

## **Descriptive use exception does not obviate need for disclaimer**

Examination/Opposition  
National procedures

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The registrar of trademarks has upheld the examiner's decision to make the registration of three device marks conditional upon the applicant's notice of disclaimer (June 5 2008).

**Colgate-Palmolive Co** applied for the registration of three device marks containing the words 'lady speed stick' (Applications 167523, 167522 and 167784). The examiner requested that Colgate provide a notice of disclaimer in respect of the words 'lady' and 'stick', but Colgate objected. The registrar of trademarks was called upon to rule on Colgate's petition to register the marks without providing a disclaimer.

Colgate acknowledged that, under Section 21 of the **Trademarks Ordinance 1972**, the registrar may request that an applicant provide a disclaimer when the latter seeks to register a mark containing an element that is generic, descriptive or customary in the trade. However, Colgate argued that in the present case, there was no risk that either word ('lady' or 'stick') might become inaccessible to others in the trade: under Section 47 of the ordinance, registration of a trademark must not prevent a third party from truthfully using words that genuinely describe the character or quality of its goods. Colgate further argued that:

- it had provided notices of disclaimer for the corresponding word marks; and
- therefore, there was no need to provide disclaimers for its well-known device marks.

The registrar thus had to consider whether the descriptive use exception under Section 47 of the ordinance obviated the need for a disclaimer. The registrar stated that the subsidiary issues were whether, for the purposes of providing a disclaimer:

- device marks should be treated differently from word marks; and
- well-known marks should be treated differently from other marks.

First, the registrar held that, unlike a disclaimer (which clarifies that part of a mark, when standing alone, is kept free for use by competitors), the descriptive use exception under Section 47:

- is not limited to a specific element within a mark; and
- requires proof that the element genuinely and truthfully describes the character or quality of the third party's goods.

Thus, the provision of a disclaimer under Section 21 serves to ensure the integrity of the register and provides greater certainty as to the scope of protection of the mark. In contrast, reliance on Section 47 lowers the accuracy of the register and decreases certainty.

Second, the registrar held that, whereas a disclaimer excludes from the scope of protection of a trademark any element which should remain free for use by competitors, Section 47 permits use of such element where such use is truthful and genuinely describes the character or quality of the goods. Therefore, truthful use of the descriptive element of a mark under Section 47 is narrower than use of such descriptive element under Section 21.

Third, the registrar noted that the objective of Section 47 derives from the fact that the register contains elements of marks - or entire marks - that would now be ineligible for registration due to changes in the trade environment and in terminology, among other things. Because the aim of the trademark registration system is not only to serve the public interest, but also to regulate the rights of trademark owners, the ordinance does not allow the cancellation at any time of trademarks (or parts of trademarks) that have lost their distinctive character. Instead, a registration must be contested within five years of the registration date; following expiry of this five-year period, the registration may no longer be cancelled, except on grounds of bad-faith registration and/or use.

While agreeing with Colgate's proposition that device marks protect the manner in which the words are presented (rather than the words themselves), the registrar rejected Colgate's claim that applicants need not provide a disclaimer in order to register device marks. The registrar held that:

- a device mark protects a design, as well as the corresponding words (albeit to a lesser degree); and
- a conclusion to the contrary would have the effect of eliminating the need to assess the aural similarity between the marks.

Consequently, the registrar concluded that an applicant seeking to register a trademark must provide a notice of disclaimer if, in the opinion of the registrar, certain elements of the mark should remain free for use by competitors. Reliance on Section 47 is not sufficient for such purposes.

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