

**INTELLECTUAL PROPERTY OFFICE
OF THE PHILIPPINES**

BUREAU OF TRADEMARKS
Intellectual Property Center, 28 Upper McKinley
Rd., McKinley Hill Town Center, Fort Bonifacio,
Taguig City 1634, Philippines
Website: <http://www.ipophil.gov.ph>

DOCUMENT NO.	2019/1152
DATE OF NOTIFICATION	Pls. refer to the digital signature date

The International Bureau

World Intellectual Property Organization
34, chemin des Colombettes
1211 Geneva 20
Switzerland

**NOTIFICATION OF A PROVISIONAL REFUSAL OF PROTECTION
OF AN INTERNATIONAL REGISTRATION DESIGNATING
THE PHILIPPINES
Rule 17(1)**

International Registration No: **1433787**

IR Date/Subsequent Designation Date: 12 July 2018

Holder: Xiaomi Inc. [CN]
Mark: Mi Cloud
Examiner: ROLAN O. LEAÑO
Supervisor: MARITES Q. SALVIEJO

The mark has been examined, but the issues below prevent the Intellectual Property Office of the Philippines (IPOP HL) from granting the registration of the mark for **all the goods and/or services**.

Registrability Issue(s):

1. Clarify if the "advertising" services covered by the application involve advertising for other entities or for advertising applicant's own services. "Advertising" services contemplated in Class 35 refer to advertising for others that would mean the applicant is offering advertising services to the relevant sector in the industry, if not, delete said services.

2. The mark nearly resembles a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, and the resemblance is likely to deceive or cause confusion (IP Code, Sec. 123.1[d][ii]). See attachment(s).

SEC. 123. Registrability

123.1. A mark cannot be registered if it:

(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) The same goods or services, or*
- (ii) Closely related goods or services, or*
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion*

RULE 102. Registrability. — A mark cannot be registered if it:

(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) The same goods or services, or*
- (ii) Closely related goods or services, or*
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion*

3. The applicant should submit a copy of the foreign registration or provide information in the response to this provisional refusal on whether or not the mark has been registered in the foreign country. Section 131 of the IP Code requires that the mark be registered in the foreign country of first filing before the mark subject of this application can be registered by the IPOP HL.

SEC. 131. Priority Right

131.1. An application for registration of a mark filed in the Philippines by a person referred to in Section 3, and who previously duly filed an application for registration of the same mark in one of those countries, shall be considered as filed as of the day the application was first filed in the foreign country.

131.2. No registration of a mark in the Philippines by a person described in this section shall be granted until such mark has been registered in the country of origin of the applicant.

RULE 202. Priority Right; Basis for Claiming Priority Right. — An application for registration of a mark filed in the Philippines by a person referred to in Rule 201, and who previously duly filed an application for registration of the same mark in one of those countries, shall be considered as filed as of the day the application was first filed in the foreign country.

No registration of a mark in the Philippines by a person described in this Rule shall be granted until such mark has been registered in the country of origin of the applicant. However, the mark may be allowed for publication for the purpose of opposition, but such publication shall be withheld until it has been ascertained that the mark has been registered in the country of origin of the applicant. The country of origin of the applicant is the country in which the applicant is a national, domiciled, or has a bona fide and effective industrial or commercial establishment.

4. The applicant should disclaim the exclusive right to use "CLOUD" apart from the mark sought to be registered. "CLOUD" means the practice of storing regularly used computer data on multiple servers that can be accessed through the Internet. (<https://www.netlingo.com/dictionary>; <https://www.merriam-webster.com>) The applicant provides goods and services relating to cloud computing. Hence, the wording merely describes the kind, intended purpose or other characteristics of the applicant's goods and services.

