

TRADE MARKS ORDINANCE
(2011 update), 5732 -1972

CHAPTER ONE:
Interpretations

Definitions.

1. In this Ordinance

“**Mark**” means letters, numerals, words, devices or other signs, or combinations thereof, whether two-dimensional or three-dimensional;

“**Trade-mark**” means a marked used, or intended to be used, by a person in relation to goods he manufactures or deals in;

“**International Trade Mark**” -a trade mark registered in the International Register, in accordance with the provisions of the Protocol and the Madrid regulations;

“**International Trade Mark registered in Israel**” – an international trade mark which is also a registered trade mark, registered in accordance with a notice received by the Registrar under section 56E;

“**National trade mark**” – a registered trade mark, registered in accordance with an application under section 17;

“**Well-known trade mark**” -a mark that is well known in Israel as a mark owned by a person that is a citizen of a member state. A permanent resident of such state or who has an active business or factory in such state, even if the mark is not a trade mark registered in Israel or if there are no users of the mark in Israel; for the purposes of determining whether a trade mark is a well-known in public circles relating to it and the extent to which it is known as a result of marketing, shall be taken into account, inter alia;

“**Registered trade mark**” means a trade mark registered in the Register of Trade Marks under the provisions of this Ordinance and it is a national trade mark or an international trade mark registered in Israel;

“**Service mark**” means a mark used, or intended to be used, by a person in relation to service rendered by him;

“**Certification mark**” means a mark intended to be used by a person, other than a person carrying on a business, to certify the origin of goods in which he is interested, their components, mode of manufacture, quality and any other characteristics, or to certify the nature, quality or type of a services in which he is interested;

“**Collective mark**” means a trade mark or service mark belonging to a body of persons interested in the goods or service which the mark is intended to designate, and used, or intended to be used, by the members of that body in respect of such goods or services;

“**Infringement**” means the use by a person not entitled thereto of a registered trade mark, or of a mark resembling such a trade mark, in relation to goods in respect of which the trade mark is registered, or to goods of the same description;

(2) of registered trade mark in advertising goods of the class in respect of which the mark is registered of goods of the same description;

(3) of a well known trade mark even if it is not a registered trade mark, or of a mark so similar to it as to be misleading in respect of goods for which the mark is well known or in respect of goods of the same description;

(4) of a well known trade mark which is registered, or a mark similar thereto, in respect of goods not of the same trade description, provided that such use could indicate a connection between such goods and the proprietor of the registered trade mark and the proprietor of the registered trade mark might be harmed as a result of such use.

“**Union state**” means a state which 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 section 16 bis of the Convention; “**World Trade Organization**” – the World Trade Organization constituted by the agreement signed in Marrakech on 15 April 1994;

“**Member state**” -a state that is party to the Paris Treaty or a member of the World Trade Organization;

“**Geographical Indication**” means an indication that identifies in Israel goods as originating in a given geographical area of a member state, or a region or part thereof, where a given quality, characteristic or reputation connected with the goods is essentially attributable to its geographical origin.

“**The Minister**” – The Minister of Justice.

CHAPTER TWO: **Register of Trademarks**

Applicability of provisions to service marks.

2. Save as otherwise provided, the provisions of this Ordinance which apply to trade marks shall apply mutatis mutandis to service marks. Service marks, and every

reference in this Ordinance to a trade mark to goods shall be deemed to include a service mark or a service.

Provisions as to certification mark and collective mark

3. Subject to the provisions of sections 14 and 15, a certification mark and a collective mark shall be treated like a trade mark and a service mark, and every reference in this Ordinance to a trade mark or service mark shall be deemed to include a certification mark and a collective mark.

Register and contents thereof.

4. There shall be kept under this Ordinance a register for the registration of trade marks (herein after referred to as “the Register”). Registration shall be according to the following particulars:

- (1) the name, address and occupation of the proprietor of the mark;
- (2) notifications of assignments, transmissions and authorizations;
- (3) disclaimers;
- (4) conditions and limitations;
- (4A) Regarding an international trade mark registered in Israel – an indication that the trade mark is an international trade mark;
- (5) any such other particular relating to registered trade marks as may be prescribed.

The Registrar.

5. The Minister shall appoint a Registrar of Trade Marks (hereinafter referred to as “the Registrar”) under whose control the Register shall be kept.

Register to be open to public.

6. (a) The Register shall at all convenient times be open to inspection by the public in accordance with regulations. (b) A certified copy of any entry shall be given to any person requiring the same payment of the prescribed fee.

CHAPTER THREE:
Eligibility for Registration

Exclusive right to trade mark

7. A person desirous of having the exclusive right to use some mark as a trade mark may apply for the registration of such mark under the provisions of this Ordinance.

Marks eligible for registration

8. (a) No mark is eligible for registration as a trade mark unless it is adapted to distinguish the goods of the proprietor of the mark from those of other persons (a mark so adapted being hereinafter referred to as a “distinctive mark”). (b) In determining whether a trade mark is distinctive, the Registrar or the Court may, in the case of a trade mark in actual use, take into consideration the extent to which such use has rendered such trade mark in fact distinctive for goods in respect of which it is registered or intended to be registered.

Limitation to certain colors

9. A trade mark may be limited in whole or in part to one or more specific colors, and in such case the fact that it is so limited shall be taken into consideration by the Registrar or Court having to decide on the distinctive character of such trade mark. If and so far as a trade mark is registered without limitations of color, it shall be deemed to be registered in respect of all colors.

Scope of application of registration

10. (a) A trade mark must be registered in respect of particular goods or classes of goods. (b) Any question as to the class within which any goods fall shall be determined by the Registrar, whose decision shall be final.

Marks ineligible for registration

11. The following marks are not eligible for registration:

- (1) a mark referring to some connections with the President of the State of his household or to presidential patronage or a mark from which any connection or patronage might be involved;
- (2) flags and emblems of the State or its institutions, flags and emblems of foreign states or international organisations, and any mark resembling any of these;
- (3) public armorial bearings, official signs or seals used by any state to indicate control or warranty, and any sign resembling any of these and any signs from which it might be inferred that its proprietor enjoys the patronage of or supplies goods or renders services to a head of state or a government, unless it is proved to the registrar that the proprietor of the mark is entitled to use it;
- (4) a mark in which any of the following words appear: “Patent”, “Patented”, “By Royal Letters Patent”, “Registered”, “Registered Design”, “Copyright”, “To counterfeit this is forgery” or words to like effect;
- (5) a mark which is or may be injurious to public policy or morality;
- (6) a mark likely to deceive the public, a mark which contains a false indication of origin, and marks which encourages unfair trade competition;

The bracketed words do not appear in the Hebrew version, however inclusion of those words better effects the translation of TRIPS Article 22(3) which this section was intended to implement. See Devray Hesber; Bill 2819 (July 27, 1999)

(6A) a mark containing a geographical indication in respect of goods not originating in the geographical area indicated, if [inclusion of] the geographical indication [in said mark] may be misleading area in which the goods originated;

לדעתי, כדי ליישם את הוראות סעיף 22(3) להסכם טריפס הנוסח צריך להיות כדלקמן: "סימן הכולל ציון גיאוגרפי לעניין טובין שמקורם אינו באזור הגיאוגרפי המצוין, אם יש בסימן כאמור בציין-הגיאוגרפי כדי להטעות ביחס לאזור הגיאוגרפי האמיתי של מקור הטובין."

