

ISRAEL

# Global Trademark Guide

## About

This guide has been prepared by DLA Piper's team of trademark experts together with our network of contributors from around the world.

It addresses the many challenges faced by practitioners and specialists managing brand protection in one of the most dynamic, diverse and challenging regions of the world. The questions are many and varied:

- How do I recover an infringing domain name in Germany?
- Can I take action against a shadow company registration in Hong Kong?
- Is it possible to file a multi-class application in Australia?
- How do I crack down on a counterfeiter in Indonesia?
- Does the UK allow registration of colour marks?
- How quickly can I get a registration in South Korea?

The guide provides quick and accessible answers to all of these questions and many more, providing the initial guidance which every practitioner needs in developing and executing a brand protection strategy. Importantly, this guide does not contain any legal advice but instead is intended to be a practical, user-friendly summary of trademark law and practice. If you require brand protection advice, please contact the DLA Piper professionals listed in the Guide.

Finally, if you have any questions or comments, please contact us at our dedicated email address [TMGuide@dlapiper.com](mailto:TMGuide@dlapiper.com).

### Key contacts



#### Edward Chatterton

Partner  
DLA Piper Hong Kong  
[edward.chatterton@dlapiper.com](mailto:edward.chatterton@dlapiper.com)  
T: +852 2103 0504



#### Melinda Upton

Partner  
DLA Piper Australia  
[melinda.upton@dlapiper.com](mailto:melinda.upton@dlapiper.com)  
T: +61 2 9286 8209

### Editors



#### Richard Taylor

Partner  
DLA Piper UK LLP  
[richard.taylor@dlapiper.com](mailto:richard.taylor@dlapiper.com)  
T: +44 12 1262 5836



#### Satnam Sahota

Senior Associate  
DLA Piper UK LLP  
[satnam.sahota@dlapiper.com](mailto:satnam.sahota@dlapiper.com)  
T: +44 12 1281 3720



# Israel

Last modified 01 January 2021

## Key laws and regulations

The key laws and regulations with respect to trademark law and practice in Israel are:

- The Trademarks Ordinance [New Version], 5732-1972 (the "**Ordinance**")
- The Trademarks Regulations 1940 (the "**Regulations**")
- The Trademarks Regulations (Appeal before the District Court), 5748-1987
- The Trademarks Regulations (Implementation of the Madrid Protocol), 5767-2007
- The Merchandise Marks Ordinance, 1929
- The Commercial Torts Law, 5759-1999
- The Trademarks Registry Work Manual (the "**Manual**")

The Ordinance is the most important piece of legislation relating to trademarks in Israel and contains the essential provisions with respect to all material aspects of Israeli trademark law. A copy of the Ordinance (in Hebrew) can be accessed [here](#).

The Regulations set out the procedural formalities in relation to all interactions with, and proceedings before the Israeli Patent Office - Trademarks Department ("**IPO**"). The Regulations (in Hebrew) can be accessed [here](#). The Manual is a non-binding guide to the practice of the IPO and contains practical guidance with respect to procedure before the IPO. The Manual (in Hebrew) can be accessed [here](#).

## International agreements

Israel is a party to the following conventions, treaties, and agreements:

- TRIPS Agreement
- Madrid Agreement and Madrid Protocol
- Paris Convention
- Nice Agreement
- WIPO Convention
- Lisbon Agreement
- Trademark Law Treaty
- Nairobi Treaty

## National trademark office & online database

The IPO operates an online database of trademarks in both English and Hebrew, which can be accessed [here](#).

**IPO Address:** 1 Agudat Sport Hapoel St., Technology Garden, Building No. 5, Malcha, Jerusalem, 9695101, Israel

**Telephone:** +972-73-3927290

**Email:** [trademarks@justice.gov.il](mailto:trademarks@justice.gov.il)

## Filing an application

This section sets out the following:

- what may be registered as a trademark
- grounds for rejection of an application and the relevant timeframes
- ways to overcome a rejection of an application
- goods and services suitable for registration
- formalities when filing an application
- how long an application takes to mature to registration
- important factors to consider when filing an application
- practical suggestions regarding the application stage

### 1 What may be registered as a trademark?

TYPE OF MARK	REGISTRABLE?
Words (including personal names)	Yes
Designs	Yes
Letters	Yes
Characters	Yes
Numerals	Yes
Figurative Elements	Yes
Colours	Yes
Sounds	Yes
Smells	No
Shapes	Yes

### 2. Grounds for rejection and the relevant timeframes

Set out below is a table summarising the stages of examination of an Israeli trademark application.

STAGE	TIMEFRAME	DETAILS
<b>Verification of Formalities</b>	usually up to 3 working days from filing	The IPO will verify that an application complies with the formalities, details of

		<p>which are set out in section 5 below, and that a fee was paid. If an application does not comply with all formalities, the IPO will issue an office action. After receiving the application, the IPO will issue a "request for approval" which contains the details of the application. If the application meets the threshold requirements, it will be placed in a queue to be examined. The applications are reviewed according to the date of submission. The average waiting period for examining an application can take up to 12 months in 90% of the cases (as further detailed below).</p>
<b>Substantive Examination</b>		
<b>Absolute Grounds</b>	Usually up to 12 months from filing	A trademark will be rejected on Absolute Grounds if:
		· it is devoid of any distinctive character (" <b>non-distinctive</b> "), see Sec. 8(a) to the Ordinance
		· it is referring to a certain connection with the President of the State of Israel or the President's household or to presidential patronage or it is a mark from which any such connection or patronage might be inferred, see Sec. 11(1) to the Ordinance
		· it contains the flags and institutions of the State of Israel or its emblems or symbols, the flags of foreign countries and international organizations and their symbols or emblems, and any mark resembling any of these, see Sec. 11(2) to the Ordinance
		· it includes public armorial bearings, official signs or seals used by any state to indicate control or warranty, see Sec. 11(3) to the Ordinance
		· it contains the following words – "patent", "patented", "by royal letters patent", "registered", "registered design", "unregistered design", "copyright", "to counterfeit this is forgery" or words of a similar effect, see Sec. 11(4) to the Ordinance
		· it is contrary to accepted principles of morality or may be detrimental to public

		order or morality, see Sec. 11(5) to the Ordinance
		<ul style="list-style-type: none"> <li>· it is likely to deceive the public, contains a false indication of origin, or encourages unfair trade competition, see Sec. 11(6) to the Ordinance</li> <li>· it contains a geographical marking in relation to goods that do not originate in the geographical area indicated, or a geographical marking that could be misleading in relation to the genuine geographical area of the origin of the goods, see Sec. 11(6A) to the Ordinance</li> <li>· it contains a geographical marking that is verbally correct but contains a false representation that the goods originate in another geographical area, see Sec. 11(6B) to the Ordinance</li> </ul>
		· it includes marks identical with or similar to emblems of exclusively religious significance, see Sec. 11(7) to the Ordinance
		<ul style="list-style-type: none"> <li>· it includes marks in which the representation of a person appears, unless the consent of such person has been obtained, see Sec. 11(8) to the Ordinance</li> <li>· it includes marks that consist of numerals, letters or words which are in common use in trade, to distinguish or describe goods or classes of goods or which bear direct reference to their character and quality, see Sec. 11(10) to the Ordinance</li> <li>· it includes marks whose ordinary signification is geographical or a surname, see Sec. 11(11) to the Ordinance</li> <li>· it includes marks that portray wine or an alcoholic drink containing a geographical signification, if the origin of the wine or alcoholic drink is not in that same geographical area, see Sec. 11(12) to the Ordinance</li> <li>· it is identical or resembles the name or business name of another person, or contains a name identical or resembling as aforesaid, if the mark is likely to deceive the public or to cause unfair competition, see Sec. 12 to the Ordinance</li> </ul>

