

World Trademark Review *Daily*

Shape of open cigarette pack is refused registration
Israel - Gilat, Bareket & Co, Reinhold Cohn Group

Examination/opposition
National procedures

May 18 2010

The deputy registrar has rejected an application by [Philip Morris Products SA](#) to register the shape of an open cigarette pack as a trademark on the grounds that the shape would not be seen as indicating the origin of the goods (April 8 2010).

Philip Morris applied for the registration of the shape of an open pack of Marlboro special edition cigarettes. The examining attorney refused registration on the grounds that the mark was intended to protect the design of the pack's side-hinge opening, rather than to serve as a trademark.

The deputy registrar conceded that packaging may, at times, be inherently distinctive, but held that the opening mode of a cigarette pack was not protectable under the trademark legislation, which is designed to protect the existing or future goodwill of the product or the trader, but leaves the functional and aesthetic design of the product and its packaging free for use by competitors. Trademark protection for product get-up (ie, product configuration or packaging) is less widespread and more limited than that afforded to traditional trademarks. Nevertheless, product get-up may be registrable if it serves to distinguish the origin of the products. However, the need to keep elements that characterize common shapes free for use by competitors must be taken into account.

Philip Morris argued that it did not seek protection for the design of the pack itself, but for a combination of elements including a triangle design, the MARLBORO mark and the distinctive opening of the pack. Philip Morris also volunteered to disclaim the shape of the open pack.

The deputy registrar emphasized that the primary route to protect product get-up is under the tort of passing off. He stated that the features of a product that are valued *per se*, rather than as indicia of origin, are not protectable and should not be regarded as being part of the get-up. The deputy registrar noted Philip Morris' admission that the opening mode of the pack should be left free for use by competitors. Further, he held that Philip Morris had failed to prove that the shape of the pack was capable of identifying the origin of the goods. The deputy registrar concluded that, in the absence of acquired distinctiveness, the shape was not protectable. He noted that, in the future, the design could be shown to be functional - or, conversely, it could be shown to indicate the origin of the goods.

Noting Philip Morris' willingness to disclaim the shape of the pack, the deputy registrar held that the shape, as presented in the application, was not eligible for protection. He pointed out that, at the time of sale, the pack would be closed. Therefore, notwithstanding the possible disclaimer, the application focused entirely on the unusual opening of the pack. The deputy registrar thus rejected the application in its current form, but noted that he would be prepared to allow the application based on the distinctiveness acquired by other elements of the pack - on condition that the pack be presented closed and that its novel opening mode be invisible. Philip Morris was allowed to submit an appropriate picture in order to proceed with the application.

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

World Trademark Review (www.worldtrademarkreview.com) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.