SEC. 126. Disclaimers – The Office may allow or require the applicant to disclaim an unregistrable component of an otherwise registrable mark but such disclaimer shall not prejudice or affect the applicant's or owner's rights then existing or thereafter arising in the disclaimed matter, nor such shall disclaimer prejudice or affect the applicant's or owner's right on another application of later date if the disclaimed matter became distinctive of the applicant's or owner's goods, business or services. (Sec. 13, R.A. No. 166a)

RULE 604. Disclaimers. – The basic purpose of disclaimers is to make of record, that a significant element of a composite mark is not being exclusively appropriated apart from the composite. The following portions of a mark, when forming part of the composite mark, must be disclaimed to permit registration, namely: (a) a generic term; (b) a descriptive matter in the composite mark; (c) a customary term, sign or indication; or (d) a matter which does not function as a trademark, or service mark or a trade name.

Such disclaimer shall not prejudice or affect the applicant's rights then existing under some other law or thereafter arising in the disclaimed matter, nor shall such disclaimer prejudice or affect the applicant's rights to registration on another application of later date, where the disclaimed matter has become distinctive of the applicant's goods, business or services.

Where the Examiner has determined that any portion of a mark contains unregistrable matter which must be disclaimed, the Examiner shall communicate the findings to the applicant in the office action. If the applicant fails to comply with the Examiner's requirement for a disclaimer, the Examiner must make the requirement final if the application is in condition for a final action.

Partial disclaimer may be allowed with respect to some classes or some goods and/or services.

Information relating to subsequent procedure:

The applicant must respond in writing to this refusal within two (2) months from the digital signature date found at the end of this notice. The response must be filed by a duly authorized representative with a local address in the Philippines (the list of agents in the Philippines is available on the IPOPHL website). Within the two (2) month-period, the applicant may request an extension of time of another two (2) months to respond to this provisional refusal. The request for extension must be filed by the applicant's local representative in the Philippines. The request for extension can only be made once.

Failure to respond to the provisional refusal, submission of an incomplete response, or failure to request an extension of time to respond within the two-month period will result in the abandonment of the application. In case of

abandonment, the applicant has three (3) months from the abandonment date (counted from the lapse of the period to respond) to request the revival of the application. Failure to revive an abandoned application will result in its final abandonment and the confirmation of the total provisional refusal.


If the applicant is able to overturn the objections raised by the Examiner in the provisional refusal, the mark will be published for purposes of opposition. If no opposition to the registration of the mark is filed, the Office will issue a statement of grant of protection.

All responses or communications should be addressed to: THE DIRECTOR OF TRADEMARKS, Intellectual Property Office of the Philippines, 14/F Intellectual Property Center, No. 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio, Taguig City 1634, Philippines.

Additional information:

The IPOPHL requires the submission of the Declaration of Actual Use (DAU) within three (3) years from the date of international registration or the date of subsequent designation, as the case may be; within one (1) year from the fifth anniversary of the date of grant of protection of the mark; within one (1) year from the renewal date; and within one (1) year from the fifth anniversary of each renewal. The provisions governing the filing of the DAU are contained in the Trademark Regulations of 2017.

Cited mark(s)

