

MADRID PROTOCOL

Model Form 3A: Total Provisional Refusal of Protection (Rule 17(1) of the Common Regulations)

I.	Office making the notification: National Intellectual Property Centre of Georgia SAKPATENTI Address: 5, Antioch Str., 3300 Mtskheta, Georgia Email: info@sakpatenti.org.ge www.sakpatenti.org.ge
II.	Number of the international registration: 1433787
III.	Name of the holder: Xiaomi Inc.; Floor 13, Rainbow City Shopping Mall II, Of China Resources, NO. 68, Qinghe Middle Street, Haidian District, Beijing, China
IV.	<p>Information concerning the type of provisional refusal:</p> <p><i>Please indicate the type of refusal by checking only one of the following options:</i></p> <p><input type="checkbox"/> Total provisional refusal based on an <i>ex officio</i> examination</p> <p><input checked="" type="checkbox"/> Total provisional refusal based on an opposition</p> <p><input type="checkbox"/> Total provisional refusal based on both an <i>ex officio</i> examination and an opposition</p> <p><i>Where the refusal is based on an opposition, please indicate the name and address of the opponent:</i></p> <p>(i) Name of the opponent: Apple Inc.</p> <p>(ii) Address of the opponent: One Apple Park Way Cupertino CA 95014, United States of America</p>
V.	<p>Information concerning the scope of the provisional refusal:</p> <p>Total provisional refusal affects all the goods and/or services.</p>
VI.	<p>Grounds for refusal [(where applicable, see item VII)]:</p> <p>Within three months period following the publication of the trademark data in the bulletin (26/08/2019) in accordance with the Rule 18bis (1), the opposition was filed on 21/11/2019 by "Apple Inc", in respect of all claimed goods. The appellant claims that the trademark is similar and liable to be confused with the international trademarks "ICLOUD", "ICLOUD" and "ICLOUD" registered 05/06/2011, 06/06/2011 and 06/06/2011 under the numbers 1081721, 1087010 and 1106373 for the goods in classes 9, 35, 38, 42.</p>

VII. Information relating to an earlier mark:

- (i) Filing date and number, and, if any, priority date: 1. 22/07/2011, 63339/3
 2. 03/09/2011, 63924/3
 3. 06/03/2012, 66413/3

- (ii) Registration date and number (if available): 1. 05/06/2011, IRN 1081721
 2. 06/06/2011, IRN 1087010
 3. 06/06/2011, IRN 1106373

- (iii) Name and address of the owner:

Apple Inc.

One Apple Park Way Cupertino CA 95014, United States of America

- (iv) Reproduction of the mark:

1. ICLOUD
2. ICLOUD
3. ICLOUD

- (v) List of the relevant goods and/or services (this list may be in the language of the earlier application or registration):

1. 9 - Computers; computer peripheral devices; computer hardware; computer software; mobile digital electronic devices.
2. 35 - Advertising, marketing, and promotion services; advertising and marketing consultation; sales promotion services; promoting the goods and services of others; conducting market research; analysis of advertising response and market research; creation, preparation, production, and dissemination of advertisements and advertising material for others; computerized database and file management; data processing services; searching, browsing and retrieving information, sites, and other resources available on global computer networks and other electronic and communications networks for others; organizing content of information provided over a global computer network and other electronic and communications networks according to user preferences; providing business and commercial information over computer networks and global communication networks; business services, namely, dissemination of advertising for others via computer networks and global communication networks; compilations of directories for publishing on the Internet and other electronic, computer and communications networks; retail store and online retail store services; retail store services provided via the Internet and other computer, electronic and communications networks; subscription services, namely, providing subscriptions to text, data, image, audio, video, and multimedia content, provided via the Internet and other electronic and communications networks; downloadable pre-recorded text, data, image, audio, video, and multimedia content for a fee or pre-paid subscription, provided via the Internet and other electronic and communications networks; arranging and conducting of commercial, trade and business conferences, shows, and exhibitions; information, advisory and consultancy services relating to all the aforesaid.
- 38 - Telecommunications; telecommunication access services; communications by computer; communication between computers; delivery of digital music by telecommunications; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; delivery of messages by

electronic transmission; delivery of digital music by telecommunications; electronic mail services; streaming of video content via a global computer network; electronic transmission of audio and video files via communications networks; information, advisory and consultancy services relating to all the aforesaid.

