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Welcome to the 13th edition of the International Associates Action Group Newsletter. We are still looking for contributors so please get in touch with me at david@gearhartlaw.com If interested in becoming an editor or just want to get involved in our Action group please do let myself or Cristina Guerra know. See you next Month!

Yours,

David Postolski

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Israel and Innovation – a Good Match

Having been invited to present at the AIPLA and AIPPI Conference March 20-22, 2016, in Tel Aviv to speak about Post Grant Review proceedings for patents, I was honored to travel to Israel. I must admit that my trip to Israel was one filled with doubt and fear of the unknown, having not been there for almost 15 years, and never having gone as a professional Intellectual Property attorney.

However now my trip to the Holy Land of Israel is complete. Wow! To sum it up: Having traveled there before because my father is in fact Israeli the surprise had more to do with my first time being in Israel as a professional, in a suit, with cufflinks, and as part of the AIPLA (American Intellectual Property Law Association) delegation of 13 U.S. Intellectual Property and patent lawyers and as a speaker at the AIPPI (International Association for the Protection of Intellectual Property) Conference on the economy of innovation.

Israel takes its IP seriously both in high tech and life sciences and rightfully so, as it is the startup nation and is now known as the scale up nation. Israel has the highest per capita of PhDs and the technology and Pharma research to back it up. Speaking on post grant review proceedings was an honor and experiencing Israel through the eyes of their patent attorneys (equivalent to U.S. patent agents) was rather eye opening for me.

The delegation tour started with a visit to Israel’s Ministry of Justice IP division where we met with advocate Howard Poliner and then continued to the Israel patent office where we met with the commissioner of patents Asa Kling. The discussion was not only exciting but eye opening to learn of Israel’s high ranking place in the world of innovation and international patent filings. We then visited the first of two technology transfer offices of Israel’s largest universities. First, we visited Yissum Research and Development Hebrew University in Jerusalem (responsible for diverse inventions ranging from the seedless cherry tomato, Mobileye technology for automobiles and their dementia drug Exelon). A few days later we visited the technology transfer office of Ben Gurion University, a world leader in agricultural innovations. The university is located in a cyber park in the city of Be’er Sheva, which is fast becoming and is appropriately named Israelis hi-tech park. Companies from all over the world have opened offices there and the energy is frenetic and exciting to be around.
At the Conference we heard from many dignitaries including but not limited to Israel’s Minister of Justice Ayelet Shaked, Israel Supreme Court Justice Hanan Melcer, India Supreme Court Justice AK Sikri, Director General of the World IP Law Organization (WIPO) and members of Israel’s Chief Scientist Office (CSO). The CSO mission is to match and fund businesses that want to move into world markets as well as assist U.S. businesses to move into and break into markets. Due to its size it’s very easy to see that the key innovation players in Israel have put the country in a strategic place among the top five countries for IP (U.S., Europe, China, Japan, and Korea).

When God spoke to Moses at the burning bush, Israel was referred to as a “good and spacious land, a land flowing with milk and honey...” Scholars have said that the key word is “flowing.” Fruit trees grow in many different terrains, but their produce only overflows with nectar or honey when the land is especially fertile. Similarly, animals survive in many habitats, but only overflow with milk when they are in particularly fertile pastures. Thus, Israel is often referred to as a “land flowing with milk and honey” as it is indicative and symptomatic of a greater good—the fertility of the Promised Land. Israel is now known as the startup nation or in more recent years the scale up nation. Innovation is in their DNA. Invention is what built Israel as the startup nation and invention will take this fertile nation of entrepreneurs and lead them into the future as the scale up nation.

David Postolski, Esq., Gearhart Law LLC, david@gearhartlaw.com
Europe’s New Unitary Patent System: What you need to know and do now

A huge change in European patent law is on our doorstep. Decisions need to be made – strategies need to be set.

Europe will soon have a new patent court (the UPC) that provides patentees with the advantage of pan-European infringement actions and injunctions, but introduces the risk of pan-European revocation actions. As part of the new system, it will also be possible to get a unitary patent (UP), which is a single patent that will provide protection across the majority of European Union member states with just a single renewal fee corresponding to the renewal fee of four member states. The most interesting thing about the new system is that it introduces choice - for some time to come you can choose to stick with the old system, which is reliable but arguably expensive for litigating across Europe, or go with the new system, which is unknown, potentially risky, but could be advantageous to many. Patentees, licensors and licensees need to start thinking about whether the new system or the old system suit their patents and business in good time before the new system comes into force, which is looking increasingly likely to be within the next 6 to 12 months.

Within the next year the biggest European patent law change in over 30 years is going to happen; Europe will for the first time have a court system that allows for pan-European revocation and infringement patent actions. With the European Union (EU) having the largest GDP in the world, ahead of the USA and China, this new system will introduce huge opportunities for some companies and major risks for others. We shall consider how this new court system, the unified patent court (UPC), and the new single European patent, the unitary patent (UP), could affect your business, and what you need to be doing now to both protect your business and allow you to make the most of the opportunities it presents.

What’s changing?

The most important thing to note is that it is not a complete overhaul. Instead, the changes introduce choice. The old system is still available, at least for the initial seven year transitional period, but you can alternatively choose the new system or combinations of both as we will discuss.

