

In reply please quote our reference

Your reference : N.A.
Our reference : 2018/45084831648S
Date : 26 July 2018
Writer's direct number : +65 6330 2727

WORLD INTELLECTUAL PROPERTY ORGANIZATION
INTERNATIONAL REGISTRATIONS DEPARTMENT
34, CHEMIN DES COLOMBETTES, 1211 GENEVA 20
SWITZERLAND

Dear Sir/Madam

NOTIFICATION OF PROVISIONAL REFUSAL OF PROTECTION TO THE INTERNATIONAL BUREAU OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION ACCORDING TO ARTICLE 5 OF THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

1. Office making the notification:

Intellectual Property Office of Singapore (IPOS)

2. International Registration Number:

1400443

3. Trade Mark Number(s) issued by the IPOS for this International Registration:

Trade Mark Number : 40201808792W

Class Number(s) : 09

4. Name of holder of the International Registration:

SOFTBANK ROBOTICS EUROPE

5. Ground(s) of the Provisional Refusal:

Provisions of Singapore Law: The relevant provisions of Singapore law are attached.

5.1 Section 8(2)(b)

The mark is objectionable under Section 8(2)(b) of the Trade Marks Act (Cap. 332, 2005 Rev. Ed.) which states that a trade mark shall not be registered if because it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public.

The mark is in conflict with the following trade mark(s) in respect of the indicated class(es):

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S.No	Cited Trade Mark No	Name of Proprietor/ Applicant	Mark Status	Trade Mark	Subject Class No Objected To
1	40201601899 X	Pepper Technologies Limited	Registered	Pepper	09
2	40201800694 S	SoftBank Robotics Group Corp.	Pending (Under Examination)	PEPPER	09

We are of the view that having a common predominant word element "Pepper" within the marks at issue, they are considered as a whole, highly similar on the conceptual, visual and phonetic levels.

This brings to a likelihood of confusion for the relevant public as to the source of the goods, which are deemed as conflicting as well. Based on dictionary definition, a "robot" refers to "a machine capable of carrying out a complex series of actions automatically, especially one programmable by computer" (source: <https://en.oxforddictionaries.com/definition/robot>). As such, the Holder's goods are considered to be complementary to the computer-related goods claimed by the proprietor of the cited mark 40201601899X and also identical to those in the cited mark 40201800694S. The trade channels in which the Holder's goods are sold are therefore likely to be the same or similar to those of the cited proprietors' as well.

5.2 **How to overcome our objection(s) under section 8(2)(a) and/or (b)**

You may consider the following options:

- (a) Assign the marks in the name of a single entity; or
- (b) Obtain a letter of consent from the cited proprietor; or
- (c) File evidence to show honest concurrent use in Singapore.

In other words, you may file evidence to show that before the date of this application, your mark has been put to use for the goods and/or services applied for at the same time as the cited mark(s) according to honest practices in commercial and industrial standards. This evidence may show that the public is used to distinguishing between your mark and the cited mark(s) and there is no likelihood of confusion in the public.

The evidence should show concurrent use of your mark and the cited mark(s) for a period of at least 5 years before the date of this application. The evidence should be presented by way of a statutory declaration.

For guidance as to how the letter of consent or evidence of honest concurrent use should be presented, please refer to the Registry's web site at <http://goo.gl/a1CjVx>.

6. **Goods and/or services affected by the refusal:**

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#01-01 Manulife Centre
Singapore 189554

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This refusal applies to all the goods in Class(es) 09 of the international registration.

7. Request for review:

The holder of the international registration may file a request for a review of this refusal with IPOS.

The request for review must comply with the following:

- (a) quote the International Registration number, relevant trade mark number(s), corresponding class number(s) and Singapore reference number(s).
- (b) furnish an address for service in Singapore. The holder may appoint an agent by filing Form CM1.

Please note that any form(s) filed with the International Bureau of the World Intellectual Property Organization in response to this refusal, will not be treated as a request for a review of this refusal unless the above has been complied with.

8. Extension of time:

The holder may seek an extension of time to request for a review of this refusal by filing Form CM5.

