



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:

1664726

III. Name of the holder:

Solera Global Technology Limited

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 March 28, 2024. 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 Nos. TMA1,038,076, TMA1,106,449, TMA1,038,075 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.

Any comments you may wish to submit will receive consideration.

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 or services are not in specific and ordinary commercial terms:

Goods

(1) computer software and application software, recorded or downloadable, for [...], website and digital marketing tools, relating to marketing and advertising in connection with automotive or other motorized vehicles, and transportation and distribution industries; security and safety devices for automotive and other motorized vehicles in the nature of electronic sensors and [...] to detect and prevent security risks; (Nice class 9)

Services

(1) advertising, marketing, direct mail and promotion services for automotive retailers, namely, providing [...] marketing, [...] and promotion services during the sale, post-sale, service, maintenance and repurchase of automobiles; financial record-keeping of electronic payment data; electronic; (Nice class 35)

(4) Charter and cargo transportation services in the nature of providing cargo transportation, routing and dispatching, and [...] for the transportation industry through a global computer network. (Nice class 39)

(5) software as service (SaaS) services featuring software for [...] website and digital marketing tools, all relating to marketing and advertising in connection with automotive and other motorized vehicles, and transportation and distribution industries. (Nice class 42)

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,

Christine Pappas-Kelly

Examination Section

819-921-1298

fax: 819-953-2476

VII. Information relating to an earlier mark:

1777427 TMA1,038,076
1922202 TMA1,106,449
1748295 TMA1,038,075

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

2016-04-14, **1777427**, 2015-11-20

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

2019-07-09, TMA1,038,076

(iii) Name and address of the owner:

Solera Holdings, Inc.
7 Village Circle, Suite 100
Westlake, TX 76262
UNITED STATES OF AMERICA

(iv) Reproduction of the mark:

SOLERA

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

(Class 9) Downloadable computer software and computer application software for mobile 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 vehicle collision repair

(Class 35) Cost assessment services, namely, estimating dollar value damage to automobiles and structures; providing trade information regarding the location of used vehicle parts; providing an online searchable database featuring informational listings on location and cost of used and recycled vehicle parts; online database management; collection and analysis of quality metric data for providing utilization, satisfaction, quality and financial measurements of suppliers and consumers in the field of property and vehicle repair; 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, developing promotional campaigns for others, direct marketing of the goods and services of others, and advertising the goods and services of others and direct mail advertising of the goods and services of others during the sale, post-sale, services, maintenance and repurchase of automobiles; Providing business risk evaluation information to insurance companies; providing an on-line searchable database featuring lists of the locations and costs of used and recycled vehicle parts for purchase by others; financial record-keeping of electronic payment data; electronic payment support services in the nature of electronic administrative invoice processing; insurance claims auditing of vehicle damage insurance claims for others; electronic payment support services in the nature of electronic administrative invoice processing; electronic invoice processing for bills in the automotive, construction, and insurance fields; insurance claims auditing of vehicle damage insurance claims for others; vehicle and structural damage insurance claims auditing services; 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

(Class 36) Financial services in the automotive, construction, and insurance fields, namely, electronic processing of insurance claims and payment data for damage to vehicles and structures; insurance consultation, namely, consultation in the fields of vehicle collision and structural repair claims processing and management; insurance claims administration 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 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; analyzing and 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; bill payment services and electronic payment processing services of bill payment data

(Class 37) Providing an on-line computer database in the field of vehicle damage diagnosis, repair and maintenance for use by auto technicians

(Class 42) Non-downloadable computer software 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, 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 motorized vehicles, and driving records

(Class 45) Providing databases of public vehicle records regarding undisclosed motorists' driving records pertaining to accidents, arrests, and vehicle registration information for public safety and regulatory compliance purposes; driver monitoring service, namely, providing online, non-downloadable computer programs allowing fleet owners and operators to track commercial drivers' traffic violations for regulatory compliance purposes

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

2018-09-27, **1922202**, 2018-05-02

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

2021-08-10, TMA1,106,449

(iii) Name and address of the owner:

Solera Holdings, Inc.
1301 Solana Blvd.
Bldg. # 2, Suite 2100
Westlake, TX 76262
UNITED STATES OF AMERICA

(iv) Reproduction of the mark:

