

World Trademark Review Daily

Court recognises that slogans may be inherently distinctive
Israel - Gilat, Bareket & Co, Reinhold Cohn Group

Examination/opposition
National procedures

February 02 2012

In *Eveready Battery Company Inc v Registrar of Trademarks* (AR (TA Distr) 21488-05-11, December 8 2011), the Tel Aviv District Court has affirmed the Trademark Office's refusal to register the advertising slogan 'free your skin' on the grounds that it was descriptive of shaving products and razors, but held that slogans may be inherently distinctive.

The appellant, the owner of the [Schick](#) brand, sought to register the mark FREE YOUR SKIN in respect of shaving soaps, shaving preparations and shaving cosmetics and toiletries in Class 3, and for razors and razor blades in Class 8 of the [Nice Classification](#). Following the Trademark Registry examiner's initial refusal on the grounds that the mark lacked distinctive character, the appellant argued that the mark was suggestive or, at least, registrable *telle quelle* under a lower standard based on its registration abroad.

The deputy registrar of trademarks agreed in principle that a slogan should be examined in the same way as any other mark, but held that, in many cases, slogans convey promotional messages to consumers, rather than indicate the source of the goods. He consequently refused to register the mark, holding that:

- it was a promotional slogan that was descriptive of some aspect or quality of the goods, and should thus remain open to the public; and
- it was devoid of any distinctive character.

On appeal to the Tel Aviv District Court, the appellant argued that slogans, as multi-word marks, may have inherent distinctive character and, therefore, should not be automatically categorised as descriptive or laudatory. It further argued that FREE YOUR SKIN was not descriptive or laudatory, but merely suggestive of the desired effect of the products.

The court ruled that the registrability of slogans must be examined in accordance with the general criteria applicable to all marks; the presence of a promotional message does not deprive a slogan of the ability to be inherently distinctive.

The court then reiterated that marks are categorised into:

- inherently distinctive marks - a category which comprises fanciful/arbitrary and suggestive marks; and
- non-inherently distinctive marks which are common to the trade or must remain open to the trade - a category which comprises descriptive and laudatory marks (these fall within the scope of Section 11 (10) of the [Israeli Trademarks Ordinance 1972 \(New Version\)](#), which provides that such marks are registrable only if they have acquired distinctiveness).

The court noted that a mark consisting of laudatory terms, the choice of which was not obvious, would be registrable.

In its decision, the court criticised Circular Letter MN 29, issued by the registrar of trademarks in 2004, which stated that slogans are devoid of inherent distinctiveness due to their nature as advertising messages that are not perceived as denoting source, and are registrable only if they are shown to have acquired distinctive character through use and to be perceived as indicators of source. The court held that the advertising purpose of a phrase does not by itself prejudice its ability to indicate source and distinguish the goods.

The court noted that, to examine whether a slogan has the ability to indicate source, various factors should be taken into consideration, including:

- the content of the message;
- the manner in which it is displayed;
- the language;
- the length;
- the degree of catchiness;
- the type of goods; and
- the relevant segment of the public.

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As an auxiliary test, the court may consider whether a consumer could be expected to use the slogan to request the goods from a sales assistant.

On the facts of the case, the court concluded that FREE YOUR SKIN was directly descriptive of clean skin and hair removal, or of the pleasant sensation obtained after using the products, in a way that did not require consumers to make any intellectual effort. It did not show the minimum degree of originality or sophistication required to make the mark suggestive. The court also noted that 'free your skin' was widely used for the description of cosmetic products and services, and should be left open to the trade. Even on the assumption that the mark was on the borderline between descriptive and suggestive, the court followed the case law of the Supreme Court that, in borderline cases, free competition and free speech should be favoured. The court concluded that the mark was devoid of any distinctive character and, therefore, was not registrable under the laxer standard of *telle quelle* registration.

Following this decision, on January 5 2012 the newly appointed registrar of trademarks revoked the 2004 Circular Letter which had set stricter standards for the examination of slogans.

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