

# World Trademark Review Daily

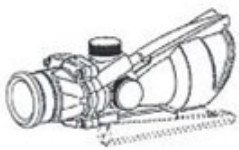
**Configuration of telescopic gun sights refused registration  
Israel - Gilat, Baretet & Co, Reinhold Cohn Group**

**Examination/opposition  
National procedures**

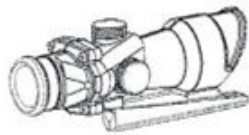
June 10 2011

The Israeli Trademark Office (IPTO) has refused to register three-dimensional marks consisting of the configuration of telescopic gun sights, holding that the marks were devoid of any distinctive character - despite the [United States Patent and Trademark Office \(USPTO\)](#) finding that they had acquired distinctiveness through use (Application to register Marks 174765 and 174766 in the name of Trijicon Inc, April 27 2011).

US manufacturer [Trijicon Inc](#) sought to register two trademarks for “telescopic gun sights” in Class 9 of the [Nice Classification](#), claiming priority from a US registration.



Mark 174765



Mark 174766

The marks were refused by the IPTO examiners on the grounds that they were three-dimensional product configurations which were not intended to serve as trademarks and were not eligible for registration. The examiners' position did not change following:

- the Supreme Court's decision in the *Toffifee* case, in which it was held that a product configuration is not registrable based on inherent distinctiveness, but may be registered based on acquired distinctiveness (for further details please see "[Product configuration cannot be registered based on inherent distinctiveness](#)" and "[Additional hearing denied in TOFFIFEE case](#)"); and
- IPTO Circular Letter 61, which was issued in the wake of the *Toffifee* ruling (for further details please see "[New circular on registrability of three-dimensional marks](#)").

In the hearing before the IP adjudicator, Trijicon invoked Section 16 of the [Trademarks Ordinance \[New Version\] \(5732/1972\)](#), which, in the relevant part, allows the registration of a mark based on its registration abroad, even if it does not possess distinctive character in the sense of Section 8 of the ordinance, provided that it is not “devoid of any distinctive character”. Section 16 has been successfully invoked, for example, in the context of the *telle quelle* registration of promotional slogans (eg, see "[McDonald's slogan application successful due to foreign registrations](#)").

Trijicon argued that the marks were not “devoid of any distinctive character” and that they had acquired distinctiveness through use abroad. Moreover, they had been found to have acquired distinctiveness through use by the USPTO.

The IP adjudicator recognised that Section 16 does not require that the mark distinguish the owner's goods from those of others, as mandated by Section 8; however, it does require some degree of distinctiveness.

Citing the *Kremlyovskaya* decision (for further details please see "[Shape of Kremlyovskaya vodka bottle refused registration](#)"), in which it was held that product configurations are descriptive and not distinctive, the IP adjudicator noted the importance of the purposive interpretation of IP laws. According to this interpretation, perpetual trademark protection should be granted to marks that distinguish a trader's goods from those of others, and should not exclude from the public domain marks that should remain free for use by the trade. The IP adjudicator emphasised that product configurations, for the most part, consist of functional and aesthetical features, neither of which may be excluded from the public domain, other than through the limited protection of patents and designs, respectively.

The IP adjudicator held that the marks at issue were devoid of any distinctive character. Therefore, their registration would prevent the manufacture of binoculars of any configuration, which would be a severe blow to competitors. Furthermore, configurations are mostly functional, and any non-functional features are covered by industrial designs and should not be excluded from the public domain in favour of a single trader.

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The IP adjudicator noted Trijicon's argument that, because the USPTO had found that the marks had acquired distinctiveness through extensive use, they met the requirement of minimal distinctiveness under Section 16 of the ordinance, even though they were devoid of inherent distinctiveness. However, the IP adjudicator held that he could not adopt the USPTO's determination.

The IP adjudicator further held that, in light of the purpose of Israeli laws, extensive use could not confer on Trijicon an exclusive right to use the telescopic gun sights pictured in the marks, especially by way of perpetual protection as a trademark. The adjudicator emphasised that extensive use does not equal to distinctiveness; even if it had been shown that the relevant public associated the telescopic gun sights at issue with Trijicon, such association did not necessarily mean that they were perceived as a trademark.

The IP adjudicator concluded that the marks consisted of functional and design features and, therefore, should remain free for use by the public and competitors.

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