(6B) a mark containing a geographical indication that is literally correct, however that contains a false representation to the effect that the goods originated in a different area;

(7) a mark identical with or similar to emblems of exclusively religious significance.

(8) a mark on which the representation of a person appears, unless the consent of that person has been obtained; in the case of representation of a deceased person, the Registrar shall request the consent of his survivors unless, in his opinion, reasonable grounds exist for not doing so;

(9) a mark identical with one belonging to a different proprietor which is already on the register in respect of the same goods or description of goods, or so nearly resembling such a mark as to be calculated to deceive;

(10) a mark consisting 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 or quality, unless the mark has a distinctive character within the meaning of section 8(b) or 9;

(11) a mark whose ordinary significance is geographical or a surname, unless represented in a special manner or unless having a distinctive character within the meaning of section 8 (b) or 9;

(12) a mark identifying wines or spirits that contains a geographical indication, if such wine or spirit did not originate in that geographical area;

Intended to explicitly implement TRIPS Article 16(2) and Paris 6bis.

(13) a mark identical to, or misleadingly similar with, a well known trade mark even if the mark is not registered in respect of goods for which the mark is well known or in respect of goods of the same description;

(14) a mark identical to or similar to a well-known trade mark being a registered trade mark, even in respect of goods not of the same class, if the mark sought to be registered might indicate a connection between the goods in respect of which the mark is sought and the registered proprietor of the trade mark, and the registered proprietor of the trade mark might be harmed as a result of using the mark sought.

Mark identical with name of other person

12. The Registrar may refuse an application for registration of a trade mark identical with or resembling the name or business name of another person, or containing a name identical or resembling as aforesaid, if the mark is likely to deceive the public or to cause unfair competition.

Name or description of goods

13. Where a mark contains also a name or description of any goods, the Registrar may refuse to register it in respect of other goods; but he may so register it if in actual use the

mark varies according to the goods for which it is used and the applicant adds a note to such effect in his application.

Registration of Certification Mark

14. (a) The Registrar may register a certification mark if he is satisfied that the proprietor of the mark is competent to certify the characteristics to be designated by the mark.

two) A certification mark is capable of registration even if it lacks distinctiveness as required by section 8 (a).

three) A certification mark may be transferred only with the permission of the Registrar.

Registration of Collective Mark

15. (a) The Registrar may register a collective mark if he is satisfied that it is intended for use by members of the body of persons concerned and that such body has control over the use of the mark by its members.

two) For every purpose of this Ordinance, the use of a collective mark by a member of this body shall be deemed to be used thereof by the body, whether or not the body itself uses or intends to use it.

(c) A collective mark may be transferred only with the permission of the Registrar.

Registration of marks registered abroad

16. (a) Notwithstanding the provisions of sections 8 to 11, the Registrar shall not refuse to register a trade mark Registered as a trade mark in its country of origin unless

(1) registration of the mark in Israel will infringe rights acquired in Israel by another person; or

(2) the mark is devoid of any distinctive character; a trade mark shall not be disqualified from registration if it is different from the trade mark registered in its country of origin in a manner that does not alter its distinctiveness, and does not adversely affect its identity in the form in which it has been registered in the said country of origin; or

(3) the mark consists exclusively of signs or indications which may serve in trade to designate the kind, quality, quantity, place of origin, intended purpose, time of production or value of the goods; or

(4) the mark is customary in current language or in the bona fide and established trade practices in Israel; or

(5) the mark is contrary to public order or morality; or

(6) the mark is likely to deceive the public.

(b) For the purpose of a trade mark whose registration under this section is applied for, "country of origin" means the Union state in which the applicant has an effective and serious industrial or commercial establishment or, if he has no such establishment within a state as aforementioned, the Union state in which he has his domicile or, if he has no domicile within a state as aforesaid, the Union state of which he is a national.

(c) Where the Registrar accepts for registration a mark which would not have been registered but for the provisions of subsection (a), such fact shall be indicated in the publication of the application and in the register.

CHAPTER FOUR:
REGISTRATION PROCEEDINGS

Application.

17. (a) Any person claiming to be the proprietor of a trade mark used or intended to be used by him who is desirous of registering the same shall apply in writing to the Registrar in the prescribed manner.

(b) An application as stated in sub-section (a) may be filed regarding one class of goods or a number of classes of goods.

Powers of Registrar

(a) Subject to the provisions of this Ordinance, the Registrar may refuse an application or accept it absolutely or subject to conditions, amendments or modifications, or to amendment in italics. such limitations as to mode or place of use or otherwise as he may think right to impose.

(b) Regarding an application to register a trade mark in respect of a several classes of goods, the Registrar may request its division into a number of separate applications; and the filing date of each one of the applications so divided will be the filing date of the original application.

Appeal.

19. Where the Registrar refuses an application, his decision shall be subject to appeal to the Supreme Court.

Errors and corrections.

20. The Registrar of the Supreme Court may at any time, whether before or after acceptance, correct any error in or in connection with an application or may permit an applicant to amend his application upon such terms as they may think fit.

Requirement of disclaimer.

21. (a) If a trade mark contains matter common to the trade or otherwise of a non-distinctive character, and it appears to the Registrar or the supreme Court that the proprietor of the mark is not entitled to the exclusive use of such matter or of part thereof, they may, in deciding whether such trade mark shall be entered or shall remain upon the Register, as a condition thereof require that the proprietor disclaim any right to the exclusive use of such matter or make such other disclaimer as they consider necessary in order to define his rights under the registration.

(b) A disclaimer under this section shall not affect any rights of the proprietor of the trade mark except such as arise out of the registration of the mark.

Cancellation of applications.

22. (a) Where the applicant has not complied with a demand of the Registrar within the time prescribed by him, and the Registrar has given the applicant notice in writing on the prescribed form, and three months have passed from the date of the notice and the applicant has still not complied with the demand, the Registrar may regard the application as void.

(b) The Registrar may extend the times prescribed under this section if he has been requested to do so in the manner and within the time prescribed by regulations and the applicant has given reasonable grounds for the request.

Advertisement

23. When an application has been accepted, whether absolutely or subject to conditions or limitations, the Registrar shall, as soon as possible after such acceptance and advertise the application, as accepted, in the prescribed manner, specifying every condition and limitation subject to which it has been accepted.

Opposition.

24. (a) Any person may within three months, from the date of the advertisement, file with the Registrar a notice of opposition to the registration of the mark.

