



MADRID PROTOCOL

Total Provisional Refusal of Protection

(Rule 17(1) of the Regulations under the Protocol)

I. Office making the notification:

Canadian Intellectual Property Office

II. Number of the international registration:

1510070

III. Name of the holder:

YANDEX LLC

IV. Information concerning the type of provisional refusal:

Total provisional refusal based on an ex officio examination

V. Information concerning the scope of the provisional refusal:

Total provisional refusal affects all the goods and/or services.

VI. Grounds for refusal [(where applicable, see item VII)]:

This examiner's report concerns the above identified Protocol application. To avoid abandonment proceedings, a proper response must be received by this office by November 17, 2021. All correspondence respecting this Protocol application must indicate the file number.

This Protocol application has been examined under the provisions of the Trademarks Act and Trademarks Regulations.

Pursuant to paragraph 30(2)(a) of the Trademarks Act, an application for the registration of a trademark must contain a statement in ordinary commercial terms of the associated goods or services. Furthermore, section 29 of the Trademarks Regulations requires that the statement must describe each of those goods or services in a manner that identifies a specific good or service. It is considered that the following goods or services are not in specific and ordinary commercial terms:

1. ... monitoring apparatus, other than for medical purposes; sound recording apparatus; global positioning system [gps] apparatus; telephone apparatus; electronic numeric displays; ... audio interfaces; ...; measuring instruments; interfaces for computers; ... encoded magnetic cards; ... encoded key cards; ...; monitors [computer hardware]; monitors [computer programs]; ...; sound recording carriers; magnetic data media; optical data media; ... computer software, recorded; ...; signalling panels, luminous or mechanical; ...; transmitters [telecommunication]; ...; transmitters of electronic signals; computer software platforms, recorded or downloadable; ...; digital signs; ...; distance measuring apparatus; ... teaching apparatus; ...; weighing apparatus and instruments; navigational instruments; measuring apparatus; measuring devices, electric; observation instruments;

navigation apparatus for vehicles [on-board computers]; satellite navigational apparatus; regulating apparatus, electric; telecommunication apparatus in the form of jewellery; ...; computer software applications, downloadable; computer programs, recorded; ...; computer programs [downloadable software]; ...; processors [central processing units]; electronic publications, downloadable; control panels [electricity]; radar apparatus; ...; teaching robots; ...; optical fibers [light conducting filaments]; traffic-light apparatus [signalling devices]; signals, luminous or mechanical; ...; scanners [data processing equipment]; ...; speed indicators; audiovisual teaching apparatus; ...; gauges; steering apparatus, automatic, for vehicles; ...; sound reproduction apparatus; invoicing machines; data processing apparatus; ...; sound alarms; anti-theft warning apparatus; computer peripheral devices; ...; ...; chips [integrated circuits]; ...; security tokens [encryption devices]; speed measuring apparatus [photography]; ... (class 9)

2. Commercial information agencies; ...; demonstration of goods; ...; ...; professional business consultancy; consultancy regarding public relations communication strategies; consultancy regarding advertising communication strategies; ...; marketing; marketing in the framework of software publishing; targeted marketing; ... organization of exhibitions for commercial or advertising purposes; ...; ...; sponsorship search; commercial intermediation services; providing business information via a web site; provision of commercial and business contact information; ...; presentation of goods on communication media, for retail purposes; ...; sales promotion for others; ...; rental of advertising time on communication media; publicity material rental; rental of billboards [advertising boards]; ...; ...; dissemination of advertising matter; ... registration of written communications and data; advertising; on-line advertising on a computer network; outdoor advertising;; ...; business inquiries; ...;... pay per click advertising; procurement services for others [purchasing goods and services for other businesses]; ... outsourcing services [business assistance]. (class 35)

3. ... information about telecommunication; ... message sending; computer aided transmission of messages and images; ...; transmission of digital files; providing online forums; ...; rental of message sending apparatus; ...; rental of telecommunication equipment; ...; transmission of electronic mail; ...; telecommunications routing and junction services; streaming of data. (class 38)

4. ...travel reservation; transport reservation;...message delivery; ...; delivery of goods; ... transportation information; storage information; transportation logistics; ...; hauling; carting; ...; removal services; transport of travellers; guarded transport of valuables; bus transport; car transport; boat transport; passenger transport; ...; transport brokerage;; packaging of goods; escorting of travellers; wrapping of goods; ...; transport; ... storage of goods; ... (class 39)

5. Academies [education]; ...; education information; recreation information; entertainment information; layout services, other than for advertising purposes; microfilming; videotape editing; production of radio and television programmes; providing online electronic publications, not downloadable; game services provided online from a computer network; correspondence courses; practical training [demonstration]; training services provided via simulators; providing recreation facilities; arranging and conducting of colloquiums; arranging and conducting of congresses; arranging and conducting of conferences; arranging and conducting of workshops [training]; arranging and conducting of in-person educational forums; arranging and conducting of seminars; organization of competitions [education or entertainment]; vocational guidance [education or training advice]; television entertainment; ...; vocational retraining; ... educational examination; ... publication of texts, other than publicity texts; entertainment services; ... teaching; educational services provided by schools; coaching [training]; (class 41)

