ICC). In the early 1990's she emigrated to Israel, where she completed her legal traineeship in a large law firm specialized in commercial law and was admitted as a member of the Israel Bar Association. Ms. Ezratty-Farhi practiced in various aspects of commercial law in Israel, before specializing in intellectual property law and, in particular, trademark law.

Ms. Ezratty-Farhi is a member of INTA and of the Intellectual Property Committee of the Israeli Bar Association.