

World Trademark Review Daily

Philip Morris fails to prevent registration of cigarette mark by British American Tobacco
Israel - Gilat, Baret & Co, Reinhold Cohn Group

**Examination/opposition
National procedures**

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In *Philip Morris Products SA v British American Tobacco (Brands) Ltd* (opposition to the registration of trademark No 232527, August 25 2013), the registrar of trademarks has dismissed an opposition by [Philip Morris Products SA](#) against the registration of CLICK SWITCH REFRESH by [British American Tobacco \(Brands\) Ltd](#).

British American Tobacco applied for the registration of the trademark CLICK SWITCH REFRESH in Class 34 of the [Nice Classification](#) for cigarettes, tobacco, tobacco products, lighters, matches and smokers articles.

Philip Morris opposed the registration on several grounds listed in the [Trademarks Ordinance \[New Version\] 5732-1972](#). In particular, Philip Morris argued that:

- the mark lacked distinctive character and was thus ineligible for registration under Section 8(a) of the ordinance;
- it was descriptive of the mode of use of the products to which it referred, and was thus ineligible for registration under Section 11(10) of the ordinance;
- it was ineligible for *telle quelle* registration under the exception set forth in Section 16(3) of the ordinance; and
- it was ineligible for registration as an advertising tagline/slogan.

Philip Morris further argued that the mark violated public policy (and was thus barred under Section 11(5) of the ordinance) and was liable to create unfair competition, as it would confer on the applicant an unwarranted monopoly over its constituent words.

As to descriptiveness, Philip Morris argued that the mark described the movements that a user is supposed to make in order to change the taste of the cigarettes, which were promoted as combining two tastes in one cigarette (ie, clicking the filter, which contains a menthol capsule; switching the filter to distribute the liquid contained in the capsule; and enjoying the resulting fresh taste). Philip Morris adduced as evidence the applicant's advertising material for its Lucky Strike brand of cigarettes, which contained the line: "Click here to change the taste".

The applicant submitted that it used the mark CLICK SWITCH REFRESH, which was already registered and used in many other jurisdictions, to advertise its Kent brand of cigarettes. According to the applicant, the mark was inherently distinctive and had come to be associated with the Kent brand by the public as a consequence of the applicant's use. The applicant argued that the words making up the mark and the order in which they appeared were neither common in the trade nor descriptive of the goods, since the mode of use could be described differently, as shown by the evidence regarding the Lucky Strike brand. The applicant further argued that, as it consisted of an unusual combination of words, the mark served to indicate the origin of the goods. In addition, the Israeli consumers, for whom English is not a main language, would perceive the mark as distinctive.

The registrar emphasised that, in accordance with case law, a tagline/slogan should be examined in the same way as any other mark, and is not necessarily devoid of inherent distinctiveness. Further, he reiterated that a mark should be examined in its entirety, so that it is the distinctive character of the specific combination of the words that is being examined.

As to descriptiveness, the registrar held that, while functional messages describing the mode of use of goods would not be registrable, an unusual combination of descriptive words, which is sufficiently removed from the mere combination of their meanings, may be registrable.

With regard to the CLICK SWITCH REFRESH mark, the registrar noted that it was not syntactically correct; therefore, it could be considered as an arbitrary combination, and was clearly arbitrary with regard to the claimed goods other than cigarettes. He further observed that the mode of use could be described differently (eg, press/squeeze or turn/twist, and any other taste could be used instead of 'refresh') and, therefore, the combination was unusual - all the more so for Israeli consumers for whom it had no common meaning in Hebrew. The registrar concluded that the mark was suggestive, rather than descriptive. Accordingly, it was ruled that the mark:

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- was not descriptive of the goods;
- did not relate directly to the characteristics of the goods; and
- possessed distinctive character.

Accordingly, the registrar refrained from considering:

- the issue of whether the mark had acquired a secondary meaning;
- the issue of *telle quelle* registrability; and
- Philip Morris' allegation that the mark contained a laudatory word ('refresh') in contravention of the laws restricting the advertisement of tobacco products and, consequently, in violation of public policy - the registrar left open the possibility of relying on such laws to substantiate a public policy ground of opposition.

The mark was thus allowed for registration.

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

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