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Your Reference: 1868569  
Our Reference: 12903-TM114898CA01

## **RESPONSE**

The Registrar of Trade-marks  
Gatineau, Quebec

### **Attention: Judy Tom, Examination Section**

Dear Registrar:

**Re: Canadian Trade Mark Application**  
**Trademark: F1 Design**  
**Application No. 1868569**  
**Applicant: Formula One Licensing B.V.**



This is in reply to the Examiner's report dated January 7, 2019. The Examiner has raised several objections based on both technical and substantive grounds. These grounds are addressed individually below.

#### **1. Paragraph 30(a) Objection**

The Examiner has requested a statement in more specific terms of certain goods and services in the application. We attach a revised application wherein some of these terms have been redefined in ordinary commercial terms and others have been deleted. Given these amendments, we submit that the description of goods and services is now in compliance with the provisions of paragraph 30(a) of the *Act*.

#### **2. Paragraph 12(1)(d) Objection**

The Examiner has objected to registration of the subject mark on the basis that it is considered confusing with the registered trademark **F1 RACING & DESIGN** (TMA633014), pictured below, owned by Haymarket Magazines Limited covering "compilations of magazines in book form and or magazine articles in book form; periodical publications; magazines; journals; photographs; re-print articles of periodical publications; posters; stickers" and the publishing of such goods.

We respectfully request a six-month extension of time, until **January 7, 2020** to address the 12(1)(d) objection based on this mark as the parties have an existing commercial relationship and are discussing consent. As the Practice Notice dated June 17, 2019 states that the Office



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will generally grant an application one (1) extension of time to file a response (see <http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr04543.html>), we submit that this request is justified and look forward to receiving confirmation that this extension of time has been granted.

### **3. Objection Based on the *Canada Post Corporation Act***

The Examiner has raised an objection based on the *Canada Post Corporation Act* with respect to the goods and services described as postal stamps and postal services.

Enclosed is a revised trademark application wherein the following services have been deleted:

- Class 16: commemorative stamp sheets” and “postage stamps”
- Class 39: “postal services”

In view of this deletion, we respectfully submit that the objection should be withdrawn.

### **4. Objection Based on the *Bank Act***

The Examiner has raised an objection based on the *Bank Act* with respect to the services described as banking services.

Enclosed is a revised trademark application wherein the following services have been deleted from Class 36: “home banking services; private banking; banking services; banking services via the Internet or on any wireless electronic communication network; telephone banking services”.

In view of this deletion, we respectfully submit that the objection should be withdrawn.

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We look forward to receiving confirmation that the objections based on paragraph 30(a), the *Canada Post Corporation Act*, and the *Bank Act* have been withdrawn. We also look forward to receiving confirmation that an extension of time of six months, until January 7, 2020, has been granted to address the objection based on paragraph 12(1)(d).

Respectfully submitted,

BERESKIN & PARR LLP/S.E.N.C.R.L., s.r.l.  
Agent for the Applicant



Jonathan Colombo / Wynnie Chan

/jty

/ss

Encl.