41 - Educational and entertainment services.

42 - Application service provider (ASP) services, namely hosting computer software applications; computer hardware and software consulting services; information relating to computer hardware or software provided on-line from a global computer network or the Internet; creating and maintaining web-sites; hosting the web-sites of others; providing search engines for obtaining data via communications networks; providing search engines for obtaining data on a global computer network; electronic storage of data; information, advisory and consultancy services relating to all the aforesaid.

45 - Online social networking services; internet-based social networking services.

3. 38 - On-line delivery of digital images.

39 - Physical storage of electronically-stored data, text, images, audio and video; physical storage services for archiving electronic data; information and consultation in connection therewith.

40 - Photographic film developing; photographic film printing; photographic and digital image processing, printing, and reproduction; on-line processing, and developing of digital images; on-line printing of digital images onto photographic paper, photographic books or merchandise; advisory and consultancy services relating to all the aforesaid.

VIII. Corresponding essential provisions of the applicable law: **Article 5 (c), Article 16.**

IX. Information relating to the possibility to request a review or file an appeal:

(i) Time limit for requesting review or appeal:

A response to the opposition can be filed at SAKPATENTI Chamber of Appeals no later than 2 months from the date of publication of the current notification in the WIPO Gazette of International Marks. If no response is filed within 2 months Chamber of Appeals will proceed to issue decision on the case in the WIPO Gazette of International Marks.

(ii) Authority to which such request for review or appeal should be made:

A response to the opposition shall be filed at SAKPATENTI Chamber of Appeals.

(iii) Whether the request for review or appeal has to be filed in a specific language and/or through the intermediary of a representative whose address is within the territory of the Contracting Party:

Be informed that proceedings in Georgia are carried out in the Georgian language. A response to the opposition may be filed through the representative with a registered address in Georgia or a patent attorney of Georgia.

(iv) Other requirements, if any:

X. Signature or official seal of the Office making the notification:

Acting Head of Department



Medea Tchitchinadze

XI. Date of the notification to the International Bureau:

21.11.2019

XII. Extract from the Trademark Law of Georgia**Article 3. TRADEMARK**

1. A trademark is a sign or combination of signs that can be represented graphically and is capable of distinguishing the goods or services or both (hereinafter referred to as "goods") of one undertaking from those of other undertakings.
2. The sign may be a word or words, including proper names, letters, figures, sounds, a design or a three-dimensional figure, including the shape of goods or their wrapping and also other packaging, including colors or combination of colors.
3. The trademark is protected by registration at «Sakpatenti» or by virtue of international agreement.
4. Well-known trademarks in Georgia are protected without registration, under Article 6^{bis} of the Paris Convention. The trademark is recognized as well-known by the Chamber of Appeals of «Sakpatenti» or by the court, in its competence, upon the request of an interested person.

Article 4. ABSOLUTE GROUNDS FOR REFUSAL OF REGISTRATION

1. A sign, or combination of signs shall not be registered as a trademark where it:
 - (a) does not comply with the requirements of Article 3 (1) of this Law;
 - (b) represents a single non-stylized (standard) letter or figure, or a single colour taken separately;
 - (c) is not capable of distinguishing the relevant goods;
 - (d) is descriptive in respect of the goods for which its registration is requested, consists exclusively of the kind, quality, quantity, feature, value, intended purpose, geographical origin, place of sale, time or other characteristics of the goods or can be regarded as such;
 - (e) is widely used as a generic term for the particular type of goods;
 - (f) represents a widely established trade term or sign, characteristic of goods, for which registration is sought;
 - (g) insults or is contrary to national dignity, religious sentiment and traditions and moral standards;
 - (h) is likely to deceive the public (as to the feature, quality, geographical origin or other characteristics of the goods);
 - (i) completely or in any of its constituent elements coincides with the national emblems or the flags, emblem or full or abbreviated names of foreign states; the emblems of intergovernmental or other international organizations or their abbreviated or full names; official control, warranty and test hallmarks, signs (including certification marks of goods) seals, orders and medals; the official or historical names, emblems and State flags of the constituent parts of Georgia; the banknotes of Georgia or the imitation of the forgoing; such a sign may be included in a trademark, as a feature not qualifying for protection, if the permission of the Ministry of Culture or the holder has been obtained.
2. A three-dimensional sign shall not be registered as a trademark, where its shape:
 - (a) is established exclusively by the nature of the goods;
 - (b) is necessary for a technical result to be achieved.
3. The provisions of paragraph 1(c), (d), (e), (f), and (h) above shall not apply if, before a decision is taken on its registration, a trademark has become distinctive through use in the course of trade in relation to the goods specified in the application.

