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Date

May 2008

## To Whom It May Concern:

### Circular Letter No. 61 of Dr. Meir Noam, Registrar of Patents, Designs and Trademarks 3-Dimensional Trademark Update

We would like to draw your attention to a Circular Letter issued by the new Registrar of Patents comprising an update regarding 3-Dimensional Trademark Applications. Said Circular Letter states as follows [translated from Hebrew]:

*"THIS CIRCULAR LETTER CONCERNS THE POLICY OF THE ISRAELI TRADEMARK OFFICE REGARDING SUITABILITY FOR REGISTRATION OF THREE-DIMENSIONAL IMAGES, SUCH AS IMAGES OF CONTAINERS, BOTTLES, TABLETS ETC., AS TRADEMARKS DUE TO THE SUSPICION THAT SOME OF THESE APPLICATIONS FOR REGISTRATION ARE INTENDED TO CIRCUMVENT THE LIMITATIONS OF REGISTERING DESIGNS [FOR INSTANCE PRIOR PUBLICATION AND LIMITED SCOPE OF PROTECTION]. THE PRESENT UPDATE COMES IN LIGHT OF SUPREME COURT DECISION NO. 11487/03 FROM MARCH 23<sup>RD</sup>, 2008 IN THE MATTER OF AUGUST STORCK KG VS. ALPHA INTUIT FOOD PRODUCTS INC.*

- A. *AS A RULE, THE PROPER WAY TO PROTECT THREE-DIMENSIONAL DESIGNS OF GOODS OR THEIR PACKAGING IS BY FILING AN APPLICATION TO REGISTER A DESIGN.*
- B. *A THREE-DIMENSIONAL TRADEMARK IS NOT QUALIFIED FOR REGISTRATION AS A TRADEMARK ON THE BASIS OF HAVING AN INHERENT DISTINCTIVE CHARACTER.*
- C. *IN ORDER NOT TO ELIMINATE THE DIFFERENTIATION BETWEEN A TRADEMARK AND A DESIGN, IT WILL BE POSSIBLE TO WEIGH REGISTRATION OF THREE-DIMENSIONAL IMAGES AS TRADEMARKS UNDER SPECIAL CIRCUMSTANCES, TO BE PROVED BY MEANS OF FILING EVIDENCE, THAT THREE ACCUMULATIVE CONDITIONS HAVE BEEN MET, NAMELY:*

- *THE IMAGE REQUESTED FOR REGISTRATION ACTUALLY FULFILLS THE ROLE OF A TRADEMARK;*
  - *THE IMAGE REQUESTED FOR REGISTRATION DOES NOT POSSESS AN AESTHETIC OR A SIGNIFICANTLY FUNCTIONAL ROLE;*
  - *AS A RESULT OF USE, THE MARK HAS ACQUIRED A DISTINCTIVE CHARACTER [AN ACQUIRED DISTINCTIVE CHARACTER] SHOULD IT BE POSSIBLE TO PERSUADE THE REGISTRAR THAT INDEED A SPECIAL CASE AS DESCRIBED ABOVE IS IN QUESTION .*
- D. IN THE EVENT THAT IT WILL BE DECIDED THAT A MARK IS SUITABLE FOR REGISTRATION, ITS REGISTRATION WILL BE CONDITIONAL UPON GIVING A DISCLAIMER CLARIFYING THAT THE MARK IS THREE-DIMENSIONAL.*
- E. PRESENT CIRCULAR LETTER No. 61 VOIDS THE REGISTRAR'S PREVIOUS CIRCULAR LETTER No. 28."*

In view of the above it is still hard to register 3-dimensional Trademarks in Israel. However, as indicated above, there are some exceptions and it is easier than it used to be.

Please do not hesitate to contact us should you require further assistance and/or clarification.

Yours very truly,  
DR. YITZHAK HESS & PARTNERS