6. Computer systems analysis; recovery of computer data; ... mechanical research; scientific research; technological research; ...; information technology [IT] consultancy; ...; data security consultancy; technological consultancy; quality control;

... software as a service [SaaS]; ...; conversion of computer programs and data, other than physical conversion; conducting technical project studies; ...; hosting computer sites [web sites]; server hosting; ... creating and designing website-based indexes of information for others [information technology services]; ... copying of computer programs; cloud computing; outsource service providers in the field of information technology; off-site data backup; computer technology consultancy; telecommunications technology consultancy; ...; electronic data storage; surveying; (class 42)

As a general rule, goods described by the terms “accessories”, “equipment”, “apparatus”, “systems”, or “products” are not considered acceptable without further specification since they are considered to include different types of goods with different channels of trade which are not necessarily sold in close proximity. (statement 1)

Additionally, section 29 of the Trademarks Regulations requires that the statement of the goods or services must describe each of those goods or services in a manner that identifies a specific good or service. Therefore, statements of goods or services cannot include such indefinite terms as “or”. For more information on acceptable definite terms please visit Section 2.5.4.4 “Definite Terms – “Namely”, “Consisting of” or “Specifically”” of the Trademarks Examination Manual found on the CIPO Trademarks website. (statement 1)

Pursuant to paragraph 30(2)(a) of the Trademarks Act and section 29 of the Trademarks Regulations, the goods described as “computer software” must specify both the function and the field of use of the software to be considered in ordinary commercial terms and described in a manner that identifies a specific good. (statement 1)

Please note that the use of brackets in the statements of goods and services is only acceptable when what comes before the brackets is already compliant with paragraph 30 (2) (a) of the Trademarks Act. For instance, “belts (clothing)” would be acceptable since the Goods and Services Manual lists the goods “belts” as acceptable and the inclusion of the parentheses merely confirms that the goods are the most commonly understood meaning of “belts”. However, since “clothing” is not considered to be a specific good pursuant to the provisions of paragraph 30(2)(a) of the Trademarks Act, a description of goods such as “clothing (belts)” is not acceptable since the description of goods is ambiguous. (statement 1 and 2)

Please also note, advertising, promotion and marketing services must clearly indicate a real service is provided to the public. For example, if the applicant's “advertising” and “marketing” services simply make the public aware of the applicant's own products, there is not considered to be a benefit to the public. In order to determine if the service is being offered to a third party, examiners may ask for further specificity by questioning the means or manner by which the service is provided. (statement 2)

Generally, services that include the term “telecommunications” (e.g., “telecommunication services”), or that relate to “telecommunication services” (e.g., “communication services”, “information technology services”, “electronic commerce services”), are not considered acceptable without further specification, since “telecommunication” in this context can include any communication at a distance. Therefore, services that either include the term “telecommunications” or relate to “telecommunication services” should specify the nature of the services (i.e., the specific type of communication) and the field of the services (i.e., area of business the applicant provides these services). (statement 3)

For further guidance on redefining the statements of goods or services, please refer to the Goods and Services Manual available on our website. This searchable tool is not an exhaustive list of acceptable terms, but it may be used as a guide to the specificity and ordinary commercial term requirements of the Trademarks Act and its Regulations.

The applicant is required to file an amended Protocol application, using the e-service on the CIPO website at www.cipo.ic.gc.ca, by fax at 819-953-2476 or by mail at the following address:

Registrar of Trademarks
Place du Portage I
50 Victoria Street, room C-114
Gatineau, QC K1A 0C9

Upon satisfactory compliance with the above-mentioned requirement, further office action will be undertaken.

If the applicant has any specific questions in respect of this Office action, please contact the assigned examiner. Please note that for general inquiries, including assistance with filing of the revised Protocol application, queries about the status of an application or receipt of correspondence, you may contact our Client Service Centre toll free at 1-866-997-1936.

Yours truly,

Alison Szawiola
Examination Section
819-639-0763
fax: 819-953-2476

VII. Information relating to an earlier mark:

-
- (i) Filing date and number, and, if any, priority date:
Not applicable
 - (ii) Registration date and number (if available):
Not applicable
 - (iii) Name and address of the owner:
Not applicable
 - (iv) Reproduction of the mark:
Not applicable
 - (v) List of the relevant goods and/or services (this list may be in the language of the earlier application or registration):
Not applicable

VIII. Corresponding essential provisions of the applicable law:

Paragraph 30(2)(a) of the Trademarks Act
Section 29 of the Trademarks Regulations

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

- (i) Time limit for requesting review or appeal:
2021-11-17
- (ii) Authority to which such request for review or appeal should be made:
Registrar of Trademarks
- (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:
Correspondence must be in French or English
- (iv) Other requirements, if any:
Not applicable

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

Registrar of Trademarks

XI. Date of notification to the International Bureau:

2021-05-17



17 mai/May 2021

Votre référence Your File

40709-016

Notre référence Our File

2007663

Numéro EI IR Number

1510070

ClickHouse

BCF S.E.N.C.R.L./BCF LLP
1100, boul. René-Lévesque Ouest
25e Étage
Montréal
QUÉBEC H3B 5C9
Attention: Johanne Auger

RE: Trademark: ClickHouse
Applicant: YANDEX LLC

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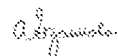
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