

Section 24(a1)(2) does not allow transfer of registration to opponent

Examination/Opposition
National procedures

Israel - Reinhold Cohn Group

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In opposition proceedings against the registration of the mark RÈGAL, the IP adjudicator has held that where the opponent claims ownership of a mark as grounds for opposition under the Israeli [Trademarks Ordinance 1972 \(New Version\)](#), Section 24(a1)(2) of the ordinance does not allow the transfer of the registration to the opponent (December 14 2008).

Pet Products Ltd sought to register the trademark RÈGAL for pet food. [US Grain Company](#) opposed the application on the grounds that it was the owner of the mark. Pet Products withdrew its application by way of notice of abandonment.

Following the abandonment of the application, US Grain requested that the Trademarks Office transfer the registration to itself.

The adjudicator refused to transfer the registration to US Grain. The adjudicator held that should an opposition be upheld, the proceedings may result only in the rejection of the application, and not in the transfer of the registration to the opponent. The adjudicator stated that although Section 24(a1)(2) of the ordinance lists ownership of a mark as grounds for opposition, it does not provide for the transfer of the registration to the opponent. In order to obtain registration of the mark, the opponent must apply to the Trademarks Office in accordance with the procedure set forth by the ordinance.

The decision highlights the difference between the Israel [Patents Law 1967](#) and the Trademarks Ordinance. Section 33 of the Patents Law expressly provides that opposition proceedings may result in the registration being granted to the opponent. However, the ordinance contains no such provision, and the decision of the adjudicator in the present case has now clarified that such outcome was not possible in trademark opposition proceedings.

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