Firstly, when a European patent grants you will either be able to validate the patent nationally in line with the old system and get a bundle of national patents, or elect unitary status, meaning you have a single UP having effect across all signatory states.

What do we mean by signatory states? Well, firstly, the new court is only open for use by member states of the EU. So for countries where you could obtain protection from a patent granted by the European Patent Office (EPO), which are not EU member states, such as Switzerland and Norway, you’ll still have to validate your European patent in those countries and get a national patent there. In addition, not all European Union member states are signatories or intend to sign up to the new system. Key countries falling into that category are Spain and Poland, the fifth and sixth largest countries in the EU by population.

In practice, this means that you have a choice between the old system and the new system, but even if you choose the new system you might still have to carry out at least some old-style validations in certain countries to get your desired protection.

Secondly, for existing patents, pending patent applications, patent applications yet to be filed and supplementary protection certificates (SPCs) you have a choice of jurisdiction: the national courts or the new UPC. On the day that the UP and UPC come into force, all European patents and pending European patent applications will automatically join the new system, which means that revocation and infringement actions can be brought before the UPC. However, at the same time, for all patents excluding UPs which have the exclusive jurisdiction of the UPC, you’ll have a choice as to whether to stay in the new system of the UPC, or opt-out and go back to the old system of national courts.
What do I need to do now?

The key actions that every owner of a European patent or company operating in Europe will need to make before the new UP and UPC system comes in are as follows.

1. As a patentee you need to decide whether to get a unitary patent (UP) with effect across all signatory states of the new system, or go down the tried and tested national validation route.

2. You’ll also need to decide whether you want your patents subject to the unified patent court (UPC), a new pan-European patent court, or opt-out of that system and stick with the national courts.

3. As a licensor or licensee, you’ll need to determine which party in the agreement has the right to make these decisions about the UP and UPC.

4. If you’re a company operating in Europe, you may want to consider how the new system can be used to your advantage to position yourself with respect to competitors’ patents.

Given the importance of the choices involved, we shall consider each of these points in turn, taking into consideration the pros and cons of each choice as well as the opportunities and threats that these choices may present.

Opt-out of the UPC and into the national courts?

The first decision that needs to be made is whether you want a patent to be in the new system and be able to litigate the patent before the UPC and national courts, or you want to opt-out of the UPC and limit patent litigation to the national courts only. Let’s briefly consider the factors that might affect that decision.

The opt-out decision factors

Risk aversion
The UPC is a new court system with no legal precedent, we therefore do not know what to expect from it. The courts may be patentee friendly or they may not. In either case, the new system introduces a risk of a life-long central validity attack, something European patents are currently exposed to only for nine months post-grant. Opting out avoids these risks but, of course, also foregoes the potential benefits of the new system, namely pan-European injunctions and pan-European damages from infringement actions. Furthermore, the potential variation in approaches by different divisions of the UPC, particularly in the formative years, could be seen as a risk for some, but an advantage for others.

Patent value
For high value patents this risk becomes even greater and it may be worthwhile looking to opt them out of the new system. For low value patents it may be worth taking a punt on the new system.

Patent strength
If you believe your patent is strong, perhaps the advantages of the new system such as pan-European injunctions make it worthwhile staying in. In contrast, if they are weak, the risk of a pan-European revocation action could make it preferable to opt-out.
Budget
There are two aspects to the effects of the UPC on budget. The first is the cost of litigating. The UPC provides a single court to hear a pan-European action. This should be cheaper than litigating in various courts across Europe, despite the fact that the UPC court fees will be relatively high. The second is the fact that while the official fee for opting-out each patent has been dropped, there may be attorney fees for dealing with the opt-out, or the effort to analyse a portfolio to determine what to opt out case by case. Hence, staying in the new system is certainly the cheaper option.

Territorial Coverage
If a pan-European injunction or infringement action is desirable because you are operating all across Europe then the UPC will be more appealing. However, if you are only operating in Germany, or perhaps you only have German licensees, then the UPC suddenly becomes less relevant.

What’s the word on the street?
Most want to let others make the first move. So what are other companies planning? Well, we’re hearing very different strategies.

Some companies see the risk of a new legal system as too big for them and are happy for others to take the risks. They are therefore opting their whole portfolio out. Not only does this protect the whole portfolio from the risks of the UPC, but it also saves on the time and cost of reviewing a whole patent portfolio. Other companies simply don’t litigate in Europe and are therefore not sensitive to the uncertainty of the new court.

For these companies, the cost and effort of opting out may sway them to remain passive and take no action. For companies who protect their patents in a large number of countries the cost saving provided by the UP may outweigh the risks associated with the new court.

It was speculated that big-pharma would opt their whole portfolios out because their patents are of such high value. Surprisingly, we are hearing that while most indeed want to opt their crown jewels out of the new system to protect them from the risk of central revocation, they want to leave at least a reasonable proportion in the new system so that they can help develop the new law in their industry’s favour.

Then there are companies such as patent assertion entities (PAEs) who have a tough decision to make; the advantage of central infringement actions and a single negotiating tool is extremely attractive, but the threat of central revocation, particularly when their business model is entirely based around patents, makes the new system equally risky.

Making decisions and tactics

Tactical tip 1: Opt-out your patent to shelter it from central revocation and then opt-in the patent to bring a pan-European attack.
Tactical tip 2: File a divisional application directed to an almost identical invention as the parent, opt-out the parent and keep the divisional in the new system. Then you get the best of both systems.

