

In reply please quote our reference

Your reference:

Our reference: 2023/00033590IRSDQ

Date: 17 February 2023

Writer's direct number:

WIPO

WORLD INTELLECTUAL PROPERTY ORGANIZATION
INTERNATIONAL REGISTRATIONS DEPARTMENT
34, CHEMIN DES COLOMBETTES, 1211 GENEVA 20
SWITZERLAND

Dear Sir/Madam

**NOTIFICATION OF PROVISIONAL REFUSAL OF PROTECTION TO THE INTERNATIONAL BUREAU OF THE
WORLD INTELLECTUAL PROPERTY ORGANIZATION ACCORDING TO ARTICLE 5 OF THE PROTOCOL
RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF
MARKS**

- 1 Office making the notification:**
Intellectual Property Office of Singapore (IPOS)
- 2 International Registration Number:**
1664726
- 3 Trade Mark Number(s) issued by the IPOS for this International Registration:**
Trade Mark Number : 40202256595Q
Class Number(s) : 09, 35, 36, 37, 39 and 42
- 4 Name of holder of the International Registration:**
SOLERA GLOBAL TECHNOLOGY LIMITED
- 5 Ground(s) of Provisional Refusal:**

Provisions of Singapore Law: The relevant provisions of Singapore law are attached.

5.1 Section 8(2)(b)

The mark is objectionable under section 8(2)(b) of the Trade Marks Act 1998 which states that a trade mark must not be registered if because it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public.



We are of the view that the subject mark is in conflict with the following trade mark in respect of the indicated class:

Cited Mark

S/N	Cited TM No./ IR No. (Status) Applicant Name(s)	Representation	Objected Classes
1	40201521297Q (Registered) Solera Holdings, Inc.	SOLERA	Class 09: All goods Class 35: All services. Class 36: All services. Class 37: All services. Class 42: All services.

The earlier marks have been cited against the subject mark as they have been deemed to be similar. Both marks share the common distinctive element “SOLERA” which is likely to be regarded by the average consumers as the badge of trade origin.

While we note the additional device and stylisation of the term “SOLERA” in the subject mark, we are of the view that the device is insufficient to offset the overall similarities between the marks in question. The stylised term “SOLERA” is a dominant component of the subject mark, and both subject and earlier marks are pronounced as “So-le-ra”. The conceptual identity conveyed by both marks also remain similar, despite the stylisation and device in the subject mark. As a result, we are of the view that the subject and earlier marks are visually and conceptually similar, and aurally identical.

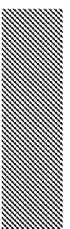
Taking into account the overall similarities of the marks, and the goods and services offered, it is likely that a substantial portion of the average consumers would be confused and led into believing that the holder’s goods and services originate from the same source as the cited proprietor or, that they are economically linked.

In view of the above, we believe that an objection under section 8(2)(b) is established.

6 How to overcome our objection under section 8(2)(b)

You may consider the following options:

- (a) Obtain a letter of consent from the cited proprietor; or



(b) File evidence to show honest concurrent use in Singapore. In other words, you may file evidence to show that before the date of this application, your mark has been put to use for the goods and/or services applied for at the same time as the cited mark(s) according to honest practices in commercial and industrial standards. This evidence may show that the public is used to distinguishing between your mark and the cited mark(s) and there is no likelihood of confusion in the public. The evidence should show concurrent use of your mark and the cited mark(s) for a period of at least 5 years before the date of this application. The evidence should be presented by way of a statutory declaration. For guidance as to how the letter of consent or evidence of honest concurrent use should be presented, please refer to <https://go.gov.sg/tm-sampleLOC> or <https://go.gov.sg/tm-sampleSD> respectively.

7 Specification of services

We note that you have applied for protection of the mark for goods and services in 09, 35, 36, 37, 39 and 42. However, we are raising objections under rule 19(2)(b)(ii)(A) of the Trade Marks Rules for the following services:

Class 35

- a) *business data query services for providing utilization, satisfaction, quality and financial measurements of suppliers and consumers in the field of vehicle repair for business purposes*

The description is vague. Please clarify the exact nature of the services and reword for our consideration.

- b) *cost containment, referral, and auditing and coordinating services for the purchase, billing and installation of products or rendering of services by others in the automotive and insurance fields*

The underlined description is vague. Please clarify the exact nature of the services and reword for our consideration.

- c) *collection and analysis of quality metric data for business purposes, customer relationship management in the nature of providing information, and business information services in the nature of providing customer satisfaction information, all pertaining to insurance claims and vendors who complete work pursuant to those claims in the fields of automotive repair via a global network*

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The underlined description is vague. Please clarify the subject matter of the information services provided to aid classification.

Please note that no form or fee is required for an amendment to the specification of goods or services of an international registration designating Singapore.

8 Goods and/or services affected by the refusal:

This refusal applies to the following goods and/or services:

Class No.	Scope of Refusal
9	All goods.
35	All services.
36	All services.
37	All services.
42	All services.

7 Request to review:

The holder of the international registration may file a request for a review of this refusal with IPOS.

