

Injunction granted in registered design infringement case

Design

Israel - Gilat, Bareket & Co, Reinhold Cohn Group

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In *Ronit Flags of the World Ltd v Practmatia Marketing Ltd* (Case 1562/04, July 26 2009), the Tel Aviv District Court has enjoined the defendants from importing and marketing car flag holders on the grounds that they infringed the plaintiff's registered design.

Ronit Flags of the World Ltd owns a registered design in Israel for a car flag holder. The defendants imported car flag holders which allegedly infringed Ronit's registered design. Miniature flags that are clipped onto the car's windshield are sold in Israel around Independence Day.

The court held that:

- the defendants' products constituted an obvious imitation of Ronit's registered design under Section 37(1)(b) of the Patents and Designs Ordinance 1924; and
- the defendants had actual or imputed knowledge of the design.

Under Section 37(1)(b) of the ordinance, knowledge of the existence of the registered design is required. In the present case, the court found that even if the defendants had no actual, specific knowledge of the design, they ought to have been aware that the flag holders might have been protected by certain rights. Therefore, knowledge could be imputed.

The court further noted that under established case law, a defendant may counterclaim for invalidity of the plaintiff's registration during the course of infringement proceedings. However, in the present case, the court rejected the defendants' counterclaim both on procedural and substantive grounds.

First, the defendants' claim that the registration had been wrongly extended was rejected on the grounds that this claim had not been raised in the statement of defence.

The court then addressed the defendants' claim that the design was ineligible for registration on the grounds of lack of novelty or originality. The court reiterated that according to the law, a design registration protects the novel and specific external features of an industrial product. In the present case, the court found the defendants had failed to prove that Ronit's car flag holder was ineligible for registration.

The court also rejected as unfounded the claim that the design was merely a "mechanical device" which was ineligible for protection under Section 2 of the ordinance.

The court thus granted a permanent injunction preventing the defendants from importing, manufacturing and selling car flag holders protected by, or obviously similar to, the registered design. The amount of damages was decided separately.

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