If it’s tough to work out what to do with your portfolio because you think there may be value in some of your patents being in the new system, but you need to protect others by keeping them out, then there are some techniques that can be used to sort your patents. Our paper “The UPQ: a decision making tool for Europe’s new patent system” covers that in detail, so we won’t look at that any more here. However, there are some tactical pointers to consider.
Firstly, it’s important to know that if you opt-out, you can opt back in again. The advantage here is that you can opt-out and shelter your patent from central revocation, but then opt back in to bring a pan-European infringement action or obtain a pan-European injunction. This seems like a very good strategy to take. However, it’s important to bear in mind that if you opt-out and an action is brought before any national court then you can’t opt back in.

Secondly, consider filing a divisional application – opting one of the parent and divisional out of the new system and keeping the other in the new system. This way you could potentially have both jurisdictions available for bringing actions and potentially two bites of the cherry. If you just make minor changes to the wording of the divisional from the parent during prosecution, or you direct the parent to the apparatus and the divisional to the method, you should have no problem getting two patents directed to effectively the same invention. You could even try to obtain the same claims twice; since currently national laws, for example in the UK and Germany, do not prevent obtaining a standard European patent and a UP for the same invention. The EPO is likely to try and stop this but since there is no legal basis for a prohibition against double patenting at the EPO itself, this may be worth trying. The EPO boards of appeal have previously decided that double patenting may indeed be justified if there is a legitimate interest to obtain two European patents for the same invention.

**Opt-out timing**

Tactical tip 3: Decide what to opt-out now and then register your opt-outs in the sunrise period. If you don’t you could be stung by a central revocation action the day that the new court opens its doors. This is particularly pertinent if you have a high value patent, or a patent that successfully made it through EPO opposition.

So you’ve decided on your opt-out strategy, what next? At some point in the coming months we expect the court to come into effect. Once we know that this is happening a six-month ‘sunrise period’ will precede the start of the new system, which will enable patent owners to officially opt patents, patent applications and SPCs out of the new system. We strongly recommend that you have opted out all of the patents and patent applications that you want opted out during the sunrise period. This is because as soon as the new court comes into effect you risk being stung by a central revocation action. In short, now is the time to start thinking and planning, and it won’t be long until you need to do something.

**Unitary patent or national patents?**

It is easy to see the decision as to whether you want a UP or a bundle of national patents as a decision based purely on cost, but there are other factors to consider too. Each factor that you should take into account is set-out below. Again, more detail is provided in our paper “The UPQ: a decision making tool for Europe’s new patent system”.

**Renewal fees**

The renewal fee to maintain the patent in force for the UP is based on the combined renewal fees of the four countries signatory to the new system in which European patents are most frequently validated, namely the UK, Germany, France and the Netherlands. Say you’re in the telecoms space and you frequently just validate in the UK and Germany. For you, the new UP probably won’t look very attractive from a cost perspective. In contrast, let’s say you’re a big pharma company and you’re getting protection in every country you can. The new system will be extremely attractive because it provides a huge cost saving.
Translations

The other cost to take into account is that if you apply for a UP you’ll have to get the whole patent translated into another language of a member state; something that may not be required in the old system for certain sets of countries. As a result there may be an increase in translation cost when using the UP. However, realising that this is a formal requirement, there will be ways to minimise these costs such that it should not be a major factor in deciding for a or against a UP.

Geographical coverage

For some, potentially getting protection in 25 European states for the price of four could make the new system a real draw. Remember, if you go down the old bundle of national patents route, you only have protection in those countries in which you validate your European patent. So the UP is an impressive offer in terms of geographical bang for your renewal fee buck.

Implications on the courts

If you have a UP you can’t opt-out of the UPC. If you have national patents then you have a choice. The decision that you’ve made about whether or not to opt-out of the UPC may therefore also affect some decisions regarding the UP vs national patents question.

For many companies the UP v bundle of national patents question may be determined solely by the company position on the UPC. If a company doesn’t want to use the UPC, or risk being subject to the UPC, then the UP is not an option. For companies not running for their life away from the UPC, the choice is likely to be a simple cost benefit analysis, balancing geographical reach and cost over the life of the patent.

For pending patent applications, remember that the UP is not an option if your application grants before the UP comes into force, you can only get a bundle of national patents at present. But keep in mind that the new system is on its way. If the UP looks favourable to you, you might want to consider slowing down the prosecution of pending European patent applications so that when your patents grant you can elect unitary status and obtain UPs.

How does this all affect my licences and patent-related agreements?

The introduction of this new court system with new rules, new options and decisions to be made will inevitably affect existing licences and the drafting of new licences and other agreements. As a result, existing agreements relating to one or more national patents that derive from European patents, or in relation to pending European patent applications will need to be reviewed. The terms of exiting licences that could be affected by these changes can be summarised into three main groups:

1. Who can opt-out, opt-in, withdraw opt-outs and withdraw opt-ins?
2. Who can bring proceedings and what has to be done to bring proceedings?
3. Who decides whether you get a UP or bundle of national rights?

