



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:

1518695

III. Name of the holder:

Hyperloop Technologies, Inc.

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 January 6, 2022. 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.

The trademark is considered to be clearly descriptive or deceptively misdescriptive of the character of the associated goods. Specifically, the trademark clearly describes that the goods incorporate or pertain to a pod(s), where "pod" is defined as "A detachable or self-contained unit on an aircraft, spacecraft, vehicle, or vessel, having a particular function" by the Oxford Dictionary.

Alternatively, if the goods do not have this feature, trait, or characteristic, the trademark is considered to be deceptively misdescriptive.

Therefore, in view of the provisions of paragraph 12(1)(b) of the Trademarks Act, the trademark does not appear registrable.

The word "character" means a feature, trait or characteristic of the goods and services. The test of whether a trademark is clearly descriptive considers the immediate first impression of the average Canadian user, purchaser, or consumer of the associated goods and services.

One of the most important purposes of paragraph 12(1)(b) of the Trademarks Act is to protect the right of all traders to use apt descriptive language. The courts have recognized that descriptive words are the property of all and cannot be appropriated by one person for their exclusive use since this would give them an unfair advantage over competitors in the same trade.

Furthermore, pursuant to paragraph 37(1)(d) of the Trademarks Act, it appears that the trademark is not distinctive.

The Registrar's preliminary view is that the trademark is not inherently distinctive, as trademarks which do not appear registrable pursuant to paragraph 12(1)(b) of the Trademarks Act are considered not inherently distinctive. In particular, the trademark POD does not distinguish the goods of the applicant from those of another person or business in that the trademark is indicative that the applicant's goods incorporate or relate to a pod(s). Trademarks which describe a characteristic of a good cannot inherently act as a source identifier. As such, the consumer would not be able to distinguish the source of the applicant's goods from those of a competitor since the applied-for trademark is merely a generic description of a particular characteristic of the goods and it is considered that other traders should be able, in the ordinary course of their business, to use it in association with the same goods.

Pursuant to paragraph 32(1)(b) of the Act, the applicant may wish to furnish the Registrar with evidence establishing that the trademark was distinctive at the filing date of the Protocol application for its registration. Alternatively, the applicant may wish to provide, in writing, information which would persuade the Registrar to withdraw the objection that the trademark is not, on a preliminary view, inherently distinctive.

The applicant's action and/or written comment is awaited.

Moreover, 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 are not in specific and ordinary commercial terms:

- 1) Land vehicles, hover vehicles, magnetic levitation vehicles and [...] (class 12)
- 2) apparatus for locomotion by land, air or water, namely, [...], magnetic levitation vehicles, [...], vehicles that travel in a vacuum or partial vacuum within an enclosed tube (class 12)

For further guidance on redefining the statements of goods, 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.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

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 amended 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,

Damith Silva
Examination Section
819-360-8702
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 12(1)(b) of the Trademarks Act
Paragraph 30(2)(a) of the Trademarks Act
Paragraph 32(1)(b) of the Trademarks Act
Paragraph 37(1)(d) 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:
2022-01-06

- (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:

2021-07-06



6 jui/Jul 2021
Votre référence Your File

Notre référence Our File
2015752
Numéro EI IR Number
1518695

SMART & BIGGAR LLP
SUITE 900, 55 METCALFE STREET
P.O. BOX 2999, STATION D
OTTAWA
ONTARIO K1P 5Y6
Attention: Debbie Hiemstra

RE: Trademark: POD
Applicant: Hyperloop Technologies, Inc.

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