<p><b>Relative Grounds</b></p>		<ul style="list-style-type: none"> <li>· When a mark is identical to another mark belonging to a different owner, which is already in the Register in respect of the same goods or description of goods, or nearly resembling such a mark and is deceiving, see Sec. 11(9) to the Ordinance</li> </ul>
		<ul style="list-style-type: none"> <li>· When a mark is identical to or resembles a well-known mark, so as to deceive, even if it is not a registered trademark, in relation to goods in respect of which the mark is well known or in respect of goods of the same description, see Sec. 11(13) to the Ordinance</li> <li>· When a mark is identical to or resembles a well-known trademark that is a registered trademark, and this even if it is in respect of goods that are not of the same description, if the mark whose registration is being requested could indicate a connection between the goods in respect of which the mark is requested and the owner of the registered mark, and the owner of the mark may be adversely affected as a result of the use of the requested mark, see Sec. 11(14) to the Ordinance</li> </ul>
		<ul style="list-style-type: none"> <li>· If separate applications are made by different persons to be registered as owners of identical trademarks or those that are similar so as to deceive, in respect of the same goods or description of goods, and the special application was submitted as the previous application was accepted, the Registrar may refrain from accepting any of the applications until their rights are determined by an agreement between the applicants approved by the Registrar, and in the absence of such agreement or approval, the Registrar shall decide, for reasons that shall be recorded as to which application shall continue to be processed in accordance with the Ordinance, see Sec. 29 to the Ordinance</li> </ul>

### 3 Ways to overcome a rejection and the relevant timeframes

Set out below is a table summarising how to overcome a rejection on the most common Absolute Grounds and/or Relative Grounds.

GROUNDS OF REFUSAL	DETAILS
<b>ABSOLUTE GROUNDS</b>	
Non-Distinctive Descriptive Generic	<p>An applicant can overcome a rejection on Absolute Grounds by:</p> <ul style="list-style-type: none"> <li>· filing a reasoned written reply within three months of the date of the Registrar's notice (in accordance with Regulations 24-25). If the applicant has not done so, the Registrar will regard the application as void in accordance with Sec. 22 of the Ordinance.</li> </ul> <p>In this regard, a necessary condition for registering a trademark will be to distinguish between the mark of the owner's goods and the goods of others. In exceptional cases, registration may be obtained for non-fundamentally distinctive signs (in accordance with Sec. 8(a) to the Ordinance), if it has been proven that the trademark acquired a second meaning following its use (in accordance with Sec. 8(b) to the Ordinance). It should be emphasized in this regard that there is a spectrum regarding the distinguishing nature of the mark, such that a generic trademark, without exception, will not be accepted as it cannot be expropriated from the public, but descriptive signs, notwithstanding imaginary signs will be more likely to be accepted.</p>
<b>RELATIVE GROUNDS</b>	
Earlier Registered Mark(s)	An applicant can overcome a refusal on Relative Grounds by:
	<ul style="list-style-type: none"> <li>· filing written arguments and evidence to demonstrate why the refusal is unjustified; and/or</li> </ul>
	<ul style="list-style-type: none"> <li>· filing evidence to demonstrate that, prior to the filing date of the application, the mark had been used honestly and concurrently with the earlier cited mark(s); and/or</li> </ul>
	<ul style="list-style-type: none"> <li>· obtaining the consent of the owner(s) of the earlier registered mark(s); and/or</li> </ul>
	<ul style="list-style-type: none"> <li>· cancelling, invalidating, revoking and/or acquiring the earlier registered mark(s)</li> </ul>

Absolute and Relative Grounds for refusal can be raised by the IPO simultaneously. The number of attempts an applicant is entitled to, with respect to overcoming a refusal is as follows:

- **First Refusal Notice** - as mentioned above, if the applicant has not filed a reasoned reply in writing within three months from the notice date, the Registrar shall regard the application as void under Sec. 22 to the Ordinance, and shall send notice thereof to the applicant; If the applicant files a reasoned reply in writing within the time period set for a reply, the Registrar will examine the reply and inform the applicant whether the Registrar has decided to accept the application, whether completely or subject to conditions, changes, amendments or restrictions that the Registrar deems appropriate to impose.
- **Conditional Acceptance** - If the Registrar receives the applicant's request, subject to conditions, amendments, changes or restrictions or subject to registration of a disclaimer, and the applicant objects, the applicant shall, within three months from the notice date, file a reasoned written reply; If the applicant files reasoned objections in writing within the time period set for this

matter, the Registrar will examine them and inform the applicant whether the Registrar has decided to accept the application, whether completely or subject to conditions, changes, amendments or restrictions that the Registrar deems appropriate to impose.

- **The Decision of the Registrar** - In general, if the applicant receives a refusal notice (as mentioned above), the applicant may, within three months, request that the Registrar conduct a hearing regarding the applicant's application for registration of a trademark. The Registrar may require the applicant to present its claims, to file a summary of its claims in writing within one month from the date on which the applicant is required to do so, provided that the applicant has not made written claims in the same matter before or if the Registrar finds that this will be beneficial to the hearing.

Every deadline in the Regulations can be extended, upon request, by the Registrar, to take any action or to file any request thereon, after giving the same notice to the other parties and after taking the same actions in connection with this notice, and under the same conditions as the Registrar may direct.

## 4 What goods and services are appropriate?

Israel has adopted the 1 - 45 Nice Classification of Goods and Services established by the Nice Agreement (1957) and also allows class headers to be used as specifications (e.g. "Clothing, footwear and headgear" (class 25)).

## 5 What are the formalities with respect to filing an application?

The following are the required formalities for applying to register a trademark in Israel:

- an application is filed at the Trademark Online System ("**TMONLINE**")
- to obtain a filing date, the following information must be provided:
- name, ID number (or corporation number), address and contact details of the applicant
- a representation of the mark
- when a representative is involved in the filing process (attorney or patent attorney only), the representative's details are required
- a list of goods or services for which the mark is to be registered
- details of any priority claim
- A copy of the first application must be attached when approved by an appropriate authority in a country within a period of up to three months from the date of application in Israel. If the treaty document is registered in a language other than the English language, a certified translation must be attached to a formal or English language
- there is a requirement to provide a Power of Attorney when a representative is involved in the application process
- there is **no** requirement to provide a Certificate of Incorporation
- applications must be filed online. Only an individual who is not a corporation or is not an attorney may file an application by post or physically deliver it to the IPO
- multi-class applications are permissible
- the particulars of an application filed will be sent to the applicant within a few days of filing if filed by post or fax and will be sent to the applicant or the applicant's agent promptly but no later than 3 working days, if filed online

## 6 How long does an application take to mature to registration?

Typically, if an application proceeds smoothly without any objections being raised by the Registrar or any third parties, the application will usually be examined within twelve (12) months (on average). The receipt of the application and the application will be published in the Trademarks Journal (which is part of the Israeli Official Gazette). If no objection is filed within three (3) months from publication, the mark will be registered, and a Certificate of Registration will be issued.