While on the face of it these points look simple, there are lots of complex issues that need to be taken into consideration when it comes to the effect of the new European patent system on existing and future licences. These issues are discussed in detail in our paper “The UPC: a licensing executives dream?”. However, the key message to take away is that you need to review your licences because when they were drafted it is likely that the new laws and court system was just a distant dream.

Tactical tip 4: If the UP looks favourable to you, you might want to consider slowing down the prosecution of pending European patent applications so that when your patents grant you can elect unitary status and obtain UPs. Tactical tip 5: Look to revise your existing licences to take into account the key decisions of (1) opt-in v opt-out, (2) who can bring proceedings, and (3) UP v bundle of national patents. Tactical tip 6: As a patentee, consider the information you are giving competitors by filing an opt-out request. It may be beneficial to delay filing any opt-out requests when the sunrise period starts, but beware of the risks of leaving things late. Tactical tip 7: Monitor competitor patents for opt-out decisions and consider proactively bringing revocation actions (UPC or national) to lock the opt-out status (in or out, as the case may be).
What if the boot is on the other foot?

As long as you are operating within the EU, you will most likely have to contend with the new system not only as a patentee but also as a competitor of a patentee. Whether or not you like the idea of the UPC for your own patent portfolio, you could potentially be at the receiving end of a patent action in the new system or perhaps you'll be thinking about making use of the new possibility for central revocation.

While much of your thinking about your freedom to operate in Europe will remain unchanged, the weighting you attach to different options may change. Given the prospect of pan-European damages and injunctions, the scales may tip in favour of being proactive sooner. We think that as a result, companies operating in Europe may consider clearing the way by attacking a competitor’s patent that looks risky more readily. While the EPO opposition procedure provides a trusted tool for this, the introduction of a pan-European revocation action in the UPC, which is potentially available throughout the life of a European patent, may provide you with new options.

We discuss these issues in detail in our paper “The UPC: dealing with third party patents”. However, one point is time critical and worth considering as a priority; if there are competitor patents that are perceived as a competitive risk, these should be identified and monitored in the run-up to the UPC. The UPC provides for central revocation for the life of the patent but only for those patents that have not been opted out. However, once a central revocation action has been started, the patentee can no longer opt out. It is therefore worth your while monitoring problematic competitor patents, in particular those which are out of the nine month EPO opposition period, and to consider starting a central revocation action as soon as possible, assuming that the patentee has not opted the patent out during the sun-rise period before the UPC starts. This would lock the patent into the UPC and hence make it susceptible to life-long central revocation. An easy starting point for this might be identifying patents that you attacked in an EPO opposition, but failed to get them revoked, or any other patents you know may be problematic. For the former, the UPC could therefore offer you with a second chance to get a problematic European patent revoked.

Tactical considerations also apply if a competitor has opted out a problem patent. As we’ve discussed, a tactical move by patentees is to opt-out their patents to shelter them from central revocation, but then opt them back in when they are ready for a pan-European attack. It may be preferable for you to bar the competitor from opting back in when it suits, and you may prefer not being subject to the jurisdiction of the UPC with its pan-European damages and injunctions. In this case, you may wish to consider bringing a national revocation action to lock the problem patent out of the UPC for good.

Preparing to bring a revocation action takes time. This is the case if brought before the UPC, a national court or patent office. We therefore recommend that you review any freedom to operate studies that you have carried out in respect of Europe to see if there are any problem patents for which it would be beneficial to be proactive when the UPC comes into force. This also has implications for patentees: we expect that well informed patentees will want to limit information available to competitors and may consider opting out only late in the sunrise period. However, patentees need to be careful taking this approach because a patent is only deemed opted out once it is shown as such on the register. Given there could be a delay between filing an opt-out and it being processed, a window of opportunity could emerge for filing an attack. Again, monitoring competitors’ patents and being prepared to pounce may enable you to make the most of such opportunities.
Get your strategy in place now

There may now be less than a year to go until the new court opens its doors and the new patent will come into being. Both European patentees and companies operating in Europe will have to deal with the new system. Whether you are a patentee or a company operating in Europe, now is the time to start preparing for the new system; to define your strategy, review your and your competitors’ patents and to define and execute actions in line with your strategy. Our three companion papers discuss the issues in further detail and hopefully give you a springboard from which you can start planning for the new system.

Nick Shipp and Alexander Korenberg, Kilburn & Strode, UK
A Beer Trademark Infringement Case in… Belgium, “non peut être”!

Belgium is not only famous for its Royal Palace bigger than Buckingham Palace and the world’s biggest producer of comics per capita. It’s mostly known for the culinary delights: chocolate, waffles, French fries, and beers. With over 800 kinds of beers made in Belgium, consumers have to choose wisely. It’s not beer o’clock, so in the meantime let’s enjoy a trademark case (AB Inbev vs. Buval; available in Dutch only).

Anheuser-Busch Inbev (AB Inbev), known for their constant battle over the trade mark “Budweiser”, brews over 200 beer brands, including “Jupiler”, the number one beer in Belgium. As a result, Inbev is the happy registered proprietor of two figurative trademark (see below) at the Benelux Office for Intellectual Property (BOIP).

With the backup of a specialized marketing team Aldi, an international discount supermarket retail profile, decided to introduce a new packaging (new logo, bottle, emblem, packaging) for its beer: “Buval”.