(a1) the following are causes for opposition to the registration of a mark:

(1) there is a reason for which the registrar may, under the provisions of this Ordinance, refuse the application for registration;

(2) the opponent claims that he is the owner of the mark;

(b) The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(c) The Registrar shall send a copy of the notice to the applicant.

(d) The applicant shall send to the Registrar, in the prescribed manner and within the prescribed time, a counter statement to the opposition, setting forth the grounds on which he relies for his application.

(e) If the applicant does not send a counterstatement as aforesaid, he shall be deemed to have abandoned his application.

(f) If the applicant sends a counterstatement, the Registrar shall furnish a copy thereof to the person who has given notice of opposition and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions, registration is to be permitted.

25. (a) A decision of the Registrar under section 24(f) shall be subject to appeal to the Supreme Court.

two) An appeal under this section shall be made within thirty days from the date of the decision of the Registrar.

(b1) The appellant shall notify the Registrar of the filing of an appeal under this section within 30 days of the date of its filing. (c) In the appeal the Court shall, if required to do so, hear the parties and the Registrar and shall give a judgement determining whether, and subject to what conditions registration is to be permitted.

(d) During the hearing of the appeal any party may, either in the manner prescribed or by the special leave of the Court, bring forward further material for the consideration of the Court.

(e) The opponent or the Registrar may take no further grounds of opposition other than those stated by the opponent in the notice of opposition save by leave of the court which hears the appeal. Where any grounds are taken by leave as aforesaid, the applicant may on giving notice as prescribed withdraw his application without payment of costs of the opponent.

(f) The Court may, after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting its identity. A mark so modified shall be advertised in the prescribed manner before being registered.

26. When an application has been accepted and the time for notice of opposition has expired without there having been opposition or, there having been opposition, it has been decided in the favor of the applicant, the Registrar shall on payment of the prescribed fees, unless the application has been accepted in error or unless the Court otherwise directs, register the trade mark.

27. The date on which the application for registration of a trademark was filed shall be entered as the date of registration thereof.

28. On the registration of a trade mark, the Registrar shall issue to the applicant a certificate of registration in the prescribed form.

(a) Where separate applications are made by different persons to be registered as proprietors respectively of identical or similar to a misleading degree trademarks in respect of the same goods or description of goods, and the later application was filed before the acceptance of the prior application, the Registrar may refrain from registering any such persons until their rights have been determined accepting the applications until their respective rights have been determined by agreement between them approved by the Registrar. In the absence of such agreement or approval, the Registrar shall refer the dispute to the Supreme Court, decide, for reasons which shall be recorded, which application shall continue to be processed pursuant to the provisions of this Ordinance.

(b) The decision of the Registrar under subsection (a) may be appealed to the Supreme Court within thirty days of the date of the Registrar's decision.

30. (a) Where it appears to the Registrar that there is honest concurrent use, or where there are other special circumstances which in his opinion justify the registration of identical or similar trade marks for the same goods or description of goods by more than one proprietor, the Registrar may permit such registration subject to such conditions and limitations, if any as he may think fit. (b) A decision of the Registrar under subsection (a) shall be subject to appeal to the Supreme Court. The appeal shall be filled within thirty days from the date of the decision of the Registrar. In the appeal, the Court shall have all the powers conferred upon the Registrar under subsection (a).

CHAPTER FIVE:
DURATION AND RENEWAL OF REGISTRATION

31. The registration of a trade mark shall be valid for seven years ten years from the date of filing of the application and may be extended thereafter in accordance with the provisions of sections 32 to 35.

32. The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of such trade mark regarding some or all of the goods or classes of goods in respect of which it is registered for a period of ten years from the date of expiration of the original registration or the last renewal of registration such date hereinafter referred to as “expiration date”.

33. (a) At the prescribed time before the expiration date, the Registrar shall send notice in the prescribed manner to the registered proprietor of the date at which the registration will expire and the conditions as to payment of fees and other matters upon which registration will be renewed.

(b) If the fee is not paid within six months after the expiration date, (hereafter – the first period) the Registrar shall remove the trade mark from the Register; however:

(1) if the fee is paid within the first period said six months, it shall be increased by a prescribed amount;

(2) if the Registrar is satisfied that it is just to do so, he may on the request of the proprietor of the mark restore the registration, on such conditions as he may think fit, upon payment of the unpaid fee and the prescribed additional fee provided that the application was filed within six months after the termination of the first period.

34. Where a trade mark has been removed from the register for non-payment of the fee for renewal, such trade mark shall nevertheless, for the purpose of any application for registration during one year after such removal, be deemed to be registered trade mark.

35. The provisions of section 34 shall not apply where the Registrar is satisfied either (1) that there has been no bona fide trade use of the trade mark during the two years preceding the removal; or (

2) that no description or confusion would be likely to arise from the use of the trade mark, which is the subject of the application for registration by reason of any previous use of the trade mark which has been removed.

CHAPTER SIX:
CHANGES AND CANCELLATIONS

36. (a) The Registrar may, on request made in the prescribed manner by the registered proprietor

(1) correct any error in his name or address;

(2) enter any change in his name or address;

(3) strike out any goods or classes of goods from those for which the trade mark is registered;

(4) enter in respect of the trade mark any disclaimer or any memorandum which does not in any way extend the rights given by the existing registration.

(5) cancel the entry of the trade mark in the Register. (b) Any decision of the Registrar under subsection (a) shall be subject to appeal to the Supreme Court.

37. (a) The registered proprietor of any trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter such trade mark in any manner not substantially affecting its identity.

(b) The Registrar may refuse leave or may grant it subject to such conditions and limitation as he may think fit. Any such refusal or conditional or limited permission shall be appealable to the Supreme Court.

(c) If leave is granted, the trade mark as altered shall be advertised in the prescribed manner.

38. (a) Subject to the provisions of this Ordinance, any person aggrieved by the non-insertion or omission from the Register without sufficient cause, or by any entry wrongly remaining on the Register, or by any error or defect in any entry in the Register, may make application in the prescribed manner to the Supreme Court or may, at his option, make such application in the first instance to the Registrar.

(b) The Registrar may, at any stage of the proceedings refer the application to the Supreme Court, or he may, after hearing the parties, determine the question between them subject to appeal to the Supreme Court.

(c) The Supreme Court may, in the proceeding under this section, decide any question that it may be necessary or expedient to decide in connection with the rectification of the Register. (d) In the case of fraud in the registration, assignment or transmission of a registered mark, the Registrar may himself apply to the Court under the provisions of this section.