Registration No.	4/2013/00003645
Registration Date	14 November 2013
Registrant	WESTERN DIGITAL TECHNOLOGIES, INC. - 3355 MICHELSON DRIVE, SUITE 100, IRVINE, CALIFORNIA 92612, United States of America
Trademark	WD MY CLOUD  MY CLOUD
Disclaimer	NONE
Translation	NONE
Goods / Services	Class 9: COMPUTER SOFTWARE, NAMELY FIRMWARE AND MOBILE APPLICATIONS, USED TO CONNECT AND MANAGE NETWORKED DEVICES FOR REMOTE ACCESS, BACK-UP, SHARING AND SYNCING OF DOCUMENTS AND FILES STORED ON, STREAMED THROUGH, HOSTED ON OR RUN ON DATA STORAGE DEVICES, HARD DRIVES, DISK DRIVES, SOLID STATE DRIVES, MEDIA PLAYERS, INTERNET SERVERS AND CLOUD STORAGE SERVICES; COMPUTER SOFTWARE, NAMELY FIRMWARE AND MOBILE APPLICATIONS, USED TO TRANSMIT, MANAGE, STORE, SECURE, ENCRYPT, CENTRALIZE, BACK-UP, TRANSFER, CUSTOMIZE, NAVIGATE, PLAY, VIEW, ACCESS, SHARE, STREAM, SYNCHRONIZE, MODIFY, UPLOAD, AND DOWNLOAD FILES, INFORMATION, DATA OR MEDIA STORED ON, STREAMED THROUGH, HOSTED ON OR RUN ON DATA STORAGE DEVICES, HARD DRIVES, DISK DRIVES, SOLID STATE DRIVES, MEDIA PLAYERS, INTERNET SERVERS AND CLOUD STORAGE SERVICES; COMPUTER SOFTWARE, NAMELY FIRMWARE AND MOBILE APPLICATIONS, FOR TRANSFERRING, STREAMING, VIEWING AND PLAYING TEXT, DATA, AUDIO AND VIDEO FILES, DIGITAL IMAGES AND MULTIMEDIA CONTENT FROM DATA STORAGE DEVICES, HARD DRIVES, DISK DRIVES, SOLID STATE DRIVES, MEDIA PLAYERS, INTERNET SERVERS AND CLOUD STORAGE SERVICES TO TELEVISIONS, VIDEO MONITORS, PROJECTORS AND COMPUTER AND MOBILE DEVICES, NAMELY SMARTPHONES, COMPUTER TABLETS AND LAPTOPS; ELECTRONIC DATA STORAGE DEVICES, NAMELY, HARD DISK DRIVES, DIGITAL DISK DRIVES, MEDIA PLAYERS, INTERNET SERVERS AND CLOUD STORAGE SERVICES AND SOLID STATE DRIVES; COMPUTER STORAGE DEVICES, NAMELY, COMPUTER MEMORY HARDWARE AND HARD DRIVES FOR COMPUTERS. Class 42: COMPUTER AND ELECTRONIC DATA STORAGE, DATA ENCRYPTION AND SECURITY; PROVIDING NON-DOWNLOADABLE COMPUTER SOFTWARE, NAMELY FIRMWARE AND MOBILE APPLICATIONS; DESIGN, DEVELOPMENT, UPDATING AND

MAINTENANCE OF COMPUTER SOFTWARE, FIRMWARE, MOBILE APPLICATIONS, DATA STORAGE DEVICES, HARD DRIVES, DISK DRIVES, SOLID STATE DRIVES, MEDIA PLAYERS AND COMPUTER PERIPHERALS; PROVIDING COMPUTER SOFTWARE, NAMELY FIRMWARE AND MOBILE APPLICATIONS, USED TO TRANSMIT, MANAGE, STORE, SECURE, ENCRYPT, CENTRALIZE, BACK-UP, TRANSFER, CUSTOMIZE, NAVIGATE, PLAY, VIEW, ACCESS, SHARE, STREAM, SYNCHRONIZE, MODIFY, UPLOAD, AND DOWNLOAD FILES, INFORMATION, DATA OR MEDIA STORED ON, STREAMED THROUGH, HOSTED ON OR RUN ON DATA STORAGE DEVICES, HARD DRIVES, DISK DRIVES, SOLID STATE DRIVES, MEDIA PLAYERS, INTERNET SERVERS, CLOUD STORAGE SERVICES AND COMPUTER PERIPHERALS; PROVIDING COMPUTER SOFTWARE, NAMELY FIRMWARE AND MOBILE APPLICATIONS, USED TO TRANSFER, STREAM, VIEW AND PLAY TEXT, DATA, AUDIO AND VIDEO FILES, DIGITAL IMAGES AND MULTIMEDIA CONTENT FROM DATA STORAGE DEVICES, HARD DRIVES, DISK DRIVES, SOLID STATE DRIVES, MEDIA PLAYERS, INTERNET SERVERS AND CLOUD STORAGE SERVICES AND COMPUTER PERIPHERALS TO TELEVISIONS, VIDEO MONITORS, PROJECTORS AND COMPUTER AND MOBILE DEVICES, NAMELY SMARTPHONES, COMPUTER TABLETS AND LAPTOPS; PROVIDING OPTIMIZED, REMOTE ACCESS TO AND MANAGEMENT OF FILES, INFORMATION, DATA OR MEDIA STORED ON, STREAMED THROUGH, HOSTED ON OR RUN ON DATA STORAGE DEVICES, HARD DRIVES, DISK DRIVES, SOLID STATE DRIVES, MEDIA PLAYERS, INTERNET SERVERS AND CLOUD STORAGE SERVICES USING A NETWORK OR INTERNET CONNECTION; PROVIDING TEMPORARY USE OF NON-DOWNLOADABLE COMPUTER SOFTWARE FOR USE IN ACCESSING, EDITING, COLLECT, UPDATING, MANIPULATING, MODIFYING, ORGANIZING, STORING, BACKING UP, SYNCHRONIZING, TRANSMITTING, AND SHARING DATA, DOCUMENTS, FILES, INFORMATION, TEXT, PHOTOS, IMAGES, GRAPHICS, MUSIC, AUDIO, VIDEO AND MULTIMEDIA CONTENT VIA GLOBAL AND LOCAL COMPUTER NETWORKS, MOBILE DEVICES AND MOBILE APPLICATIONS AND OTHER COMMUNICATIONS NETWORKS.

