

# World Trademark Review Daily

**McDonald's slogan application successful due to foreign registrations  
Israel - Gilat, Bareket & Co, Reinhold Cohn Group**

**Examination/opposition  
National procedures**

October 01 2010

The deputy registrar has allowed the registration of the phrase 'I'm lovin' it' as a *telle quelle* registration (August 19 2010).

McDonald's Corporation applied for the registration of the phrase 'I'm lovin' it'. The examiner of the Trademarks Office refused registration on the grounds that the phrase was a promotional slogan and did not function as a trademark.

The deputy registrar noted that the eligibility of a slogan for registration as a trademark under the Trademarks Ordinance [New Version] (5732/1972) must be decided based on the following three-prong test:

- whether the phrase is used as a trademark and is intended to identify the source of the product (distinctive character under Section 8 of the ordinance);
- whether the public perceives the phrase as indicating the product or its source (distinctive character under Section 8); and
- whether the mark is eligible under Section 11.

The deputy registrar dismissed the argument that 'loving' was not a laudatory term and that the change in spelling ('lovin') affected the function of the mark as indicating a source.

The deputy registrar held that the phrase 'I'm lovin' it' conveyed a laudatory message and was not inherently distinctive, despite the - unusual - use of the first person singular and of the present progressive tense. Based on promotional material presented to him, the deputy registrar further held that McDonald's did not intend the slogan to acquire a secondary meaning, but to retain its original, literal meaning. He found support for this conclusion in the fact that the slogan had also been translated into Hebrew.

Examining the second prong of the test, the deputy registrar held that proof of extensive advertising expenditures, while necessary to demonstrate distinctiveness acquired through use, was not tantamount to a showing of acquired distinctiveness. The fact that consumers associated the phrase with McDonald's restaurants, as shown by a consumer survey, was not deemed to show acquired distinctiveness, because secondary meaning had not been acquired. Moreover, due to the laudatory character of the phrase, it was doubtful whether 'I'm lovin' it' was actually able to acquire secondary meaning.

Having concluded that the phrase was ineligible for registration under Section 8 of the ordinance, the deputy registrar nevertheless allowed the registration of the mark *telle quelle* under Section 16 of the ordinance based on foreign registrations for 'I'm lovin' it'. *Telle quelle* registration of a mark registered abroad is allowed under Section 16 as long as the mark is not devoid of any distinctive character. Although the characteristics of the mark (ie, its unusual syntax and the use of the first person) were insufficient to render the phrase distinctive, they were sufficient to conclude that it was not devoid of any distinctive character. A disclaimer of all forms of the word 'love' was required.

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

---

**World Trademark Review ([www.worldtrademarkreview.com](http://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.**