39. (a) An application under section 38 for the removal of a trade mark from the Register regarding some or all the goods or classes of goods in respect of which it is registered on the ground that it is not eligible for registration under sections 7 to 11 of the Ordinance, or on the ground that the mark creates an unfair competition in respect of the applicant's right in Israel, must be made within five years of the issue of the certificate of registration under section 28. (a1) Notwithstanding the provisions of subsection (a), an application for removal of a trade mark on the grounds that the application for registration of the mark was filed in bad faith may be filed at any time; (b) Notwithstanding the provisions of subsection (a) (1) a trade mark of a non-resident registered in the country of origin shall not be removed from the Register save on grounds which under section 16 preclude registration; (2) a trade mark of a non-resident which is not eligible for registration under the provisions of sections 8 to 11 and which

has been registered under the provision 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 to 11 when it is no longer registered in the country of origin; nothing in this provision shall prevent the proprietor of the mark from providing that at the time of application for removal the mark would have been eligible for registration upon application by a resident of Israel.

40. Where the Court orders the rectification of the Register, it shall direct that notice of the rectification shall be served upon the Registrar by the successful party, and the Registrar shall, upon receipt of the notice, rectify the Register in accordance with the order.

41. [a] Without prejudice to the generality of the provision of sections 38 to 40, application for the cancellation of the Registration of a trade mark regarding some or all of the goods or classes of goods in respect of which a trade mark is registered (hereinafter – goods regarding which the cancellation is requested) may be made by any person interested on the ground that there was no bona fide intention to use the trade mark in connection with the goods for which it is registered in connection with the goods regarding which there is a request to cancel the registration and that there has in fact been no bona fide use of the trade mark in connection with those goods in connection with the goods regarding which there is a request to cancel the registration, or that there had not been any such use during the three years preceding the application for cancellation.

[b] The provisions of subsection (a) shall not apply where it is proved that the non-use is due to special circumstances in the trade and not to any intention not to use, or to abandon, the mark in respect of the said goods.

[c] For the purpose of this section, there shall be deemed not to have been bona fide use of the trade mark in the event of any of the following

(1) use of the trade mark in Israel in advertising only whether in the local press or in foreign newspapers reaching Israel unless there are special circumstances which in the opinion of the Court or the Register justify the non-use of the mark on goods manufactured or sold in Israel.

(2) cancellation of an authorisation to use the mark given to a manufacturer in Israel under section 50 unless the authorisation is cancelled following an infringement of conditions or because the person who gave the authorisation intends himself to manufacture the goods for which the mark is to be used or to grant the authorisation to another manufacturer in Israel.

[d] Application for cancellation may be made in the prescribed manner either to the Supreme Court or, at the option of the applicant, may be made in the first instance to the Registrar.

[e] The Registrar may at any stage of the proceedings refer the application to the Supreme Court, or he may, after hearing the parties, determine the question between them subject to appeal to the Supreme Court.

[f] in this section, “use” of a trade mark shall include

[1] use of a registered trade mark by its proprietor or by an authorized person under section 50 in a manner that differs from that noted on the register in such a way as not to change the distinct character of the mark as it is registered;

[2] use by an authorized person under section 50 on condition that such use is subject to the control of the proprietor of the mark.

42. (a) In any legal proceeding in which the relief sought includes alteration or rectification of the Register, the Registrar shall have the right to appear and be heard and shall appear if so directed by the Court. (b) Unless otherwise directed by the Court, the Registrar in lieu of appearing and being heard may submit to the Court a statement in writing signed by him giving particulars of the proceedings before him or of the grounds of any decisions given by him in relation to the manner at issue or of the practice and procedure of the office in like cases or of other matters relevant to the issue, and within his knowledge as Registrar as he shall think fit, and a statement as aforesaid shall be deemed to be evidence in the proceeding.

43. The Registrar may, with the approval of the Minister of Justice, make such regulations, prescribe such forms and generally do such things as he thinks expedient for empowering him to amend the Register, whether by making or expunging or varying entries therein, so far as may be requisite for the purpose of adapting the designation therein of the goods of classes of goods in respect of which trade marks are registered to any substituted or amended classification they may be prescribed.

44. (a) The Registrar shall not, in exercise of any power conferred on him by section 43, make any amendment of the Register that would have the effect of adding any goods to those in respect of which a trade mark is registered (whether in one or in more classes) immediately before the amendment is to be made, or of antedating the registration of a trade in respect of any goods.

(b) The provisions of subsection (a) shall not have effect in relation to goods as to which the Registrar is satisfied that compliance with the said provisions would involve undue complexity and that the addition or the antedating would not affect any substantial quantity of goods and would not substantially prejudice the rights of any person.

45. (a) the Registrar shall notify any proposal for the amendment of the Register by virtue of his power under section 44 to the registered proprietor of the trade mark affected, and the registered proprietor may appeal against such proposals to the Supreme Court. The proposal, with any modifications, shall be advertised. (b) A person who considers himself aggrieved by the proposed amendment may oppose it before the Registrar on the ground that it contravenes the provisions of section 44, and the decision of the Registrar on the opposition shall be subjected to appeal to the Supreme Court.

CHAPTER SEVEN: **RIGHT OF PROPRIETOR OF TRADE MARK**

46. (a) Subject to any conditions of limitations entered in the Register, the valid registration of a person as proprietor of a trade mark shall give him the right to exclusive user of such trade mark upon, and in every matter relating to, the goods in respect of which it is registered.

(b) Where several persons are registered proprietors of the same goods, each of them shall have the same rights as if he were the sole registered proprietor of such trade mark shall be acquired by any one of such persons as against any other by the registration

thereof except in so far as their respective rights have been defined by the Registrar or the Supreme Court.

46A. (a) The proprietor of a well known trade mark, even if it is not registered trade mark, shall be entitled to the exclusive use of the mark in respect of the goods for which the mark is well known in Israel or in respect of goods of the same description.

(b) The proprietor of a well known trade mark that is a registered trade mark shall also be entitled to the exclusive use of that mark in respect of goods which are not of the same description if use of that mark by a person other than the proprietor would be likely to indicate a connection between the said goods and the registered proprietor of the mark, and the registered proprietor is likely to be damaged by such use.

46B. A mark that is not a registered trade mark shall be considered, for the purposes of goods shown at an official or officially recognized international exhibition held in Israel, as a registered mark for the duration of the term in which the exhibition is held.

47. Registration under this Ordinance shall not prevent any genuine use by a person of his own name or the name of his business or the geographic of his place of business, name of the place of business or the name of the place of business of any of his predecessors in business or the use by any person of any genuine description of quality of his goods.

48. [a] A registered trade mark may be assigned by the proprietor thereof, or pass by operation of law regarding some or all of the goods or classes of goods for which it is registered, either with or without the goodwill of the business concerned in the goods for which it has been registered. However, the Registrar may refuse to register a transfer as aforesaid if, in his opinion, the mark by the transferee is likely to deceive the public or, in his opinion, the transfer is contrary to public order. [b] For the purpose of subsection (a), a pending application for the registration of a trademark shall be treated as if it were a registered trademark.

