

In reply please quote our reference

Your reference : N.A.  
Our reference : 2020/6379393809T  
Date : 29 January 2020  
Writer's direct number : +65 6330 2796

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:**

1482770

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

Trade Mark Number : 40201921216Y

Class Number(s) : 34

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

NJOY, LLC

**5. Ground(s) of the Provisional Refusal:**

**Provisions of Singapore Law:** The relevant provisions of Singapore law are attached.

**5.1 Section 7(1)(b)**

The mark is objectionable under section 7(1) of the Trade Marks Act (Cap. 332, 2005 Rev. Ed.) as:

it is devoid of any distinctive character. The mark which consists of the phrase in plain text "MAKE SMOKING HISTORY" would merely be perceived as a promotional statement by the average consumers when it is applied in the context of the goods claimed. Specifically, the mark serves to inform that the consumer can give up on real smoking through use of the applicant's goods which are smoking substitutes, and is hence unable to function as an indicator of trade source for the aforesaid goods, rendering it objectionable under section

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7(1)(b) of the Trade Marks Act.

**5.2 How to overcome our objection(s) under section 7(1)(b), (c) and/or (d)**

Please file evidence showing that the mark has, before the date of application, in fact acquired a distinctive character as a result of the use made of it in Singapore. The evidence should relate to at least 5 years of use prior to the date of application of the mark. The evidence of use should be filed by way of a statutory declaration. For guidance as to how the evidence of 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) 34 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 **29 May 2020**, 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.

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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:

Mr. Chin Ji Heian Ken  
Assistant Registrar  
for Registrar of Trade Marks  
Singapore

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Intellectual Property Office of Singapore  
1 Paya Lebar Link, #11-03  
PLQ 1, Paya Lebar Quarter  
Singapore 408533

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W [www.ipos.gov.sg](http://www.ipos.gov.sg)

## PROVISIONS OF SINGAPORE LAW

### TRADE (CHAPTER

### MARKS

### ACT 332)

#### Section 2(1) Interpretation

"sign" includes any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, aspect of packaging or any combination thereof.  
"trade mark" means any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person.

#### Section 7 Absolute grounds for refusal of registration

(1) The following shall not be registered:

- (a) signs which do not satisfy the definition of a trade mark in section 2(1);
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; and
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

(2) A trade mark shall not be refused registration by virtue of subsection (1) (b), (c) or (d), if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

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