

World Trademark Review Daily

Rival applications for condom marks allowed to proceed
Israel - Gilat, Bareket & Co, Reinhold Cohn Group

Examination/opposition
National procedures

September 09 2010

The deputy registrar has refused to register the word mark PLAY for condoms, but has allowed the applications for the marks DUREX PLAY and LIFESTYLES PLAY to proceed to registration (July 15 2010).

LRC Products Ltd, the owner of the DUREX mark, applied for the registration of the word marks PLAY (Application 174678) and DUREX PLAY (Application 174730) for condoms and other products in Class 10 of the [Nice Classification](#). [Ansell Limited](#), the owner of the LIFESTYLES mark for condoms, subsequently applied for the registration of the device mark LIFESTYLES PLAY (Application 178348) for condoms. The Trademark Office initiated proceedings between the rival applications under Section 29 of the [Trademarks Ordinance \(New Version\) \(5732/1972\)](#).

The deputy registrar first considered the argument that the word 'play', by itself, was a descriptive word - or, at least, was customary in the trade. The deputy registrar noted that, although the focus of Section 29 proceedings is the rival claims of the applicants, the issue of a mark's eligibility for registration may be addressed, in certain circumstances, within the context of such proceedings. The deputy registrar further stated that, because the outcome of proceedings under Section 29 is liable to injure one of the applicants (which will lose all rights in the mark), it is appropriate to consider the possibility of parallel registration under Section 30.

With regard to the registrability of the word 'play', the deputy registrar noted that either of the following conclusions could be reached:

- The word is, by itself, inherently ineligible for registration.
- The word is inherently distinctive or may be capable of acquiring distinctiveness. However, because it is common in the trade, it should be left free for use by competitors.
- Assuming that the word is eligible for registration, each party should be able to continue to use it, since such use is in good faith.
- Assuming that the word is eligible for registration, and one of the applicants would be injured if it were not granted exclusive use of the word, only the mark of that applicant should be registered.

This last conclusion required the deputy registrar to decide which applicant had a better right to the word 'play'.

The deputy registrar noted that the extensive use of the word by each applicant for its products worldwide should be taken into account, as it would influence the perception of the Israeli consumer. The deputy registrar went on to consider whether the relevant public would associate the word 'play' with either applicant in respect of the relevant products. The deputy registrar noted that both parties used the word as a secondary mark (in conjunction with their main marks), but did not use it on its own. Such use could not demonstrate that the word 'play' had distinctive character, either existing or acquired, because the word served to distinguish between the different products of the parties - and not to indicate the origin of the goods. The deputy registrar concluded that, because the owner of the DUREX mark used the word 'play' only in conjunction with its house mark DUREX, such use did not confer distinctive character on the word 'play'.

Therefore, the deputy registrar held that both parties should be allowed to use the word 'play' in conjunction with their house marks, with no risk of confusion or dilution. The deputy registrar also opined that, had there been no application for the registration of the word 'play' by itself, the applications for the marks DUREX PLAY and LIFESTYLES PLAY would not have been heard as rival applications and would both have been allowed, with or without a disclaimer, with no need for recourse to parallel registration under Section 30 of the ordinance.

Accordingly, the application for the registration of the mark PLAY was rejected, and the rival applications for DUREX PLAY and LIFESTYLES PLAY were allowed to proceed. Costs of IS15,000 were awarded against LRC.

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

World Trademark Review *Daily*

World Trademark Review (www.worldtrademarkreview.com) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.