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**Use of mark as part of trade name does not constitute use as a trademark**

Cancellation  
National procedures

**Israel - Gilat, Bareket & Co, Reinhold Cohn Group**

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In *Off Oz Industries (1991) Ltd v Off Tenne Meat Enterprises Ltd* (Application to strike mark No 169322, February 20 2011), the IP adjudicator has struck the device mark OFF TENNE, registered for meat and poultry products in Class 25 of the [Nice Classification](#), off the Trademarks Register on the grounds of non-use.

The trademark owner, Off Tenne Enterprises Ltd, operated a meat and poultry business until 1991, when it leased its factory to the applicant, Off Oz Industries (1991) Ltd, and granted it a non-exclusive licence to use the name *Off Tenne* (Hebrew for 'poultry basket') to sell poultry. The device mark was applied for in 2003 and registered in 2005, subject to a disclaimer of all the words except '*tenne*' ('basket'). Following a renewal of the lease, the applicant was authorised to use the name *tenne* to sell poultry for the term of the lease. The authorisation to use the mark was not recorded in the Trademarks Register. Pursuant to the lease of the factory, the trademark owner ceased to engage in the sale of poultry. Following a conflict between the parties and the termination of their contractual relationship, the tenant-licensee sought to have the mark cancelled on the grounds of non-use.

Under Section 41(a) of the [Trademarks Ordinance \(New Version\) 5732-1972](#), the registrar may, at the request of an interested person, cancel a trademark that has not been used during the three years preceding the application. However, a mark will not be cancelled if special circumstances in the trade prevented the owner from using it. Moreover, the registrar may decide to let the mark remain on the register if exceptional circumstances are shown.

The trademark owner argued that use of the mark within its corporate name constituted "use as a trademark". The IP adjudicator noted that such use could, in principle, constitute "use" for the purpose of Section 41 of the ordinance, provided that the company name is imprinted on the goods or services for which the mark is registered. In the present case, the trademark owner's evidence consisted of invoices for the rent of its factory. The IP adjudicator held that the trademark owner did not use the company name for the purpose of trade in the goods for which the mark was registered. Moreover, such use did not constitute use of the device mark at issue and, therefore, could not be considered as "use" for the purpose of Section 41.

The grant of a licence/franchise to use the name *Off Tenne* was also held not to constitute use of the mark by the owner in respect of the goods for which the mark was registered.

Use of the name *Off Tenne* by the applicant, which was licensed to use the name in connection with its lease of the premises, was held not to be attributable to the owner: under the provisions of the ordinance, only use by a registered authorised user is equivalent to use by the owner. Moreover, the owner did not prove that the applicant used the device mark as registered.

The IP adjudicator held that, where the party applying for cancellation is a former licensee relying on the non-recordal of its use, such circumstances may be considered to be extraordinary circumstances warranting the refusal of the application for cancellation. However, the circumstances of the present case were not extraordinary, as the authorisation to use the mark was not exclusive and did not preclude the owner from using its mark. Even if the authorisation had been registered, it was not shown that the licensee made use of the mark as registered. Further, the owner could have recorded the licence itself.

*David Gilat and Sonia Shnyder, Gilat Bareket & Co, Reinhold Cohn Group, Tel Aviv*

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