49. [a] Where a person becomes entitled to a registered trade mark by assignment or by operation of law, he shall apply to the Registrar to register his title and the Registrar shall, on proof of title to his satisfaction, register him as the proprietor of the trade mark and shall make entry in the Register, in the manner prescribed, of the transfer or of any instrument relating to the title. [b] Any decision of the Registrar under this section shall be subject to appeal to the Supreme Court. [c] Except in cases of appeals under this section, a document or instrument in respect of which no entry has been made in the Register under this section shall not be admitted in evidence in any court in proof of the title to a trade mark unless the Court otherwise directs.

50. (a) The proprietor of a registered trade mark may authorize another person (in this ordinance referred to as an “authorized person”) to use such trade mark in relation to all or any of the goods in respect of which it is registered. (b) An authorization shall not be valid unless it has been registered under the provisions of this section, and the Registrar may register it subject to such conditions and limitations as he may think fit. (c) So long as the authorized person uses the mark in relation to the goods, in the course of his business, in accordance with the authorization and subject to any conditions and limitations attached thereto, his use of the mark shall be deemed to be exclusive use

thereof by the proprietor thereof. (d) The Registrar may register an authorization if it has been proved to his satisfaction that the use of the trade mark in relation to the goods in respect of which registration is applied for is not contrary to public order and is not likely to deceive.

51. (a) An application, in the prescribed form, for the registration of an authorization shall be submitted by the proprietor of the mark and by the person to be registered as the authorized person and shall indicate, inter alia

(1) the relationship between the proprietor of the mark and the person to be registered as the authorized person, including the extent of the control of the proprietor of the mark over the use thereof by the authorized person;

(2) the goods in respect of which the authorization is sought;

(3) the conditions of limitations which are to apply to use of the mark by virtue of the authorization if the same is registered;

(4) the period of validity of the authorization if its registration is requested for a determinate period. (b) The Registrar may demand any document, evidence or particular which appear to him to be useful in determining the application. (c) Particulars as referred to in subsections (a) and (b), other than particulars to be registered, shall not be open to inspection by the public.

Variation and cancellation of registration of authorization

52. (a) The Registrar may, on application by the proprietor of the mark in the prescribed form, vary the registration of an authorization, in regard to any matter relating to the goods to which the authorization applies and to the conditions and limitations to which it is subject. (b) The Registrar may cancel the registration of an authorization on application by the authorized person in the prescribed form. (c) The Registrar may cancel the registration of an authorization if he has been requested so to do and it has been proved to his satisfaction that the existence of the authorization, or the use of the trade mark by the authorized person, is contrary to public order or is likely to deceive it. (d) Before canceling an authorization or varying the conditions thereof under this section, the Registrar shall give every interest party an opportunity to be heard. (e) Where the registration of a mark has been cancelled or removed from the Register any authorization given in respect thereof shall be void. (f) The provisions of this section shall not derogate from the provisions of sections 38 to 49.

Continued use of a trademark

52A. Notwithstanding the provisions of this Ordinance, where an application for registration of a trademark is filed, or where a trade mark has been registered in good faith, or where rights to a trade mark have been acquired through use in good faith, neither the eligibility of the mark for registration, the validity of the registration, nor the right to use such trade mark, shall not be prejudiced for the sole reason that the trade mark is identical or similar to a geographical indication or to a well known trade mark, provided that the application for registration of the trade mark, the registration of the trade mark or the acquisition of rights through use as aforesaid were effected prior to –
1) in the case of a well known trade mark -the day on which the trade mark become a well known trade mark; 2) in the case of a geographical indication -1 January 2000, or

the date on which the geographical indication became protected in the member state in which the geographical area indicated by the geographical indication is situated.

Right of Appeal

53. Decisions by the Registrar under sections 50 to 52 shall be subject to appeal to the Supreme Court.

CHAPTER EIGHT: **REGISTRATION OF FOREIGN TRADE MARKS**

54. (a) If the Government has signed an agreement with the government of a foreign state for mutual protection of Trade marks, and the Minister of Foreign Affairs has notified such fact, then so long as the agreement is in force, any person who has applied for protection for a trade mark in that state, or his legal representative or assignee shall be entitled to registration of his trade mark under this Ordinance in priority to other applicants, provided he filled his application within six months from the date on which he applied for protection in the foreign state. (b) The provisions of subsection (a) shall not entitle the proprietor of the trade mark to recover damages for infringements which occurred prior to the date on which his trade mark was actually registered in Israel. (c) The registration of a trade mark shall not be invalidated by reason only of its use in Israel during the six-months period referred to in subsection (a).

Priority Rights

55. (a) A person person or a person who preceded him in proprietorship who has filed an application for the registration of a trade mark in a Member State, or the legal successor of such a person, (in this section – a prior application) may apply for the registration of the mark in Israel under the provisions of this section, and his application and request that his application shall have priority over any application for registration filed after the date of filing of the application abroad the prior application, provided that the following two conditions are satisfied:”

(1) The request for priority was filed together with the application for registration of a trade mark in Israel;

(2) The application for registration of a trade mark in Israel was filed within six months of the filing date of the earliest prior application.

[b] An application for registration under subsection (a) shall be filed within six months from the date of filing of the first application for registration of the mark. A request for priority may be made with regard to some or all of the goods or classes of goods that were included in the application for the registration of a trade-mark in Israel, and having been made, that priority request will be subject to the provisions of subsection (a) in respect of that claim.

[b1] Where the request for priority under the provisions of subsection (a) was based on more than one prior application, and priority was requested on the basis of each of those applications, the provisions of subsection (a) shall apply to the goods or classes of goods regarding which the registration of a trade mark was requested, in accordance

with the date of the earliest prior application relating to said goods or class of goods, respectively.

[b2] Where the request for priority was based upon part of a prior application, the provisions of section (a) shall apply as if that same part had been filed for registration abroad in a separate prior application

[c] The provisions of this section shall not confer a right to damages for an infringement committed before the date of filing of the application for registration of the mark in Israel.

Filing of an Application

56. An application for registration of a trade mark under section 54 or 55 shall be made in the same manner as an ordinary application under this Ordinance.

Chapter H-1: International Applications

Article One: Definitions

This chapter will come into force three months after accession to the Madrid Protocol.

Definitions

56A In this chapter –“registered holder of an international trade mark – a person in whose name an international trade mark is registered;

“international application” – an application for the registration of a trade mark as an international trade mark filed with the International Bureau pursuant to Articles 2 (2) and 3 of the Protocol;

“international application designating Israel” – an international application in which the applicant stipulates Israel as a destination for the registration of the trade mark;

“application for extension” – an application for extension of the registration of a trade mark as an international trade mark filed in the International Bureau under Article 3ter(2) of the Protocol, in which the applicant designates an additional Contracting State, that had not been indicated in the prior international application, as a destination for the registration of the trade mark;

“application for extension designating Israel”-an application for extension in which the applicant stipulates Israel as a destination for the registration of the trade mark.

