IPOS
INTELLECTUAL PROPERTY
OFFICE OF SINGAPORE

In reply please quote our reference
Your reference : N.A.
Our reference : 2018/3888089417P
Date : 19 January 2018
Writer's direct number : +65 6330 2731

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:**

   1368861

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

   Trade Mark Number : 40201719944U

   Class Number(s) : 09 AND 42

4. **Name of holder of the International Registration:**

   BIO-RAD MEDICAL DIAGNOSTICS GMBH

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.

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Singapore 189554

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

S.No	Cited Trade Mark No	International Reg No	Mark Status	Trade Mark	Subject Class No Objected To
1	T1414200A	1215369	Registered	IH-Web Stay Connected	09

The above mark is cited because it is similar to the subject mark and the goods belonging to the cited proprietor, Bio-Rad Laboratories SAS, overlap with the goods being claimed by the applicant in Class 09.

The marks are similar in that both contain "IH-WEB" which is likely to be the dominant element by which the average consumers will identify the trade origin. The additional phrase "Stay Connected" in the cited mark will merely be regarded as an extension to the mark "IH-WEB" and does not help to differentiate between the two marks.

In light of the above, we are of the view that there exists real likelihood that a substantial portion of the target consumers of the applicant's goods would be confused in the sense that they would think that the applicant and cited proprietor are related or have business links between them.

Hence, we believe that an objection under Section 8(2)(b) is established.

5.2 **How to overcome our objection(s) under section 8(2)(a) and/or (b)**

You may consider the following options:

(a) Obtain a letter of consent from the cited proprietor; or

(b) 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.

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 **19 May 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.

11. **Forms and fees:**

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

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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 Pang Hui Jiun
Assistant Registrar
for Registrar of Trade Marks
Singapore

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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.

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. **T1414200A**	Wi-Web Stay Connected

International Registration Designating Singapore

International Registration No.	1215369
Date of International Registration	12 June 2014
Date of Notification of International Registration	4 September 2014
Subsequent Designation No.	
Date of Subsequent Designation	
Date of Notification of Subsequent Designation	4 September 2014
Date of Completion of Registration Procedure	27 May 2015
Transformation Application under Madrid Protocol	
Replacement Application under Madrid Protocol	
Application Type	Trade Mark
Trade Mark Type	Conventional Mark
Description of Particular Feature(s) of Mark	
Converted Application	No
Filing Date	12 June 2014
Mark Status (unless otherwise indicated below)	Registered
Mark Status Date	12 June 2014
Status Update Date	27 May 2015
Expiry Date (unless otherwise indicated below)	12 June 2024
Publication Date	20 March 2015

Basic Mark on which IA is based

International Application No.	
International Registration No.	

Specification of Goods or Services

1) Class Number	Class 09
Goods/Services	Apparatus and instruments for in-vitro diagnostics for scientific and/or industrial use; software for in-vitro diagnostics for scientific and/or industrial use; software for in-vitro diagnostics for medical, veterinary and/or research use; data processing software for in-vitro diagnostics for medical use; data processing software for in-vitro diagnostics for medical use for analyzing biological samples; instrument management software; instrument management software used for analyzing biological samples; software used for analyzing biological samples.
Class Status	Registered
Class Expiry Date	12 June 2024

2) Class Number	Class 10
Goods/Services	Apparatus and instruments for in-vitro diagnostics for medical use; laboratory apparatus and instruments for use in in-vitro diagnostics for medical, veterinary and/or research use; laboratory apparatus and instruments for use in in-vitro diagnostics for medical, veterinary and/or research use for analyzing biological samples.
Class Status	Registered
Class Expiry Date	12 June 2024

Current Applicant or Proprietor Details

1) Name	Bio-Rad Laboratories SAS
UEN/Company Code	MC027434E
Country of Incorporation	France
State of Incorporation	
Address	3 boulevard Raymond Poincare, F-92430 MARNES LA COQUETTE, France

Priority Details

1) Class No.	**09**
Priority Date	12 December 2013
Country	France
Goods/Services	All goods/services claimed in this application

2) Class No.	**10**
Priority Date	12 December 2013
Country	France
Goods/Services	All goods/services claimed in this application