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<thead>
<tr>
<th>Marken van Eiseis</th>
<th>Gelaakte teken van Verneesters</th>
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<tbody>
<tr>
<td>Jupiler</td>
<td>Buval</td>
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<tr>
<td>Jupiler LEAGUE</td>
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AB Inbev alleged that Aldi’s Buval Logo, infringed their registered trademarks for “Jupiler”, under Article 2.20(1)(b) and 2.20(1)(c) of the Benelux [Belgium-Netherlands-Luxembourg] Convention on IP (BCIP).

Article 2.20(1)(b) [confusion]

Inbev claimed that Aldi’s ‘Buval’ mark, posed a ‘risk of confusion in the mind of the public’ under Article 2.20 of the BCIP.

In order to evaluate the similarity of the contested sign with the earlier trademark, the Court noted that “the average consumer who purchases beer in supermarkets or similar establishments often do not read all the information on the various products, letting themselves be guided more by the overall visual impression produced by the labels or packaging”. (That’s, of course, if you are very thirsty; otherwise Belgians are choosing wisely). In those circumstances, for the purposes of assessing whether there is a likelihood of confusion or a link between the signs in question, the analysis of the visual similarity between those signs becomes of greater importance than the result of the analysis of their aural and conceptual similarities.

The Court noted that there was no aural similarity for the signs in question. There is indeed no high possibility of mispronunciation leading a person to mistake one mark with the other. When analyzing the visual similarity of the signs in question, the Court held that there was an infringement. Evidences are numerous: same color combination (red, white, and black), a red background, a wild animal motif/logo with a black and white contrast (animal in black and the contours and the eyes in white); the white rectangle and the red borders with the mark in black letters; and an emblem/shell with a red-white/grey contrast.
For instance, the Judge noticed that the contested sign used a lay-out similar as Inbev in the realization of its logo:

“In this case, Aldi and the brewery Martens have a similar layout or arrangement of a number of elements that are used by the plaintiff with its brands. The combination of these elements with almost identical red background color makes the sign of the defendants appeals to the mark no. 893 358 of the claimant which is also characterized by a red background color”.

In sum, the Court found that the appearance of Aldi’s can resulted in infringement of Inbev’s ‘Jupiler’ trademark.

**2.20(1)(c) Unfair Advantage**

After acknowledging that the sign (Buval) was used in the course of trade and in respect of goods which were identical to those for which Inbev’s trademark were registered, the Judge looked at the question whether the trademark enjoyed a reputation in the Benelux territory.

Buval was merely used since August 2015, which was not disputed by Aldi, while AB Inbev’s brands were registered in May 2012 and November 2014. “(…) In the Benelux territory, it is sufficient for the registered trade mark to be known by a significant part of the public concerned in a substantial part of that territory, which part may consist of a part of one of the countries composing that territory” (CJEU, General Motors Corporation contre Yplon SA, in Case C-375/97)

Taking into consideration all the relevant facts of the case, in particular the intensity, geographical extent and duration of its use (it’s been almost 50 years that Jupiler beers are sold in Belgium), and the size of the investment made by the undertaking in promoting it (Inbev invested 13 million EUR in the promotion of Jupiler in 2014), the Court decided that Jupiler enjoyed a reputation for beers.

For the application of Article 2.21(1)(c) BCIP, a confusion or a risk of confusion is not required. It is sufficiently likely that the contested sign of the defendants raises the trademark proprietor in mind. Tthe Court decided that there was a real risk of dilution (detriment to the distinctive character of Inbev’s trademark). The use by Aldi of a similar sign, particularly for identical products, entailed a risk that Inbev will lose exclusivity and over time will no longer be capable of arousing immediate association with the goods for which those marks are registered. This is even more true where alleged goods are sold by Aldi widely. Given the reputation of Inbev, there is indeed a risk that the brand, in the eyes of the normally informed and reasonably observant consumer, would lose its distinctive character for the beers.

In conclusion, AB Inbev successfully claimed against Aldi for both confusing use and taking unfair advantage of the repute of their ‘Jupiler’ trade marks. Aldi was ordered to remove all cans and bottles of Buval beer within 10 days of the judgment and to stop advertising and using the Buval logo on beer bottles and packaging.

By Thomas Dubuisson, Koan Lorenz Law Firm, Brussels, Belgium (tdu@koanlorenz.com)
Jewish National Fund (JNF, KKL) Registers Trademarks

The JNF (KKL) has attempted to register the following Israel wordmarks:

- 251088 “Community Forest”
- 251091 as above, but in Hebrew
- 251119 "Click to Plant”
- 251092 as above, in Hebrew
- 251116 ספר היערות lit. the Forest Book
- 256439” The Wedding Book”
- 256443” The Bar Mitzva Book”
- 256441” The Bat Mitzva Book”

These books are designed for registering occasions for donating money for tree planting and land purchase, and the like.

The marks cover division and dissemination of capital, including charity funds, charitable donations, raising capital, funds and donations, charitable organizations, fund-raising organization all included in Section 36.

The Jewish National Fund predates the State of Israel. It was set up to provide funding for land purchase in Palestine and has invested heavily in tree planting and in draining and then again to reflood the Hula Swamp.