The request for review must comply with the following:

- (a) quote the International Registration number, relevant trade mark number(s), corresponding class number(s) and Singapore reference number(s).
- (b) furnish an address for service in Singapore. The holder may appoint an agent by filing Form CM1. All forms have to be filed online via our registered account.

Please note that any form(s) filed with the International Bureau of the World Intellectual Property Organization in response to this refusal, will not be treated as a request for a review of this refusal unless the above has been complied with.

8 Extension of time:

The holder may seek an extension of time to request for a review of this refusal by filing Form CM5.

9 Deadline to observe:

If the holder does not file a request for review or apply for an extension of time to do so by **17**



June 2023, the application for the refused goods and/or services indicated in paragraph 6 of this refusal will be treated as withdrawn (continued processing possible).

10 Request continued processing of an application that is treated as withdrawn (continued processing possible):

If the application becomes treated as withdrawn (continued processing possible), the holder may request to continue processing the application by filing Form CM13 together with the request for review within two months from the deadline in paragraph 9. If Form CM13 is also not filed in time, the application for goods and/or services that are not refused will proceed to publication.

11 Forms and fees:

The forms referred to in this provisional refusal and the relevant fees may be found at <https://digitalhub.ipos.gov.sg>.

12 Further refusal of protection:

Please note that a further refusal of protection may result from an opposition, which may be filed after the expiry of 18 months from the date on which the Intellectual Property Office of Singapore was notified of the international registration. This applies to all goods and/or services claimed in the international registration.

This refusal is issued by:

Mr Samuel Chong Junjie
Assistant Registrar
for Registrar of Trade Marks
Email: Samuel_chong@ipos.gov.sg

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PROVISIONS OF SINGAPORE LAW

TRADE MARKS ACT (CHAPTER 332)

Section 2(1) Interpretation

"earlier trade mark" means –

(a) a registered trade mark or international trade mark (Singapore), the application for registration of which was made earlier than the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks; or

(b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was a well known trade mark,

and includes a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) subject to its being so registered.

Section 8 Relative grounds for refusal of registration

(2) A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected; or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public.

TRADE MARKS RULES

Rule 19 Specification

(2) Every application form shall contain, for each class of goods or services to which the application relates

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(a) the class number as set out in the Nice Classification as in force on the date of that application; and

(b) a specification of those goods or services which

(i) is appropriate to that class;

(ii) is described in such a manner as to (A) indicate clearly the nature of those goods or services; and (B) allow those goods or services to be classified in accordance with the Nice Classification as in force on the date of that application; and

(iii) complies with any other requirement of the Registrar

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CITED MARK DETAILS

Trade Mark No. 40201521297Q	SOLERA
Application Type	Trade Mark
Trade Mark Type	Trade Mark
Description of Particular Feature(s) of Mark	
Application Date	04 December 2015
Mark Status (unless otherwise indicated below)	Registered
Mark Status Date	04 December 2015
Status Update Date	08 March 2018
Date of Completion of Registration Procedure	08 March 2018
Expiry Date (unless otherwise indicated below)	04 December 2025
Publication Date	29 December 2017
Specification of Goods or Services	
Class Number	09
Goods/Services	Downloadable computer software and computer application software for mobile

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devices for use in the automotive, vehicle, fire, and health industries for vehicle identification and for vehicle and structural loss valuation, appraisals, damage estimation, inspection, repairs, repair workflow and tracking, customer satisfaction tracking, for interfacing with intelligent estimating system software; downloadable computer software and computer application software for analysis and control of workflow, profits, and business growth, for employee allocation; downloadable computer software and computer application software for performance tracking; downloadable computer software and computer application software for tracking inventory of vehicle parts; downloadable computer software and computer application software for managing databases for ordering vehicle parts, for sharing client data, and for processing, clearing, and reconciling financial transactions between insurers, vehicle and structural repair facilities, appraisers, salvage operators, recyclers in the automotive, vehicle, fire, and health industries, and vehicle and structure owners; downloadable electronic publications in the nature of newsletters in the field of vehicle insurance, collision repair, and vehicle salvage and recycling; downloadable manuals and recorded manuals in the field of automotive vehicle parts; downloadable instructional manuals and recorded instructional manuals in the fields of automotive vehicle repair and

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	vehicle collision repair
Class Status	Registered
Class Expiry Date	04 December 2025
Class Number	35
Goods/Services	Cost price analysis, namely, estimating dollar value damage to automobiles and structures; providing trade information regarding the location of used vehicle parts; commercial information services on location and cost of used and recycled vehicle parts provided by access to an online computer database; online database management; collection and analysis of quality metric business data for providing utilization, satisfaction, quality and financial measurements of suppliers and consumers in the field of property and vehicle repair; business consultancy services relating to cost containment, referral, and auditing services for the purchase, billing and installation of products or rendering of services by others in the automotive, construction and insurance fields; advertising, marketing, direct mail and promotion services for automotive retailers, namely, providing advertising, marketing, direct mail and promotion services during the sale, post-sale, service, maintenance and repurchase of automobiles; Providing business risk evaluation information to insurance companies; commercial information services on the locations and costs of used and recycled vehicle parts for purchase by others provided by access to an online computer database; book-

