



The Trademark Prosecution Review

2024

**Israel: New Practice Paper Indicates
Increasingly Strict Stance Toward
Descriptive and Non-Distinctive Marks**

The Trademark Prosecution Review

2024

The first edition of the *WTR Trademark Prosecution Review* takes a wide-ranging view of best strategies for securing trademarks in the key regions of the Americas, the Asia-Pacific, and Europe, the Middle East and Africa. The review combines on-the-ground knowledge and analytic insight to offer an unparalleled deep dive into the prosecution landscape in specific key markets.

Generated: April 22, 2024

The information contained in this report is indicative only. Law Business Research is not responsible for any actions (or lack thereof) taken as a result of relying on or in any way using information contained in this report and in no event shall be liable for any damages resulting from reliance on or use of this information. Copyright 2006 - 2024 Law Business Research

Israel: New Practice Paper Indicates Increasingly Strict Stance Toward Descriptive and Non-Distinctive Marks

Dor Cohen-Zedek and **Abishag Levy**

Pearl Cohen Zedek Latzer Baratz

Summary

[IN SUMMARY](#)

[DISCUSSION POINTS](#)

[REFERENCED IN THIS ARTICLE](#)

[LEGAL FRAMEWORK](#)

[UNREGISTERED MARKS](#)

[REGISTERED MARKS](#)

[PROCEDURES](#)

[ENFORCEMENT](#)

[OWNERSHIP CHANGES AND RIGHTS TRANSFERS](#)

[RELATED RIGHTS](#)

[ONLINE ISSUES](#)

IN SUMMARY

The legal framework of the Israeli trademark registration process, its prosecution and enforcement. In the past several years, Israel has become extremely strict in its examination practice, specifically regarding non-distinctive marks. Just recently, a new Practice Paper has been circulated determining the distinctiveness of word marks and design marks. Applicants should become aware of this recent stance.

DISCUSSION POINTS

- Scope of protection of registered trademarks and unregistered mark
 - Trademark registration procedure, maintenance and renewal
 - Trademark enforcement
-

REFERENCED IN THIS ARTICLE

- The Trademarks Ordinance (new version – 5732/1972)
 - The Trademarks Regulations 1940
 - The Trademark Regulations (Implementation of the Madrid Protocol) (5767/2007)
 - Work instructions for determining distinctive marks – Practice Paper (2023)
 - The Unjust Enrichment Law (5739/1979)
 - The Commercial Torts Law (5759/1999)
 - The Consumer Protection Law (5741/1981)
-

LEGAL FRAMEWORK

Relevant national laws include:

- the Trademarks Ordinance (new version – 5732/1972);
- the Trademarks Regulations 1940;
- the Trademarks Order (Protection of Industrial Property) 1934;
- the Merchandise Marks Ordinance 1929, as amended;
- the Merchandise Marks Regulations 1935;
- the Appellations of Origin (Geographical Indications) (Protection) Law (5725/1965);
- the Appellations of Origin (Procedure of Registration of Appellations of Origin Originating in a Foreign Country) Regulations (5727/1967);
- the Appellations of Origin (Procedure before Appeal Committee) Regulations (5727/1966);
- the Symbols Protection Act (5735/1974);
- the Trademark Regulations (Implementation of the Madrid Protocol) (5767/2007);

- the Unjust Enrichment Law (5739/1979);
- the Commercial Torts Law (5759/1999); and
- the Consumer Protection Law (5741/1981).

Israel has signed the following international treaties:

- the Paris Convention for the Protection of Industrial Property (1883), Stockholm (1967);
- the Agreement on Trade-Related Aspects of Intellectual Property Rights;
- the Nice Agreement on the International Classification of Goods and Services (1957), Stockholm (1967);
- the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (1958), Stockholm (1973); and
- the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

UNREGISTERED MARKS

While the Trademark Ordinance predominantly provides protection for registered trademarks, it also protects unregistered well-known trademarks.

