



## **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:**

1536764

**III. Name of the holder:**

Arnold & Richter Cine Technik GmbH & Co. Betriebs KG

**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 April 5, 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.

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) Optical filters; adapters for lighting apparatus, included in this class; fittings for the aforesaid goods, included in this class; fitted transport cases for carrying the aforesaid goods; mechanical adaptors for lighting equipment, included in this class (Class 9)
- 2) Other lighting items; fittings and spare parts for the aforementioned goods, included in this class; fitted transport cases for carrying the aforementioned goods (Class 11)

The following three-part test is considered when determining whether a statement of

goods or services is considered to be "specific" within the meaning of section 29 of the Trademarks Regulations:

1. Are the goods or services sufficiently specific so that it is possible to assess whether the trademark is clearly descriptive of those goods or services?
2. Are the goods or services sufficiently specific so that it is possible to assess confusion with another trademark?
3. Are the goods or services sufficiently specific to ensure that the applicant will not have an unreasonably wide ambit of protection?

As a general rule, goods described by the term "apparatus" 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.

Whereas in some cases the context of a statement of goods may serve to specify "fittings and spare parts," please note that goods which are separated by semicolons ( ; ) are generally considered to stand on their own and therefore must meet the specificity and ordinary commercial term requirements without regard to the other listed goods.

As the goods preceding "fittings and spare parts for the aforementioned goods" are separated by semicolons, it is not clear if "the aforementioned" applies to all of the goods listed in the statement. In order to remove this ambiguity, the applicant may wish to amend the statement of goods by replacing the semicolons with commas.

Finally, while subsection 30(3) of the Trademarks Act requires goods and services to be listed according to the Nice Classification, please note that the office does not consider Nice Classes to be ordinary commercial terms. Therefore, statements of goods cannot include phrases such as "included in this class".

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.ic.gc.ca](http://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,

**VII. Information relating to an earlier mark:**

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- (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:  
2022-04-05
- (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:**

2021-10-05



5 oct/Oct 2021  
Votre référence Your File

Notre référence Our File  
2034677  
Numéro EI IR Number  
1536764

Arnold & Richter Cine Technik GmbH & Co. Betriebs KG  
Herbert-Bayer-Str. 10  
80807 München  
GERMANY

RE: Trademark: Quick Lighting Mount  
Applicant: Arnold & Richter Cine Technik GmbH &  
Co. Betriebs KG

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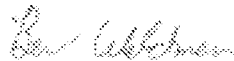
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Yours truly,



Benjamin Welchner  
Examination Section  
819-360-9549  
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