A deficiencies refusal will usually delay an application by three (3) months, whereas an Absolute Grounds and/or Relative Grounds refusal can delay an application by up to two (2) years, depending on how quickly it can be overcome (assuming that it can be overcome).

## 7 What are the important factors to consider when filing an application?

It is advisable to file every trademark in English and in Hebrew for defensive purposes.

## 8 Other practical hints and tips regarding the application stage

Only minor clerical errors can be amended once the application is submitted.

## Opposition

### 1 What are the grounds on which oppositions can be based?

Trademark applications can be opposed on both absolute and relative grounds, for any of the following reasons:

#### ABSOLUTE GROUNDS

- it is devoid of any distinctive character
- it implies a connection to the President of the State of Israel or the President's household or to presidential patronage or it is a mark from which any such connection or patronage might be inferred
- it contains the flags and institutions of the State or its emblems or symbols, the flags emblems or symbols of foreign countries and international organizations and any mark resembling any of the said
- it includes public armorial bearings, official signs or seals used by any state to indicate control or warranty
- it contains the following words – “patent”, “patented”, “by royal letters patent”, “registered”, “registered design”, “unregistered design”, “copyright”, “to counterfeit this is forgery” or words of a similar effect
- it is contrary to accepted principles of morality or may be injurious to public order or morality
- it is likely to deceive the public, contains a false indication of origin, or encourages unfair trade competition
- it contains a geographical marking in relation to goods that do not originate in the geographical area indicated, or a geographical marking that could be misleading in relation to the genuine geographical area of the origin of the goods
- it contains a geographical marking that is verbally correct but contains a false representation that the goods originate in another geographical area
- it includes marks identical with or similar to emblems of exclusively religious significance
- it includes marks on which the representation of a person appears, unless the consent of such person has been obtained
- it includes marks that consist of numerals, letters or words which are in common use in trade, to distinguish or describe goods or classes of goods or which bear direct reference to their character and quality
- it includes marks whose ordinary signification is geographical or a surname
- it includes marks that portray wine or an alcoholic drink containing geographical significance, if the origin of the wine or alcoholic drink is not in that same geographical area
- it is identical or resembles the name or business name of another person, or contains a name identical or resembling as aforesaid, if the mark is likely to deceive the public or to cause unfair competition

#### RELATIVE GROUNDS

- When a mark is identical with another mark belonging to a different owner, which is already registered in the Register in respect of the same goods or description of goods, or so nearly resembling such a mark that it is deceiving
- When a mark is identical to or resembles so as to deceive, a well-known mark even if it is not a registered trademark, in relation to goods in respect of which the mark is well known or in respect of goods of the same description
- When a mark is identical to or resembles a well-known trademark that is a registered trademark, and this even if it is in respect of goods that are not of the same description, if the mark whose registration is being requested could indicate a connection between the goods in respect of which the mark is required and the owner of the registered mark, and the owner of the mark may be adversely affected as a result of the use of the requested mark
- If separate applications are made by different persons to be registered as owners of identical trademarks or those that are similar so as to deceive, in respect of the same goods or description of goods, and the special application was submitted as the previous application was accepted, the Registrar may refrain from accepting any of the applications until their rights are determined by agreement between them approved by the Registrar, and in the absence of such agreement or approval the Registrar shall decide, for reasons that shall be recorded as to which application shall continue to be processed in accordance with the Ordinance
- There is due cause and by virtue thereof the Registrar is empowered under the provisions of the Ordinance to refuse the application for registration
- The objector claims to be the owner of the mark

Only the owner of the earlier trademark or right is entitled to bring opposition proceedings under relative grounds.

### 2. What is the opposition process and what are the timeframes involved?

Set out below is a table summarising the procedure and timeframes involved in bringing an opposition against a trademark application:

STAGE	PROCEDURE AND TIMEFRAME	DEADLINE EXTENDIBLE?
<b>Filing Opposition</b>	Within the 3-month period commencing on the date on which particulars of the application for registration are published in the Israeli Trademarks Journal (" <b>Prescribed Period</b> ")	The deadline may not be extended.
<b>Sending a copy of notice of opposition to the applicant</b>	This should be done simultaneously when filing the opposition according to Regulation 36.	
<b>Filing a counterstatement</b>	The applicant's counterstatement must be filed with the Registrar within 2 months following the date on which the copy of the notice of opposition is received, according to Regulation 37.	The deadline may be extended at the discretion of the Registrar according to Regulation 82.
<b>Sending a copy of counterstatement to the opponent</b>	This should be done simultaneously when filing the counterstatement.	
<b>Filing evidence in support of the opposition</b>	If a counterstatement was filed, the opponent should file evidence in support of the opponent's opposition within 2 months after the date of receipt of the counterstatement. *	The deadline may be extended at the discretion of the Registrar according to Regulation 82. Failure to file evidence within the time period will result in the opposition being deemed abandoned.
<b>Sending a copy of evidence in support of opposition to the applicant</b>	This should be done simultaneously when filing the evidence in support of the opposition.	
<b>Filing evidence in support of the application</b>	If the opponent files evidence within the relevant time frame (2 months), the applicant must file evidence in support of the application. *	The deadline may be extended at the discretion of the Registrar according to Regulation 82.
<b>Sending a copy of evidence in support of the application to the opponent</b>	This should be done simultaneously with filing the evidence in support of the application.	
<b>Filing additional evidence in reply to evidence in support of opposition</b>	If the applicant files evidence, the opponent may file evidence which is strictly in reply to that filed by the applicant. This must be filed within 2 months following the date on which the applicant's evidence is received. *	The deadline may be extended at the discretion of the Registrar according to Regulation 82.
<b>Sending a copy of the additional evidence in support of opposition to the applicant</b>	This should be done simultaneously when filing the further evidence in support of the opposition.	

<b>Application for Leave with the Registrar to file further evidence</b>	Neither the opponent nor the applicant can file additional evidence, unless the Registrar has decided otherwise.	
<b>Registrar calling for a hearing and notifying each party to the proceedings of the particulars</b>	After the evidence is submitted, the Registrar must set a time for clarifying the opposition.	
<b>HEARING</b>	If the applicant has not admitted the facts alleged by the opponent, the order of argument shall be as follows: the opponent is the first to summarize its arguments, after which the applicant is entitled to summarize its arguments. If the applicant admits the facts alleged by the opponent but claims the opponent is not entitled to the requested relief, the applicant will argue first, and the order of argument will be contrary to the above said.	
<b>DECISION - the Registrar sending a notice of the decision to each party</b>	The decision will be delivered by the Registrar to the parties.	
<b>FILING AN APPEAL WITH THE DISTRICT COURT</b>	An appeal on the Registrar's decision may be filed within 30 days from the decision to the District Court. A notice of motion and entry of appeal must be sent to the Registrar within 30 days after the appeal was filed.	These deadlines are not extendible.