Indeed, Israel is one of the first countries to invest in reforestation and is fairly unique in having more trees now than a century ago. The JNF gives out Christmas trees to Israeli Christians and tree planting certificates that use up a fair amount of wood pulp from their tree planting operations. The organization is recognized by Israel Law since 1953 and, as Applicant defines it: the KKL is a Zionist Organization established as a means of raising capital investment for purchasing lands within the Land of Israel and preparing them for Jewish settlement. Today, the organization raises funds from Israelis and from Diaspora Jews for funding its activities in the Land of Israel.

The marks were rejected under Section 8(a) and 11(10) of the trademark ordinance.

The Applicant argued that 2511088 “Community Forest” and 251091 are distinctive and do not reflect the nature of the services provided. The Examiner considered them descriptive but was prepared to allow them to be registered under Section 8(b) if acquired distinctiveness could be shown.
The Applicant argued that the JNF has been using the phrases “Golden Book” and “Forest Book” and “Honour Book” since the beginning of the 20th Century, and provided evidence to this effect. However, the Examiner considered that Forest Book is descriptive and generic and thus could not be registered under section 8(a) and 11(10).

Israel Trademark Application Numbers 251119 “Click to Plant” and 251092 are used for internet services for donating money for planting trees. The Applicant argued that the phrase was a unique and distinctive combination of words whereas the Examiner considered this descriptive and the uniqueness didn’t help in this respect. Applicant argued that the marks were not actually descriptive and that they needed a logical jump to link their meaning with the service to which they referred. Examiner noted that clicking resulted in a tree being planted and therefore considered the marks descriptive but was willing to allow them if acquired distinctiveness could be shown.

Similar arguments were raised with respect to Israel Trademark Application Numbers 256439 “The Wedding Book”, 256443 “The Bar Mitzva Book and 256441 “The Bat Mitzva Book”.

The Applicant was granted various extensions and on 11 February 2011, a hearing was held before the commissioner.

After the hearing, the Applicant requested to narrow down the range of services as follows: Division and distribution of charitable donations, raising capital, funds and donations, charitable organizations, fund-raising organization all included in Section 36.

As to Community Forest, the Applicant argued that graphical marks 251110 and 251128 were allowed, so the word marks should be as well. The graphical marks are shown below:

![Community Forest](community_forest.png)

![KKL Yaar](kkl_yaar.png)

community forest  kkl yaar

[MF, Frankly I can’t follow the argument that since these were allowed, the words Community Forest in Hebrew or English should be allowed].

Mr Dickstein of the KKL submitted an Affidavit to the effect that the Wedding, Bar Mitzva and Bat Mitzva books include details of the celebrants but do not include details of the donations (which are recorded elsewhere) and therefore cannot be considered descriptive. Furthermore, these books are not in circulation and can only be viewed by prior arrangement.
The book marks are not for books. They were not submitted for paper products in class 16. The donor or celebrant does not receive a book.

Furthermore, all these marks are for fund-raising purposes and do not include the words fund-raising, charity, and the like, and therefore are not descriptive since there is no relationship between the mark and the service.

Whereas the KKL does plant community forests, the money raised using Israel Trademark Application Numbers 2511088 “Community Forest” and 251091 "יער קהילתי" may be used for other purposes. [MF – this seems to me to be misleading and against the public order, but highly reminiscent of the great Ephraim Kishon, Menachem Golan, Chaim Topol film Sallah Shabbati].

Israel Trademark Application Numbers 251119 “Click to Plant” and 251092 "לקלק כדי לנטוע" are not truly descriptive since the clicking only virtually plants the tree which happens later.

The KKL sees marks as necessary to register so that they can prosecute third parties pretending to be the Jewish National Fund.

Ruling

As stated on page 1 of Seligsohn “Copyright Laws and Other Similar Legislation 1973”, the purpose of trademarks is twofold. They serve to protect the mark owner from incursion by competitors, but also serve to enable the customers to correctly identify the source of goods and services. From this it follows, that the main purpose of trademarks is to avoid misleading. To achieve this, Section 8 requires that trademarks are distinctive; whether inherently so as per part (a) or having acquired distinction, as per part (b).

(a) A mark is not registerable as a trademark unless it can distinguish between the goods and services of the trademark owner and those of others (henceforth, having a distinctive nature)

(b) The registrar or Court when determining if a trademark indeed has a distinctive nature may determine if through usage the mark has acquired distinctiveness for the goods for which it is applied or registered

The distinctive nature referred to in Section 8(a) of the Trademark Ordinance is such that a consumer seeing the mark can tell the source of the goods, and if used for different goods, can know that all come from a common source (see Seligsohn, page 20).

Marks may be generic, descriptive, indicative, arbitrary or made up words. There is a continuum between the categories, known as the descriptive spectrum. Generic marks cannot be registered. (see Civil Appeal 5792/99 “Telecommunication and Religious-Jewish Family Education (1997) LTD – Magazine “Family” vs. SBC Advertising, Marketing and Sales LTD – “Good Family Magazine”. 2001, (11) 534. As per Section 11(10) of the Trademark Ordinance, where a mark is descriptive of a product or service that it marks, it is protectable only if it has acquired distinctiveness as per Section 8(b).

Consequently, first one tests whether a mark is generic or descriptive, and if descriptive, whether it has acquired distinctiveness, with the mark being examined in relationship to the relevant goods (Appeal 21488-05-11 Eveready Battery Company Inc. vs. Commissioner of Patents and Trademarks, section 27, 8 Dec 2011.