Unregistered marks that are not considered well known may be protected under:

- the Commercial Wrongs Law (5759/1999), incorporating the tort of passing off;
- the Consumer Protection Law (5741/1981), according to which a lawsuit may be initiated against a third party using the mark in a manner that deceives the consumer public; and
- the Law of Unjust Enrichment (5741/1981), according to which unfair competition and unfair use of one's goodwill in a mark is prohibited.

According to Israeli law, there is no specific use requirement for establishing the mentioned rights. Each case is judged on its own merits, and the duration, extent, nature of use and nature of the mark are all taken into consideration to determine eligibility for protection. Unregistered rights may also be protected under different laws, including the Unjust Enrichment Law, the Commercial Torts Law and the Consumer Protection Law.

REGISTERED MARKS

Any person or legal entity may obtain protection for a mark. No power of attorney is required before filing, but one must be submitted to the Israeli Trademark Office (ITO) at a later stage. No notarisation or legalisation is required.

Scope Of Protection

Marks that are usually eligible for registration include those that are fanciful, arbitrary or distinctive, or that have acquired distinctiveness.

The following marks are not eligible for registration:

-

- a mark referring to a connection with the president of Israel or his or her household, or to presidential patronage, or a mark from which a connection or patronage might be inferred;
- flags and emblems of the state, its institutions, foreign states or international organisations, and any mark resembling any of these;
 - public armorial bearings, official signs or seals used by any state and signs resembling any of these, and any sign from which it might be inferred that the owner enjoys the patronage of, or supplies goods or renders services to, a head of state or government, unless it can be proved that the rights holder is entitled to use it;
 - a mark in which any of the following words appear: 'patent', 'patented', 'by royal letters patent', 'registered', 'registered design', 'copyright', 'to counterfeit this is forgery' or words to that effect;
 - a mark that is or may be injurious to public order or morality;
 - a mark that is likely to deceive the public, contains a false indication of origin or encourages unfair trade competition;
 - a mark containing a geographical indication that may be misleading as to the real geographical area from which the goods originated;
 - a mark containing a geographical indication that is literally correct, but that contains a false representation to the effect that the goods originated in a different area;
 - a mark identical or similar to emblems of exclusively religious significance;
 - a mark on which the representation of a person appears, unless the consent of that person has been obtained (in the case of representation of a deceased person, the consent of his or her successors is required unless reasonable grounds exist for not obtaining it);
 - a mark identical to one belonging to a different owner that is already registered in respect of the same goods or description of goods, or so nearly resembling such a mark as to cause likely confusion;
 - a mark consisting of numerals, letters or words that are in common use in trade to distinguish or describe goods or classes of goods, or that bear direct reference to their character or quality, unless the mark has a distinctive character;
 - a mark whose ordinary significance is geographical or a surname, unless represented in a special manner or unless having a distinctive character;
 - a mark identifying wines or spirits that contains a geographical indication, if the wine or spirit did not originate in that geographical area;
 - a mark identical or misleadingly similar to a well-known trademark, even if the mark is not registered with respect to goods for which the mark is well known or with respect to goods of the same description;
 - a mark identical or similar to a well-known registered trademark, even with respect to unrelated goods or services, if the mark sought to be registered might indicate a connection between the goods with respect to which the mark is sought and the registered owner of the trademark, and the registered owner of the trademark might be harmed as a result of using the mark sought; and

- a mark identical to, resembling or containing the name or business name of another person or entity, if the mark is likely to deceive the public or to cause unfair competition.

PROCEDURES

Filing And Examination Proceedings

Multi-class trademark applications are available in Israel. The mark is examined several months after filing. Proceedings may be accelerated under certain conditions. The examination is conducted based on absolute as well as relative grounds. With respect to absolute grounds, it should be noted that in recent years the ILTMO has become significantly strict with its examination practice in relation to descriptive and non-distinctive marks.

