

In reply please quote our reference

Your reference : N.A.  
Our reference : 2018/41908061603V  
Date : 17 April 2018  
Writer's direct number : +65 6330 2727

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:**

1387286

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

Trade Mark Number : 40201802176W

Class Number(s) : 07 AND 09

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

JOHNSON CONTROLS TECHNOLOGY COMPANY

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 | Name of proprietor    | Mark Status | Trade Mark     | Subject Class No Objected To |
|------|---------------------|-----------------------|-------------|----------------|------------------------------|
| 1    | T8305944D           | JOHNSON CONTROLS, INC | Registered  | <b>P E N N</b> | 09                           |

We are of the view that having a common word element "Penn" with no other free-standing element(s) within the marks at issue, they are considered as a whole, highly similar on the conceptual, visual and phonetic levels. This brings to a likelihood of confusion for the relevant public as to the source of the goods, which are also conflicting.

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

You may consider the following options:

- (a) Assign the marks in the name of a single entity; 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.

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>.

## 5.3 Specification of goods

We are raising objections under Rule 19(2)(b)(ii)(A) of the Trade Marks Rules for the following goods:

### Class 7:

- (a) *"Single-phase condenser fan speed control for refrigerator and air conditioning units".*

The above goods appear to be analogous to "electronic speed controllers" in Class 9. The

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current description therefore has to be specified with sufficient clarity and precision for acceptance in this Class. Please propose an alternative wording for our consideration.

(b) *“Variable speed drive controls for HVAC and refrigerator units”*.

The description is imprecise and the nature of the goods has to be specified with sufficient clarity and precision for acceptance. Please clarify the exact goods of intent.

(c) *“Electronic pressure transducers for refrigerator and air conditioning units”*.

The above goods appear to be analogous to “transducers” in Class 9. The current description therefore has to be specified with sufficient clarity and precision for acceptance in this Class. Please propose an alternative wording for our consideration.

Please note that no form or fee is required for an amendment to the specification of goods or services of an international registration designating Singapore.

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

This refusal applies to all the goods in Class(es) 07, 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 **17 August 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):**

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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/>.

**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 Corinne Yip  
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.

### TRADE MARKS RULES

#### Rule 19 Specification

(2) Every application form shall contain, for each class of goods or services to which the application relates -

(a) the class number as set out in the Nice Classification as in force on the date of that application; and

(b) a specification of those goods or services which -

(i) is appropriate to that class;

(ii) is described in such a manner as to -

(A) indicate clearly the nature of those goods or services; and

(B) allow those goods or services to be classified in accordance with the Nice Classification as in force on the date of that application; and

(iii) complies with any other requirement of the Registrar.

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**CITED MARK DETAILS**

|  |                |
|--|----------------|
| <b>Trade Mark No.</b><br>T8305944D   | <b>P E N N</b> |
| <b>National</b>  |                |
| <p align="center"><b>Application Type</b> Trade Mark<br/> <b>Trade Mark Type</b> Conventional Mark<br/> <b>Description of Particular Feature(s) of Mark</b><br/> <b>Converted Application</b> No<br/> <b>Application Date</b> 16 November 1983<br/> <b>Mark Status (unless otherwise indicated below)</b> Registered<br/> <b>Mark Status Date</b> 16 November 1983<br/> <b>Status Update Date</b> 31 March 2004<br/> <b>Date of Completion of Registration Procedure</b> 16 November 1990<br/> <b>Expiry Date (unless otherwise indicated below)</b> 16 November 2024<br/> <b>Publication Date</b> 23 June 1989<br/> <b>Transformation Application under Madrid Protocol</b><br/> <b>Replacement Application under Madrid Protocol</b></p> |                |
| <b>Basic Mark on which IA is based</b>   |                |
| <p align="center"><b>International Application No.</b><br/> <b>International Registration No.</b></p>  |                |
| <b>Specification of Goods or Services</b>  |                |
| <p align="center"><b>1) Class Number</b> Class 09<br/> <b>Goods/Services</b> Apparatus and instruments for surveillance, monitoring, signalling, checking and calculating data; electrical and electronic apparatus and instruments, all included in Class 9; electromechanical control apparatus and instruments, all included in Class 9; photographic, cinematographic, optical, measuring, signalling, checking (supervision) apparatus and instruments; calculating machines; burglar alarm.<br/> <b>Class Status</b> Registered<br/> <b>Class Expiry Date</b> 16 November 2024</p>   |                |
| <b>Current Applicant or Proprietor Details</b>   |                |
| <p align="center"><b>1) Name</b> JOHNSON CONTROLS, INC<br/> <b>UEN/Company Code</b> E00469810A<br/> <b>Country of Incorporation</b> United States of America<br/> <b>State of Incorporation</b> Wisconsin</p>  |                |

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**Address** 5757 North Green Bay Avenue, Milwaukee, Wisconsin 53209,  
United States of America

**Agent/Correspondence Details**

**1) Agent Name** RODYK IP

**UEN/Company Code** T07LL0439G

**Representative Name**

**Address For Service** P.O. BOX 462  
ROBINSON ROAD POST OFFICE  
Singapore 900912

**Action Representing** For all matters relating to the application, registration/grant, except those matters expressly excluded

**2) Agent Name** RODYK IP

**UEN/Company Code** T07LL0439G

**Representative Name**

**Address For Service** P.O. BOX 462  
ROBINSON ROAD POST OFFICE  
Singapore 900912

**Action Representing** Renewal

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