



MADRID PROTOCOL

Total Provisional Refusal of Protection

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

I. Name of the Office:

Canadian Intellectual Property Office

II. International registration number:

1593347

III. Name of the holder:

Nosio S.p.A.

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:

The provisional refusal affects all the goods and 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 March 6, 2023. 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 primarily merely the surname of an individual who is living or has died within the preceding thirty years. The previous requirement to find a minimum number of listings of a name in Canadian phone directories before an objection is raised has been removed. Research has found that the surname MILEO appears in Facebook and LinkedIn. Therefore, in view of the provisions of paragraph 12(1)(a) of the *Trademarks Act*, the trademark does not appear registrable.

Moreover, 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 since MILEO is primarily merely the surname, and therefore does not act as a source identifier of the applicant's goods. Other traders, in the ordinary course of their business, should be able to identify the same or similar goods and services by their surname. It should also be noted that if an objection is raised because the trademark is primarily the name or surname under paragraph 12(1)(a) of the *Trademarks Act*, the Examiner will also raise an objection under paragraphs 37(1)(d) and 32(1)(b), since surnames are not considered to be inherently distinctive.

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.

Any comments the applicant may wish to submit in writing will receive consideration. 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 the following goods are not in specific and ordinary commercial terms:

- 1) Alcoholic beverages (class 33).

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 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,

Oksana Prosvirina
Examination Section
819-431-3174
fax: 819-953-2476

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 services (this list may be in the language of the earlier application or registration):

Not applicable

VIII. Provisions of the applicable law:

Paragraph 12(1)(a) of the *Trademarks Act*

Paragraph 37(1)(d) of the *Trademarks Act*

Paragraph 32(1)(b) 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 or otherwise respond to the opposition:

- (i) Time limit to request a review or file an appeal or otherwise respond to the opposition:

2023-03-06

- (ii) Calculation of time limit (the time limit runs from):

2022-09-06

- (iii) Authority to which such request for review, appeal or response should be made:

Registrar of Trademarks

- (iv) Whether the request for review, appeal or response has to be filed in a specific language or through a local representative:

Correspondence must be in French or English

- (v) Other requirements, if any:

Not applicable

X. Date and signature of the Office:

Registrar of Trademarks

2022-09-06



6 sept/Sep 2022
Votre référence Your File

Notre référence Our File
2109906
Numéro EI IR Number
1593347

CHANTAL ST. DENIS
(O'BRIEN TM SERVICES INC)
262, chemin Eardley
Gatineau
QUEBEC J9J 2Y7
Attention: Chantal St. Denis

RE: Trademark: MILEO
Applicant: Nosio S.p.A.

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Yours truly,



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