

In reply please quote our reference

Your reference : N.A.
Our reference : 2018/4283806449P
Date : 18 May 2018
Writer's direct number : +65 6331 6545

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:**

1387075

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

Trade Mark Number : 40201802161Q

Class Number(s) : 09, 37, 38, 41, 42 AND 45

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	International Reg No	Mark Status	Trade Mark	Subject Class No Objected To
1	T9109490C		Registered	METASYS	09

We take the view that the subject mark is similar to the cited mark as they share the same textual element "METASYS". The minor difference in font type would still give consumers the impression that the subject mark is an extension, line or version of the cited mark. Further, the applicant's goods overlap with the cited proprietor's goods in Class 9.

Taking into account the similarities of the marks and goods, we believe that it is likely that a substantial portion of the relevant public will be confused into thinking that the applicant's goods originate from the same economic source as the proprietor of the cited mark, or from a source which is economically linked to the proprietor of the cited mark.

In view of the above, 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>.

5.3 **Specification of goods and/or services**

We note that you have applied for protection of the mark for goods and/or services in various classes. However, we are raising objections under rule 19(2)(b)(ii)(A) of the Trade Marks Rules for the following goods and/or services:

Class 42

- (a) "computer services, namely, monitoring via electronically gathering, analyzing and formatting data and reporting to others on the performance of building, facility and

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plant controls, control devices, apparatus and systems, and building, facility and plant, automation and optimization devices, apparatus and systems to ensure proper functioning” – Please clarify as the description is vague. You may consider amending to “monitoring of computer systems to detect breakdowns via electronically gathering, analyzing and formatting data and reporting to others on the performance of building, facility and plant controls, control devices, apparatus and systems, and building, facility and plant, automation and optimization devices, apparatus and systems to ensure proper functioning” for clarity.

- (b) “technical support services, namely, 24/7 service desk or help desk services for IT infrastructure, operating systems, database systems related to building, facility, and plant controls, control devices, apparatus and systems, and building, facility and plant control, automation and optimization software, devices, apparatus and systems” – The description is vague as the subject matter of the technical support services is not specified. Please consider amending to “technical support services, namely, technical advice in the field of information technology provided via 24/7 service desk or help desk for IT infrastructure, operating systems, database systems related to building, facility, and plant controls, control devices, apparatus and systems, and building, facility and plant control, automation and optimization software, devices, apparatus and systems” for clarity.
- (c) “monitoring building, facility and plant automation and optimization systems to ensure proper functioning” – Please clarify as the description is vague. You may consider amending to “monitoring of computer systems to detect breakdowns in building, facility and plant automation and optimization systems to ensure proper functioning” for clarity.

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 9, “computer services, namely, monitoring via electronically gathering, analyzing and formatting data and reporting to others on the performance of building, facility and plant controls, control devices, apparatus and systems, and building, facility and plant, automation and optimization devices, apparatus and systems to ensure proper functioning”, “technical support services, namely, 24/7 service desk or help desk services for IT infrastructure, operating systems, database systems related to building, facility, and plant controls, control devices, apparatus and systems, and building, facility and plant control, automation and optimization software, devices, apparatus and systems” and “monitoring building, facility and plant automation and optimization systems to ensure proper functioning” in Class 42.

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.

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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 **18 September 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/>.

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 Yeo Li Ting
Assistant Registrar
for Registrar of Trade Marks

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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

(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is sought to be registered are identical with the goods or services for which the earlier trade mark is registered.

(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

Trade Mark No. T9109490C	METASYS
National	
<p align="center">Application Type Trade Mark Trade Mark Type Conventional Mark Description of Particular Feature(s) of Mark Converted Application No Application Date 21 October 1991 Mark Status (unless otherwise indicated below) Registered Mark Status Date 21 October 1991 Status Update Date 10 November 2001 Date of Completion of Registration Procedure Expiry Date (unless otherwise indicated below) 21 October 2021 Publication Date 11 July 1997 Transformation Application under Madrid Protocol Replacement Application under Madrid Protocol</p>	
Basic Mark on which IA is based	
<p align="center">International Application No. International Registration No.</p>	
Specification of Goods or Services	
<p align="center">1) Class Number Class 09 Goods/Services Electrical and electronic installations for the control of heating , air conditioning , ventilating , refrigeration , lighting , fire alarm and security access systems ; all being control of industrial operation ; parts and fittings of the aforesaid goods ; all included in Class 9. Class Status Registered Class Expiry Date 21 October 2021</p>	
Current Applicant or Proprietor Details	
<p align="center">1) Name Johnson Controls Technology Company UEN/Company Code E18003645Q Country of Incorporation United States of America State of Incorporation Michigan Address 2875 High Meadow Circle Auburn Hills, MI 48326-2773 United States of America</p>	
Mark Clauses	

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1) This application is accompanied by an application for the registration of a person as a registered user

Agent/Correspondence Details

1) Agent Name KHATTARWONG LLP
UEN/Company Code T12LL0001E
Representative Name
Address For Service 80 RAFFLES PLACE
#25-01 UOB PLAZA 1
Singapore 048624
Action Representing Transfer of ownership

2) Agent Name KHATTARWONG LLP
UEN/Company Code T12LL0001E
Representative Name
Address For Service 80 RAFFLES PLACE
#25-01 UOB PLAZA 1
Singapore 048624
Action Representing For all matters relating to the application, registration/grant, except those matters expressly excluded

3) Agent Name KHATTARWONG LLP
UEN/Company Code T12LL0001E
Representative Name
Address For Service 80 RAFFLES PLACE
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Singapore 048624
Action Representing Renewal

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