“application designating Israel” – an international application that designates Israel, or an application for extension that designates Israel;

“Madrid Agreement” – the Madrid Agreement (Stockholm) within the meaning of Article 1 of the Protocol;

“the International Bureau” – as in Article 11 of the Protocol;

“the International Register” – as in Article 2 (1) of the Protocol;

“the Protocol”* -the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks as signed in Madrid on 27 June 1989; the term “Marks” as used in the aforesaid agreements should be understood as relating to “trade marks”;

“Contracting State” – a state or inter-governmental organization which is a party to the Protocol pursuant to Article 1 thereof;

“office of origin” – an office of a contracting state as defined in section 2(2) of the Protocol, in which an international application or an application for extension is filed;

“Madrid Regulations”* – the regulations common to the Madrid Agreement and the Protocol, as in force on 1 July 2001, in accordance with the amendment of those Regulations as specified in the attached Schedule.

Article Two: International Applications Originating in Israel

The Registrar as an office of origin

(a) The Registrar shall serve as an office of origin in respect of international applications and extension applications which do not designate Israel, which are filed under the provisions of section 56C.

(b) The Registrar is responsible for the processing of the applications referred to in subsection (a) and their transmission to the International Bureau; for purposes of this paragraph the provisions of this sub-chapter shall apply, and with respect to in any relevant matter not addressed by this sub-chapter, the provisions of the Madrid Protocol and Regulations shall apply.

Filing of an international application or extension application.

An Israeli citizen, Israeli resident or person who has an active industrial or commercial concern in Israel, who has filed an application to register a trade mark in Israel as a national trade mark, or who is the holder of a national trade mark, may file with the Registrar, in his capacity as an office of origin, on the basis of the application or registration as stated, and in accordance with the provisions of this chapter

(1) an international application that does not designate Israel;

(2) an extension application that does not designate Israel, provided that the applicant is the holder of an international trademark.

The Registrar’s notifications to the international bureau

Where the Registrar has transmitted to the International Bureau an international application, he shall notify the International Bureau of each of the following, in accordance with the provisions of this chapter:

(1) A final decision regarding the basic application, under sections 18 or 22 concerning its dismissal, cancellation, or acceptance subject to conditions, amendment or modification or restrictions, provided that the proceeding which culminated in such decision was commenced prior to the determining date;

(2) A final judgment given on appeal pursuant to section 19, provided that the proceedings culminating in the decision on appeal were commenced prior to the determining date;

(3) A final decision or judgment prohibiting the registration of a mark in respect of some or all of the goods or class of goods in respect of which the application was made, provided that said decision or judgment was given in consequence of a notice of opposition filed pursuant to the provisions of section 24 prior to the determining date

opposing the registration of the trade mark as a national trade mark in accordance with the basic application.

(4) The basic registration expired prior to the determining date and was not renewed pursuant to the provisions of sections 32 and 33.

(5) A decision regarding the striking or the cancellation of the basic registration or of goods or classes of goods indicated in that registration, pursuant to an application filed by the registered holder of the trade mark pursuant to the provisions of section 36 prior to the determining date.

(6) A final decision or a final judgment, regarding the striking or cancellation of the basic registration or of some or all of the goods or classes of goods indicated in said basic registration, resulting from an application filed in accordance with the provisions of sections 39 or 41 prior to the determining date;

(7) Additional matters determined by the Minister of Justice in accordance with the provisions of the Protocol and Madrid Regulations.

In this section –

“The basic application” – the application for the registration of a trade mark in Israel as a national trademark upon which an international application is based.

“The determining date” – a date later than five years after the international registration of the trade mark;

“the basic registration” – a national trade mark upon which the international application is based.

Article Three: International Applications Designating Israel

Application of Ordinance’s provisions to

56E. Where the Registrar received notification from the applications designating Israel International Bureau regarding the filing of an application designating Israel, he will assess the trade mark’s eligibility for registration, and the provisions of this Ordinance shall apply, mutatis mutandi and in accordance with the following changes:

(1) The provisions of section 17 shall not apply:

(2) With respect to section 24(c), the copy of the notice of opposition as stipulated in section 24(b) shall be sent to the International Bureau, according to the provisions of the Protocol and the Madrid Regulations within the period specified at the beginning of section 56F;

(3) With respect to registration in accordance with section 26, the Registrar shall record in the register that the trade mark is an international trade mark;

(4) Instead of the provisions of section 27, the following provisions shall apply: [a] The date of registration in the Register of an international trade mark registered in Israel, resulting from an international application designating Israel – shall be the date on which the international trade mark was registered in the International Register; [b] The date of registration in the Register of an international trade mark registered in Israel, resulting from an extension application designating Israel, will be the date on which the extension application was registered in the International Register;

Notification of refusal or of submission of opposition

Within 18 months of the day on which the application designating Israel was sent to the Registrar, he will deliver a notification to the International Bureau regarding each of the following, in accordance with the provisions of this chapter:

- (1) A decision holding that the trademark is not eligible for registration, or that the application can only be accepted subject to conditions, amendments, changes or restrictions, in accordance with the provisions of section 18;
- (2) The filing of an opposition to the registration of a trade-mark, or existence of the possibility that such an opposition may be filed even after the passage of the above 18 months. (b) Where the Registrar notified the International Bureau of the existence of the possibility that an opposition may be filed in accordance with the provisions of subsection (a)(2), he shall, within one month after the end of the period for filing such oppositions, notify the International Bureau of all oppositions filed during the aforesaid opposition period.

Registration of an international trade-mark

56G. Where the Registrar did not give notice to the International Bureau under section 56F within the periods stipulated therein, he shall register the trade mark in the Register and indicate therein that it is an international trade mark.

Notification of a final decision in an opposition

Where the Registrar has made a decision in the matter of an opposition the filing of which he had previously notified to the International Bureau under the provisions of section 56F (a) or (b), and where within 30 days of the date of said decision the Registrar has not received notification under section 25(b1) of the filing of an appeal of said decision, the Registrar shall notify his decision in the said opposition matter to the International Bureau; (b) Where an appeal under section 25 was filed against the Registrar's decision on an opposition, the Registrar shall inform the International Bureau of the final decision of the court hearing said appeal.

International trade-mark replacing national trademark

The registration of an international trade-mark in the Register under the provisions of this Article shall replace the registration of a national trade mark, for all purposes, if the following three conditions are met: (1) At the time of the filing of the application to the International Bureau designating Israel, the applicant applied for international trade mark was a national trade mark; (2) The international trade mark and the national trade mark are registered both in the International Register and the Register in the name of the same person; (3) The international mark is registered in the International Register in respect of Israel regarding all the goods in respect of which the national trade mark is registered. The replacement of the registration under the provisions of subsection (a) shall not derogate from rights acquired by reason of the registration of the national trade-mark. Where the registration of the national mark has been replaced by the registration of an international mark, it shall be recorded in the Register.