Registration No. 4/2013/00005702

Registration Date 27 March 2014

Registrant WESTERN DIGITAL TECHNOLOGIES, INC. - 3355 MICHELSON DRIVE, SUITE 100, IRVINE, CALIFORNIA, 92612, United States of America

Trademark MY CLOUD

MY CLOUD

Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE THE WORD "CLOUD" APART FROM THE MARK AS SHOWN.

Translation NONE

Goods / Services **Class 9:** COMPUTER SOFTWARE, INCLUDING FIRMWARE AND MOBILE APPLICATIONS, USED TO CONNECT AND MANAGE NETWORKED DEVICES FOR REMOTE ACCESS, BACK-UP, SHARING AND SYNCING OF DOCUMENTS AND FILES STORE ON, STREAMED THROUGH, HOSTED ON OR RUN ON DATA STORAGE DEVICES, HARD DRIVES, DISK DRIVES, SOLID STATE DRIVES, MEDIA PLAYERS, INTERNET SERVERS AND CLOUD STORAGE SERVICES; COMPUTER SOFTWARE, INCLUDING FIRMWARE AND MOBILE APPLICATIONS, USED TO TRANSMIT, MANAGE, STORE, SECURE, ENCRYPT, CENTRALIZE, BACK-UP, TRANSFER, CUSTOMIZE, NAVIGATE, PLAY, VIEW, ACCESS, SHARE, STREAM, SYNCHRONIZE, MODIFY, UPLOAD, AND DOWNLOAD FILES, INFORMATION, DATA OR MEDIA STORED ON, STREAMED THROUGH, HOSTED ON OR RUN ON DATA STORAGE DEVICES, HARD DRIVES, DISK DRIVES, SOLID STATE DRIVES, MEDIA PLAYERS, INTERNET SERVERS AND CLOUD STORAGE SERVICES; COMPUTER SOFTWARE, INCLUDING FIRMWARE AND MOBILE APPLICATIONS, FOR TRANSFERRING, STREAMING, VIEWING AND PLAYING TEXT, DATA, AUDIO AND VIDEO FILES, DIGITAL IMAGES AND MULTIMEDIA CONTENT FROM DATA STORAGE DEVICES, HARD DRIVES, DISK DRIVES, SOLID STATE DRIVES, MEDIA PLAYERS, INTERNET SERVERS AND CLOUD STORAGE SERVICES TO TELEVISIONS, VIDEO MONITORS, PROJECTORS, AND COMPUTER AND MOBILE DEVICES, INCLUDING SMARTPHONES, COMPUTER TABLETS AND LAPTOPS; ELECTRONIC DATA STORAGE DEVICES, INCLUDING, HARD DISK DRIVES, DIGITAL DISK DRIVES, MEDIA PLAYERS, INTERNET SERVERS AND CLOUD STORAGE SERVICES AND SOLID STATE DRIVES; COMPUTER STORAGE DEVICES, INCLUDING,

