



Intellectual  
Property  
Office

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World Intellectual Property  
Organisation (WIPO)  
International Bureau  
34, Chemin des Colombettes  
1211 Geneva 20  
Switzerland

**Your Reference:**  
**International Registration No:**  
WO0000001510070  
**Examiner:** Sharon Fleet  
**Direct Telephone:** +44(0)1633811094  
**Date:** 30 January 2020

Please reply by **30 March 2020** quoting the International Registration number

Dear Sir/Madam,

**Intl Reg No:** WO0000001510070  
**Mark:** ClickHouse  
**Holder:** YANDEX LLC  
**Classes:** 9, 35, 38, 39, 41, 42

**Notification of a Provisional Partial Refusal of Protection (not based on an opposition) by the Intellectual Property Office**

I have examined your designation under the Trade Marks Act 1994 and carried out a search of the relevant trade mark registers. Your designation does not appear to meet the requirements for Protection for the following reasons.

**Absolute grounds for refusal**

**Retail – Class 35**

There is an objection under Section 1(1) and Rule 8(2)(b) against the following 'retail service'-type terms listed in your class 35 specification:

Retail services for downloadable and pre-recorded music and movies; online retail services for downloadable ring tones; online retail services for downloadable digital music.

These terms do not meet the legal criteria as set out by the Court of Justice of the European Union in the Praktiker case (see C-418/02). Our classification practice in respect of 'retail service'-type claims is set out in the current edition of the Trade Marks Manual (under the section entitled 'The Classification Guide'). For more information on this practice, you can view the Manual via the following hyperlink:

<https://www.gov.uk/guidance/trade-marks-manual>

This objection may be overcome by amending the objectionable terms to the following:

Retail services connected with the sale of downloadable and pre-recorded music and movies; online retail services connected with the sale of downloadable ring tones; online retail services connected with the sale of downloadable digital music;

**Search for earlier trademarks – for your information only**

I have searched the relevant trade mark registers and found earlier trade mark that I think you should be aware of. My initial view is that your trade mark and your goods and services are similar to the earlier trade mark and their services. Therefore the public are likely to confuse your trade mark with the earlier trade mark.

The earlier trade mark I found is listed at the end of this report.

I am not refusing to accept your designation because of the earlier trade mark. Should you decide to proceed with your designation I am obliged to inform the owners of the marks listed below, that your designation will be published in our online journal. I will only notify UK trade marks and International Registrations (UK). UK trade marks begin with the prefix 'UK'. International UK trade marks begin with the prefix 'WO'.

We do not notify holders of European Union Trade Marks (EUTM) or International Registrations (EU), which also have protection in the UK; these are for your information only

If you proceed, your designation will be published in the online Trade Marks Journal and anyone can oppose your designation should they have grounds to do so. If such action were to be successful, this would likely result in a costs award against you. Further information can be found on our website:

[ipo.gov.uk/tmoppose](http://ipo.gov.uk/tmoppose)

**Next steps**

If you disagree with my assessment of your designation, you can write or telephone me. My contact details are shown at the top of this letter. Your response can be sent by post, fax or emailed to the following:

[Trademark.examination@ipo.gov.uk](mailto:Trademark.examination@ipo.gov.uk)

If following this discussion, you still disagree with my findings you have the right to request a hearing with a senior officer to argue against the absolute grounds issues raised. You cannot request a hearing in respect of the earlier trademarks as these are not formal objections.

If your address is outside of the European Community, the Isle of Man or the European Economic Area you must provide us with a contact address in one of

the above areas. This can be done by filling in and returning a Form TM33 "Appointment of change of Representative (for trade mark owners or holders)". This form is available at:

[ipo.gov.uk/tmforms](http://ipo.gov.uk/tmforms)

If you do not reply by the date shown above, I will publish it in our online Trade Marks Journal, but only for:

Classes 9, 38, 39, 41 and 42 for the specifications as filed.

And Class 35 for a specification that reads as follows:

Commercial information agencies; advertising agencies; rental of advertising space; employment agencies; computerized file management; accounting; invoicing; demonstration of goods; opinion polling; market studies; business information; commercial information and advice for consumers in the choice of products and services; business research; marketing research; personnel recruitment; business management and organization consultancy; business organization consultancy; business management consultancy; personnel management consultancy; professional business consultancy; consultancy regarding public relations communication strategies; consultancy regarding advertising communication strategies; layout services for advertising purposes; marketing; marketing in the framework of software publishing; targeted marketing; updating and maintenance of data in computer databases; online retail services connected with the sale of downloadable and pre-recorded music and movies; online retail services connected with the sale of downloadable ring tones; online retail services connected with the sale of downloadable digital music; organization of exhibitions for commercial or advertising purposes; payroll preparation; data search in computer files for others; sponsorship search; commercial intermediation services; providing business information via a web site; provision of commercial and business contact information; provision of an on-line marketplace for buyers and sellers of goods and services; web indexing for commercial or advertising purposes; presentation of goods on communication media, for retail purposes; economic forecasting; auctioneering; sales promotion for others; promotion of goods and services through sponsorship of sports events; production of advertising films; rental of advertising time on communication media; publicity material rental; rental of billboards [advertising boards]; rental of vending machines; rental of sales stands; publication of publicity texts; radio advertising; dissemination of advertising matter; direct mail advertising; registration of written communications and data; advertising; on-line advertising on a computer network; outdoor advertising; advertising by mail order; television advertising; compilation of statistics; compilation of information into computer databases; business inquiries; systemization of information into computer databases; advisory services for business management; compiling indexes of information for commercial or advertising purposes; tax preparation; drawing up of statements of accounts; telemarketing services; administration of consumer loyalty programs; administration of frequent flyer programs; administrative processing of purchase orders; public relations; market intelligence services; web site traffic optimisation; tax filing services; search engine

optimisation for sales promotion; price comparison services; pay per click advertising; procurement services for others [purchasing goods and services for other businesses]; word processing; outsourcing services [business assistance].

**The provisional refusal of all other services will then become final.**

Yours faithfully

*Sharon Fleet*

**Trade Marks Registry**

## **Earlier Marks**

### ***1) Earlier Mark:***

**Trade Mark ID:** UK00003017440

**Domain:** Domestic Trade Mark

## **Mark Representation**

ClickHouse

**Filing Date/Date of Designation:** 09/08/2013

## **Services**

**Class:** 35

Business consultancy, in the field of transport and delivery; Business management consultancy in the field of transport and delivery; Business management in the field of transport and delivery.

**Class:** 39

Delivery services; Arranging the delivery of goods; Delivery by road; Delivery of food and drink prepared for consumption; Delivery of parcels by road; Delivery and storage of goods; Storage and delivery of goods; Delivery of goods.

## **Owner/Holder Details**

**Name:** Timothy Julian Waters

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**Postcode:** SL6 4LL

**Country:** GB