\* Note: The Registrar may extend the period in which a party may file evidence at its discretion upon the request of the party seeking an extension. The party seeking an extension shall send a copy of the request to every other party to the proceedings. Generally, it is possible to get extensions without filing any evidence in support of such extension requests. It is customary to request the opponent party's consent for the requested extension.

### 3. What are the formalities when filing an opposition?

The following are the formalities when filing an opposition:

- lawyers and patent attorneys shall apply on the "Patent and Trademark Registrar's online filing" website and pay a fee
- if an opposition is being filed in respect of some of the goods and/or services in the specification rather than all of them, this should be stated
- the statement of grounds should set out the primary facts on which the opposition is based and must identify the precise sections and subsections upon which each objection is based
- there is **no** need to include evidence in the statement of grounds. Evidence should be filed by way of statutory declaration or affidavit at the evidence stage of proceedings
- if the opposition is based on an earlier trademark, the statement of grounds should also set out the following particulars:
  - a representation of that earlier trademark
- if it is registered, a statement of the goods or services in respect of which the earlier trademark is registered
- the registration or application number of the earlier trademark in Israel
- if it is not registered, a statement of the goods or services in respect of which it is used

### 4. What are the important things to consider when filing an opposition?

- **Grounds for Opposition:** Consider the ground(s) for opposition on which you will be relying
- **Evidence Gathering:** Comprehensive evidence gathering should be started as soon as possible, to ensure the requisite quantity and quality of evidence. Think carefully about what documents and statements will be needed to solidify the case, and the practical steps required to acquire the same (for example, print screens from relevant websites, advertisements and brochures etc.)
- **Expert Evidence:** Consider if it would be beneficial to instruct an expert to support your case. When making this decision, bear in mind the cost of engaging an expert, as well as the time frame (particularly if your expert is based overseas)
- **Evidence in Person:** Generally, evidence is not required to be given in person, and a statutory declaration or affidavit should suffice. However, it is possible that a witness may be required to give oral evidence or to be subject to cross-examination, thus anyone who makes a statement in connection with filing the opposition should be made aware of this possibility

## 5. Other practical suggestions

When filing an opposition, the opponent should ensure that every relevant ground is pleaded. Grounds for opposition can be removed after filing, but additional grounds cannot be added.

# Cancellation and invalidation

## Invalidation & Amendment (Sec. 38-39 to the Ordinance)

### 1. On what grounds can a trademark registration be invalid or amended?

Anyone can file an invalidation action for the removal or amendment of a trademark with respect to all or some of the goods and services. This should be done within five years of the registration date. Yet, an invalidation action can be filed with respect to applications that were filed in bad faith, notwithstanding the five-year limit.

The action can be filed based on the grounds that the trademark is not eligible for registration under Sections 7 to 11 of the Ordinance (absolute and relative grounds), or that the mark creates unfair competition in respect of the applicant's rights in Israel.

Notwithstanding the foregoing:

- a trademark of a non-resident registered in the country of origin shall not be removed from the Register save on grounds that preclude such registration pursuant to Section 16 (Registration of marks registered abroad)
- a trademark of a non-resident which is not eligible for registration under the provisions of Sections 8-11 to the Ordinance (which include certain absolute and relative grounds) and which has been registered under the provisions of Section 16, may be removed from the Register at any time on any of the grounds precluding its registration under the provisions of Sections 8-11 where it is no longer registered in the country of origin; this does not prevent the owner of the mark from proving that at the time of the application for removal, the mark would have been eligible for registration upon application by a resident of Israel

### 2. What is the invalidation process and what are the timeframes involved?

The invalidation process is similar to the opposition process, as mentioned above.

- **Filing an Application for Invalidation** - when filing an invalidation and/or amendment action, the said notice shall be accompanied by a copy to the owner, according to Regulation 36.
- **Owner Files Counter-Statement** - the counterstatement must be filed with the Registrar within 2 months following the date on which the copy of the notice of the invalidation and/or amendment is received, according to Regulation 37. A copy should be served on the applicant (opposing party).
- **Applicant's Evidence** - if a counterstatement was filed, the applicant should file evidence in support of the invalidation request within 2 months following the date of receipt of the counterstatement. A copy should be served on the owner.
- **Owner's Evidence** - If the applicant does not present evidence, the applicant is deemed to have waived his application, unless the Registrar has ordered otherwise, whereas if the applicant files evidence within the relevant time frame (2 months), the owner must either file evidence in support, in the form of affidavits, all the evidence the owner wishes to submit. A copy should be served on the opposing party.
- **Applicant's Evidence in Response** - If the owner files evidence, the applicant may file evidence which is strictly in reply to that

filed by the applicant. This must be filed within 2 months following the date on which the owner's evidence is received.

- Neither the applicant nor the owner can file further evidence, unless the Registrar has decided otherwise.
- **Hearing** - After the evidence is submitted, the Registrar will set a time for clarifying the invalidation request.
- **Summations** - the applicant for invalidation and/or amendment action is the first to summarize its arguments, after which the owner is entitled to summarize its arguments. If the owner admits the facts alleged by the applicant for invalidation action but claims that the applicant is not entitled to the requested relief, then the owner will present its argument prior to the applicant, and the order of argument will be contrary to the above said.
- The decision will be delivered by the Registrar to the parties.

### 3. What are the relevant timeframes?

The procedure and timeframes for filing an application for the invalidation of a registered trademark are the same as for the opposition action to a registered trademark.

### 4. What are the important factors to consider when filing an application for invalidation?

The following points are important to consider when filing an application for invalidation:

A registered trademark will not be declared invalid on relative grounds for refusal if:

- it has acquired a distinctive character following registration
- the owner of the earlier mark or right consented to the registration; and/or
- if the mark was registered on the ground(s) that there has been honest concurrent use of the mark, the Registrar or the court will not declare it to be invalid unless it is satisfied that there has in fact been no honest concurrent use of the trade mark

#### **Cancellation Due to Non-Use (Sec. 41 to the Ordinance)**

An application before cancellation against a registered mark can be filed by any third party in respect of certain goods or classes of the goods or some of them for which the mark was registered, on the grounds that there was no *bona fide* intention to use the trademark in connection with such goods and that in fact, there has been no *bona fide* use of the trademark during the 3 years preceding the application for cancellation.

This provision shall not apply where it is proved that the **non-use is due to special circumstances** in commerce and not due to any intention not to use or to abandon the mark in respect of the said goods.

There shall not be deemed to have been *bona fide* use of the trademark in the event of any of the following:

1. Use of the trademark in Israel for advertising only, whether in the local press or in foreign newspapers distributed in Israel, unless there are special circumstances which, in the opinion of the Court or the Registrar justify the non-use of the mark on goods manufactured or sold in Israel.
2. Cancellation of an authorization to use the mark, given to a manufacturer in Israel (license), unless the authorization is cancelled following an infringement of the authoriser's conditions, or due to the fact that the authoriser intends to manufacture the goods for which the mark is to be used, or the authoriser intends to grant the authorization to another manufacturer in Israel.