Indeed, in the past year a new Practice Paper has been circulated by the ILTMO, according to which descriptive or non-distinctive word elements appearing in basic or standard typeface, lettering or handwritten style typefaces are not registrable. Where standard typefaces incorporate elements of graphic design as part of the lettering, those elements need to have sufficient impact on the mark as a whole to render it distinctive. When these elements are sufficient to distract the consumer's attention from the descriptive meaning of the word element or are likely to create a lasting impression of the mark, the mark is registrable. The mere 'addition' of a single colour to a descriptive/non-distinctive word element, either to the letters themselves or as a background, is not sufficient to render the mark distinctive. Use of colors is common in trade and would not be seen as an indication of origin. However, it is possible that an unusual and memorable arrangement of colors could render a mark distinctive.

With respect to the figurative elements in the mark, descriptive or non-distinctive verbal elements combined with simple geometric shapes are unlikely to be acceptable, in particular when these shapes are used as a frame or border. On the other hand, geometric shapes can add distinctiveness to a sign when their presentation, configuration or combination with other elements creates a global impression which is sufficiently distinctive.

A figurative element is considered to be descriptive and/or devoid of distinctive character whenever:

- it is a mere depiction of the goods and services;
- it consists of a symbolic or stylised portrayal of the goods and services that does not depart significantly from their common representation;
- and/or it is common in the trade.

A figurative element which does not represent the goods and services but has a direct link to the characteristics of the goods and services will not render the mark distinctive, unless it is sufficiently stylised.

With respect to both the word and figurative elements in the mark, principally, a combination of figurative elements and word elements, which if considered individually are devoid of distinctive character, does not give rise to a distinctive mark. That said, a combination of such elements when considered as a whole could be perceived as an indication of origin due to the presentation and composition of the sign. This will be the case when the combination results

in an overall impression which is sufficiently far removed from the descriptive/non-distinctive message conveyed by the word element.

A unique procedure in Israel relates to a refusal based on the existence of a corresponding pending application (*inter partes* proceedings). If such a refusal is issued, the parties may resolve the conflict by reaching a settlement approved by the registrar. Otherwise, the registrar will issue a decision based on three criteria:

- the applicants' good faith in choosing the trademark;
- the extent of use of the respective marks; and
- the filing dates of the applications.

According to local practice, and because Israel belongs to those common law countries where trademark rights may commonly be acquired by use, more emphasis is given to first use and to volume of use than to the date of filing.

A response to the examiner's objection must be filed within three months. If no response is submitted by this deadline or no extension of time is requested, the ITO will ultimately close the file. Extensions are available up to eight months from the date on which the response should have been filed, while the applicant is required to finalise the examination within two years of the first office action.

Once accepted, the mark will be published in the *Trademarks Gazette*.

Opposition

Upon publication, third parties have three months to oppose the registration. If no opposition is filed, the mark will proceed to registration. The opposition period cannot be extended.

Once the opposition is filed, the applicant has two months to respond by filing a counterstatement. Two months thereafter, the opponent must file their evidence in support of the opposition. Subsequently, the applicant has two months to file their counterevidence and the opponent may then file evidence in response. The evidence is submitted in the form of affidavits. An oral hearing is then scheduled before the ITO (unless the parties reach a procedural agreement to waive cross-examinations). The parties then proceed to submit their oral or (usually) written summations and summations in reply. A decision will be issued thereafter. Such a decision is final and binding, unless it is appealed to the relevant district court.

Registration

If no opposition is filed within the opposition period or if an opposition has been dismissed, the mark proceeds to registration.

Renewal

Registered trademarks are valid for 10 years from the application date.

Removal From Register

Any person may file an invalidation action to remove or amend a trademark from the register on the grounds that it is not eligible for registration. Such an application should be filed within five years of the registration date. However, if an application is filed in bad faith, there is no five-year limit.

A registered mark may become vulnerable to non-use cancellation action three years after its registration date. A cancellation action against a registered mark may be initiated by any third party on the grounds that there was no good-faith intention to use the trademark in connection with the goods for which it was registered, and that there has been no good-faith use of the trademark during the three years preceding the application for cancellation.

