

**' .com' ending does not render generic mark distinctive**  
**Israel - Gilat Bareket & Co, Reinhold Cohn Group**

**Examination/opposition**  
**National procedures**

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In *Application to Register Mark 241856 in the name of TravelJigsaw Limited* (June 30 2015), the Israel Patent and Trademark Office (IPTO) (through IP adjudicator Bracha) has refused to register the word mark RENTALCARS.COM on the grounds that it was generic and directly descriptive of the applicant's services, as the '.com' ending was devoid of any source-indicating significance.

TravelJigsaw Limited, a UK-based company operating the website '[rentalcars.com](http://rentalcars.com)', sought to register RENTALCARS.COM as a word mark in Israel in respect of a wide range of car hire, booking and travel services (including via the Internet) in Class 39 of the [Nice Classification](#). The IPTO examiner refused registration, citing:

- the mark's lack of distinctive character under Section 8(a) of the [Trademarks Ordinance \(New Version\) 5732-1972](#); and
- the fact that it was directly related to the nature or quality of the services for which registration was sought, and thus ineligible for registration under Section 11(10) of the ordinance.

The applicant brought the matter for a hearing before the IP adjudicator of the IPTO, arguing that its mark:

- was distinctive (eg, because the element '.com' imparts a distinctive character);
- was not descriptive of the relevant services (eg, because the website corresponding to the mark at issue serves merely as a platform for connecting clients with car rental companies);
- had been registered in other jurisdictions; and
- had acquired distinctive character through use.

In the judicial proceeding before the IP adjudicator, the mark was held to be ineligible for registration. Reiterating the rule that a common name for goods or services must remain free for use by the public, even if it is in a foreign language that is understood by a considerable segment of the public, the IP adjudicator determined that RENTALCARS.COM is a direct and precise description of the services listed in the application (car rentals being the principal services, with the remainder services being ancillary). The adjudicator noted that the '.com' ending, which is a generic top-level domain, is a common ending which does not render a mark distinctive. Further, the adjudicator emphasised that the registration of a word combination as a domain name does not imply that it can be registered as a trademark, since domain names do not need to meet the same criteria as trademarks (eg, distinctive character).

The adjudicator concluded that RENTALCARS.COM:

- was a generic name that was directly connected to the services provided by the applicant; and
- was not related in any way to the applicant's name - TravelJigsaw Limited - so that it was impossible for the public to identify the applicant as the source of the services.

The mark was thus held to be a combination of two generic elements devoid of any source-identifying significance. Therefore, it was a generic combination which should not be taken out of the public domain.

While a generic mark cannot acquire distinctiveness through use, the adjudicator, for the sake of completeness, analysed whether the applicant had proved that the mark had acquired distinctive character – a heavier burden for marks approaching the descriptive/generic side of the spectrum. Notwithstanding the evidence adduced by the applicant regarding the number of visits (hundreds per month in Israel between 2011 and 2013) to the applicant's '[rentalcars.com](http://rentalcars.com)' website (active since 2003), the number of transactions via the website and advertising expenses (including in Israel), the adjudicator determined that the mark had not acquired distinctive character.

The adjudicator further held that website visits did not show public acquaintance with the applicant's mark, because the underlying word combination in the online search is common for consumers wishing to rent a car and is often prompted by the search engine. Evidence of advertising expenses, it was noted, did not distinguish between those relating to the word mark and those relating to the applicant's stylised mark. In addition, foreign trademark registrations primarily related to the stylised mark.

Accordingly, the mark was refused registration.

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