#### The Process of Filing a Cancellation Action:

- **Filing of an Application for Cancellation** - when filing a cancellation action, the said notice shall be accompanied by a copy to the owner.
- **Owner Files Counter-Statement** - the counterstatement must be filed with the Registrar within 2 months following the date on which the copy of the notice of the cancellation action is received, according to Regulation 37. A copy should be served on the applicant (opposing party).
- **Applicant's Evidence** - if a counterstatement was filed, the applicant should file evidence in support of the applicant's cancellation within 2 months following the date of receipt of the counterstatement. A copy should be served on the owner.
- **Owner's Evidence** - If the applicant does not present evidence, the applicant is deemed to have waived its application, unless the Registrar has ordered otherwise, whereas if the applicant files evidence within the relevant time frame (2 months), the owner must file evidence in support, in the form of an affidavit, which includes all the evidence the owner wishes to submit. A copy should be served on the opposing party.
- **Applicant's evidence in response** - If the owner files evidence, the applicant may file evidence which is strictly in response to that filed by the applicant. This must be filed within 2 months following the date on which the owner's evidence is received.

- Neither the applicant nor the owner can file further evidence, unless the Registrar has ordered otherwise.
- **Hearing** - After the evidence is submitted, the Registrar must set a time for clarifying the cancellation application.
- **Summations** - the applicant for cancellation action is the first to summarize its arguments, after which the owner is entitled to summarize its arguments (the summations are usually submitted in writing). If the owner admits the facts alleged by the applicant for cancellation action but claims that the applicant is not entitled to the requested relief, then the owner will argue first, and the order of argument will be contrary to the above said.
- The decision will be delivered by the Registrar to the parties.

## 5. Other Practical Suggestions

## 6. What are the relevant timeframes?

The procedure and timeframes for filing an application for the cancellation of a registered trademark are the same as an action for the invalidation of a registered trademark on grounds other than non-use, as set out above.

# Enforcement

## 1. How is a trademark infringed?

A registered trademark can be infringed, when any person uses the following marks and is not entitled to do so by the mark owner:

- a registered trademark or a mark resembling such trademark, in relation to goods in respect of which the trademark is registered, or to goods of the same description
- a registered trademark in advertising goods of a class in respect of which the mark is registered, or goods of the same description
- a well-known trademark even if it is not a registered trademark, or a mark so resembling it that it could be misleading in relation to goods in respect of which the mark is recognized or in respect of goods of the same description; or
- a well-known trademark that is a registered trademark, or a mark resembling it, in respect of goods that are not of the same description, and provided that such use could indicate a connection between the said goods, and the owner of the registered trademark is likely to be adversely affected as a result of such use

*What are the options when enforcing a trademark?* The owner of a registered trademark or of a well-known trademark may bring an action for infringement.

The trademark owner is the one who can bring an enforcement action, in the circumstances as detailed below.

### CUSTOMS POWERS & PROCEDURES

According to Sec. 69A to the Ordinance, an owner of a registered trademark whose right has been infringed or an owner which has a reasonable fear that its trademark might be infringed, may give notice in writing to the Director of Customs that he is the owner of the trademark, and request to delay the release of the goods that the owner claims to be offending goods, and that they be treated as goods whose importation is prohibited under the Customs Ordinance.

The owner of a registered trademark must furnish the Director of Customs with primary evidence, and a guarantee of an amount prescribed by the Director of Customs in order to cover any cost connected with the delay or in order to compensate for any damage that may be caused by such delay, if it should appear that such delay was not justified, and must also pay any fee prescribed in this regard under the Customs Ordinance.

### CIVIL PROCEEDINGS

Trademark enforcement proceedings may be brought before the Israeli District Court. According to Sec. 63B of the Ordinance, the District Court is the competent court.

In some situations, it may be appropriate to consider applying for an interim remedy. For example, if there is an urgent need to intervene to prevent the defendant's infringing behaviour. The additional (and often high) cost of filing an application for an interim relief should always be balanced against the impact of the infringing mark, and the likelihood of success at trial.

The primary types of interim remedies are:

- **Interim Injunction:** The Court has the power to issue interim injunctions and may do so if there is a serious issue to be adjudicated, and the balance of convenience lies in favour of granting the injunction (for example, if the claimant could not, if successful, be adequately compensated by damages, the court will then consider granting an injunction). In this instance, the claimant may in return have to provide an undertaking as to damages in favour of the defendant.
- **Temporary Attachment** - In order for a temporary attachment order to be issued, the applicant must meet at least two cumulative conditions: the existence of allegedly reliable evidence for the existence of a cause of action (Regulation 362 (b) of the Civil Regulations) and the existence of a reasonable concern that failure to issue the order will burden the execution of the judgment (Regulation 374 (b) of the Civil Regulations).
- **Anton Piller Order:** The claimant may apply for an order to access the defendant's premises to preserve articles pending trial. This would be advisable if there is a risk that the defendant would dispose of evidence pertaining to the infringement before trial. However, the evidentiary threshold is extremely high meaning such orders are not easily obtained.

LITIGATION PROCESS

Issue and Serve on the Defendant the Statement of Claim or the Petition	. statement of claim . petition or interim injunction if relevant
<i>Application for Interim Relief</i>	<i>If a statement of claim is not endorsed with a writ, the claimant must serve a statement of claim to the defendant before the expiry of 7 days after the filing of the application.</i>
Claimant is responsible for serving the defendant the Commencement Document upon filing with court by:	. Personal service . Service by registered post
Defendant's Response	. File a statement of defense to the main action within 60 days after receiving the statement of claim. If an application for interim relief was filed, the court will set a deadline for defendant's response.
Subsequent Stages	. Claimant may serve a reply to the defendant's response within 15 days
	. If the defendant counterclaims, the claimant must file and serve a defence within 60 days
Discovery	. Each party has a duty to disclose all documents (favourable or otherwise) relevant to the issues in dispute. The discovery must be supported in an affidavit
	. The discovery comprises of:
	. General discovery: each party prepares and submits a list of all documents relevant to the issues. Copies of non-privileged documents must be provided on request
	. Specific discovery: each party may request his opponent to disclose specific documents in his possession or control . Questionnaires: each party may present questions to his opponent

Preliminary motions	. Parties can submit preliminary motions regarding the discovery process, requesting the court to order a party to disclose documents or respond to questions
Exchange of affidavits of evidence in chief and filing of experts' reports (if applicable)	
Trial (cross-examination)	
Summations (oral or in writing)	

## REMEDIES

The following remedies are available following a successful trademark infringement action (Sec. 59 and 59A):

