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| 1 juin/Jun 2020 |
| *Votre référence Your File*  12903-TM114898CA01 |
| *Notre référence Our File*  1868569 |
| *Numéro EI IR Number* |

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| BERESKIN & PARR LLP/S.E.N.C.R.L., S.R.L.  SCOTIA PLAZA  40 KING STREET WEST  40th FLOOR  TORONTO  ONTARIO M5H 3Y2 | | |
| Attention: Wynnie Chan | | |
| RE: | Trademark: | F1 Design |
|  | Applicant: | Formula One Licensing B.V. |

This examiner's report concerns the above identified application. To avoid abandonment proceedings, a proper response must be received by this office by December 1, 2020. All correspondence respecting this application must indicate the file number.

Thank you for your correspondence dated April 3, 2020.

The objection raised pursuant to paragraph 12(1)(d) of the *Trademarks Act* is withdrawn.

The applicant’s comments have been reviewed; however, it is maintained that a statement in more specific terms of “**gloves for protection against accidents**” is required pursuant to pursuant to paragraph 30(2)(a) of the *Trademarks Act* and section 29 of the *Trademarks Regulations*.

The applicant has submitted that there are over 150 applications with the identical term that have proceeded to registration; however, the examiner is unable to assess those applications as there could be other wording that rendered those applications registrable. In the four specific registrations the applicant has submitted, it is submitted that MASKOON (TMA1063335) is not on par with the case at hand as it is further specified as “gloves for protection against accidents, namely, asbestos gloves for protection against accidents”. As such, although state of the register evidence may be used to establish a long-standing practice by the Registrar with respect to a particular word or phrase (*Thomas J. Lipton, Ltd.* v. *Salada Foods Ltd.* (No. 3) (1979), 45 C.P.R. (2d) 157), it is considered that the applicant has not demonstrated this in the present case.

In the present case, the examiner is of the opinion that the statement “gloves for protection against accidents” does not meet the three-part test in that it would provide the applicant a wide ambit of protection since it could include *asbestos gloves for protection against accidents* and *motorcycle gloves for protection against accidents* which are used in two very different trades.

While the term “gloves” is considered to be a pre-approved term in the *Goods and Services Manual*, it is respectfully submitted that “gloves” do not include *gloves for protection against accidents* and would be limited to apparel for casual or formal wear. Moreover, there is an *additional note* attached to the entry “gloves” in the *Goods and Services Manual* where it notes the following:

This entry reflects the most commonly understood meaning of gloves, i.e., a fitted covering for the hand for casual or formal wear. Other types of gloves can be found using the search function.

Having regard to the foregoing, the requirement raised pursuant to paragraph 30(2)(a) of the *Trademarks Act* and section 29 of the *Trademarks Regulations* is hereby maintained.

You are further advised that this application may be refused under subsection 37(1) of the *Trademarks Act* if your next response does not overcome all objections.

The applicant’s action and/or written comment is awaited.

Pursuant to paragraph 30(2)(a) of the *Trademarks Act*, an application for the registration of a trademark must contain a statement in ordinary commercial terms of the associated goods and services. Furthermore, section 29 of the *Trademarks Regulations* requires that the statement must describe each of those goods or services in a manner that identifies a specific good or service.  It is considered that the following **bolded goods and/or services** are not in specific and ordinary commercial terms.

In addition, pursuant to subsection 30(3) of the *Trademarks Act*, the application must group the goods and services according to the classes of the Nice Classification. The underlined goods and/or services appear to be improperly classed or require further specificity in order to group them according to the classes of the Nice Classification.

