

In reply please quote our reference

Your reference : N.A.
Our reference : 2017/38262251697Q
Date : 28 December 2017
Writer's direct number : +65 6331 6582

WORLD INTELLECTUAL PROPERTY ORGANIZATION
INTERNATIONAL REGISTRATIONS DEPARTMENT
34, CHEMIN DES COLOMBETTES, 1211 GENEVA 20
SWITZERLAND

Dear Sir/Madam

NOTIFICATION OF PROVISIONAL REFUSAL OF PROTECTION TO THE INTERNATIONAL BUREAU OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION ACCORDING TO ARTICLE 5 OF THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

1. Office making the notification:

Intellectual Property Office of Singapore (IPOS)

2. International Registration Number:

1251408

3. Trade Mark Number(s) issued by the IPOS for this International Registration:

Trade Mark Number : 40201718395T

Class Number(s) : 09 AND 11

4. Name of holder of the International Registration:

INTERNET GROUP D.O.O.

5. Ground(s) of the Provisional Refusal:

Provisions of Singapore Law: The relevant provisions of Singapore law are attached.

5.1 Section 8(2)(b)

The mark is objectionable under section 8(2)(b) of the Trade Marks Act (Cap. 332, 2005 Rev. Ed.) which states that a trade mark shall not be registered if because it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public.

The mark is in conflict with the following trade mark(s) in respect of the indicated class(es):

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S.No	Cited Trade Mark No	International Reg No	Mark Status	Trade Mark	Subject Class No Objected To
1	40201605826U		Pending (Under Examination)	TESLA	09
2	40201605828W		Registered	TESLA	09

The subject mark is thought to closely resemble the cited marks 40201605826U and 40201605828W as all three marks share the same distinctive word "Tesla".

While the word "Tesla" in the subject mark and cited mark 40201605828W may be represented in a stylised fashion, the primary identity of the marks still rests in the term "Tesla" with which consumers would identify as the source of the goods concerned. Hence, we believe that consumers are likely to find that the subject mark and cited earlier marks are alike.

As for the goods offered by the Applicant in Class 9 such as "computer programs [downloadable software] not intended for use in vehicles and energy storage systems; downloadable computer software applications not intended for use in vehicles and energy storage systems; recorded computer operating system programs not intended for use in vehicles and energy storage systems; recorded computer programs not intended for use in vehicles and energy storage systems; software [recorded programs] not intended for use in vehicles and energy storage systems", they are found to be similar to and overlap with those offered in Class 9 under the cited marks such as "computer software for monitoring, optimizing and regulating the storage, transmission and discharge of energy to and from such electric battery systems".

Taking the above similarities in the marks and goods offered under the respective marks, we take the view that average consumers are likely to be confused about the commercial origin of the goods. As a result, they could mistakenly believe that the goods all originate from the same source when they do not.

5.2 How to overcome our objection(s) under section 8(2)(b)

You may consider the following options:

- (a) Remove the conflicting goods and/or services; or
- (b) Obtain a letter of consent from the cited proprietor; or
- (c) File evidence to show honest concurrent use in Singapore.

In other words, you may file evidence to show that before the date of this application, your mark has been put to use for the goods and/or services applied for at the same time as the cited mark(s) according to honest practices in commercial and industrial standards. This evidence may show that the public is used to distinguishing between your mark and the cited mark(s) and there is no likelihood of confusion in the public.

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The evidence should show concurrent use of your mark and the cited mark(s) for a period of at least 5 years before the date of this application. The evidence should be presented by way of a statutory declaration.

For guidance as to how the letter of consent or evidence of honest concurrent use should be presented, please refer to the Registry's web site at <http://goo.gl/a1CjVx>.

6. Goods and/or services affected by the refusal:

This refusal applies to all the goods in Class(es) 09 of the international registration.

7. Request for review:

The holder of the international registration may file a request for a review of this refusal with IPOS.

The request for review must comply with the following:

- (a) quote the International Registration number, relevant trade mark number(s), corresponding class number(s) and Singapore reference number(s).
- (b) furnish an address for service in Singapore. The holder may appoint an agent by filing Form CM1.

Please note that any form(s) filed with the International Bureau of the World Intellectual Property Organization in response to this refusal, will not be treated as a request for a review of this refusal unless the above has been complied with.

8. Extension of time:

The holder may seek an extension of time to request for a review of this refusal by filing Form CM5.

9. Deadline to observe:

If the holder does not file a request for review or apply for an extension of time to do so by **28 April 2018**, the application for the refused goods and/or services indicated in paragraph 6 of this refusal will be treated as withdrawn (reinstatable). Please refer to paragraph 10 on reinstatement of an application that is treated as withdrawn (reinstatable).

10. Reinstatement of an application that is treated as withdrawn (reinstatable):

If the application for the refused goods and/or services indicated in paragraph 6 of this refusal becomes treated as withdrawn (reinstatable), the holder may request to reinstate the application by filing Form CM13 together with the request for review within six months from the deadline in paragraph 9.

Please note that reinstatement is not automatic. Reinstatement will be allowed only after we have conducted a new conflicting mark search and are satisfied that the mark to be reinstated does not conflict with any trade mark applications filed with IPOS prior to the filing of the required documents.

If the holder also does not request to reinstate the application in time, the application for goods and/or services that are not refused will proceed to publication.

