



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:

1635962

III. Name of the holder:

Simplyworks Inc.

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 November 1, 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.

In view of paragraph 37(1)(c) of the Trademarks Act, the applicant does not appear to be entitled to registration. Specifically, the entitlement date of November 1, 2021 of the subject Protocol application is later than the entitlement dates of December 1, 2020 and December 3, 2020 of co-pending and confusing application nos. 2,067,421 and 2,068,383, the 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 trademarks with application nos. 2,067,421 and 2,068,383, pertains to all the goods and services presently designated in the subject Protocol application.

Additionally, 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 examiner finds that the trademark, SIMPLY WORKS is not adapted to distinguish the applicant's goods and services due to the fact that it is a phrase which is commonly used in the trade. The examiner has attached research demonstrating use of the phrase in the associated trade (see Annex 1). Please note, all research is available to Canadians and likely to be viewed by Canadians. As a result, consumers will not perceive this phrase as applied to applicant's goods and services as a source indicator pointing uniquely to applicant. Rather, consumers purchasing applicant's goods and services will perceive the applicant's trademark as a phrase commonly used by multiple individuals and entities rather than a sole source of goods and/or services.

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.

Finally, 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 or services are not in specific and ordinary commercial terms:

- 1) cosmetic preparations for the care of mouth and teeth; (Class 3)

2) non-medicated toilet preparations; (Class 3)

3) Advertising services relating to cosmetics; (Class 35)

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

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,

Angela Felker

Examination Section

873-355-9184

fax: 819-953-2476

Annex 1:

Organic Skin Care Products | Natural Skin Care | Organic Apoteke

Simply Works - Studio AHNTONE

FACEatelier | INDI & ARY (indiandary.com)

Evidence based skin care that simply works - Professional Beauty

\$9 L'oreal Bare Naturale Gentle Lip Conditioner Simply Works - Makeup and Beauty Blog

Narcyss - Modern Wellness

Organic cosmetics simply works better | ECO-Cosmetics (eco-naturkosmetik.de)

Otto Skin Goods

VII. Information relating to an earlier mark:

2067421
2068383

-
- (i) Filing date and number, and, if any, priority date:
2020-12-01, **2067421**
- (ii) Registration date and number (if available):
Not applicable
- (iii) Name and address of the owner:
Simple Works Inc.
11 Citino Dr
Hamilton
CANADA
- (iv) Reproduction of the mark:
SIMPLE WORKS
- (v) List of the relevant goods and services (this list may be in the language of the earlier application or registration):
(Class 35) Online retail sales of wine making kits; online retail sales of pet food and pet treats; online retail sales of clothing, footwear and handbags; online retail sales of cosmetics; online retail sales of soaps for personal use; online retail sales of beauty products, namely, makeup, namely foundation, blush, mascara, eyeshadow, lipstick, makeup tools and applicators; online retail sales of skin care products, namely, facewash, lotions, toners and treatments; online retail sales of toys; online retail sales of computers, namely, laptops, notebook ,computers and desktop computers; online retail sales of housewares; online retail sales of board games and video games; online retail sales of electronics, namely, televisions, computer monitors, video game systems, light bulbs, lamps, vacuum cleaners; online retail sales of small appliances, namely, toasters, electric kettles for household purposes, whistling kettles and non-electric kettles, microwave ovens; online retail sales of home improvement products, namely, power tools and hand tools, and light fixtures, namely, built in wall and ceiling mounted light fixtures, motion activated light fixtures, faucets; online retail sales of arts and craft products, namely, acrylic, oil and latex hobby paints.

