

AMERICAN APPAREL held to be generic
Israel - Gilat, Bareket & Co, Reinhold Cohn Group
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Examination/opposition
National procedures

An IP adjudicator at the Israeli Trademarks Office has refused to register the trademark AMERICAN APPAREL for clothing, footwear and headwear (April 22 2009).

US company [American Apparel Inc](#) applied for the registration of the trademark AMERICAN APPAREL (Applications 184606 and 184607) for goods in Class 25 and services in Class 35 of the [Nice Classification](#) in respect of clothing, footwear and headwear. The examiner refused to register the mark.

American Apparel submitted evidence regarding its long-term use of the mark in the United States (allegedly since 1988) and the large volume of sales of goods bearing the mark in the United States and worldwide. American Apparel showed that it had sold branded goods in Israel since 2006. American Apparel argued that its mark consisted of an unusual combination of words. It further stated that the Israeli public was not familiar with the word 'apparel', and submitted a consumer survey demonstrating this argument.

The IP adjudicator affirmed the examiner's decision. He held that AMERICAN APPAREL was ineligible for registration - either as a local mark or as a foreign mark under Section 16 of the Israeli [Trademarks Ordinance 1972 \(New Version\)](#) - on the grounds that it:

- was descriptive of the goods for which registration was sought; and
- had not acquired distinctiveness in Israel.

In particular, the IP adjudicator held that it is not necessary to determine the relevant public where the applicant admits that the dictionary meaning of its mark is generic (as opposed to suggestive, for example). The word 'apparel' in respect of clothing is a generic term describing the nature of the goods, and this is true for all consumers. The IP adjudicator further held that the English language is within the realm of knowledge of many members of the Israeli public and is routinely used in trade. Therefore, the IP adjudicator concluded that the mark was descriptive of the nature of the goods and lacked inherent distinctiveness.

In addition, the IP adjudicator found that American Apparel's limited volume of sales in Israel and very limited advertising efforts were insufficient to prove that its mark had acquired distinctiveness in Israel. Relying on, among other things, the consumer survey submitted by American Apparel, the IP adjudicator found that if the mark had acquired distinctiveness in Israel, the respondents would have linked the word 'apparel' with American Apparel and its goods.

The IP adjudicator also dismissed American Apparel's argument that its mark was unusual in English - the fact that a mark is unusual does not necessarily mean that it is not generic.

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