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keeping of electronic payment data; business management services relating to electronic payment support services in the nature of electronic administrative invoice processing; consultancy relating to auditing of insurance claims of vehicle damage for others; preparation of invoices in relation to electronic invoice processing for bills in the automotive, construction, and insurance fields; consultancy relating to auditing of vehicle and structural damage insurance claims; providing trade information for auto technicians collection and analysis of quality metric data, customer relationship management in the nature of providing information, and business information services in the nature of providing customer satisfaction information, all pertaining to insurance claims and vendors who complete work pursuant to those claims in the fields of automotive repair and building reconstruction and restoration, via a global network; compiling data in the nature of driving records, vehicle information and information regarding drivers of motorized vehicles for use to determine financial risk of insurers

Class Status Registered
Class Expiry Date 04 December 2025

Class Number 36
Goods/Services Financial services in the automotive, construction, and insurance fields, namely, electronic processing of insurance claims and payment data for damage to

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vehicles and structures; insurance consultation, namely, consultation in the fields of vehicle collision and structural repair claims processing and management; insurance claims assessment and processing, namely, reviewing, managing, and processing vehicle and structural damage insurance claims for others; financial valuation, namely, vehicle and structural loss valuation services, repair cost appraisal, and estimating dollar value damage to vehicles and structures; providing financial information pertaining to insurance claims and vendors who complete work pursuant to those claims in the fields of automotive repair and building reconstruction and restoration via a global computer network; Insurance consultation services, namely, providing risk assessment analysis for insurance underwriting applications; providing information and on-line computer databases for the purpose of assessing, evaluating and reporting insurance risks associated with underwriting property and casualty insurance; financial risk assessment and management services, namely, providing predictive financial risk analysis and information to insurers based on a database of public records regarding driving records pertaining to accidents, arrest and other driving violations to manage risk and providing predictive financial risk analysis and information to insurers based on a database searchable by zip code and geographic regions

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containing data used to assess risk variables to manage and price for risk; insurance services, namely, insurance policy verification for determining whether an individual or a business has insurance currently or had insurance as of a particular date providing financial risk assessment analysis for insurance underwriting applications; fire and auto insurance underwriting services; providing information regarding underwriting property and casualty insurance and providing an on-line computer databases in the underwriting property and casualty insurance field for the purpose of assessing, evaluating and reporting insurance risks; financial risk assessment of insurers by analyzing data in the nature of driving records, vehicle information and information regarding drivers of motorized vehicles; bill payment services and electronic payment processing services of bill payment data

Class Status Registered
Class Expiry Date 04 December 2025

Class Number 37
Goods/Services Providing information, including online, about vehicle damage diagnosis, repair and maintenance, for use by auto technicians

Class Status Registered
Class Expiry Date 04 December 2025

Class Number 42
Goods/Services Providing online non-downloadable computer software for use in the

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automotive, vehicle, fire, and health industries for vehicle identification and for vehicle and structural loss valuation, appraisals, damage estimation, inspection, repairs, repair workflow and tracking, customer satisfaction tracking, and for processing, clearing, and reconciling financial transactions between insurers, vehicle and structural repair facilities, appraisers, salvage operators, recyclers in the automotive, vehicle, fire, and health industries, and vehicle and structure owners; providing temporary use of non-downloadable online computer software in the fields of automobile insurance and automobile repair for collecting and analyzing data on critical business performance indicators to increase employee efficiency and improve overall performance and profitability; providing online non-downloadable software for the tracking and reporting of the status of vehicle repairs between vehicle repair service providers and vehicle owners; platform-as-a-service (PAAS) featuring computer software platforms for tracking, updating and producing reports regarding the status of vehicle repairs between vehicle repair service providers and vehicle owners; providing a website featuring technology that enables users to retrieve information regarding motorized vehicles, drivers and passengers of motorized vehicles, driving records and vehicle information; computer services, namely, electronic storage of information about motorized vehicles, drivers of

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	motorized vehicles, and driving records; providing online, non-downloadable computer programs for allowing fleet owners and operators to track commercial drivers' traffic violations for regulatory compliance purposes
Class Status	Registered
Class Expiry Date	04 December 2025
Class Number	45
Goods/Services	Providing physical safety of persons and security of tangible property information, including online, regarding undisclosed motorists' driving records pertaining to accidents, arrests, and vehicle registration information for public safety and regulatory compliance purposes
Class Status	Registered
Class Expiry Date	04 December 2025
Mark Clauses	
Current Applicant or Proprietor Details	
Name	Solera Holdings, Inc.
UEN/Company Code	
Country/Territory of Incorporation/Residency	UNITED STATES OF AMERICA
State of Incorporation	Delaware
Address	7 Village Circle, Suite 100, Westlake Texas 76262, United States of America
Agent/Correspondence Details	

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Agent Name	ELLA CHEONG LLC
UEN/Company Code	
C/O Name	
Address for Service	300, BEACH ROAD, #31-04/05, THE CONCOURSE Singapore 199555
Action Representing	Matters relating to application, registration / grant
For more information, please refer to the IPOS Register.	

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