A name used for goods or services should remain available to the public, even if it is not a Hebrew word, See Seligsohn, page 35. See also the Israel trademark ruling concerning the 232102 and 23103 for “SkiDeal” from 20 Jan 2013.
In light of the above background, Israel Trademark Application, the following marks 256439 “The Wedding Book”, 256443 “The Bar Mitzva Book and 256441 “The Bat Mitzva Book” which do not relate to real books, but at best to a register of donations, is not descriptive, but could be considered as indicative. The fact that the marks are in English is irrelevant.

The Commissioner considers that one meeting such marks would assume that they are for a souvenir book or a photo-album. The specific usage for soliciting donations does not take the phrases out of the public domain, and therefore there is no reason not to allow the marks to be registered for the specific usage requested.

As to 251116 “The Forest Book”, this is not a physical book that describes Israeli forests or Israeli trees. The Applicant claims that it is simply a means of soliciting donations and there is no connection between the Forest Book and the usage if the mark. The Forest Book does not list which tree was planted, when and financed by which donation, it is simply a register that states, for example, “that three trees were planted in the name of Marshall George from Virginia on such and such a date.” The Commissioner was satisfied that the mark is not descriptive and can therefore be registered.

However, “Click to Plant”, “לקלק כדי לנטוע” and “Community Forest” do directly describe the services that are advertised and which the Applicant provides, which is a mouse or keyboard click that enables a donation towards tree planting. Whether the mark is in Hebrew or English, it links the trivial Internet clicking with planting, and indicates that one should click in order to plant. The Applicants accept that the marks are for soliciting funds for tree planting, even if some is used for related, supporting activity. This can be contrasted with the 232527 “Click Switch Refresh” decision in the Phillip Morris vs. British American Tobacco (Brands) LTD ruling from 25 Aug 2013 where the clicking was for an electrical cigarette and the clicking was thus an atypical action, which is different from the current case where a mouse or keyboard click is intended. Thus the “Click to Plant” and "לקלק כדי לנטוע" are descriptive and lack the distinctive character required for registration under Section 8(a).

“Community Forest” is also problematic in that donations solicited may, inter alia by used for the purpose of planting forests for use by the community in addition to other causes to which it may be diverted. [MF – I sense a facetious tone here]. This pushes the “Community Forest and "לקלק כדי לנטוע" marks towards the descriptive end of the spectrum and there appears to be a clear connection between the marks and the services for which they are used.

Having ruled that “Click to Plant”, "לקלק כדי לנטוע" “Community Forest” and "לקלק כדי לנטוע" are descriptive, the next question is whether the marks can be considered as having acquired distinctiveness, in which case they could be registerable under Section 8(b). In this regard, the Commissioner referred to Judge Berliner’s ruling in Appeal 2673/04 Coffee to Go Marketing (1997) LTD vs. Israel Shaqued (15 April 2007) on page 11:

Interim Summary: Coffee to Go is a completely descriptive term and it is forbidden for registration under section 11(10) of the Ordinance. Even if one argues that originally there was something new and fresh about this combination [ MF the phrase, not the coffee], over time it has become a term that describes the service and goods and one comes to the same conclusion….  

…consequently, the only way for such a mark to survive as a trademark is if it can serve to distinguish the source of the service of goods as per Section 8(b) or 9.

As one moves along the descriptive spectrum towards the descriptive and generic end, the Applicant has a more difficult job showing acquired distinctiveness. See 3559/02 Toto Zahav LTD vs. The Council for Organizing Sport Related Gambling, 59(1) 873, paragraph 9. However, as per Section 11(10), a
descriptive or laudatory mark may acquire distinctiveness (Bagatz 144/85 Klil vs. Commissioner of Patents and Trademarks PD 42(1) 309, 315).

There are various legal tests for determining if a mark has acquired distinctiveness, which look at the period during which the mark is used, how it is publicized and whether the mark is identified with the provider by the public – See Appeal 18/86 The Israel Venetian Glass Factory LTD vs. Les Verries des Saint Gobain PD 45(3) 224, 238 (1991). As to the period of use, an affidavit provided by Applicant shows that the Jewish National Fund was established in 1901, but this tells one nothing regarding when the requested marks were first used for fund-raising purposes.

the Applicant trued to show that the “Click to Plant”, "לקלק כדי לנטוע,” “Community Forest” and "יער קהילתי" marks are identified with the Jewish National Fund by means of a Google search. However, as ruled in the GHI case, one has to be very wary of Google Searches and conclusions drawn. The Commissioner does not consider that the results as generated can teach anything regarding Internet usage, and considered the results as ambiguous [MF – not clear why the Commissioner didn’t do his own search or have an Examiner do one].

The Commissioner was not convinced that “Click to Plant”, "לקלק כדי לנטוע,” “Community Forest” and "יער קהילתי” had acquired distinctiveness as required by Sections 8(b) and 10(11). In conclusion, the “Click to Plant”, "לקלק כדי לנטוע,” “Community Forest” and "יער קהילתי” are refused but 256439 “The Wedding Book”, 256443 “The Bar Mitzva Book and 256441 “The Bat Mitzva Book” are allowed for charity funds, charitable donations, raising capital, funds and donations, charitable organizations, fund-raising organization all included in Section 36.