**Goods**

**Class**: 9

(5) …; **gloves for protection against accidents**; holograms; decorative magnets; printers for use with computers; laser speed detectors; doors alarms; cassette players; portable cassette players; portable CD players; CD players; mini-disc players; DVD players; MP3 players; contact lenses; eyeglasses; videotape recorders; computer carrying cases; windsocks for indicating wind direction; pressure gauges; digital maps; money counting and sorting machines; dictating machines; credit card reading machines; automatic teller machines (ATM); pressure sensors; microphones; modems; computer monitors; computers; solar panels; computer screens; plasma display panels; protective films adapted for computer screens; flat panel electroluminescent display screens; downloadable ringtones and graphic representations for cellular telephones; magnetic identification bracelets; central processing units; computer games; computer software for database management; electronic publications in the nature of books and periodicals; downloadable electronic books and periodicals; portable radios; computer mouse; audio-receivers and video-receivers; tire pressure gauges; clothing for protection against fire; semiconductors; simulators for the steering and control of vehicles; home theatre projectors, home theatre surround sound systems; computer software for editing, downloading, transmitting, receiving, creating, playing, extracting, encoding, decoding, displaying, storing and organizing **digital text**, computer graphics, digital photographs, electronic books and magazines; computer software, particularly software for transmission, recording, reproduction, visualization, organization, management, manipulation and review messages, **digital text**, digital photographs, movies, music and **electronic sounds** to facilitate communications between two or multiple users via the global computer network; ear plugs for divers; flash memory cards, secure digital (SD) memory cards; integrated circuit cards namely smart cards; magnetically encoded credit cards, magnetically encoded gift cards; identity cards, magnetically; magnetically encoded phone cards; blank integrated circuit cards; computer keyboards; keyboards for cellular telephones; facsimile machines; smartphones; portable telephones; electronic pocket translators; transceivers; cathode ray tubes; x-ray tubes for scanners; anti-glare glasses; safety goggles; sunglasses; computer disc drives; insulated clothing for protection against accidents or injury, irradiation and fire; video discs, video tapes, magnetic tapes, magnetic discs, DVDs, floppy discs, optical discs, compact discs, mini-discs, CD-ROMs, all the aforementioned being blank; video discs, video tapes, magnetic tapes, magnetic discs, DVDs, floppy discs, optical discs, compact discs, mini-discs, CD-ROMs, all the aforementioned being pre-recorded with music, movies or digital photographs; camcorders; video telephones; anti-dazzle shades; integrated circuits; fuel cells; video games

**Class**: 16

(9) …; ticket dispensers; plastic film for preserving foodstuffs; paperweights; paper clasps, clips; fountain pens; boxes for pens; holders for cheque books; event programs; booklets; colouring and drawing books; square rulers; paintings (pictures), framed or unframed; blank flip charts; felt-tip colouring pens; comic books; magazines (periodicals); sealing stamps; bookmarkers; envelopes (stationery); bookends; stationery cases, pen and pencil holders, writing paper holders, stands for writing implements, document file racks; photograph stands; stands for pens and pencils; inking pads; note cards; invitation cards; greeting cards; postcards; gift cards; thumbtacks; tissues of paper; ink; sporting event tickets; place mats of paper; towels of paper; towel wipes of paper; napkins of paper for removing make-up; travellers' cheques

**Class**: 32

(15) Mineral and aerated waters; fruit beverages and fruit juices; beers; syrups and powders mixes for making beverages; mineral and aerated waters; fruit and vegetable drinks; energy drinks; vitamin enriched water, vitamin enriched fruit juice; frozen fruit drinks; isotonic drinks; beers; non-alcoholic beers; ales; lagers; fruit and vegetable juices

**Services**

**Class**: 35

(1) Business administration; business management; advertising the wares and services of others; business administration services; advertising agencies- publicity agencies; financial sponsorship of sporting and cultural events and activities; compilation and recording of data at sports events and activities; …; retail store services featuring **sports-related equipment**, clothing, games, toys, **souvenirs**, **printed materials**, books, computer software, bags, **electronic devices**, eyeglasses, homewares, **personal care products**, perfumes, **household products**, fuels, lubricants, **tools**, vehicles, jewellery, stationery, furniture, luggage, sporting equipment, ear protectors, headphones, food, drinks; retail sale of interactive compact discs, CD-ROMs, and computer games; online retail services for interactive compact discs, CD-ROMs, and computer games; retail sale of food

