



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:

1393518

III. Name of the holder:

RIVEDIL DI CODARDO COSIMO

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 June 22, 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.

In view of paragraph 12(1)(d) of the Trademarks Act the trademark does not appear to be registrable since it is considered confusing with registered trademark(s) no(s). TMA1,060,798, particulars of which are attached.

In assessing whether there is a reasonable likelihood of confusion between the trademark and the cited trademarks, the Registrar must have regard to the provisions of subsection 6(2) of the Trademarks Act, which provides that:

The use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

The Registrar must consider all the surrounding circumstances including those stated in subsection 6(5) of the Act

(a) the inherent distinctiveness of the trademarks or tradenames and the extent to

- which they have become known;
- (b) the length of time the trademarks or tradenames have been in use;
 - (c) the nature of the goods, services or business;
 - (d) the nature of the trade;
 - (e) the degree of resemblance between the trademarks or tradenames in appearance or sound or in the ideas suggested by them.

Confusion is tested in terms of the average consumer's first impression of the one trademark and imperfect recollection of the other trademark(s), and not by a side-by-side scrutiny. The "average consumer" is a likely buyer of the associated goods or services who has an average education in English and/or French.

Please be advised that the objection, as noted above with respect to the cited trademark(s) with registration no(s). TMA1,060,798, pertains to all the goods presently designated in the subject Protocol application.

The applicant's written comments with respect to this matter are invited.

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 and 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 and services are not in specific and ordinary commercial terms:

- 1) Paints; (Class 2)
- 2) mordants; (Class 2)
- 3) varnishes; (Class 2)
- 4) anti-corrosive preparations; (Class 2)
- 5) wood coatings [paints]; (Class 2)
- 6) coatings for roofing felt [paints]; (Class 2)
- 7) colorants; (Class 2)
- 8) dyes; (Class 2)
- 9) pigments; (Class 2)
- 10) distempers; (Class 2)
- 11) enamels [varnishes]; (Class 2)
- 12) coatings [paints]; (Class 2)
- 13) fixatives [varnishes]; (Class 2)
- 14) glazes [paints, lacquers]; (Class 2)
- 15) protective preparations for metals; (Class 2)
- 16) coloring [colouring] wood; (Class 2)
- 17) lacquers; (Class 2)

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

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 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,

Angela Felker
Examination Section
873-355-9184
fax: 819-953-2476

VII. Information relating to an earlier mark:

1806866 TMA1,060,798

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- (i) Filing date and number, and, if any, priority date:
2016-10-28, **1806866**
- (ii) Registration date and number (if available):
2019-10-25, TMA1,060,798
- (iii) Name and address of the owner:
BASF Corporation
100 Park Avenue
Florham Park, NJ 07932
UNITED STATES OF AMERICA
- (iv) Reproduction of the mark:
SAHARA
- (v) List of the relevant goods and/or services (this list may be in the language of the earlier application or registration):
7 Power operated mixing machine used to apply colorant to sand, rock, stone, concrete aggregate, mulch and wood.

VIII. Corresponding essential provisions of the applicable law:

Paragraph 12(1)(d) of the Trademarks Act
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:
2022-06-22

- (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:

2021-12-22



22 déc/Dec 2021
Votre référence Your File

Notre référence Our File
2048225
Numéro EI IR Number
1393518

Sahara
PREMIUM

ROBIC
630, boul. René-Lévesque Ouest
20e étage
Montréal
QUÉBEC H3B 1S6

RE: Trademark: Sahara PREMIUM
Applicant: RIVEDIL DI CODARDO COSIMO

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The Registrar must consider all the surrounding circumstances including those stated in subsection 6(5) of the *Act*

- (a) the inherent distinctiveness of the trademarks or tradenames and the extent to which they have become known;
- (b) the length of time the trademarks or tradenames have been in use;
- (c) the nature of the goods, services or business;
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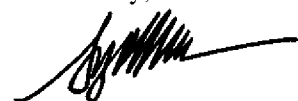
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Gatineau, QC K1A 0C9

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