



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:

1720506

III. Name of the holder:

The Social Gaming Group IP B.V.

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 **December 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*.

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. 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) Computer programs and software for use with sports, quizzes, ...; computer programs and software for keeping scores; downloadable software applications for use with sports, quizzes, ...; downloadable software applications for keeping scores; electronic software for handheld devices and wireless devices for use with sports, quizzes, ...; computer programs and software for ordering drinks, snacks and food; downloadable software applications for ordering drinks, snacks and food; computer programs and software for delivery of drinks, snacks and food; downloadable software applications for delivery of drinks, snacks and food; platform software; interactive multimedia entertainment software; interactive video software; interactive multimedia computer programs; virtual and augmented reality software for use in mobile devices

for integrating electronic data with real world environments; photographic, cinematographic, optical, weighing, measuring, signaling, checking and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; measuring, detecting, monitoring and controlling devices; data storage devices and media; data processing software; media content. (class 9)

2) Toys, games, and playthings; shuffleboards; sporting articles and equipment; video game apparatus, ..., and amusement machines; portable gaming devices; apparatus for electronic games adapted for use with an external display screen or monitor; gymnastic articles; all the aforesaid excluding card games, collectible card games, trading card games, educational card games and playing cards. (class 28)

3) Entertainment services in the field of games, sports, ...; entertainment services in the field of games, sports, ... with the view of accommodating networking; electronic games services; interactive game services; online game services; social game services; virtual reality game services; arranging and conducting of sports and game competitions and events; arranging, conducting and organizing of (online) sports and game competitions, tournaments and events, ...; organization of food and drink tasting events for entertainment and educational purposes; timing and scoring of games, quizzes and sports events; audio, video and multimedia production, and photography; rental [leasing] of equipment for gaming, electronic gaming, video gaming, social gaming, arcade video gaming events, quizzes and sports events, ...; providing of on-line electronic publications [not downloadable]; all the aforementioned services also being provided via social media, the internet or a global computer network; (class 41)

4) temporary accommodation; rental of venues for meetings, parties, exhibitions and seminars. (class 43)

With respect to goods described by the terms "apparatus", as a general rule, such goods 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.

Section 29 of the *Trademarks Regulations* requires that the statement of the goods or services must describe each of those goods or services in a manner that identifies a specific good or service. Therefore, statements of goods or services cannot include such indefinite terms as "including", "for example", "i.e.", "e.g.", "and/or" and "etc."

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 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,

Lihui Jiang

Examination Section

819-962-6751

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*

IX. Information relating to the possibility to request a review, file an appeal or otherwise respond to the refusal:

- (i) Time limit to request a review, file an appeal or otherwise respond to the refusal:

A complete response is required within 6 months from the date of issuance of the provisional refusal.

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

(a) The time limit starts on: 2024-06-28

(b) The time limit ends on: 2024-12-28

- (iii) Whether the time limit can be extended:

Yes

- (iv) Authority to which such request for review, appeal or response should be made:

Registrar of Trademarks

- (v) 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

- (vi) Other requirements, if any:

Not applicable

X. Date and signature of the Office:

Registrar of Trademarks



28 juin/Jun 2024
Votre référence Your File

Notre référence Our File
2247171
Numéro EI IR Number
1720506

DLA PIPER (CANADA) LLP
Suite 2700, The Stack
1133 Melville St
Vancouver
BRITISH COLUMBIA V6E 4E5
Attention: Christopher L. Bennett

RE: Trademark: SHUFL
Applicant: The Social Gaming Group IP B.V.

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