Ruling by Commissioner Assa Kling, 17 February 2016.

This article was written by Dr Michael Factor, an Israel Patent Attorney and was first published in the IP Factor blog. www.ipfactor.co.il. For queries relating to IP in Israel, Michael may be contacted at mfactor@ipfactor.co.il
Can An Israeli Opposer Force Applicant to Testify in Hebrew?

Disney Enterprises Inc filed a number of Israel trademark applications including:

Israel Trademark Application No. 246341 for “The Jungle Book”
Israel Trademark Application No. 246342 for “Mowgli”
Israel Trademark Application No. 246096 for “Bagheera”
Israel Trademark Application No. 246098 for “Baloo”
Israel Trademark Application No. 246100 for “Kaa”
Israel Trademark Application No. 246117 for “Shere Khan”

The marks were filed for classes 9 and 41 and cover:

Audio discs; audio recordings; audio and video recordings; audio speakers; binoculars; calculators; camcorders; cameras; CD-ROMs; CD-ROM drives (as part of the computer); CD-ROM writers (as part of the computer); cellular telephones; cellular telephone accessories; cellular telephone cases; chips containing musical recordings; face plates for cellular telephones; compact disc players; compact disc recorders; compact discs; computer game programs; computer game cartridges and discs; computers; computer hardware; computer keyboards; computer monitors; computer mouse; computer disc drives; computer software; cordless telephones; decorative magnets; digital cameras; digital video and audio players; DVDs; DVD players; DVD recorders; digital versatile discs; digital video discs; pre-recorded optical and magneto-optical discs; optical and magneto-optical disc players and recorders for audio, video and computer data; electrical and optical cables; electronic personal organizers; eyeglass cases; eyeglasses; graduated rulers for office and stationery; headphones; karaoke machines; microphones; MP3 players; modems (as part of a computer); mouse pads; motion picture films; musical recordings; pagers; personal stereos; personal digital assistants; printers; radios; sunglasses; televisions; television sets; video cameras; video cassette recorders; video cassette players video game cartridges; video game discs; video cassettes videophones; video recordings; walkie-talkies; wrist and arm rests for use with computers; all included in class 9, and
Production, presentation, distribution, and rental of motion picture films; production, presentation, distribution, and rental of television and radio programs; production, presentation, distribution, and rental of sound and video recordings; entertainment information; online interactive entertainment; production of entertainment shows and interactive programs for distribution via television, cable, satellite, audio and video media, cartridges, laser discs, computer discs and electronic means; production and provision of entertainment, news, and information via communication and computer networks; amusement park and theme park services; educational and entertainment services rendered in or relating to theme parks; live stage shows; presentation of live performances; theater productions; entertainer services; all included in class 41.

Zvi Efra, Azriel Ashrov and Tamir Productions and Entertainment LTD opposed the marks.

Disney submitted a Declaration by Steven Ackerman, and Adv. Roi Levi who represents the Opponents claims to have a language and learning impediments that make reading and writing English difficult and that as language skills are not essential for Israeli lawyers to pass the Israel Bar, he is not required to know English.

The official languages in Israel are Hebrew and Arabic and so there is no reason to allow Mr Ackerman to file a declaration in English.

Disney’s representative accused Adv. Roi Levi of inequitable behavior by filing frivolous requests as time-wasting tactics and noted that Disney had offered to have the declaration and its appendices be translated into Hebrew.
Adv. Roi Levi countered that Disney had behaved inequitably by providing a non-Hebrew expert witness and that they should provide a translator for the hearing to enable cross-examination of the witness.

**Ruling**

In Circular M.G. 7 by Moshe Goldberg from 29 April 1999, then Commissioner Goldberg allowed non-Israeli parties to provide evidence in English. However, in the Opposition to trademark application 222275 Merck vs. Schreiber (124 November 2011) it was ruled that where the one party does not speak English, they are entitled to have evidence translated into Hebrew at the expense of the other party.

In this instance, Adv. Roi Levi had claimed not to understand English and to have learning and understanding disabilities but had not provided evidence that this was the case. Certainly his allegations that Disney had acted in bad faith by choosing an English speaking witness were without foundation since Disney is an American company.

Disney was ordered to provide Hebrew language versions of the Affidavit and its appendices and to provide a licensed translator for the hearing. However, Ms Yaara Shoshani Caspi reserved the right to award costs to Disney should it transpire that Opposer’s counsel did in fact understand English.

**Comment**

I do not know what a licensed or authorized translator is.

However, it seems reasonable that the hearing be conducted in English unless one party really can’t understand and in such cases, is entitled to a translation.

As to the marks, Disney made a cartoon of a book by Rudyard Kipling and apparently they consider that they have rights to the title of the book for a very wide range of entertainment related services and nobody else can make a film or show called the Jungle Book or anything including any of the names of the main characters. I think this is utterly unreasonable. Disney deserves copyright to their artwork and that also should eventually enter the public domain.

This article was written by Dr Michael Factor, an Israel Patent Attorney and was first published in the IP Factor blog. [www.ipfactor.co.il](http://www.ipfactor.co.il). For queries relating to IP in Israel, Michael may be contacted at [mfactor@ipfactor.co.il](mailto:mfactor@ipfactor.co.il)
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