-
- (i) Filing date and number, and, if any, priority date:
2020-12-03, **2068383**
- (ii) Registration date and number (if available):
Not applicable
- (iii) Name and address of the owner:
Simple Works Inc.
11 Citino Dr
Hamilton
CANADA

- (iv) Reproduction of the mark:
SIMPLE WORKS & Design



- (v) List of the relevant goods and services (this list may be in the language of the earlier application or registration):
(Class 35) Online retail sales of wine making kits; online retail sales of pet food and pet treats; online retail sales of clothing, footwear and handbags; online retail sales of cosmetics; online retail sales of soaps for personal use; online retail sales of beauty products, namely, makeup, namely foundation, blush, mascara, eyeshadow, lipstick, makeup tools and applicators; online retail sales of skin care products, namely, facewash, lotions, toners and treatments; online retail sales of toys; online retail sales of computers, namely, laptops, notebook ,computers and desktop computers; online retail sales of housewares; online retail sales of board games and video games; online retail sales of electronics, namely, televisions, computer monitors, video game systems, light bulbs, lamps, vacuum cleaners; online retail sales of small appliances, namely, toasters, electric kettles for household purposes, whistling kettles and non-electric kettles, microwave ovens; online retail sales of home improvement products, namely, power tools and hand tools, and light fixtures, namely, built in wall and ceiling mounted light fixtures, motion activated light fixtures, faucets; online retail sales of arts and craft products, namely, acrylic, oil and latex hobby paints.

VIII. Provisions of the applicable law:

Paragraph 30(2)(a) of the *Trademarks Act*

Paragraph 32(1)(b) of the *Trademarks Act*

Paragraph 37(1)(c) 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 or otherwise respond to the opposition:

- (i) Time limit to request a review or file an appeal or otherwise respond to the opposition:
2023-11-01
- (ii) Calculation of time limit (the time limit runs from):
2023-05-01

- (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

2023-05-01



1 mai/May 2023
Votre référence Your File

Notre référence Our File
2157369
Numéro EI IR Number
1635962

Simplyworks Inc.
701-802, Mokdong-ro 212,
Yangcheon-gu
Seoul
REPUBLIC OF KOREA

RE: Trademark: simply works
Applicant: Simplyworks Inc.

