

AL ECONOMICA held to be descriptive of laundry products
Israel - Gilat, Bareket & Co, Reinhold Cohn Group
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Cancellation
National procedures

In *The Procter & Gamble Co v Reckitt Benckiser NV* (September 1 2009), the trademarks registrar has struck the trademark AL ECONOMICA from the register and has allowed the registration of the mark ACE AL-ECONOMICA.

Reckitt Benckiser NV owned registrations for the trademark AL ECONOMICA in Israel. '*Economica*' is a generic term designating bleach containing a low concentration of sodium hypochlorite that is used for bleaching and disinfection. *Economica* is mainly used for cleaning surfaces and may not be used to bleach fabrics. Reckitt marketed a stain removal product under the trademark KALIA and the accompanying mark AL ECONOMICA (which may be translated as '*economica-free*'). The AL ECONOMICA mark aimed to convey the message that although the product removed stains effectively, it did not have the adverse effects of *economica* on fabrics and colours.

The Procter & Gamble Co (P&G) applied to register the mark ACE AL-ECONOMICA for bleaching and laundry preparations. Reckitt opposed the application based on its AL ECONOMICA mark. In response, P&G sought to:

- cancel Reckitt's AL ECONOMICA mark; and
- amend the registration for the KALIA AL ECONOMICA mark to include a disclaimer for '*al-economica*'.

Reckitt claimed that it had coined the phrase '*al-economica*' for its novel product and that it had exclusive rights in that phrase. It submitted survey evidence showing that:

- 70% of the respondents were familiar with the phrase; and
- over 25% of the respondents associated it with Reckitt's product.

A marketing expert testified that the phrase was not common in Hebrew and was not descriptive.

In contrast, P&G's language experts testified that the term '*al-economica*' was a 'free combination' which had no meaning beyond the sum of its elements. P&G also submitted survey evidence showing that:

- approximately 50% of the respondents considered that the phrase was descriptive of cleaning products; and
- less than 25% of the respondents associated it with a single manufacturer.

A marketing expert also testified that the phrase was descriptive of 'non-bleach' products and pointed out that it was written in smaller font on Reckitt's Kalia product.

The registrar reiterated that the dual function of a trademark is to:

- allow a trader to distinguish its goods from those of others; and
- enable consumers to identify the source of the goods.

Examining the inherent distinctiveness of the AL ECONOMICA mark, the registrar noted that both elements - the prefix '*a*' and the term '*economica*' - were generic in Hebrew. Relying on linguistic evidence, the registrar found that the combination of these elements was a 'free combination' that would immediately be perceived as such by Hebrew speakers - as opposed to a 'restricted collocation', which has a different meaning than the sum of its elements. The registrar concluded that the AL ECONOMICA mark was directly descriptive of laundry products and, therefore, was not inherently distinctive. The registrar also noted that neither the novelty of the product, nor the alleged novelty of the phrase '*al-economica*', detracted from the descriptiveness of the mark. This finding was supported by the consumer surveys.

The registrar also found that despite Reckitt's prolonged (and, so far, exclusive) use, the AL ECONOMICA mark had not acquired a secondary meaning in Israel.

Therefore, the registrar ordered that:

- P&G's ACE AL-ECONOMICA mark proceed to registration;
- Reckitt's AL ECONOMICA mark be struck from the register; and
- Reckitt's other marks be amended to include a disclaimer.

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