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Burden of proving acquired distinctiveness heavier where mark is descriptive

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**Examination/opposition
National procedures**

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The Israeli Trademark Office has refused to register the trademark TOUR DE ISRAEL for cycling competitions, holding that it was not inherently distinctive and that it had not been shown to have acquired distinctiveness (Application to register mark 221122 by Tzimuk Irgum Eruim Ltd, November 20 2011).

Applicant Tzimuk Irgum Eruim Ltd sought to register the word mark TOUR DE ISRAEL in respect of a competitive cycling tour of Israel in Class 41 of the [Nice Classification](#). To support its application, which had been refused by the examiner, the applicant asserted that the mark had been widely advertised since 2009 and used for the cycling event at issue since 2010.

Upon review, the IP Adjudicator concluded that the use of 'tour' and 'tour de' for cycling competitions was common in the trade in Israel and abroad. Therefore, the mark lacked distinctive character under Section 8 (a) of the [Trademarks Ordinance \(New Version\) 5732-1972](#). Further, the mark was barred from registration due to:

- the geographic meaning of the element 'Israel' under Section 11(11) of the ordinance; and
- the fact that the mark related directly to the nature or the quality of the services for which registration was sought under Section 11(10) of the ordinance.

The adjudicator noted that the mark was not a coined expression combining descriptive elements, but merely a combination of two descriptive elements.

Referring to the applicant's evidence of extensive advertising in support of its argument of acquired distinctiveness, the adjudicator reiterated that the burden of proving acquired distinctiveness is heavier where the mark is on the descriptive/generic side of the distinctiveness spectrum. She held that extensive advertising did not indicate that the public had learnt to associate the mark with the applicant. Moreover, because only one competition had been held under the mark so far, it was difficult to deduce that the distinctive character of the mark was sufficient to confer exclusive use on the applicant.

The adjudicator distinguished the mark from TOUR DE FRANCE, to which the applicant compared its mark, holding that TOUR DE FRANCE had enjoyed decades of consumer recognition and was well-known worldwide. The adjudicator further noted that TOUR DE CALIFORNIA had been refused registration in the United States due to a likelihood of association with TOUR DE FRANCE.

Registration of the mark TOUR DE ISRAEL was thus refused based on the lack of inherent distinctiveness and on the applicant's failure to demonstrate acquired distinctiveness.

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