Application of Ordinance provisions to International Trade-marks

The provisions of this Ordinance regarding a registered trade mark shall apply to international trade-marks registered in Israel, mutatis mutandis, and in accordance with the following changes:

Regarding sections 31 and the concluding part of section 32, the extension of the validity or renewal of a registered trade mark shall be in accordance with the provisions of Articles 6(1), 7 and 8 of the Protocol and in accordance with the provisions of the Madrid Regulations;

(2) The provisions of sections 33, 36 and 37 shall not apply;

(3) (a) Regarding sections 49, 51 and 52 – applications for the registration of matters specified below shall be submitted either directly to the International Bureau or through the office of origin, all in accordance with the Madrid Regulations;

(1) Application for registration of a transfer arising under section 49(a) by either assignment or operation of law;

(2) Application for registration of authorized use under section 51(a);

(3) Application for the change of a registration regarding authorized use under section 52(a) or for the cancellation of such registration. (b) Where the Registrar has received notification from the International Bureau of the filing of one of applications specified in subparagraph (a), he shall decide said matter in accordance with the provisions of this Ordinance.

Notification of striking or cancellation of international trade mark

56K. The Registrar shall notify the International Bureau of any final decision or final judgment concerning the striking or cancellation of an international trade mark registered in Israel under the provisions of sections 39 or 41 in respect of some or all of the goods for which it was registered under the provisions of this chapter.

Consequences of deletion from international register or cancellation

Where the International Bureau notifies the Registrar of the striking or cancellation of an international registration from the international register, with regard to some or all of the goods or classes of goods in respect of which it is so registered, and where said international registration is also registered in the (Israel) Register, the Registrar shall strike or cancel the international registration in the Register, in respect of those goods or classes of goods that were struck or cancelled from the international register and so notified to the Registrar; The date of the striking or cancellation from the international register of said international registration shall be deemed to be the date of the striking or cancellation of said international registration from the Register;

The provisions of sub-paragraph (1) above shall also apply to a trade mark registered in the register under the provisions of section 16, and the provisions of section 39(b) shall not apply for that purpose.

(b) Where the International Bureau has notified the Registrar of the striking or cancellation of an international trade mark from the international register, regarding some or all of the goods in respect of which it had been registered, and where at that time there is a pending application designating Israel, the Registrar shall discontinue the

processing of said pending application in respect of the goods so notified as having been struck or cancelled from the international registration.

Replacement of international trade mark by national trade mark

Where an international trade mark was struck or cancelled from the International Register, pursuant to notification from the office of origin under Article 6(4) of the Protocol, with regard to some or all of the goods or classes of goods in respect of which it had been registered, and where within three months of the date of such striking or cancellation, the person who had been the holder of said international trade mark files an application for the registration of an identical trade mark as a national trade mark in respect the goods struck or cancelled from said international registration, the following provisions shall apply:

(1) Regarding an international trade mark registered in Israel, the registration of which in the Register had been struck or cancelled pursuant to the provisions of section 56L(a) – the Registrar shall register the trade mark in the Register as a national trade mark, in accordance with the application;

(2) (a) Regarding an application designating Israel which was published in accordance with the provisions of section 23 -the application for the registration of a national trade mark shall replace the application that designates Israel for all intents and purposes, and any opposition filed against the registration of the international trade mark shall be regarded as an opposition filed against the registration of the national trade mark; (b) Where the application designating Israel claimed priority under the provisions of section 55, said priority shall apply in respect of the application for the registration of the national trade mark. (3) The date of the registration of the national trade mark shall be as stated in section 56E(4).

CHAPTER NINE: **INFRINGEMENT**

57. (a) The proprietor of a registered trade mark or the proprietor of a well-known trade mark may bring an action for infringement; the Court shall not entertain an action for infringement in respect of an unregistered trade mark. However, in the case of a well-known trade mark, it may entertain an action for infringement of a mark even it is not registered.

58. In an action for infringement, evidence shall be admitted of the usages of the trade in respect of the get-up of the goods for which the trade mark is registered and of any trade marks is registered and of any trade marks or get-up legitimately used in connection with such goods by other persons.

59. (a) 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 dealing with the case is competent to grant and be entitled to the remedies set forth in section 59A; (b) for the purposes of an infringement relating to a well-known trade mark that is not a registered trade mark, the plaintiff shall be entitled to relief by way of injunction only;

Additional Remedies

59A. (a) The court may order, at the end of hearing the claim, one of the following:
[1] the destruction of goods produced during the performance of the infringement or which served in performing the infringement (in this section -“the goods”);
[2] where the plaintiff so requests, the transfer of ownership of the goods to the plaintiff, in consideration for payment of the value of them but for the infringement;
[3] on the doing of any other thing in respect of the goods.

However, the court shall not allow the defendant to possess the goods, even if the defendant has removed the infringing marks, except in extraordinary cases.

Italics indicate Madrid amendments.

[b] A party that files an application for the destruction of goods under this section shall notify the Israel Police Force of such in the manner prescribed by the Minister in the regulations, and the court shall not hear such an application without giving the Police an opportunity to make claims.

CHAPTER TEN: **PENALTIES**

60. (a) A person who commits any of the following acts shall be liable to imprisonment for a term of three years or a fine seven times the fine provided for in section 61(a)(4) of the Penal Law, 5737-1977 (hereinafter referred to as “the Penal Law”).

[1] applies for the purpose of trade, without the permission of the proprietor of the mark or any person acting on his behalf, a registered trade mark or an imitation of such mark, on goods in respect of which the mark is registered in the Register or on the packaging of such goods, and which is likely to mislead any other person in this manner;

[2] imports for the purpose of trade, without the permission of the proprietor of the mark or any person acting on his behalf, goods or their packaging marked by a trade mark registered in the Register in respect of such goods, or an imitation of the aforesaid mark, and the mark is likely to mislead any other person; however, the provisions of this paragraph shall not apply in respect of goods marked with the permission of any person who is the proprietor of the mark in the country in which the mark was made;

[3] engages in the sale, hire or distribution of goods marked or imported to Israel contrary to the provisions of paragraphs (1) and (2), or sells, lets for hire or distributes such goods on a commercial scale;

[4] is in possession of goods marked or imported to Israel contrary to the provisions of paragraphs (1) and (2) for the purposes of trading in such goods.

[b] Where an offence under subsection (a) is committed by a body corporate, such corporate body shall be liable to double the fine provided for the offence.

[c] A person passing on false information to the Registrar in connection with an application for registration of a mark in the Register shall be liable to imprisonment for a term of one year.

[d] [1] A senior officer of a body corporate shall be obliged to supervise and take any action necessary to prevent any of the offences set forth in this section (hereinafter

referred to as “an offence”) by a body corporate or any of its employees. Where such officer is in breach of his aforesaid obligation he shall be liable to the fine stated in section 61(a)(4) of the Penal Law.

