

# Israel

**Israeli law recognizes a broad range of signs as being registrable as trademarks. However, the Trademark Office's practice on this matter is rather restrictive**

Israel's legal doctrine and the position of the country's Trademark Office *vis-à-vis* the registrability of various types of non-traditional marks have evolved recently and therefore deserve special attention.

The term 'mark' is defined in Section 1 of the Trademarks Ordinance [new version] 5732/1972 as "letters, numerals, words, images or other signs or combinations thereof, whether two-dimensional or three-dimensional". This broad definition explicitly recognizes the possibility of registering three-dimensional signs, which are usually regarded as non-traditional trademarks. The phrase 'other signs' also opens the door to the registration of other types of non-traditional mark, as long as the signs are capable of being represented graphically. This article discusses the registrability of the shapes of products or of their packaging and colours in most details, as these:

- are the most commonly applied-for non-traditional marks in Israel; and
- have been specifically addressed in case law, unlike other types of non-traditional mark.

## Three-dimensional marks

As mentioned above, in light of the broad definition of the term 'mark' in the Trademarks Ordinance, there is no statutory obstacle preventing the registration of three-dimensional marks in Israel, provided that the signs comply with the criteria for registration set forth in the ordinance.

The term 'three-dimensional trademark' is very broad and encompasses various types of mark. One category includes signs in three-dimensional form which are entirely separate from the product itself. Another category includes three-dimensional signs that are not part of the inherent shape of the product, but rather constitute an additional element extrinsic to the product (eg, the statuette on the bonnet of Rolls-Royce cars). Since the marks belonging to both categories fulfil the classic role of a trademark, the criteria applied to their registrability are

basically the same as those applied to traditional marks. Accordingly, these marks may be registered on the basis of inherent distinctiveness.

A different category of three-dimensional trademarks includes marks consisting of the shape of the product itself. The Israeli Supreme Court addressed the registrability of this type of mark in a precedential ruling rendered in March 2008 (Case CA 11487/03, *August Storck KG v Alfa Intuit Food Products Ltd*). In its decision, the Supreme Court held that a mark consisting of the three-dimensional shape of a product cannot be registered on the basis of inherent distinctiveness. Nevertheless, such a mark can be registered on the basis of acquired distinctiveness, provided that the shape of the product has no real functional or aesthetic role. The aforementioned ruling essentially confirms the strict policy that the Trademark Office has applied in recent years when examining applications to register three-dimensional trademarks.

Following the Supreme Court ruling in the *August Storck Case*, the registrar of trademarks issued a circular that clarifies the current policy of the Trademark Office regarding the registrability of three-dimensional images as trademarks. In the circular, the registrar expresses the opinion that, in general, the proper way to protect three-dimensional designs of goods or their packaging is by filing an application for the registration of a design. According to the circular, three-dimensional images may be registered as trademarks in special cases, where it is proved by evidence that the following three cumulative conditions are met:

- The image *de facto* functions as a trademark;
- The image has no real aesthetic or functional role; and
- The mark has acquired a distinctive character as a result of use to an extent that can convince the registrar that a special case is involved (mere presentation of sales figures is unlikely to convince the registrar that the shape of a product has acquired distinctiveness and more compelling evidence, such as a market survey, will have to be submitted for that purpose).

Marks consisting of the shape of packaging may be considered as belonging to a separate category of three-dimensional mark. Unlike three-dimensional marks consisting of product shape, it is unclear whether the shape of packaging is registrable on the basis of inherent distinctiveness. The Supreme Court referred to this issue in the *August Storck Case* and in another judgment that was rendered in May 2008 (Case CA 3776/06, *Ein Gedi Cosmetics Ltd v The Registrar of Patents, Designs and Trademarks*) but in neither case did the court rule on this matter because it was not required to do so to decide the cases.

In view of the registrar's position that the proper way to protect a three-dimensional shape of packaging is through design registration, the criteria to be applied by the Trademark Office to the shape of packaging are expected to be similar to those applied to product shapes. In a recent decision (Trademark Application 169606), the deputy registrar held that the criteria applied to the shapes of goods should also be applied to the shapes of bottles and containers.

In practice, applications for the registration of three-dimensional marks consisting of the shape of a product or its packaging will be rejected by the examiner and the applicant will be presented with the option of raising arguments before the registrar, in order to convince him that the mark is indeed registrable.

## Colours

In principle, colour marks are registrable in Israel. However, a single colour is regarded as lacking inherent distinctiveness, and this also appears to be the case when a combination of colours is involved. Colours *per se* will be allowed for registration in Israel only in rare cases, where the applicant can prove that the colour has acquired a distinctive character.

In *Eastman Kodak Company v Conko Ltd* (CA 225/96), the Tel Aviv District Court ruled that:

- the colour yellow is a trademark of the Eastman Kodak Company; and
- Kodak is the only company authorized to use this colour in connection with photography products.

To the authors' best knowledge, this is the only case where the Israeli courts have been willing to accept that a single colour constitutes a protectable trademark.

A trademark application to register a colour should include a visual presentation of the colour. In addition, applicants may designate the colour by using an internationally recognized colour identification system code such as Pantone. However, this mode of description is not mandatory under local trademark law and practice.

The registrar of trademarks has recently considered the registrability of colour combination marks. The applications at hand (Trademark Applications 182676, 182677, 182679 and 182680) sought the registration of the colours green and yellow in any possible combination to be applied to a parallelepiped-shaped packaging of any size. The registrar rejected the applications, finding that the marks were abstract and undefined. It may be inferred from this decision that an application for the registration of a colour combination mark should include a systematic arrangement associating the colours concerned in a predetermined and uniform way.

### Sounds

Sounds are registrable as trademarks in Israel. A trademark application to register a sound mark should be submitted together with the sound recording. It is also advisable to submit a graphical reproduction of the mark – for instance, in the form of musical notation.

To date, only a limited number of sound marks have been applied for and registered in Israel. According to Trademark Office practice, proof of acquired distinctiveness is not a prerequisite for registration.

### Scents and tastes

The unofficial position of the Trademark Office is that olfactory and taste marks are not registrable. Conflicting views on this matter have been expressed by leading trademark commentators. Since the position of the Trademark Office regarding the registrability of scents and tastes has not yet been challenged and there is no case law on this matter, it is not clear whether these types of mark can be registered in Israel.

### Moving images and holograms

As is the case with scents and tastes, the unofficial position of the Trademark Office is that moving images and holograms are not registrable as trademarks. Since the



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position of the Trademark Office in this matter has not yet been challenged and the issue has not yet been addressed in local case law, it is not yet clear whether these types of mark can be registered in Israel.

### Conclusion

While it is clear that certain types of non-traditional mark are registrable in Israel, there is still uncertainty regarding the registrability of other types of non-traditional mark. The increasing use of new technologies and the development of innovative and creative marketing strategies may lead to an increase in the number of applications filed in Israel for the registration of non-traditional marks. This expected increase will require the registrar of trademarks and the civil courts to address various aspects related to non-traditional marks that have not yet been decided. Thus, at least part of the uncertainty surrounding the registrability of non-traditional trademarks in Israel will be resolved.

In the meantime, brand owners should remember that while colours and three-dimensional product or packaging shapes can be registered in principle, in practice it is quite difficult to do so. Therefore, brand owners should consider alternatives – for instance, they should consider protecting the unique shape of their products or packaging by registering a design. [WTR](#)