



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:

1640009

III. Name of the holder:

Get-Grin 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 4, 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 clearly descriptive or deceptively misdescriptive of the character of the following goods:

Class 10: Telemetry devices for medical applications; medical apparatus and instruments, namely, medical devices and apparatus for digital imaging; medical devices and apparatus for image acquisition; medical device used for the collection biometric data at home; medical devices, namely, sensors to collect human health data for the purposes of providing telemedicine services.

Specifically, the trademark clearly describes that the goods are, or encompass, gradient-index lenses for medical imaging. In this regard, research shows that GRIN is a common acronym for gradient-index, which covers optical effects produced by a gradient of the refractive index of a material (<https://www.thorlabs>).

com/newgrouppage9.cfm?objectgroup_id=11167 and https://en.wikipedia.org/wiki/Gradient-index_optics).

Alternatively, if the goods do not have this feature, trait, characteristic, or quality, the trademark is considered to be deceptively misdescriptive.

Therefore, in view of the provisions of paragraph 12(1)(b) of the Trademarks Act, the trademark does not appear registrable.

The word "character" means a feature, trait or characteristic of the goods and services. The test of whether a trademark is clearly descriptive considers the immediate first impression of the average Canadian user, purchaser, or consumer of the associated goods and services.

One of the most important purposes of paragraph 12(1)(b) of the Trademarks Act is to protect the right of all traders to use apt descriptive language. The courts have recognized that descriptive words are the property of all and cannot be appropriated by one person for their exclusive use since this would give them an unfair advantage over competitors in the same trade.

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 when considered in association with the following goods:

Class 10: Telemetry devices for medical applications; medical apparatus and instruments, namely, medical devices and apparatus for digital imaging; medical devices and apparatus for image acquisition; medical device used for the collection biometric data at home; medical devices, namely, sensors to collect human health data for the purposes of providing telemedicine services.

Trademarks which do not appear registrable pursuant to paragraph 12(1)(b) of the Trademarks Act are considered not inherently distinctive. In particular, the research shows that the word GRIN, is an is a common acronym for gradient-index. As such, the trademark does not distinguish the source of the applicant's goods, noted above, from those of a competitor, since the applied-for-trademark merely informs the consumer that the goods are, or encompass, gradient-index lenses for medical imaging.

Pursuant to paragraph 32(1)(b) of the Trademarks 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.

Further, 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 and services are not in specific and ordinary commercial terms:

1. telemedicine systems consisting of downloadable computer software, computer hardware, and body scanning cameras used for medical digital image capture, storage, retrieval and transmission over telecommunications media (class 9);
2. telemetry devices for medical applications (class 10);
3. medical apparatus and instruments, namely, medical devices and apparatus for digital imaging (class 10);
4. medical devices and apparatus for image acquisition (class 10);
5. medical device used for the collection biometric data at home (class 10);
6. medical devices, namely, sensors to collect human health data for the purposes of providing telemedicine services (class 10);
7. remote monitoring of data indicative of the health or condition of patients by electronic, computer and telecommunications means for diagnosis and treatment purposes (class 44).

Pursuant to paragraph 30(2)(a) of the Trademarks Act and section 29 of the Trademarks Regulations, goods described as "computer software" must specify both the function and the field of use of the software to be considered in ordinary commercial terms and described in a manner that identifies a specific good.

Further, statements in more specific terms of the goods presently designated as "apparatus", "devices" and "instruments" are required pursuant to section 29 of the Trademarks Regulations. The goods must also be defined in ordinary commercial terms in compliance with the provisions of paragraph 30(2)(a) of the Trademarks Act. As a general rule, goods described by the terms "apparatus", "devices" and "instruments" are not considered acceptable without further specification since they are considered to include different types of goods with different channels of trade which are not necessarily sold in close proximity.

The following three-part test is considered when determining whether the statement of goods or services is considered to be "specific" within the meaning of section 29 of the Trademarks Regulations:

1. Are the goods or services sufficiently specific so that it is possible to assess whether the trademark is clearly descriptive of those goods or services?
2. Are the goods or services sufficiently specific so that it is possible to assess confusion with another trademark?
3. Are the goods or services sufficiently specific to ensure that the applicant will not have an unreasonably wide ambit of protection?

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,

Kimberly Dunn
Examination Section
819-665-8767
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 12(1)(b) of the *Trademarks Act*

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

Paragraph 32(1)(b) 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:
2023-11-04
- (ii) Calculation of time limit (the time limit runs from):
2023-05-04
- (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

2023-05-04



4 mai/May 2023
Votre référence Your File

Notre référence Our File
2161146
Numéro EI IR Number
1640009

Get-Grin Inc.
382A Rte 59
Airmont NY 10952
UNITED STATES OF AMERICA

RE: Trademark: GRIN
Applicant: Get-Grin Inc.

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Yours truly,



Kimberly Dunn
Examination Section
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