



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:

1639824

III. Name of the holder:

Alexander Binzel Schweisstechnik GmbH & Co. KG

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 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). TMA733,417, particulars of which are attached.

Furthermore, in view of paragraph 37(1)(c) of the Trademarks Act, the trademark does not appear to be entitled to registration. Specifically, the entitlement date of July 15, 2021 of the subject Protocol application is later than the entitlement date(s) of August 7, 2020 of co-pending and confusing application(s) no(s). 2,044,545 and 2,044,547, 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 trademark(s) with registration no(s). TMA733,417, pertains only to the goods presently designated in the subject Protocol application as:

Machines and machine tools for treatment of materials and for manufacturing; (Class 7)

Please be advised that the objection, as noted above with respect to the cited trademark(s) with application no(s). 2,044,545 and 2,044,547, pertains only to the goods presently designated in the subject Protocol application as:

Machines and machine tools for treatment of materials and for manufacturing; (Class 7)

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 or services are not in specific and ordinary commercial terms:

1) Machines and machine tools for treatment of materials and for manufacturing;

- (Class 7)
2) welding ... machines and devices; (Class 7)
3) industrial robots; (Class 7)
4) robots for machine tools; (Class 7)
5) robotic mechanisms for working metal; (Class 7)
6) robots for welding; (Class 7)
7) electric arc cutting apparatus; (Class 7)
8) electric arc welding apparatus; (Class 7)
9) robotic electric arc welding apparatus. (Class 7)

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

VII. Information relating to an earlier mark:

1294932 TMA733,417
2044545
2044547

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- (i) Filing date and number, and, if any, priority date:
2006-03-23, **1294932**

- (ii) Registration date and number (if available):
2009-01-28, TMA733,417
- (iii) Name and address of the owner:
ABI Anlagentechnik Baumaschinen Industriebedarf Maschinenfabrik und Vertriebsgesellschaft
mbH
Am Knüchel 4
63843 Niedernberg
GERMANY
- (iv) Reproduction of the mark:
ABI
- (v) List of the relevant goods and services (this list may be in the language of the earlier application or registration):
Construction equipment for foundations and shoring, namely, downhole drilling bits, earth augers and excavator mounted attachments, namely, hydraulic drills, foundation drilling machines, pile drivers machines, vibrators, impact hammers and rammers for underground drilling, silent piling pressing machines and pile extraction machines, soil mixing equipment, namely, power-operated tillers.
- Renting, maintenance, repair and servicing of construction machinery, construction tools and building material; inspection of construction projects, namely supervising of construction sites.

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- (i) Filing date and number, and, if any, priority date:
2020-08-07, **2044545**
- (ii) Registration date and number (if available):
Not applicable
- (iii) Name and address of the owner:
ABI Auto-Bake Industries Ltd
61 Performance Dr
Richmond Hill
CANADA
- (iv) Reproduction of the mark:
ABI LTD
- (v) List of the relevant goods and services (this list may be in the language of the earlier application or registration):
(Class 7) automated mixers for bread dough, bread dough dividing machines, dough scoring machines, dough marking and branding machines, sandwich assembly machines, lye application machines, seed and topping application machines, automated proofing machines, sorting machines, refrigerated agitator bowls for bread dough, electronically controlled pocket bread dividers, and dough handling equipment, namely, dough feeders, dough conveyors, dough trough hoists and post lift hoists; automated dough kneaders, sheeting, coiling and molding machines for dough processing, croissant rollers, croissant forming machines, croissant bending machines and curling units; cutting tables and cutting machines for pastry or dough processing; laminating machines, dough dividing machines, dough stamping machines, pastry and croissant filling machines, guillotine dough cutters, streusel machines, apparatus for dissipating remaining dough, cross roller units, dough forming and shaping machines, bagel

strand and bagel twisting machines; cutting rollers, dough reels, coiling apparatus, winding rollers, rollers for the production of lattice cake, folding plough apparatus, damping units, machine parts, namely, rounder screw for attachment to dough processing machines, dough dividers and rounders; equipment for use in industrial kitchens, namely, baking machines, mixing machines, dough dividing machines and electric dough processing, forming and dividing equipment, namely multi dividers, bagel dividers, dough rounders, and bagel formers; food mixers; packaging machines; optical systems for calibration and process control and automation in the food production and food processing industry.