COMPUTER MEMORY HARDWARE AND HARD DRIVES FOR COMPUTERS

Class 42: COMPUTER AND ELECTRONIC DATA STORAGE; DATA ENCRYPTION AND SECURITY; PROVIDING NON-DOWNLOADABLE COMPUTER SOFTWARE, INCLUDING FIRMWARE AND MOBILE APPLICATIONS; DESIGN, DEVELOPMENT, UPDATING AND MAINTENANCE OF COMPUTER SOFTWARE, FIRMWARE, MOBILE APPLICATIONS, DATA STORAGE DEVICES, HARD DRIVES, DISK DRIVES, SOLID STATE DRIVES, MEDIA PLAYERS AND COMPUTER PERIPHERALS; PROVIDING COMPUTER SOFTWARE, INCLUDING FIRMWARE AND MOBILE APPLICATIONS, USED TO TRANSMIT, MANAGE, STORE, SECURE, ENCRYPT, CENTRALIZE, BACK-UP, TRANSFER, CUSTOMIZE, NAVIGATE, PLAY, VIEW, ACCESS, SHARE, STREAM, SYNCHRONIZE, MODIFY, UPLOAD, AND DOWNLOAD FILES, INFORMATION, DATA OR MEDIA STORED ON, STREAMED THROUGH, HOSTED ON OR RUN ON DATA STORAGE DEVICES, HARD DRIVES, DISK DRIVES, SOLID STATE DRIVES, MEDIA PLAYERS, INTERNET SERVERS, CLOUD STORAGE SERVICES AND COMPUTER PERIPHERALS; PROVIDING COMPUTER SOFTWARE, INCLUDING FIRMWARE AND MOBILE APPLICATIONS, USED TO TRANSFER, STREAM, VIEW AND PLAY TEXT, DATA, AUDIO AND VIDEO FILES, DIGITAL IMAGES AND MULTIMEDIA CONTENT FROM DATA STORAGE DEVICES, HARD DRIVES, DISK DRIVES, SOLID STATE DRIVES, MEDIA PLAYERS, INTERNET SERVERS AND CLOUD STORAGE SERVICES AND COMPUTER PERIPHERALS TO TELEVISIONS, VIDEO MONITORS, PROJECTORS, AND COMPUTER AND MOBILE DEVICES, NAMELY SMARTPHONES, COMPUTER TABLETS AND LAPTOPS; PROVIDING OPTIMIZED, REMOTE ACCESS TO AND MANAGEMENT OF FILES, INFORMATION, DATA OR MEDIA STORED ON, STREAMED THROUGH, HOSTED ON OR RUN ON DATA STORAGE DEVICES, HARD DRIVES, DISK DRIVES, SOLID STATE DRIVES, MEDIA PLAYERS, INTERNET SERVERS AND CLOUD STORAGE SERVICES USING A NETWORK OR INTERNET CONNECTION; PROVIDING TEMPORARY USE OF NON-DOWNLOADABLE COMPUTER SOFTWARE FOR USE IN ACCESSING, EDITING, COLLECT, UPDATING, MANIPULATING, MODIFYING, ORGANIZING, STORING, BACKING UP, SYNCHRONIZING, TRANSMITTING, AND SHARING DATA, DOCUMENTS, FILES, INFORMATION, TEXT, PHOTOS, IMAGES, GRAPHICS, MUSIC, AUDIO, VIDEO, AND MULTIMEDIA CONTENT VIA GLOBAL AND LOCAL COMPUTER NETWORKS, MOBILE DEVICES AND MOBILE APPLICATIONS, AND OTHER COMMUNICATIONS NETWORKS