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11. Forms and fees:

The forms referred to in this provisional refusal and the relevant fees may be found at <https://www.ip2.sg/>.

12. Further refusal of protection:

Please note that a further refusal of protection may result from an opposition, which may be filed after the expiry of 18 months from the date on which the Intellectual Property Office of Singapore was notified of the international registration. This applies to all goods and/or services claimed in the international registration.

This refusal is issued by:

Ms Jackie Tan Meng Joek
Trade Mark Examiner
for Registrar of Trade Marks
Singapore

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51 Bras Basah Road
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PROVISIONS OF SINGAPORE LAW

TRADE MARKS ACT

(CHAPTER 332)

Section 2(1) Interpretation

"earlier trade mark" means –

- (a) a registered trade mark or international trade mark (Singapore), the application for registration of which was made earlier than the trade mark in question, taking account
(where appropriate) of the priorities claimed in respect of the trade marks; or
- (b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was a well known trade mark,

and includes a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) subject to its being so registered.

"sign" includes any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, aspect of packaging or any combination thereof.

"trade mark" means any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person.

Section 8 Relative grounds for refusal of registration

(2) A trade mark shall not be registered if because –

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected; or
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,


there exists a likelihood of confusion on the part of the public.

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CITED MARK DETAILS

Trade Mark No. 40201605828W	
National	
<p>Application Type Trade Mark Trade Mark Type Conventional Mark Description of Particular Feature(s) of Mark Converted Application No Application Date 1 April 2016 Mark Status (unless otherwise indicated below) Registered Mark Status Date 1 April 2016 Status Update Date 6 October 2017 Date of Completion of Registration Procedure 6 October 2017 Expiry Date (unless otherwise indicated below) 1 April 2026 Publication Date 28 July 2017 Transformation Application under Madrid Protocol Replacement Application under Madrid Protocol</p>	
Basic Mark on which IA is based	
International Application No. International Registration No.	
Specification of Goods or Services	
<p>1) Class Number Class 09 Goods/Services Electric battery system and equipment for storage and supply of electricity to entire dwellings, buildings, and man-made fixtures; electric battery system and equipment for use in the storage, supply, transmission and stabilization of electricity supplied by or to an electric power grid or other source of electric power generation; computer software for monitoring, optimizing and regulating the storage, transmission and discharge of energy to and from such electric battery systems. Class Status Registered Class Expiry Date 1 April 2026</p>	
<p>2) Class Number Class 36 Goods/Services Financial leasing services in relation to electric battery systems for the storage, discharge, supply, transmission and stabilization of electricity; financing services relating to electric battery systems for the storage, discharge, supply, transmission and stabilization of electricity. Class Status Registered Class Expiry Date 1 April 2026</p>	

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3) Class Number Class 37 Goods/Services Installation, integration, maintenance and repair and upgrading of electric battery systems, and consulting related thereto, for the storage, discharge, supply, transmission and stabilization of electricity. Class Status Registered Class Expiry Date 1 April 2026
4) Class Number Class 42 Goods/Services Monitoring of electric battery systems for storing and supplying electricity. Class Status Registered Class Expiry Date 1 April 2026
Current Applicant or Proprietor Details
1) Name TESLA, INC. UEN/Company Code E00466970A Country of Incorporation United States of America State of Incorporation Delaware Address 3500 Deer Creek Road, Palo Alto, California 94304, United States of America
Agent/Correspondence Details
1) Agent Name DREW & NAPIER LLC UEN/Company Code 200102509E Representative Name Address For Service 10 COLLYER QUAY #10-01 OCEAN FINANCIAL CENTRE Singapore 049315 Action Representing For all matters relating to the application, registration/grant, except those matters expressly excluded

Trade Mark No. 40201605826U	
National	
Application Type Trade Mark Trade Mark Type Conventional Mark Description of Particular Feature(s) of Mark Converted Application No Application Date 1 April 2016 Mark Status (unless otherwise indicated below) Pending (Under Examination) Mark Status Date 8 April 2016 Status Update Date 8 April 2016	

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2) Class Number Class 36 Goods/Services Leasing services relating to electric battery systems for the storage, discharge, supply, transmission and stabilization of electricity; financing services relating to electric battery systems for the storage, discharge, supply, transmission and stabilization of electricity. Class Status Pending (Under Examination)
3) Class Number Class 37 Goods/Services Installation, integration, maintenance and repair and upgrading of electric battery systems, and consulting related thereto, for the storage, discharge, supply, transmission and stabilization of electricity. Class Status Pending (Under Examination)
4) Class Number Class 42 Goods/Services Monitoring of electric battery systems for storing and supplying electricity; operating, maintaining, optimizing and regulating electric battery systems for storage, discharge, supply, transmission and stabilization of electricity, and consulting services related thereto. Class Status Pending (Under Examination)
Current Applicant or Proprietor Details
1) Name TESLA, INC. UEN/Company Code E00466970A Country of Incorporation United States of America State of Incorporation Delaware

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Address 3500 Deer Creek Road, Palo Alto, California 94304, United States of America

Agent/Correspondence Details

1) Agent Name DREW & NAPIER LLC
UEN/Company Code 200102509E
Representative Name
Address For Service 10 COLLYER QUAY
#10-01 OCEAN FINANCIAL CENTRE
Singapore 049315
Action Representing For all matters relating to the application, registration/grant, except those matters expressly excluded

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