

## 3D Trademarks in Israel

*By Dr. Michael Factor and Aharon Factor Esq., JMB, Factor & Co., Israel*

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According to the Trademark Ordinance, a trademark may be either two-dimensional or three-dimensional.

In practice, whilst it is possible to apply for three dimensional trademarks the Trademark Office has issued a Circular (Circular M.N. 61) curtailing the registerability of such marks. Specifically, three dimensional trademarks which depict the goods themselves which are intended to be covered by the mark are deemed to be not inherently distinctive. Essentially the position of the patent office is that the appearance of the good is not an indication of the source of the good. Rather, it is by nature, generic. Essentially, the Trademark Office believes that the most fitting way to protect the shape and appearance of three-dimensional objects is by means of an industrial design. Since designs can provide protection for a maximum of 15 years, whereas a trademark may be renewed indefinitely, there is a great deal of interest in protecting the appearance of a good as trademarks.

Notwithstanding, it may be possible to register the shape of a good as a trademark in **special cases**, where sufficient evidence is provided to demonstrate that 3 **cumulative** conditions have been fulfilled, as follows:

1. the image requested to be registered, in practice fulfils the role of a trademark, namely it indicates the source of the goods intended to be sold under the mark and not just their appearance;
2. the image requested to be registered, does not serve a solely **aesthetic** or **functional purpose**; and
3. as a result of use, the mark has acquired a distinctive character that is indicative of the source of the good, sufficient to persuade the Registrar of Trademarks that the mark falls into the category of a special case.

By way of example, the Deputy Registrar issued a decision relating to an application for a three-dimensional trademark depicting a bottle of Kremlyovskaya Vodka, as applied by Spirits International Intellectual Property B.V., of Strassen, Luxembourg.

The Deputy Registrar ruled that an image fulfils the role of a trademark if the image alludes to or provides an indication of the source (manufacturer) of the goods covered by the mark. Accordingly, only outlines of an image which from the outset are intended to serve as a trademark, that is that they do not have a functional purpose for the goods nor are they part of the aesthetic design of the goods, and over the course of time the general public has learnt to identify them as such, can be considered suitable for registration as a trademark.

Due to the difficulty in making such distinctions, the Deputy Registrar provided assisting criteria. For example where the outlines of the image diverge from the general form of the image and hint at the name or other element which alludes to the manufacturer or source of the goods more than to the goods themselves.

In the particular case reviewed, the Deputy Registrar ruled that that the vodka bottle did not diverge from a conventional vodka bottle but rather had aesthetic features which were designed to draw the eye and attract the attention of the customer, thereby fulfilling an aesthetic function.

The Deputy Registrar did however, find amongst the various elements of the bottle, one three-dimensional feature which he did not consider to be part of the normal design of a bottle, namely a depiction of the Kremlin, embossed on the neck of the bottle. This element alludes to the name of the goods, vodka of the Kremlin, however, the element in itself when taking into account the mark in its entirety was not a central element of the three-dimensional mark. Accordingly, the Deputy Registrar ruled that the appearance of the bottle as a whole was not permissible for registration as a trademark.

In 11487/03 August Storck KG vs. Alfa Intuit Foodstuffs Ltd., concerning the distinctive shape of Toffiffee sweets, Judge Asher Gronish of the Israel Supreme Court ruled that a distinctive shape could serve as a trademark in some circumstances, but left open the question of whether distinctive packaging could be trademark protected.

Unfortunately, recent decisions of the Trademark Office relating to registering the shape of novel containers as 3D trademarks have lacked consistency.

At the end of 2010, Noah Shalev Shlomovits, the Arbitrator of Intellectual Property addressed this issue in a ruling concerning trademark application number 198897 for tehini paste in class 29 and ruled that the three-dimensional container could not be registered as a trademark. The Arbitrator did not posit the argument that the specific mark lacked distinctiveness but issued instead a blanket rejection of the registerability of containers, despite the fact that containers such as liqueur bottles and perfume containers may be sufficiently distinctive to serve as an indication of the source of the goods contained in the bottles.

In several more recent decisions of the Trademark Office, the same arbitrator has ruled that under certain conditions, 3D containers may be protected by trademarks.

For example, Israel Trademark Application Number TM 174402 for the shape of the Crown Royal Whisky bottle of Diageo North America, Inc, was refused based on the aforementioned circular MN 61. The applicant appealed, arguing that the shape of the bottle, the engraving and the distinctive cap were distinctive and indicated the source of the goods and were not merely aesthetic or functional. The applicant argued that the test to apply for cosmetics and liqueur bottles is the availability of alternatives. If other packaging choices are available, then use of a distinctive package could indicate the source of the goods.