**Class**: 38

(4) …; booking of seats for shows and sports events via a global computer network; telecommunication services, namely online retail sale by means of interactive communications with customers, namely providing electronic transmission of credit card transaction data and electronic payment data via a global computer network; teleconferencing services; mobile telephone services; videotext services and teletext services; paging services; providing access to websites offering digital music on the Internet via a global computer network or via wireless electronic communication devices; providing access to a multi-user network system giving information relating to betting and money games; providing access to a global computer network for the purpose of accessing online retail and wholesale store services; providing access to and leasing of access to **electronic bulletin boards** and online chat rooms in real time via a global computer network; providing access time to a global computer network (the Internet); providing internet access via a fibre-optic broadband network; providing access to global computer information networks for the transfer and dissemination of a wide range of information; providing online chat rooms for the transmission of messages, comments and multimedia content among users; cable television; transmission of data, namely **digital text**, digital photographs, computer graphics, **videos**, movies, music, and **electronic sounds** via satellite transmission, microwave transmission, or a global computer network; electronic transmission of **data** via mobile telephone, telephone, facsimile machine and telex; transmission of data, namely **digital text**, digital photographs, computer graphics, **videos** movies, music, and **electronic sounds** by fiber optic cable or wireless computer networks; streaming of audio and video via the Internet featuring music, movies, news, and sports; providing electronic mail and instant messaging services; transmission of text messages and digital photographs via a global computer network; transmission of digital music via the Internet or via any wireless electronic communication network; transmission of digital music via telecommunications; transmission of digital music via streaming websites; transmission of **web pages** via the Internet; facsimile transmission; on-line transmission of electronic publications, namely books and periodicals; real-time streaming of music and movies via the Internet; real-time streaming of digital music via mobile telephones; transmission and dissemination of television and radio programs via the Internet or via any wireless electronic communication network; simulcast broadcasting and uploading of film recordings and music and **videos**; simulcast broadcasting and uploading of interactive compact disks, CD-ROMs, computer programs containing musical sounds, entertainment-related audio, video, digital text and multimedia content, namely music, movies, television shows, music videos, news, sports and games and computer games; satellite television transmission

**Class**: 41

(6) Educational services in the field of automobile racing training; betting and gambling services on-line on the Internet or on any wireless electronic communication network; broadcasting of radio and television programs relating to sports and sporting events; …; entertainment services in the nature of customer reception services, namely for the provision of event hospitality services; videotape editing; entertainment services in the form of public viewing of live and delayed broadcast of sports events; entertainment services in the nature of live performances at motor sports events; information services in the field of motor sport and live performances; audio and video recording services; electronic computer game services provided by means of the Internet or mobile telephones; ticket reservation services for entertainment, sporting and cultural events; entertainment in the form of prize draws; leasing of performance venue space; translation services; photographic reporting of sports events; provision of statistical information relating to motor sport

**Class**: 42

(7) Design and development of computers and software; leasing of computers and computer software; upload, review and update of computer software for the electronic exchange of data and telecommunication networks for third parties; creation and maintenance of computer databases and software for database management; creating, compiling, maintaining and hosting internet web sites; design and development of wireless computer networks; design and development of computers and software; cloud computing provider services for general storage of data; installing and maintenance of computer software; **downloadable computer software** to enable users to create and share text, documents, pictures, photos, movies, maps and roadmaps; temporary provision of non downloadable computer software online allowing users to access programs with audio content, video, text and other multimedia content, namely music, concerts, movies, radio, television, news, sporting events, games, **cultural events, and entertainment-related programs**; …

With respect to the services “providing access to and leasing of access to **electronic bulletin boards** and online chat rooms in real time via a global computer network”, please clarify the contents of the *electronic bulletin boards*. By way of example, “providing access to and leasing of access to **electronic bulletin boards** in the field of sports and online chat rooms in real time via a global computer network” would be an acceptable amendement.

With respect to the services “transmission of **web pages** via the Internet”, please clarify the contents of the *web pages.* By way of example, “transmission of web pages of other via the Internet” would be an acceptable amendment.

With respect to the goods “**downloadable computer software** to enable users to create and share text, documents, pictures, photos, movies, maps and roadmaps”, it would appear that the services are goods. Please clarify. By way of example, “hosting **downloadable computer software** to enable users to create and share text, documents, pictures, photos, movies, maps and roadmaps” would be an acceptable amendment.

For further guidance on redefining the statements of goods or services, please refer to the *Goods and Services Manual* available on our website. This searchable tool is not an exhaustive list of acceptable terms, but it may be used as a guide to the specificity and ordinary commercial term requirements of the *Trademarks Act* and its *Regulations*.

The applicant is required to file an amended application, using the e-service on the CIPO website at [www.cipo.ic.gc.ca](http://www.cipo.ic.gc.ca/), by fax at 819-953-2476 or by mail at the following address:

Registrar of Trademarks

Place du Portage I

50 Victoria Street, room C-114

Gatineau, QC K1A 0C9

Upon satisfactory compliance with the above-mentioned requirement(s), further office action will be undertaken.

If the applicant has any specific questions in respect of this Office action, please contact the assigned examiner. Please note that for general inquiries, including assistance with filing of the revised application, queries about the status of an application or receipt of correspondence, you may contact our Client Service Centre toll free at 1-866-997-1936.

Yours truly,



Judy Tom

Examination Section

819-635-3407

fax: 819-953-2476