Cancellation and invalidation actions should usually be submitted to the registrar at first instance. The registrar's decision may then be appealed to the relevant district court at second instance. However, some actions may be submitted to the first instance court.

Searches

Official trademark searches are conducted for any identical or confusingly similar marks, word marks and device marks for as many classes as requested.

ENFORCEMENT

Civil Proceedings

A request for interim remedies is one of the most valuable tools for the protection of trademarks. The plaintiff will be granted an interlocutory injunction if the court is convinced that the plaintiff has a good chance to win the suit and that the balance of convenience leans in its favour. A plaintiff who superfluously delays action may not be granted interim remedies. There is no rule as to how much time must pass before it constitutes such a delay: this depends on the circumstances of each case. The main lawsuit, including the request for a permanent injunction, can be filed at any time within seven years of the date of infringement. However, in extreme circumstances, a superfluous delay might stop the plaintiff from bringing the claim to court.

If the plaintiff prevails, they are entitled to an injunction preventing the continuation of the infringements and, in some cases, destruction of the goods and a financial remedy.

Administrative Proceedings

According to the Customs Ordinance, Customs is entitled to detain imported goods that are suspected of infringing trademarks.

It is possible, although not mandatory, for rights holders to file a complaint while recording their registered trademarks with Customs. It is highly recommended that such a complaint be filed if the rights holder is aware of specific shipments of infringing goods bound for Israel or if they wish to bring certain trademarks to the attention of Customs.

Notwithstanding this, Customs is authorised to seize suspected goods (whether as a result of a complaint submitted by the rights holder or as a result of a random examination of shipments arriving in Israel). Once such goods are seized, Customs must send appropriate notice to the rights holder and the importer.

In most cases involving small shipments, Customs initiates a short procedure while agreeing to destroy the goods based on a written opinion submitted by the rights holder, in which it indicates the reasoning behind its belief that the goods are indeed infringing and provides that it will compensate the importer for any financial damage that may be inflicted as a result of the seizure, as well as joining Customs in any lawsuit initiated by the importer.

In other cases (mostly, when the shipment includes a high number of goods or expensive goods), Customs initiates a long procedure, under which the rights holder must file a lawsuit.

As an initial step, the rights holder must submit a bank guarantee to Customs to compensate the importer for any financial damage that may be inflicted as a result of the seizure or the filing of a lawsuit.

Whether a long or short procedure is being instigated, on receiving the customs notification, the rights holder has three working days (with a possible further three-day extension) in which to respond. To complete the short procedure, they may submit the required bank guarantee and relevant documents. Only after the bank guarantee has been submitted will Customs advise the rights holder of the importer's details and allow it to obtain a sample of the seized goods. As such, if the rights holder decides to proceed with the short procedure, they will not receive any details regarding the shipment.

Upon filing the bank guarantee, the rights holder can either settle the matter amicably with the importer or file a lawsuit against it within 10 working days of the notice date (an extension of 10 further working days is available upon filing a reasoned request). Should the rights holder choose to take no further action, the goods will be released.

Criminal Proceedings

The knowing infringement of a trademark constitutes a criminal offence. In recent years, IP police units have been downsized and their action is now limited. However, the activity levels of local police stations that do not specialise in intellectual property have increased.

The police may act on the basis of information obtained by its own investigation or a complaint initiated by the trademark owner. The trademark owner (or its representative) is usually required to assist the police by giving a deposition and testify to the nature of the infringement. It is still possible for trademark owners to file private criminal complaints.

OWNERSHIP CHANGES AND RIGHTS TRANSFERS

Assignment

A pending or registered trademark may be assigned with respect to all or some of the goods or services covered thereby. The assignment should be recorded with the ITO, among other things, in order to avoid claims of non-use and to properly maintain any goodwill of the trademark. To record an assignment in Israel, a copy of the deed of assignment executed by the assignor is required. This must state that to the best of its knowledge the recordal of the assignment will not cause confusion among the public (if such statement is not included in the assignment document, a separate document may be provided). In addition, an executed power of attorney on behalf of the assignee is required.