- In an action for infringement, the plaintiff shall be entitled to relief by way of **injunction**, and to **damages in addition to** any other relief which the Court is competent to grant.
- With regard to an infringement in respect of a well-known trademark that is not a registered trademark the plaintiff shall be entitled to **relief by way of injunction only**.
- **The Court may**, at the conclusion of the deliberations in an action, **order one of the following**:
  - Destruction of the property produced in committing the infringement or used in the perpetration thereof
  - If the plaintiff requested - the transfer of ownership of the infringing property to the plaintiff, in exchange for payment of its value, were it not for the infringement
  - The taking of any other action with regard to the property. Provided that the Court shall not permit possession of the property by the defendant even if the defendant has removed the offending marks, other than in exceptional circumstances

## 2. What are the limitations on Enforcement?

There are several legal limitations on bringing an enforcement action for trademark infringement, including the following:

- **Exhaustion of Rights** - Israeli case law has adopted a worldwide exhaustion of rights concept, therefore registered trademarks are not considered to be infringed by the use of the trademark in relation to goods which have been placed on the market anywhere in the world under the registered trademark by its owner or with its consent. However, this does not apply if the goods have been changed or impaired after the trademark owner placed them on the market.
- **Action against Registered Trademarks** - an action for trademark infringement can only be brought against an unregistered sign. If the mark is a registered trademark, a declaration of invalidity must also be sought as part of the proceedings.
- **Use of Names or Addresses** - a registered trademark may not be infringed by the use of a person of his own name and address, or the address of his place of business. Likewise, the use by a person of the name of his predecessor in business, or the name of his predecessor's place of business, is likely to not be considered as an infringement, provided that the use is in accordance with honest practices in industrial or commercial matters.
- **Use of Generic Mark** - a registered trademark is not infringed by the use of a mark which serves to denote the kind, quality and value, provided that the use is in accordance with honest practices in industrial or commercial matters.
- **Earlier use** - where an unregistered trademark or mark has been used continuously from a date preceding either the date of first use of the trademark which is registered, or the date of registration of that trademark, this shall not be considered as an infringement of the registered trademark.

The **practical limitations** to bringing an enforcement action are as follows:

- **Costs**: costs awards are discretionary, thus the cost of bringing an action can be high. It is possible that the party who lost in trial will be ordered to pay the other's costs. It should be noted, that it is common that the court does not award a party's real expenses, and the real costs of the litigation are frequently not covered. When exercising its discretion on costs, the court will consider: the conduct of the parties; the relative success of each party; and settlement offers made.
- **Time**: the proceedings may continue for a long time, sometimes years. Consideration should be given to the impact of this on the value of the damages, dilution of the brand, and potentially the adverse publicity associated with litigation. For example, given that there is discovery in Israel, any evidence obtained that supports an argument that a trademark is generic would need to be disclosed.
- **Evidence**: consider what evidence will be needed to prove the claim as well as the expense and complexity of adducing such

evidence. If any expert opinion is required, this will be an added expense to the claim. Depending on the nature of the evidence collated, there may be a risk that proceeding with the litigation will further damage or dilute the trademark.

### 3. Online Enforcement

The remedies for online trademark infringement are the same as any other infringing trademark actions, which have been outlined above.

## Criminal proceedings

According to Sec. 60 to the Ordinance, a person who commits any of the following acts, shall be liable to imprisonment of three years or to a fine of seven times the amount of the fine prescribed in Section 61(a) (4) of the Penal Law, 5737-1977 ("**Penal Law**"), which currently stands at NIS 1,582,000:

- (1) Marks, without authorization of the owner of the mark or of the owner's representative, a registered trademark or an imitation thereof, for trading, goods in respect of which the mark is registered in the Register or packaging of such goods, and is thus liable to deceive another person.
- (2) Imports for trading, without authorization of the owner of the mark or the owner's representative, goods or packaging thereof that have been marked with a trademark that is registered in the Register in respect of such goods or by imitation of such a mark, and the mark is likely to deceive another person; provided that this shall not apply in respect of goods that have been marked with authorization of whoever is the owner of the mark in the country in which the marking was done.
- (3) Deals in the sale, renting or distribution of goods that have been marked or imported into Israel in contravention of the provisions of Paragraphs (1) or (2) above, or sells or renting or distributes such goods in a commercial quantity.
- (4) Holds goods that have been marked or have been imported into Israel in contravention of the provisions of Paragraphs (1) or (2) above for the purpose of trading in them.

In the event an offence has been committed under subsection (a) by a corporate entity, it shall be liable to a fine double the amount prescribed for such offence.

When the offence has been committed by one of the corporation employees, the employee has to prove that he exercised control and did all that is possible to prevent the commission of any of the offences specified hereinabove by the corporate entity or by any of its employees; a person who commits a breach of the aforesaid duty shall be liable to the fine prescribed in Section 61(a) (4) of the Penal Law. This presumption applies, unless the employee proves that he took all possible action to discharge the said duty.

A person who gives false information to the Registrar in connection with an application for registration of a mark in the Register shall be liable to imprisonment of one year.

## Renewal

### 1. How long is a trademark valid for and when should a renewal application be filed?

A trademark is valid for a period of 10 years upon registration (the 10-year period commences following the submission of the application). The registration of the trademark may be renewed for further periods of 10 years each, and renewal applications should be filed during the 3-month period preceding the date of expiration.

Before the expiration date the Registrar will usually send a notice of the date on which the registration will expire and the conditions as to payment of fees and other matters upon which registration will be renewed.

### 2. Restoration of an expired trademark

Trademarks which have expired and not been renewed within 6 months of the date of expiration will be removed from the Register. However, the Registrar may restore the trademark to the Register and renew its registration if the fee is paid within such 6-month period, which shall be increased by a prescribed amount (late payment fee).

In addition, the Registrar may, upon the application of the owner of the trademark, if the Registrar deems that it is just to do so, restore the validity of the registration, on such conditions as the Registrar shall see fit, upon payment of the unpaid renewal fees and the

prescribed additional fee in this regard, provided that the application has been submitted after the said 6-month period but before the lapse of 12 months.

### 3. What are the formalities associated with filing a renewal application?

The following steps must be taken when filing a renewal application in the State of Israel:

- file with the Registrar a letter with the trademark number and a request for renewal of the mark
- pay the renewal fee

There are additional fees payable in respect of late renewal requests and requests for restoration, as mentioned above.

## Assignment and licenses

### Authorization to Use a Mark

An authorization to use a mark shall not be valid unless it has been registered under the provisions of Sec. 50 to the Ordinance, and the Registrar may register it subject to such conditions and limitations as the Registrar may deem fit.

Such an application for registration of an authorization shall be submitted by the owner of the mark and by the person to be registered as the authorized person and should include, *inter alia*, the following (according to Sec. 51 to the Ordinance):

- the relationship between the owner and the person to be registered as the authorized person, including the extent of the owner's control over the use thereof by the authorized person
- the goods in respect of which the authorization is sought
- the conditions or limitations which are to apply to the use of the mark by virtue of the authorization if the same is registered
- The period of validity of the authorization if its registration is requested for a determinate period

Notwithstanding the foregoing, although authorization to use a trademark under the Ordinance shall not be valid unless it has been registered under the provisions of Section 50 to the Ordinance, Israeli case law stipulates that while there is a written (evidentiary) requirement of registration, the contractual rights and obligations of the licensee (authorized person) and licensor shall be in force (by and between the parties). In addition, because it is not an action of a constitutive nature, the court may also decide to recognize such authorization towards third parties even without registration under certain circumstances.

