



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:

1588060

III. Name of the holder:

Pölky Oy

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 3, 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 compliance with paragraph 31(f) of the *Trademarks Regulations*, the applicant is required to provide a statement that colour is claimed as a feature of the trademark, along with the name of each colour claimed and an indication of the principal parts of the trademark that are in that colour.

By way of example only, the following colour claim would be acceptable.

Colour is claimed as a feature of the trademark. The colour green is claimed as a feature of the trademark. In particular, the wording POLKKY is green.

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 and services in a manner that identifies a specific good or service. It is considered that the following underlined goods and services are not in specific and ordinary commercial terms:

[Class 19] (1) Wood panelling; cladding sheets of wood; halved timber; wood chipboard; wood for making household utensils; hobby wood; wooden doors; wood rafters; wood paneling, joinery products of timber for use in buildings; wood, semi-worked; wood for building; wooden railings; wood blocks; boards made of wood particles; wood sheeting; timber laminated particle boards; building timber; timber panels; wood veneers; wood cladding; wood veneer sheets; building and construction materials and elements, not of metal; structural support members (non-metallic -); manufactured timber; sawn wood; sawn timber; cladding panels (non-metallic -); fire resisting wood; ceiling tiles (non-metallic -); ceiling coffers of non-metallic materials; wood joists; partitions, not of metal; plywood; veneer for floors; plywood for building, plywood board; veneer wood; wood veneers; cladding board (non-metallic).

[Class 31] (2) Undressed timber; litter for animals; bark for use in mulching; bark for use in mulching; decorative woodchip mulch; wood chips for use as ground cover; wood chips for the manufacture of wood pulp, woodshavings for use as animal bedding; trunks of trees; trees; undressed timber; unseasoned timber.

[Class 35] (1) Ordering services for third parties; business consultancy in the field of transport and delivery; retail services in relation to chemicals for use in forestry; wholesale services in relation to chemicals for use in forestry; sales administration; promotional marketing; promotion services; personnel management of sales personnel; providing advice relating to sales methods and techniques; administration relating to sales methods; consultancy relating to costing of sales orders; advisory and consultancy services relating to import-export agencies; wholesale of timber and processed wood; retail of timber and processed wood; wholesale and retail of building materials; presentation of goods and services; presentation of goods on communication media, for retail purposes; business management of wholesale and retail outlets; business management of wholesale outlets; wholesale ordering services.

[Class 39] (2) Storage of commercial goods; transit services; packaging of goods in transit; advisory services relating to the tracking of goods in transit; storage of goods in transit; storage of containers and cargo; container storage; consultancy services relating to transportation; arrangement of transportation; operation of stations used for transport purposes; transportation and storage; transport by heavy goods vehicles; transportation logistics; provision of data relating to methods of transport; transport brokerage; palletised freight distribution services; rental of pallets and containers for storage of goods; rental of pallets and containers for transport of goods; land freight services; freight and transport brokerage; information services relating to the movement of cargo; collection of freight; packing of freight; arranging the unloading of cargo; delivery of cargo by land; providing information relating to freight brokerage; storage of freight; storage of cargo before transportation; storage of cargo after transportation; freight warehousing; cargo delivery services; temporary storage of deliveries; bonded storage of goods; storage and delivery of goods; packaging articles for transportation; warehouse storage; provision of warehousing services and facilities.

[Class 40] (3) Material treatment information; stripping finishes; grinding; mould-inhibiting treatment; anti-mildew treatment; wood processing services; rental of machines and apparatus for wood-working; rental of machines and apparatus for plywood making; rental of machines and apparatus for veneering; rental of machines and apparatus for lumbering; annealing (services for -); planing of materials; treatment of materials using chemicals; sawing of materials; custom assembling of materials for others; laminating of wood; sawing of timber; kiln drying of timber; laminating of wood substitutes; processing of tree barks; woodturning services;

treatment of timber with preservatives; preservative treatment of wood [other than painting]; woodworking; providing information relating to woodworking; wood-carving; timber felling and processing; dry-rot treatment of timber; pressure-treatment of timber for preservation purposes; sawing of timber; timber preservation; termite-proofing and fire-proofing of timber; woodworking; kiln drying of timber; planing of materials; sawmill services; planing of materials.

Please clarify that “promotional marketing; promotion services (class 35)” offer a benefit to a third party. Services such as “advertising,” “marketing,” and “promoting” 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,” “marketing” or “promoting” the goods or services of others.

In addition, the goods/services, “bark for use in mulching” and “planing of materials”, have been listed more than once. The applicant is required to delete all redundant goods/services in the Protocol application.

Lastly, please note that while brackets or parentheses in goods or services can be used to provide additional clarification of specific terms, brackets cannot be used to provide clarification for indefinite terms. It will therefore be necessary to amend the aforementioned goods and services to replace brackets with an appropriate definite term having regard to paragraph 30(2)(a) of the *Trademarks Act* and section 29 of the *Trademarks Regulations*.

For further guidance on redefining the goods and 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

Upon satisfactory compliance with the above-mentioned requirement(s), further Office action will be undertaken.

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,

Wei Huang

Examination Section

819-639-2678

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 services (this list may be in the language of the earlier application or registration):
Not applicable

VIII. Provisions of the applicable law:

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

Section 29 of the *Trademarks Regulations*

Paragraph 31(f) 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:
2023-11-03

- (ii) Calculation of time limit (the time limit runs from):
2023-05-03
- (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

2023-05-03



3 mai/May 2023
Votre référence Your File

Notre référence Our File
2158626
Numéro EI IR Number
1588060

POLKKY

Pölkky Oy
Kemijärventie 73
FI-93600 Kuusamo
FINLAND

RE: Trademark: PÖLKKY/POLKKY
Applicant: Pölkky Oy

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