Licence

Recordal of a licence agreement in Israel is mandatory. Recordal of a licensee or registered user can take place only with respect to registered rights. If a licensee is not recorded as a registered user, the trademark registration may be cancelled for non-use. Further, not recording a licence may have other implications, including regarding the goodwill of the mark and its associated owners. A recorded licensee can take action against infringements in certain circumstances.

To record the registered user, the licence agreement should indicate:

- the relationship between the owner and the authorised person, including the extent of the owner's control over the authorised person's use;

- the goods in respect of which authorisation is sought;
- the conditions or limitations that are to apply to the use of the mark;
- the period of validity of the authorisation, if its registration is requested for a determinate period; and
- a statement that, to the best of the licensor's knowledge, the recordal of the licence will not cause confusion among the public (if the general agreement includes no statement to this effect, a separate statement may be provided).

In addition, a power of attorney signed by the licensee should be submitted. No notarisation or legalisation is required.

Merger

A copy of the merger certificate is required. The certificate must reflect a public official or agency attesting to the merger. In addition, a power of attorney must also be filed.

Change Of Name

One of the following documents is required to record a name change with the ITO:

- a copy of the name change certificate, which attests to the change of name and is made by a public official or agency;
- a copy of the official publication of the change of name; or
- a copy of a notary confirmation indicating that the change of name was registered with the proper authorities in the owner's incorporating country.

Change Of Address

One of the following documents is required to record a merger with the ITO:

- a copy of the merger certificate, which attests to the merger and is made by a public official or agency;
- a copy of the official publication of the merger; or
- a copy of a notary confirmation indicating that the merger was registered with the proper authorities in the owner's incorporating country.

As all documents are filed electronically, simple copies are sufficient. However, the ITO retains the right to request the original/certified documents, if necessary.

RELATED RIGHTS

Under specific conditions, a trademark logo that has artistic value or a slogan may be protected under copyright law. Three-dimensional marks may be protected under design law.

The issue of trademarks overlapping with other IP rights is a complex one and has barely been addressed by the Israeli courts. It appears that most cases will turn on their circumstances, but clear guidelines have yet to be established. That said, the courts have addressed the registration of 3D trademarks and slogans as trademarks, ruling that, in certain cases, the shape of a product may be protected as a 3D trademark if it has acquired distinctiveness and is used as a trademark, and that a slogan filed for registration should

be examined in the same manner as any other mark and should not be *a priori* considered inherently non-distinctive. These judgments were endorsed by the ITO.

ONLINE ISSUES

The Israel Internet Association (ISOC-IL) operates as the registry for domain names under the '.il' ccTLD. The IL-DRP is an alternative dispute resolution procedure intended to resolve disputes regarding the allocation of domain names under the '.il' ccTLD. It is not intended to create or replace judicial precedent or jurisprudence.

Under the rules for allocation of domain names under '.il', the IL-DRP will review third-party challenges to an existing allocation of a domain name by ISOC-IL on a case-by-case basis. Disputes regarding the allocation of a domain name by a holder may be brought by a third party on the following grounds:

- the domain name is identical or confusingly similar to a trademark, trade name, registered company name or legal entity registration of the complainant;
- the complainant has rights in the name;
- the holder has no rights in the name; and
- the application for allocation of the domain name was made or the domain name was used in bad faith.

PEARL COHEN

Dor Cohen-Zedek
Abishag Levy

dorc@pearlcohen.com
alevy@pearlcohen.com

121 Menachem Begin Road, Azrieli Sarona Tower, 53rd floor, Tel Aviv 6701203, Israel

Tel: +972 3 303 9000

<https://www.pearlcohen.com/>

[Read more from this firm on WTR](#)