An authorization may be general, or limited in:

- that it only applies to some of the goods and services for which it is registered; and/or
- the manner or locality in which it may be used, or any other provisions set by the owner

### Amending or Removing a Registered License

**Owner's Request** - The Registrar may, pursuant to the application of the owner of the mark, vary the registration of authorization as to everything relating to the goods to which the authorization applies and to the conditions and limitations to which it is subject.

**Request of Authorized Person** - The Registrar may cancel the registration of the authorization pursuant to the submission of an application by the authorized person.

**Misleading and Public Policy** - The Registrar may cancel the registration of the authorization if the Registrar has been requested to do so, and it has been proved to the Registrar 's satisfaction, that the existence of the authorization, or the use of the trademark by the authorized person, is contrary to public policy or is likely to deceive.

**Hearing** - Before cancelling an authorization, or varying the conditions thereof, the Registrar shall grant every interested party an opportunity to be heard.

**No authorization allowed in the absence of registration** - If the registration of a mark has been cancelled or removed from the Register, any authorization given in respect thereof shall be void.

### Assignments

A registered trademark may be assigned with respect to all or some of the goods or services covered thereby, with or without the goodwill of the business concerned with the goods for which it has been registered, provided that the Registrar may refuse to register an assignment as aforesaid if, in the Registrar's opinion, the use of the mark by the assignee is likely to deceive the public or if it is contrary to public policy.

In the event that a person has become entitled to a registered trademark, by assignment or by virtue of any other legal action, such person must file with the Registrar an application to register such person's right in order to record the assignment. This application shall contain the name, address and identification number (and any other detail required by the Registrar), together with the complete details of the relevant assignment document. This document must be presented to the Registrar for review.

The required documents:

- A bill or assignment agreement duly executed by the parties.
- Confirmation of payment of the fee required. When assigning some of the goods or classes of goods in accordance with the provisions of S 48 (a1) of the Ordinance, the fee shall be paid for each of the assignments made.
- Power of attorney on behalf of the assignor.
- Confirmation by one of the parties to the agreement or confirmation by their attorney or proxy that to the best of their knowledge the assignment will not mislead the public. Alternatively, a reference shall be made to the absence of such misleading in the assignment documents.

## Recordals

### 1. What can and should be recorded?

The following transactions can and should be recorded on the trademark Registry:

- an assignment of a registered trademark or any right in it
- the grant of a license (authorization of use) under a registered trademark
- the grant of any security interest (whether fixed or floating), over a registered trademark or any right in or under it. A security interest (whether fixed or floating), can be registered in the registries of the Registrar of Pledges and the Registrar of Companies

If an application is **not** made for the registration of any of the above interests, then (until such application is made), the transaction or interest will not bind a person acquiring a conflicting interest in or under the registered trademark (provided such person is in ignorance of the transaction or interest). Furthermore, any person who claims to be a licensee by virtue of the transactions listed above loses the statutory protection given by the Ordinance (as detailed under 'ASSIGNMENTS & AUTHORIZATION TO USE MARK' above).

Formalities for Filing a Recordal:

TYPE OF TRANSACTION	FORMALITIES FOR APPLICATION FORM	PARTICULARS TO BE ENTERED INTO THE REGISTER
Assignment of a registered Trademark or any right therein	<ul style="list-style-type: none"> <li>. The assignment agreement</li> <li>. Confirmation of payment of the fee required</li> <li>. Power of attorney</li> <li>. Confirmation that the assignment will not mislead the public</li> </ul>	<ul style="list-style-type: none"> <li>. Name, address &amp; ID No. of assignee</li> <li>. A description of the right assigned</li> <li>. A copy will be sent to the Registrar</li> </ul>
Grant of a license under a registered trademark	<ul style="list-style-type: none"> <li>. Application for registration of authorization, which includes the relationship between the parties; the goods to be authorized; the conditions; the period of validity</li> </ul>	<ul style="list-style-type: none"> <li>. Name, address &amp; ID No. of assignee</li> <li>. Whether the licence is exclusive. If limited, a description of the limitation</li> <li>. A copy will be sent to the Registrar</li> </ul>

## OTHER SUGGESTIONS

To fully protect the rights given therein, it is vital that whenever any assignments or licenses are granted, steps are taken to record such transactions against the registered trademark.

As it is not necessary to produce a copy of the license or assignment when applying to register its particulars, provided the application or notice is signed by or on behalf of the grantor or assignor, a legal representative would be able to sign the application to register on the grantor or assignor's behalf. If the application is not so signed, then documentary evidence to establish the licence or assignment will be required (for example, a copy of the licence/assignment).

## Unregistered trademark rights

While the Ordinance provides protection for registered trademarks, it also protects unregistered well-known trademarks. Unregistered marks that are not considered to be well-known trademark may be protected under different causes of action, as set forth below.

### Well-Known Trademark

A "well-known trademark" means a mark that is well-known in Israel as a mark whose owner is a citizen of a Member State<sup>[1]</sup>, a permanent resident thereof or who has an active industrial business enterprise, even if the mark is not a trademark registered in Israel, or is not used in Israel; in relation to determination of a trademark as a well-known trademark in Israel, there shall be taken into account *inter alia* the extent to which it is recognized in Israel along with the recognition as a result of the marketing endeavors.

According to Israeli case law, the main criteria for examining if a trademark is well-known are:

1. Degree of recognition - The degree of recognition can be proved, *inter alia*, by, market surveys and polls.
2. Scope and duration of use - sales' volumes and level of market penetration.
3. Scope and duration of publication of the mark - A mark may also become a well-known mark "overnight", but it will often be as a result of investing resources, time and effort in its publication.
4. The extent to which the mark is recognized, used, advertised, registered and enforced or, if applicable, other factors that may define its local, regional or global distribution.
5. The degree of inherent or acquired distinctive character of the mark; A high degree of acquired distinctive character will help in proving reputation more than inherent distinctive character.
6. The degree of uniqueness (exclusivity) of the mark and the nature and extent of the use of the mark or a similar mark by third parties; Usage of several entities in the mark may indicate that the reputation is not linked to any of them.
7. The nature of the goods or services and marketing channels: When it comes to non-competing goods, if the mark is marketed in several marketing channels, this will probably indicate a broad reputation in the public and in return the protection of non-competitive goods should be expanded. If the use of the mark is restricted to a narrow market or to specific marketing channels, this will lead to narrower protection with respect to non-competing goods.
8. The degree to which the reputation of the mark symbolizes the quality of the goods.

**Well-Known Unregistered Trademark** - A well-known trademark (even if not registered) shall entitle its owner to exclusive use of the mark in relation to goods in respect of which it is well known in Israel or in relation to goods of the same description.

**Well-Known Registered Trademark** - A well-known trademark, that is a registered trademark, shall entitle its owner to exclusive use of the mark also in relation to goods that are not of the same description, if the use of the mark by a person that is not its owner is likely to point to a connection between the said goods and the owner of the registered trademark, and the owner of the registered trademark is liable to be adversely affected as a result of such use.

