



## **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:**

1535835

**III. Name of the holder:**

RETARGETING BIZ SRL

**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 15, 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.

Descriptiveness objections

The trademark is considered to be clearly descriptive or deceptively misdescriptive of the character or quality of the associated services. Specifically, the trademark clearly describes that the services provide retargeted advertisements. In this regard, it is noted that "retargeting" is a commonly-used term in marketing to refer to online advertising toward people who have previously visited the website of the business being advertised (see Annex 1).

Alternatively, if the services do not have this feature, trait, characteristic, or quality, 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 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 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.

In addition, if an objection is raised because a trademark is clearly descriptive or deceptively misdescriptive under paragraph 12(1)(b), an objection under paragraphs 37(1)(d) and 32(1)(b) will also be raised. Therefore, 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. In particular, the subject trademark does not distinguish the services of the applicant from those of another person or business in that the trademark clearly describes or deceptively misdescribes the character of the applicant's services, namely that the services provide retargeted advertisements. Furthermore, the word "retargeting" is considered widely-enough used in the trade that it would not distinguish the applicant's services from those of others regardless of whether it is clearly descriptive.

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.

#### Statement of services

In addition, 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 all of the applied-for services (listed below for ease of reference) are not in specific and ordinary commercial terms:

- 1) Advertising services (Class 35)
- 2) Marketing services (Class 35)
- 3) On-line advertising and marketing services (Class 35)
- 4) Internet marketing services (Class 35)

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?

Services such as "advertising" and "marketing" are acceptable under the Trademarks Act only if the applicant is providing these services to another party, and the third party receives a benefit from the services. In general, the applicant must be

“advertising” or “marketing” the goods or services of others. Furthermore, “marketing” is considered to include a wide range of activity beyond advertisements, and therefore does not refer to specific services unless the specific method of marketing is described, such as direct marketing or marketing through loyalty programs.

For further guidance on redefining the statement of 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](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

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,

Benjamin Welchner  
Examination Section  
819-360-9549  
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:  
2022-04-15
- (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:**

2021-10-15



15 oct/Oct 2021  
Votre référence Your File

Notre référence Our File  
2034688  
Numéro EI IR Number  
1535835

RETARGETING BIZ SRL  
Vasile Lascar nr. 178,  
Sector 2  
Bucuresti  
ROMANIA

RE: Trademark: Retargeting  
Applicant: RETARGETING BIZ SRL

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 15, 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*.

### **Descriptiveness objections**

The trademark is considered to be clearly descriptive or deceptively misdescriptive of the character or quality of the associated services. Specifically, the trademark clearly describes that the services provide retargeted advertisements. In this regard, it is noted that "retargeting" is a commonly-used term in marketing to refer to online advertising toward people who have previously visited the website of the business being advertised (see Annex 1).

Alternatively, if the services do not have this feature, trait, characteristic, or quality, 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 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 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.

In addition, if an objection is raised because a trademark is clearly descriptive or deceptively misdescriptive under paragraph 12(1)(b), an objection under paragraphs 37(1)(d) and 32(1)(b) will also be raised. Therefore, 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. In particular, the subject trademark does not distinguish the services of the applicant from those of another person or business in that the trademark clearly describes or deceptively misdescribes the character of the applicant's services, namely that the services provide retargeted advertisements. Furthermore, the word "retargeting" is considered widely-enough used in the trade that it would not distinguish the applicant's services from those of others regardless of whether it is clearly descriptive.

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.

### **Statement of services**

In addition, 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 all of the applied-for services (listed below for ease of reference) are not in specific and ordinary commercial terms:

- 1) Advertising services (Class 35)
- 2) Marketing services (Class 35)
- 3) On-line advertising and marketing services (Class 35)
- 4) Internet marketing services (Class 35)

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?

Services such as "advertising" and "marketing" are acceptable under the *Trademarks Act* only if the applicant is providing these services to another party, and the third party receives a benefit from the services. In general, the applicant must be "advertising" or "marketing" the goods or services of others. Furthermore, "marketing" is considered to include a wide range of activity beyond advertisements, and therefore does not refer to specific services unless the specific method of marketing is described, such as direct marketing or marketing through loyalty programs.

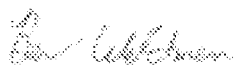
For further guidance on redefining the statement of services, please refer to the *Goods and Services Manual* available on our website. This searchable tool is not an exhaustive list of acceptable terms, but it may be used as a guide to the specificity and ordinary commercial term requirements of the *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](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

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,



Benjamin Welchner  
Examination Section  
819-360-9549  
fax: 819-953-2476

## **ANNEX 1**

<https://stablewp.com/retargeting-101/>

Are you stuck getting a ton of traffic but not making nearly enough sales?!

Well, you're not alone, on average 98% of visitors will leave a website without making a purchase.

As scary as this might sound, don't give up just yet! With **retargeting** ads, you can re-engage those lost visitors!