Article 5. RELATIVE GROUNDS FOR REFUSAL OF REGISTRATION

A trademark shall not be registered if it:

- (a) is identical to another trademark registered for the same goods;
- (b) is identical to the trademark of a third party and the goods are so similar as to create a risk of confusion between the marks, including confusion based on association;
- (c) is similar to the trademark of a third party and the goods are identical or so similar as to create a risk of confusion between the marks, including confusion based on association;
- (d) is identical or similar to a trademark well known in Georgia, existing before filing the application, so that there is a risk of confusion with it, including confusion based on association; this rule shall apply even where the lists of goods are different;
- (e) is identical or so similar to an appellation of origin or geographical indication protected in Georgia that there is a risk of confusion with it, including confusion based on association and the registration of trademark is requested for the identical or similar goods, or using such a trademark will result in using the reputation of the protected appellation of origin or geographical indication. This provision shall not apply if an appellation of origin or geographical indication is involved as a feature not qualifying for protection in the trademark of a person entitled to use it.
- (f) is identical to an industrial design protected in Georgia except where registration of the trademark is sought by the holder of the exclusive rights in the industrial design;
- (g) is identical or similar to registered trademark a third party enjoying good reputation in Georgia, and if the use of that trademark creates unfair advantages for its applicant or damages the reputation of the protected trademark; this rule shall apply where there are different lists of goods;
- (h) includes names, pseudonyms, facsimiles, portraits of persons famous in Georgia without the consent of these persons or their legatees, and if they belong to the history and culture of Georgia without the permission of the Ministry of Culture, Monuments Protection and Sport of Georgia;

(i) includes the names of historical monuments of Georgia or of reproductions thereof without the permission of the Ministry of Culture, Monuments Protection and Sport of Georgia.

**Article 16. OPPOSITION TO THE EXAMINATION DECISION AT THE
CHAMBER OF APPEALS**

1. The decision of the examination as to form may be opposed by the applicant before the Chamber of Appeals within three months after having been taken.
2. A decision of the substantive examination to refuse the registration of the trademark in respect of all or part of the list of goods may be opposed by the applicant before the Chamber of Appeals within three months after having been taken.
3. Repealed (20.12.2005 № 2380 is in force from March 1, 2006)
4. Within three months from the date of publication of the trademark data in the Bulletin, any party concerned has the right to bring an action before the Chamber of Appeals against the decision of the examination to grant registration only on the grounds that the requirements of Article 4 or Article 5 is violated. The enacted decision of the court concerning the trademark registration is not allowed to be appealed at the Chamber of Appeals on the same grounds.
5. The Chamber of Appeals shall consider the appeal within three months from the date of its filing.
6. The decision of the Chamber of Appeals may be appealed in a court.

ARTICLE 32. REGULATIONS GOVERNING THE USE OF COLLECTIVE MARKS

1. An application for a collective mark shall comply with the requirements of Article 9 and be accompanied by the regulations governing the use of the collective mark.
2. The regulations governing the use of the collective mark shall include:
 - (a) the name of the association;
 - (b) the names and legal addresses of the members of the association;
 - (c) the aim of the association;
 - (d) the conditions governing the use of the collective mark and overseeing that use;
 - (e) the rights and obligations of the members of the association regarding infringement of the rights in the collective mark;
 - (f) a list of the goods and common characteristics or indications for which the collective mark is intended.
3. If the collective mark contains a geographical name, the regulations governing the use of the mark must provide that any party whose goods originate within the geographical region so named, and who meets the conditions for use of the mark laid down in those regulations, has the right to become a member of the association and use the mark.
4. Any interested person is entitled to inspect the regulations governing the collective mark.