SOLERA

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

(Class 35) Administration of customer loyalty programs, namely, customer loyalty services for commercial, promotional and advertising purposes; providing incentive award programs for customers through issuance and processing of loyalty points for purchase of a company's goods and services

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

2015-09-30, **1748295**, 2015-03-31

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

2019-07-09, TMA1,038,075

(iii) Name and address of the owner:

Solera Holdings, Inc.
7 Village Circle, Suite 100
Westlake, TX 76262
UNITED STATES OF AMERICA

(iv) Reproduction of the mark:

SOLERA & Design



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

(Class 9) Downloadable computer software and computer application software for mobile 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, for analysis and control of workflow, profits, and business growth, for employee allocation, for performance tracking, for tracking inventory of vehicle parts, 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

(Class 16) Automotive vehicle parts manuals; instructional manuals for using software in the fields of automotive vehicle repair and vehicle collision repair

(Class 35) Estimating dollar value damage to automobiles and structures; providing trade information regarding the location of used vehicle parts; providing an online searchable database featuring informational listings on location and cost of used and recycled vehicle parts; online database management; business data query services, namely, providing utilization, satisfaction, quality and financial measurements of suppliers and consumers in the field of property and vehicle repair; cost containment, referral, auditing and coordinating 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, developing promotional campaigns for others, direct marketing of the goods and services of others, and advertising the goods and services of others and direct mail advertising of the goods and services of others during the sale, post-sale, service, maintenance and repurchase of automobiles; driver monitoring service, namely, providing an online, non-downloadable computer program to track commercial drivers' traffic violations on behalf of the owner/operators of fleet vehicles to manage business risk and assess business cost associated with the drivers' risk; Providing business risk evaluation information to insurance companies; compiling driving records, vehicle information and information regarding drivers of motorized vehicles for use by others in the insurance field; providing information regarding the location of available used vehicle parts for purchase; providing an on-line searchable database featuring informational listings on location and cost of used and recycled vehicle parts for purchase. driver monitoring service, namely, providing an online, non-downloadable computer program to track commercial drivers' traffic violations on behalf of the owner/operators of fleet vehicles to manage business risk and assess business cost associated with the drivers' risk; electronic payment support services in the nature of electronic administrative invoice processing; insurance claims auditing of vehicle damage insurance claims for others; electronic payment support services in the nature of electronic administrative invoice processing; insurance claims auditing of vehicle damage insurance claims for others; providing trade information for auto technicians

(Class 36) Financial services in the automotive, construction, and insurance fields, namely, financial management of electronic payment data, bill payment services, electronic payment processing services of bill payment data, and electronic payment support services in the nature of electronic invoice processing; electronic processing of insurance claims and payment data for damage to vehicles and structures; insurance consultation, namely, consultation in the fields of vehicle collision and structural repair claims processing and management; insurance claims administration and processing, namely, reviewing, auditing, 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, quality assessment and customer satisfaction 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. Optimization 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 containing data used to assess risk variables to manage and price for risk; insurance policy verification by determining whether an individual or a business has insurance currently or had insurance as of a particular date; providing 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

(Class 37) Providing an on-line computer database in the field of auto technicians

(Class 42) Non-downloadable computer software 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, 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 services featuring computer software applications for tracking, updating and producing reports regarding the status of vehicle repairs between vehicle repair service providers and vehicle owners; computer services, namely, online information retrieval 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 motorized vehicles, and driving records

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VIII. Provisions of the applicable law:

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

Paragraph 30(2)(a) 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:
2024-03-28
- (ii) Calculation of time limit (the time limit runs from):
2023-09-28
- (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

2023-09-28



28 sept/Sep 2023
Votre référence Your File
T6812048MAPCA
Notre référence Our File
2190680
Numéro EI IR Number
1664726



GOWLING WLG (CANADA) LLP
SUITE 1600
1 FIRST CANADIAN PLACE
100 KING STREET WEST
TORONTO
ONTARIO M5X 1G5
Attention: Jodi English

RE: Trademark: SOLERA
Applicant: Solera Global Technology Limited

This examiner's report concerns the above identified Protocol application. To avoid abandonment proceedings, a proper response must be received by this office by March 28, 2024. All correspondence respecting this Protocol application must indicate the file number.

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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.

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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,

Christine Pappas-Kelly
Examination Section
819-921-1298
fax: 819-953-2476