

Shape of Kremlyovskaya vodka bottle refused registration

Israel - Gilat, Bareket & Co, Reinhold Cohn Group

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Examination/opposition
National procedures

An IP adjudicator at the Israeli Trademarks Office has refused to register a three-dimensional mark consisting of the shape of a bottle for alcoholic beverages (April 19 2009).

[Spirits International Intellectual Property BV](#) applied to register a three-dimensional trademark consisting of the shape of the bottle of its Kremlyovskaya vodka (Application 169606). The application covered alcoholic beverages. Spirits submitted evidence of:

- registrations for the mark in other countries; and
- sales of its Kremlyovskaya vodka worldwide and in Israel.

Spirits also argued that the design properties of the bottle were unique.

The IP adjudicator noted that the issue at hand was not whether three-dimensional marks are registrable. Rather, the issue was whether the shape of a product - and, in particular, the shape of containers and bottles for goods such as liquids and gas - may be registered as a trademark.

Noting that the registrability of such shapes is governed by the decision of the Supreme Court in *August Storck KG v Alpha Intuit Foods Ltd* (the *TOFFIFEE* decision) (for further details please see "[Product configuration cannot be registered based on inherent distinctiveness](#)"), which was confirmed in a subsequent circular letter of the registrar (for further details please see "[New circular on registrability of three-dimensional marks](#)"), the IP adjudicator stressed that the [Israeli Trademarks Ordinance 1972 \(New Version\)](#) should be interpreted purposively to fit in with other areas of IP law.

The IP adjudicator reiterated that under *TOFFIFEE*, a product configuration cannot be registered on the basis of inherent distinctiveness, but may be registered only on the basis of acquired distinctiveness, provided that it has no functional or aesthetic features.

The IP adjudicator held that the *TOFFIFEE* decision struck a balance between trademark protection and the laws on patents and industrial designs, which protect the functional and aesthetic features of products. The IP adjudicator stressed that the Trademarks Office must consider the rationale underlying the different types of IP protection in deciding whether to register a trademark.

Applying the *TOFFIFEE* test in two stages, the IP adjudicator examined whether:

- the shape at issue had been designed with a view to creating an association with the source of the product in the mind of the public; and
- the shape had become associated with the product in the mind of the public.

Referring to the *obiter* in *TOFFIFEE* (under which the criteria for the registration of packaging should be less stringent than those for the registration of product configuration), the IP adjudicator held that the shape of a bottle containing liquids represents the product itself, rather than its packaging.

The IP adjudicator concluded that the mark at issue was a conventional shape the features of which were intended to attract the attention of consumers. This was supported by the fact that Spirits' affidavit referred to such features as design elements, rather than identifying elements. The adjudicator granted Spirits leave to file a separate application for the registration of a Kremlin emblem embossed on the bottle as a three-dimensional mark.

Spirits was also recently involved in proceedings in the United States and Canada with regard to its RUSSKAYA, MOSKOVSKAYA and STALINSKAYA marks (for further details please see "[Geographic misdescriptiveness standard clarified in *MOSKOVSKAYA Case*](#)", "[Spirits International loses US rights to RUSSKAYA mark](#)" and "[That which does not exist cannot be expunged](#)", says court").

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