The Arbitrator ruled that the shape of a container may be used for branding purposes and this is in the common interest of the manufacturer and the public." The Arbitrator held that the crisscrossing cut lines of the Crown Royal bottle are designed to evoke a crown, the bottle is long-identified with the product and there is a public interest in allowing such a mark to be unique to the supplier. The bottle shape was accepted for registration as a trademark.

In TM Application 195184 relating to the registerability of a cognac bottle by Martell & Co., the bottle in question has a swallow embossed on it, together with a raised dome base. The applicant argued that the bottle's raised dome indicated the interface between different cultures. The Trademark Deputy Commissioner ruled that the combination of the flying bird had been long identified with the manufacturer and the unique bottle shape was sufficiently unique to allow the bottle to be registered as a trademark.

Arguably, however, Martell supplies a range of Cognac in a range of bottles and the bottle shapes identify specific products and not the supplier. The bird itself is a trademark and is used as a trademark. It is a mark fixed onto the bottle and should be registerable as a trademark. However, the specific bottle shapes should not be protectable for perpetuity.

In a ruling concerning trademark applications 200689 and 200690, images of distinctive L'Oreal perfume bottles shaped like the torso of a woman were filed as trademarks. Since its launch in 2008, the perfume had sold some 15,000 units in Israel. The Deputy Commissioner ruled that whilst it is easy to distinguish between the design of a bottle and its appearance, it is difficult to define the

differences between the two. In this particular case, the application included colour, words on the bottle and a distinctive lid on the bottle. The Deputy Commissioner accepted the trademarks and ruled that infringement could be avoided by changing the colour or the words on the bottle.

With regard to Israel Trademark Application TM 210043 for a Head and Shoulders shampoo bottle filed by Procter and Gamble, the Deputy Commissioner ruled that there was nothing sufficiently distinctive in the design of the bottle to allow it to be registered as a trademark; this despite the unique shape of the bottle and the lid, and the logo and words on the bottle.

Unfortunately, for the applicant of a 3D trademark for the shape of a product, particularly of a container, it appears impossible to predict how the Trademark Office will relate to the application and/or whether it will be registerable on appeal.

With regard to the shape of functional objects, as opposed to containers or candies that can be made in almost any shape, it seems that the shape of functional objects cannot be registered as trademarks. Israel Trademark Applications No. 174765 and 174766 were filed by Trijicon Ltd., for telescopic rifle sights. The applications claimed priority from earlier trademark applications filed in the US. On examination, the marks were rejected for being images of the goods themselves rather than constituting the source of the goods covered by the marks.

On appeal, the applicant argued that following Augustus Storck, the Supreme Court ruling relating to registration of the Toffifee candy as a trademark, three-dimensional marks may be registered if they possess minimal acquired distinctiveness and argued that the rifle sight marks had achieved this requirement as evidenced by similar marks being registered by the USPTO. The adjudicator at the Israel Trademark Office rejected this argument and found neither inherent nor applied distinctiveness and rejected the marks.

***For more information, please contact:***

Dr. Michael Factor  
Partner  
JMB, Factor & Co.  
[mfactor@israel-patents.co.il](mailto:mfactor@israel-patents.co.il)

Born in the UK, Dr. Factor immigrated to Israel in 1994. He is a licensed Israel Patent Attorney with numerous professional affiliations including LES, the IPA, the AEA and the AIPPI. Dr. Factor has a Ph.D. in Applied Physics from the Hebrew University of Jerusalem, an M.Eng. in Materials Science & Engineering from the Royal School of Mines, Imperial College, London, and an LL.B. from the Ono Academic College, Israel. Dr. Factor has conducted surface engineering research at the UK National Physics Laboratory and at Israel's Soreq Nuclear Research Center.

Dr. Factor is experienced in drafting and prosecuting patent, trademark and design applications in all fields. He writes Israel jurisdiction reports in a number of leading IP journals and writes The IP Factor, Israel's leading blog on IP-related subjects with almost 200,000 hits.

Aharon Factor, Advocate  
Head of Trademarks & Designs  
JMB, Factor & Co.  
[afactor@israel-patents.co.il](mailto:afactor@israel-patents.co.il)

Aharon Factor was born in the UK and moved to Israel in 1994. He has a B.A. in Social Sciences from the University of Westminster and an LL.B from Queen Mary College, University of London. Admitted to the Israel Bar in 1996, Factor has extensive experience in commercial law. He manages the firm's burgeoning Trademark & Design Department.