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Yours truly,

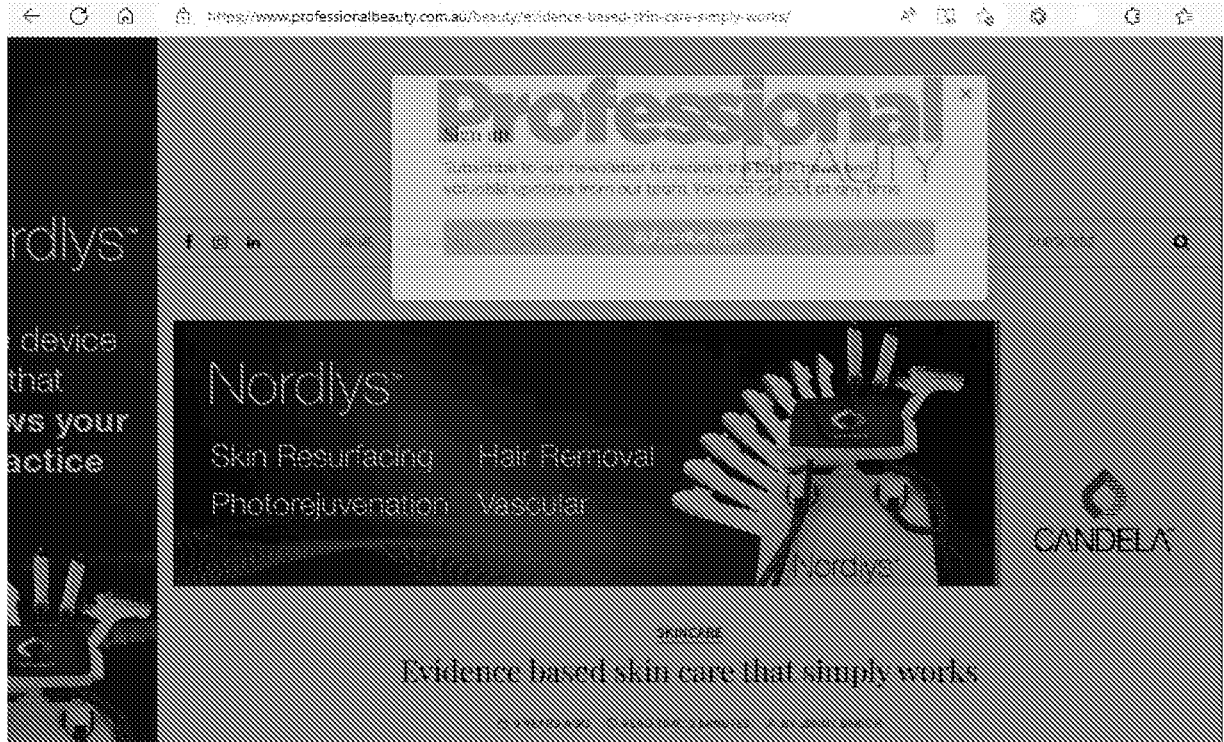


Angela Felker
Examination Section
873-355-9184
fax: 819-953-2476

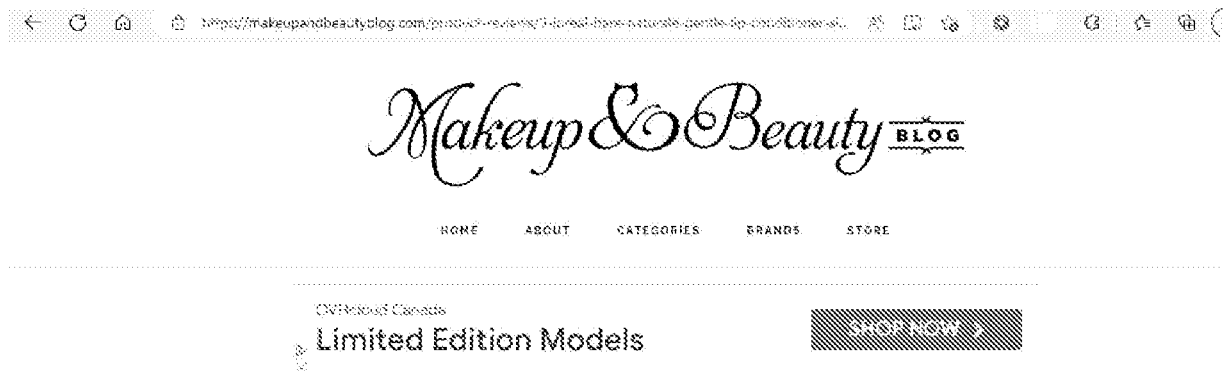
Annex 1:



The screenshot shows a web browser window with the URL <https://organicapoteke.com>. The main heading reads "NATURAL SKIN CARE THAT SIMPLY WORKS". Below this, a paragraph states: "Every product in our range has been created with results in mind. We respect nature's resources and the natural intelligence of your skin. We believe that healthy skin is beautiful skin. Our products give you healthy skin. Easy to use, easy to choose, our organic skin care products simply work." The advertisement features a side-by-side comparison of a woman's face, showing skin improvement. To the right, three skincare products are displayed. At the bottom of the ad, the text reads: "Organic Skin Care Products | Natural Skin Care | Organic Apoteke".

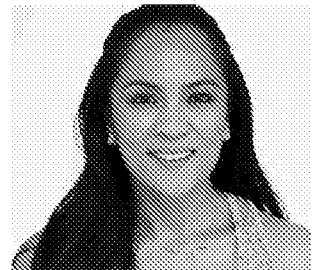


Evidence based skin care that simply works - Professional Beauty



\$9 L'oreal Bare Naturale Gentle Lip Conditioner Simply Works

January 7th, 2009 by Karen — 13 Comments



\$9 L'oreal Bare Naturale Gentle Lip Conditioner Simply Works - Makeup and Beauty Blog

← ↻ 🏠 📄 https://www.narcyss.com

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L'EAU BRUT

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Narcyss - Modern Wellness

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BLOG

📄 ORGANIC COSMETICS SIMPLY WORKS BETTER



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