(Class 42) consulting services in the fields of industrial automation, industrial control technology, automated manufacturing processes, and mechanical engineering, all for use in the food production and food processing industry; computer hardware and software development, programming, integration and implementation; mechanical and industrial automation engineering and design services in the field of process control in the food production and food processing industry; design, engineering, fabrication, assembly, installation, and servicing of baking equipment and machinery.

(i) Filing date and number, and, if any, priority date:

2020-08-07, **2044547**

(ii) Registration date and number (if available):

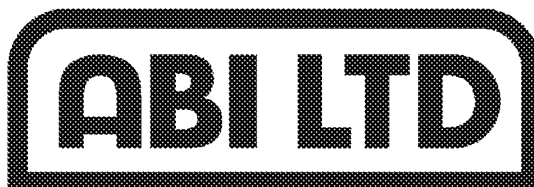
Not applicable

(iii) Name and address of the owner:

ABI Auto-Bake Industries Ltd
61 Performance Dr
Richmond Hill
CANADA

(iv) Reproduction of the mark:

ABI LTD & Design



(v) List of the relevant goods and services (this list may be in the language of the earlier application or registration):

(Class 7) automated mixers for bread dough, bread dough dividing machines, dough scoring machines, dough marking and branding machines, sandwich assembly machines, lye application machines, seed and topping application machines, automated proofing machines, sorting machines, refrigerated agitator bowls for bread dough, electronically controlled pocket bread dividers, and dough handling equipment, namely, dough feeders, dough conveyors, dough trough hoists and post lift hoists; automated dough kneaders, sheeting, coiling and molding machines for dough processing, croissant rollers, croissant forming machines, croissant bending machines and curling units; cutting tables and cutting machines for pastry or dough processing; laminating machines, dough dividing machines, dough stamping machines, pastry and croissant filling machines, guillotine dough cutters, streusel machines, apparatus for dissipating remaining dough, cross roller units, dough forming and shaping machines, bagel

strand and bagel twisting machines; cutting rollers, dough reels, coiling apparatus, winding rollers, rollers for the production of lattice cake, folding plough apparatus, damping units, machine parts, namely, rounder screw for attachment to dough processing machines, dough dividers and rounders; equipment for use in industrial kitchens, namely, baking machines, mixing machines, dough dividing machines and electric dough processing, forming and dividing equipment, namely multi dividers, bagel dividers, dough rounders, and bagel formers; food mixers; packaging machines; optical systems for calibration and process control and automation in the food production and food processing industry.

(Class 42) consulting services in the fields of industrial automation, industrial control technology, automated manufacturing processes, and mechanical engineering, all for use in the food production and food processing industry; computer hardware and software development, programming, integration, and implementation; mechanical and industrial automation engineering and design services in the field of process control in the food production and food processing industry; design, engineering, fabrication, assembly, installation, and servicing of baking equipment and machinery.

VIII. Provisions of the applicable law:

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

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

Paragraph 37(1)(c) 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:
2023-11-03
- (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



3 mai/May 2023
Votre référence Your File

Notre référence Our File
2161214
Numéro EI IR Number
1639824

Alexander Binzel SchweisstechnikGmbH & Co. KG
Kiesacker 7-9
35418 Buseck
GERMANY

RE: Trademark: ABIBUG
Applicant: Alexander Binzel SchweisstechnikGmbH
& Co. KG

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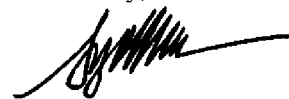
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Yours truly,



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