

World Trademark Review Daily

**Trademark Office registers four product configurations and get-ups
Israel - Gilat, Bareket & Co, Reinhold Cohn Group**

**Examination/opposition
National procedures**

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In four decisions handed down on April 13 2011, the IP adjudicator has allowed the registration of the configuration of two liquor bottles and of the getup of two perfume bottles, but refused to register the Head & Shoulders shampoo bottle (Application to register Mark 195184 in the name of Martell & Co; Application to register Mark 174402 in the name of Diageo North America Inc; Application to register Marks 200689 and 200690 in the name of L'Oréal; Application to register Mark 210043 in the name of The Procter & Gamble Company).

The applications had originally been rejected by the examiners under their application of the Supreme Court's decision in the *Toffifee* case (for further details please see "[Product configuration cannot be registered based on inherent distinctiveness](#)").

In the *Martell* case, [Martell & Co](#) sought to register the following mark (a bottle bearing the embossed image of a bird) for alcoholic beverages, excluding beer, in Class 33 of the [Nice Classification](#):



The IP adjudicator noted that, when registering product configurations as trademarks, the purposes of the different IP laws must be taken into account: with regard to trademarks, the public interest (as well as that of the owner) requires perpetual protection; in contrast, with regard to industrial designs, the public interest limits protection so as to encourage the creation of a variety of designs for the benefit of the public (after the expiry of the registration term).

The IP adjudicator further held that the ability of the public to identify a product due to its design does not suffice to make its configuration eligible for trademark registration: it must be perceived as a trademark.

The IP adjudicator was satisfied that certain beverages have come to be identified by the configuration of their bottles through long-term use. Therefore, bottle configurations may be perceived as trademarks - that is, as an indication of source. A bottle configuration may be registrable as a trademark, provided that:

- it has features that are not dictated by aesthetic considerations;
- it is intended to be an indication of source and is perceived as such by customers; and
- it has acquired a reputation over the years.

With regard to the mark at issue, the IP adjudicator held that Martell cognac has been sold for centuries under the 'flying bird' trademark, and the bird is prominently featured on the bottle (the bird appears in the centre of the bottle, with the slanted lines emphasising the impression that the bird is flying).

Although the aesthetic appeal of the raised arch at the bottom of the bottle and the relative novelty of its shape did not necessarily show an intention of using the configuration as a trademark, the IP adjudicator held that the shape emphasised the established 'flying bird' mark and the features associating the product with its manufacturer.

Registration of the mark was thus allowed. The IP adjudicator nevertheless noted that a bottle with a similar shape, but without the image of a bird and the slanted lines, would not be confusingly similar to the registered trademark for infringement purposes.

In the *Diageo* case, [Diageo North America Inc](#) sought to register the following mark in Class 33 for alcoholic beverages, excluding beer:

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The IP adjudicator allowed the registration of the mark, reiterating the reasoning given in the *Martell* decision. In particular, the IP adjudicator found that, because the liquor marketed in the bottles at issue was called 'Crown Royal', the various configuration/decoration features of the bottle and stopper were intended to give it the appearance of a crown (the picture of a crown appears on the label). Further, the IP adjudicator pointed out that the liquor had been marketed in this bottle for decades: therefore, such use of the bottle was intended to be for the purpose of product identification and was perceived as such by the public. The IP adjudicator noted that, in such a case, the interest in preserving stability in trade outweighed the interest in encouraging the creation of novel designs.

In the *L'Oréal* case, *L'Oréal* sought to register two fabric-clad perfume bottles bearing the words 'Fuel for Life' and 'Use with Caution', respectively, for perfume and other products in Class 3:



The IP adjudicator allowed the registration of the marks, but first noted that the extent of use of the marks - according to *L'Oréal's* evidence of sales of the perfume 'Fuel for Life' by Diesel, launched in Israel in 2008 - did not necessarily indicate use as a trademark.

In a *dictum*, the IP adjudicator also noted that, similarly to industrial designs, one must examine whether product configuration features are present due to - or despite - the aesthetic design. However, features that are part of an aesthetic design may contain elements that are not dictated by the design, which make the entire product configuration eligible for registration. Such elements must be distinct and prominent for the public to identify the configuration as a trademark.

With regard to the perfume bottles at issue, the IP adjudicator emphasised that *L'Oréal* did not seek to register the product configuration as such, but the entire get-up, as the marks consisted of the bottle shape, the words and the covers.

The IP adjudicator noted that protection was not sought for any of these elements separately, and that each of them remained free for use by competitors. Only the combination of the bottle shape and covers were protected and, therefore, third parties could still use some of the design elements constituting the marks without infringing them. Because the marks were registered in colour, third parties could use different colours, shapes or words.

In the last case, *The Procter & Gamble Company* sought to register the 'Heads & Shoulders' bottle in Class 3 for a variety of cosmetic preparations:

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The IP adjudicator held that the mark did not transcend the sphere of industrial designs in a way that would permit the grant of an exclusive right over the configuration of the bottle, which is the dominant and principal element of the mark. Registration of the mark would prevent competitors from using identical or similar bottles.

The IP adjudicator nevertheless examined whether the container served as a trademark. He noted that, as the applicant had not provided evidence as to how the mark was perceived by consumers, mere evidence of sales did not suffice.

The IP adjudicator referred to an earlier ruling in which the Trademark Office had held that elements that depart from the normal product shape or that point towards the manufacturer indicate that they were intended to serve as a trademark. With time, such elements may come to identify the manufacturer in the eyes of the public and render the shape registrable.

The IP adjudicator also referred to the *dictum* in the *Toffifee* case, according to which the registrability criteria for packaging should be less strict than for product configuration. However, the IP adjudicator pointed out that, according to an earlier ruling of the Trademark Office (for further details please see "[Sesame paste container not registrable as 3D mark](#)"), a container should be considered as product configuration, rather than packaging.

Registration was thus refused.

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