### Passing-Off Wrong

Unregistered marks can be protected through the cause of action of passing-off, under the Commercial Torts Law, 5759-1999, incorporating the tort of passing-off. An action for passing-off enables a trader to protect the property in trader's mark – namely the goodwill of trader's business or trade has acquired over time. A successful claim for passing-off requires three key elements:

1. Goodwill/Reputation
2. Misrepresentation
3. Damage

### GOODWILL

Goodwill can be generated over a very short or much longer period and relates to the public's positive association with the mark as denoting the goods of one trader. Goodwill vests in the business as a whole, and not in an individual mark. It is the benefit and advantage of the positive name, reputation and connections of a business. Goodwill needs to be proven by evidence.

### MISREPRESENTATION

This is usually intentional, with a deliberate attempt to benefit from another trader's success. However, it may be unintentional, such as when a defendant is unaware of a claimant's goods or mark. There must at least be some overlap between the claimant's and the defendant's business, either with respect to the type of goods or services they provide, the geographical location where they are based, or the amount of time they have been operating. It is a requirement that the misrepresentation must confuse, or must be likely to confuse the public, and a wide range of factors will be looked at by the court when deciding whether a proportion of the public would be confused. The test for confusion is that "a reasonable consumer" would be confused by the defendant's mark.

### DAMAGE

There must be actual, or a real likelihood, of damage, and this must be a result of the confusion caused by the defendant's misrepresentation. Damage is more likely to be inferred if goodwill and misrepresentation are established **and** the parties are in the same business or industry. Damage can include: loss of profit; loss of sales; loss or reduction of the chance to expand into other markets; damage to reputation; exposure to litigation; erosion of distinctiveness; and/or dilution of goodwill.

## Defences

There are no specific defences to the tort of passing-off. If a defendant is challenged for passing-off a claimant's mark, the defendant is only required to adduce evidence to refute the claim. Such evidence should include (irrespective of any evidence the claimant adduces):

- that the claimant has insufficient goodwill
- that the defendant's activities have not confused or deceived customers; and/or
- that there has been no damage

## Remedies

A successful claimant can be granted:

- an injunction (interim and permanent)
- damages or a payment from the defendant's profits
- an order for delivery up or destruction of infringing articles; and/or
- an order allowing search and seizure (which can be granted without notice to the defendant)

	PROS	CONS
<b>TRADEMARK</b> Enforcement of registered trademarks through statutory infringement proceedings.	. Stronger and clear legal protection . Receive Certificate as evidence . Easier and less expensive to prove infringement . Trademark is presumed valid unless proved otherwise by the defendant	. No action can be brought in relation to a mark until after registration . Risk of losing the trademark if the defendant counterclaims for cancellation/invalidity . Claim for unjustified threat of proceedings in case of unfavourable decision

<b>Unregistered well-known trademark</b>	. A claim under trademark law and not under commercial torts law - therefore preferable	. The burden of proof of a well-known unregistered trademark lays upon the plaintiff and the plaintiff is required to provide evidence
<b>PASSING-OFF</b> Protection of unregistered marks through common law tort action.	. Action can be brought for types of marks that cannot qualify for registration as a trademark . Action can be brought for trademarks that are in the process of registration	. Claimant must establish goodwill/reputation in the mark . It can be very difficult, and therefore expensive to prove passing-off

[1] a state which is a member of the Union for the Protection of Industrial Property under the Paris Convention for the Protection of Industrial Property and includes territories to which the Convention has been extended under Article 16 *bis* of the Convention; or a state that is a member of the World Trade Organization.

## Domain names

Domain registration (domain names) under the suffix '.il' can be registered through qualified registrars. Qualified registrars are private entities that are authorized by the Internet Domain Registration Association ("**ISOC-IL**") after their compliance with technical and service criteria has been tested (<https://www.isoc.org.il/>). The process is:

- Choosing a Domain Name
- Checking the availability of the Domain Name
- Choosing one of the available Registrars
- Completing the registration process

It is the responsibility of the applicant to ascertain whether the allocation or use of the domain name by the intended holder does not infringe the legal rights of any other third party. It is possible to check for existing domain names on 'WHOIS', and also to check against the prohibited domain names on the registration website above. For further reading see ISOC-IL registration rules, December 1998 (the Israeli Registration Rule) [here](#).

### Eligibility and Required Documents for Different Categories of ".il" Domain Names:

DOMAIN CATEGORY	ELIGIBLE APPLICANT
".co.il"	domain names will be allocated to any person or other legal entity
".org.il"	domain names will be allocated to any person or other legal entity
".gov.il"	Governmental entities of the State of Israel. For information relating to registration under this SLD, please refer to the Governmental Internet Committee website <a href="#">here</a>
".net.il"	Internet Service Providers (ISP) holding a valid license from the Israeli Ministry of Communications that govern the provision of a service
".ac.il"	Academic institutions of higher education that have been recognized as such by the Israel Council for Higher Education ("MALAG"). Under this SLD, only Domain Names authorized by

	MALAG will be allocated
".idf.il"	Israel Defense Forces entities. Under this SLD, only Domain Names authorized by the IDF Central Computing Facility ("MAMRAM") will be allocated. Applicants seeking allocation under this SLD should contact MAMRAM directly
".muni.il"	for municipal and local government authorities

## Disputes

ISOC-IL is not a party to disputes related to the holding rights in a domain name allocated or re-assigned to a holder.

The IL-DRP is an alternative dispute resolution procedure intended to provide expedited resolution for disputes regarding the allocation of Domain Names in accordance with the Rules for Allocation of Domain Names.

In case brought to court, an unlawful use of a domain name may be considered as a trademark breach.

## Company names

Content to follow shortly.

## Key dates

### General Holidays

- Every Saturday
- Rosh Hashanah (Israeli New Year)
- Day of Atonement
- Simchat Torah/Shmini Atzeret
- Passover
- Seventh day of Passover (aka Mimouna)
- Holocaust Remembrance Day
- Fallen Soldiers and Victims of Terrorism Remembrance Day
- Independence Day
- Shavuot

## Calculation of deadlines

'Month' means a full calendar month (e.g. the last day for compliance with a deadline of 'one month' commencing on 15 January, is 15 February). If a deadline falls on a weekend or public holiday it will likely be extended to the next working day, unless otherwise determined. If a period is 7 days or less and includes a Saturday or a general holiday, such day (or days) shall likely be excluded from the period, unless otherwise determined.

## External contributors



**Yael Riemer**

Partner  
FBC&Co  
[yriemer@fbclawyers.com](mailto:yriemer@fbclawyers.com)  
T: +972 3 694 4290



**Tamara Dreiman**

Associate  
FBC&Co  
[tdreiman@fbclawyers.com](mailto:tdreiman@fbclawyers.com)  
T: +972 3 694 4290

## Disclaimer

This publication is intended as a general overview and discussion of the subjects dealt with. It is not intended to be, and should not be used as, a substitute for taking legal advice in any specific situation. DLA Piper will accept no responsibility for any actions taken or not taken on the basis of this publication. If you would like further advice, please contact your usual DLA Piper contact.