[2] Where an offence has been committed by a body corporate or any of its employees, there is a presumption that the senior officer was in breach of his obligation under paragraph (1), unless it is proved that he took any action necessary to perform his aforesaid obligation.

[3] In this subsection, “senior officer” means an active manager of a body corporate, a partner -excluding a limited partner -and an officer responsible on behalf of the body corporate for the field in question in which the offence was committed.

Injunctions

61. After a conviction of an offence under section 60 the Court may in lieu or in addition to the prescribed penalties issue an injunction against a repetition of the offence.

Order for forfeiture or destruction

62. The court before which any person charged under section 60 is brought may order the forfeiture or destruction of any goods wrapping, packing or advertising material or blocks, dies and other apparatus and material for printing the marks or other materials in respect of which the offence was committed.

False representation of mark being registered

63. A person who represents a trade mark as registered which is not so registered shall be liable to a fine of 750 pounds for every offence. A person shall be deemed, for the purpose of this section, to represent that a trade mark is registered if he uses in connection with the trade mark the word “registered” or any word expressing or implying that registration has been obtained for the trade mark.

CHAPTER ELEVEN: **EVIDENCE AND PROCEDURE**

Registration to be evidence of validity

64. In all legal proceedings relating to a registered trade mark the fact that a person is registered as proprietor of such trade mark shall be prima facie evidence of the validity of the original registration of such trade mark and all subsequent assignments and transmissions of the same.

Certificate of Registrar

65. A certificate purporting to be under the hand of the Registrar

as to any entry or as to any thing which he is authorized by this Ordinance or regulations made there under to do shall be prima facie evidence of the entry having been made and of the contents thereof and of the thing having been done or not done.

Hearing of Applicant

66. Where any discretionary or other power is given to the Registrar by this Ordinance or regulations made there under, he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade mark without, if required by him within the prescribed time so to do, giving him an opportunity to be heard.

Evidence before Registrar

67. Subject to any regulation under this Ordinance, evidence in proceedings before the Registrar shall be by affidavit under section 15 of the Evidence Ordinance (New Version) 5732 -1971, or by declaration made abroad under the law of the place where it is made, so long as the Registrar does not otherwise direct; but the Registrar may, if he thinks fit, take oral testimony in lieu of or in addition of written evidence, and may permit the deponent or declarant to be cross-examined.

Powers of the Registrar with regard to witnesses.

68. The Registrar shall have the powers of a magistrate as to compelling a witness to attend before him and so hearing his testimony.

Costs

69. In every proceeding before him, the Registrar may award to a party such costs as he may consider reasonable.

Grant of notice to Customs Director

69A. (a) The proprietor of a registered trade mark whose rights have been infringed, or where there is a reasonable suspicion that they will be infringed, may give notice in writing to the Customs Director to the effect that he is the proprietor of the trade mark, and requesting the Director to delay releasing the goods that he claims are infringing goods and to treat them as goods the import of which is prohibited under the Customs Ordinance.

(b) A notice under sub-section (a) shall include one of the following: [1] An example of the original goods in respect of which the applicant has rights in the trade mark and in respect of which he gives notice of the importation of infringing goods; [2] A catalog or any other document that enables the Customs Director to compare original goods with the infringing goods.

(c) The proprietor of a registered trade mark shall provide the Customs Director with the following information, to the extent that he has knowledge of it: [1] The number of parcels to be received; [2] Sufficient notation of means of importation or the name of the ship bringing the infringing goods; [3] The date on which the infringing copies are meant to be received.

(d) The proprietor of the trade mark must provide the Customs Director with primary evidence, and a personal guarantee, as prescribed by the Customs Director, in order to cover all expenses connected with detaining goods, or in order to compensate for any damage caused as a result of the detaining of goods, should it become apparent that the detention of the goods was unjustified, and to pay any fee prescribed for this purpose in the Customs Ordinance.

(e) The provisions of this section shall not apply to infringing goods imported for personal use as defined in section 129 of the Customs Ordinance.

CHAPTER TWELVE: **FEES AND REGULATION**

Fees

70. There shall be paid in respect of applications, registrations and other matters under this Ordinance such fees as may be prescribed by the regulations.

Regulations by Minister

71. [a] The Minister of Justice may make regulations prescribing procedure in appeals, oppositions applications and references to the Supreme Court, under this Ordinance. [b] The Minister may enact regulations in any matter regarding the implementation of Chapter H-1, provided that in any matter for which there are provisions in the Protocol or the Madrid Regulations, the regulations shall be enacted in conformance with the Protocol and the Madrid Regulations.

71A. The Minister may, by Order, amend the Schedule.

Regulations by Registrar

72. Subject to the provisions of this Ordinance, the Registrar may, with the approval of the Minister of Justice, make regulations prescribe forms and generally do such things as he may think expedient

- (a) for regulating the practice under this Ordinance;
- (b) for prescribing the fees payable under this Ordinance;
- (c) for classifying goods for the purpose of registration of trade marks;
- (d) for making or requiring duplicates of trade marks and other documents;
- (e) for securing and regulating the publishing and selling or distributing in such a manner as the Registrar thinks fit, of copies of trade marks and other documents;
- (f) for regulating every other item of the business of the office in relation to trade marks and every other matter placed by this Ordinance under the control of the Registrar.

Schedule referred to in Section 56A (Periodic Amendments of the Madrid Regulations)

Commencement and application of Madrid related amendments The commencement of this Law, apart from the provisions of sections 5, 25, 29, 31, 33 (b), 43, 59A(b), 71 and

72 of the Ordinance as set forth in sections 3, 8, 10, 11, 13, 16, 20, 21 and 23 of this Law respectively, shall be three months after the date on which the State of Israel becomes a party to the Protocol (in this section – the commencement date); the Minister of Justice shall publish a notification of the date of joining in Reshumot; Said notice shall also be published on the web site of the Registrar of Trade Marks. The provisions of section 25 of the Ordinance, as worded in section 8 of this Law, shall also apply to an appeal filed prior to the day of the publication of this Law (hereinafter – the publication date), on which judgment had not been given – and for this purpose, the period of 30 days referred to in subsection (b1) of that section shall begin from the publication date. The provisions of section 29 of the Ordinance as worded in section 10 of this Law, shall also apply to applications which on the publication date had not yet been accepted, and which until that day had not been transferred to the Supreme Court. The provisions of section 31 of the Ordinance as worded in section 11 of this Law shall apply to the registration of a trade mark effected after the publication date. The provisions of section 33(b) of the Ordinance as worded in section 13 of this Law, shall also apply to a trade mark, where the expiry date of its registration as stipulated in section 32 of the Ordinance precedes the publication date, and provided that the period stipulated in paragraph (2) of that section is counted from the publication date.

The above indicated Madrid Related Amendments Published on August 6, 2003 in the Official Gazette “Sefer Hokim”, p. 1902.

End.

Source: World Intellectual Property Organization
<http://www.wipo.int>