In this article, you'll learn everything you need to know about **retargeting** and how to turn more visitors into paying customers.

## **Retargeting 101**

**Retargeting** is a form of online advertising that's targeting users based on their interactions with your website, content or products.

Most often when you hear the term **retargeting** it refers to ads (aka display ads) that are shown to users who visited your site but haven't purchased anything.

Like everyone else that's ever used the internet, chances are you've been exposed to **retargeting** ads.



<https://www.analytico.ca/what-is-retargeting-in-digital-marketing/>

## What is Retargeting in Digital Marketing?

**Retargeting** reminds your potential customers about your products or services after they leave your website without purchasing. With **retargeting** you can show these visitors relevant ads when they visit other sites. **Retargeting** can be done with apps, search, and website banner ads. It is a great tool to re-engage customers who may have forgotten about your businesses and boost your sales.

## Why is Retargeting Important?

- **Retargeting** is great for businesses who already have a traffic flow to their website. If a business has at least 100 visitors in a month, then investing in Google **retargeting** ads is a good option.
- Brands can also promote their best-selling or new products through **retargeting** ads. Promoting your products that are best liked by your previous customers can get the attention of new visitors and influence them to purchase.

<https://www.sensov.com/question/retargeting-events-success/>

## WHAT IS EVENT RETARGETING?

**Retargeting** is a form of online advertising that allows you to target past anonymous website visitors and re-display your marketing offer to them. When a potential attendee visits your website, they get tagged through a pixel and a cookie is set in their browser. The browser cookie (not a cookie of the Oreo variety) is then used to trigger ads to appear as the person browses other websites. The entire process is unobtrusive and seamless.

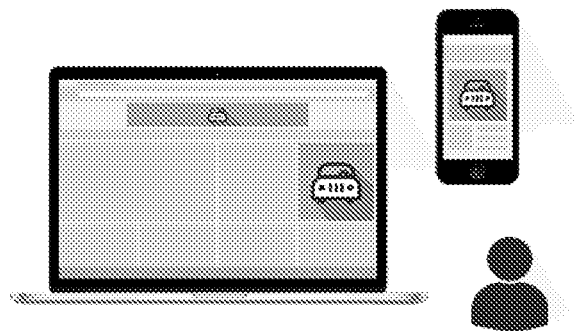
Another option is list-based **retargeting**, which allows you upload your entire member email list or past attendee lists onto the advertising platform, and specifically target these people as part of your advertising campaign. Because an existing customer is much easier to sell to than a new one, combining email and **retargeting** ads creates a powerful mix that can **seriously boost your registrations**.

## RECAPTURE REGISTRATION ABANDONMENT

Most prospective attendees will not register on their first visit, essentially abandoning their "shopping cart". A cart abandonment campaign is a tried-and-tested method for generating conversions, regardless if your event is free to attend or not.

You know these prospects have shown an interest in your event because they have visited your event landing page. The reason why they didn't register right away is not immediately important; after all, everyone needs a little reminder sometimes. What's crucial is to not let this valuable segment slip away.

With **retargeting** you could **deliver ads to everyone who visited the registration page but didn't complete it**, and remind them to do so. You can also combine this with your event timeline, and create distinct ads announcing **registration opening, speaker reveals, early bird discounts or last-chance registrations**. According to recent statistics, up to 60% of respondents say **retargeting** would encourage them to make a purchase they initially abandoned.



#### RETARGETING

Increase the likelihood of conversion by delivering ads to consumers frequenting your website and showing interest in your product offering.

[EXPLORE FEATURES](#)



#### Site Level Retargeting

Site-level data (such as pages viewed and products browsed) is used to target consumers with a catered ad that drives them through the sales funnel.



#### Proprietary Search Level Retargeting

Search data is captured and used to target prospects with ads based on the searches they perform across the web.



#### Location-Based Retargeting

Retarget users based on a device's historical location for hyper-relevant messaging.



## Retargeting: Get more value from your PPC campaign (AdWords and Facebook Ads)

**Retargeting** (also known as remarketing) targets users who have visited your website but who did not perform a desired action (purchase, registration, contact, and so on) while there. Remarketing offers them online ads that are more personalized and so attempts to "convert" them.

As a result, you can compile a list of types of prospects, based on different criteria and, by placing cookies on their browsers, you can then target them with customized advertisements that will be displayed when they visit other websites!

## Improve the results of your AdWords campaigns!

Unlike many other methods of online advertising, **remarketing** on the Google Display Network, can be extremely useful for improving your brand image and reputation, as well as for generating direct responses because customization creates a message more relevant to the user.

Contrary to what one might think, this technique is not intrusive for website visitors because you can set a weekly limit on the frequency at which the user sees your ads.

In addition, it has been shown that visitors who have been targeted by remarketing are 70% more likely to make a purchase than those who have not!

Consequently, **retargeting** is an excellent way to improve the conversion rates of your online campaigns.