

A DIAMOND IN YOUR POCKET held to be inherently distinctive Examination/opposition
Israel - **Gilat, Bareket & Co, Reinhold Cohn Group** National procedures
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An IP adjudicator at the Israeli Trademarks Office has allowed the registration of the mark A DIAMOND IN YOUR POCKET on the grounds that it was inherently distinctive (March 12 2009).

D-Card Ltd applied for the registration of the mark (Application 187420) for jewellery and precious stones. The mark was intended for use on a card bearing a small diamond for marketing purposes. The trademark examiner initially refused to register the mark, but the IP adjudicator disagreed.

In reaching his conclusion, the IP adjudicator considered whether the mark was eligible for registration as a slogan. Under Circular Letter MN 29/2004 of the Israeli registrar of patents, trademarks and designs, a slogan may be registered only if:

- it has acquired distinctiveness through use; and
- it creates a connection between the goods at issue and their commercial origin.

Relying on EU and Israeli case law, the IP adjudicator made a distinction between two types of slogans:

- those that consist of purely promotional statements; and
- those that serve to create a connection between the goods at issue and their commercial origin.

The IP adjudicator held that the mark A DIAMOND IN YOUR POCKET was not a promotional statement or a laudatory epithet. The IP adjudicator further found that the mark was both descriptive (in that consumers of the goods will carry a diamond in their pocket) and suggestive of the idea that anyone can afford a diamond. Therefore, the IP adjudicator concluded that the mark was inherently distinctive. Although this was not expressly stated, it seems that the IP adjudicator believed that the mark was able to create a connection between the goods and their commercial origin.

Surprisingly, the IP adjudicator found that there was no need to show acquired distinctiveness, which seems to contradict the wording of the Circular Letter.

David Gilat and Sonia Shnyder, Gilat Bareket & Co, Reinhold Cohn Group, Tel Aviv

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