9. Deadline to observe:

If the holder does not file a request for review or apply for an extension of time to do so by **26 November 2018**, the application for the refused goods and/or services indicated in paragraph 6 of this refusal will be treated as withdrawn (reinstatable). Please refer to paragraph 10 on reinstatement of an application that is treated as withdrawn (reinstatable).

10. Reinstatement of an application that is treated as withdrawn (reinstatable):

If the application for the refused goods and/or services indicated in paragraph 6 of this refusal becomes treated as withdrawn (reinstatable), the holder may request to reinstate the application by filing Form CM13 together with the request for review within six months from the deadline in paragraph 9.

Please note that reinstatement is not automatic. Reinstatement will be allowed only after we have conducted a new conflicting mark search and are satisfied that the mark to be reinstated does not conflict with any trade mark applications filed with IPOS prior to the filing of the required documents.

If the holder also does not request to reinstate the application in time, the application for goods and/or services that are not refused will proceed to publication.

11. Forms and fees:

The forms referred to in this provisional refusal and the relevant fees may be found at <https://www.ip2.sg/>.

12. Further refusal of protection:

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Please note that a further refusal of protection may result from an opposition, which may be filed after the expiry of 18 months from the date on which the Intellectual Property Office of Singapore was notified of the international registration. This applies to all goods and/or services claimed in the international registration.

This refusal is issued by:

Ms Corinne Yip
Assistant Registrar
for Registrar of Trade Marks
Singapore

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PROVISIONS OF SINGAPORE LAW

TRADE MARKS ACT (CHAPTER 332)

Section 2(1) Interpretation

"earlier trade mark" means –

- (a) a registered trade mark or international trade mark (Singapore), the application for registration of which was made earlier than the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks; or
- (b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was a well known trade mark,

and includes a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) subject to its being so registered.

Section 8 Relative grounds for refusal of registration

(2) A trade mark shall not be registered if because -

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected; or
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public.

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CITED MARK DETAILS

Trade Mark No. 40201800694S	PEPPER
National	
Application Type Trade Mark Trade Mark Type Conventional Mark Description of Particular Feature(s) of Mark Converted Application No Application Date 11 January 2018 Mark Status (unless otherwise indicated below) Pending (Under Examination) Mark Status Date 11 January 2018 Status Update Date 11 January 2018 Date of Completion of Registration Procedure Expiry Date (unless otherwise indicated below) Publication Date Transformation Application under Madrid Protocol Replacement Application under Madrid Protocol	
Basic Mark on which IA is based	
International Application No. International Registration No.	
Specification of Goods or Services	
1) Class Number Class 09 Goods/Services Humanoid robots with artificial intelligence. Class Status Pending (Under Examination)	
Current Applicant or Proprietor Details	
1) Name SoftBank Robotics Group Corp. UEN/Company Code E18000737W Country of Incorporation Japan State of Incorporation Address 9-1, Higashi-shimbashi 1-chome, Minato-ku, Tokyo, Japan	
Agent/Correspondence Details	
1) Agent Name DREW & NAPIER LLC UEN/Company Code 200102509E Representative Name Address For Service 10 COLLYER QUAY #10-01 OCEAN FINANCIAL CENTRE	

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Action Representing	Singapore 049315 For all matters relating to the application, registration/grant, except those matters expressly excluded
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Trade Mark No. 40201601899X	Pepper
National	
<p>Application Type Trade Mark</p> <p>Trade Mark Type Conventional Mark</p> <p>Description of Particular Feature(s) of Mark</p> <p>Converted Application No</p> <p>Application Date 1 February 2016</p> <p>Mark Status (unless otherwise indicated below) Registered</p> <p>Mark Status Date 1 February 2016</p> <p>Status Update Date 25 August 2016</p> <p>Date of Completion of Registration Procedure 25 August 2016</p> <p>Expiry Date (unless otherwise indicated below) 1 February 2026</p> <p>Publication Date 17 June 2016</p> <p>Transformation Application under Madrid Protocol</p> <p>Replacement Application under Madrid Protocol</p>	
Basic Mark on which IA is based	
<p>International Application No.</p> <p>International Registration No.</p>	
Specification of Goods or Services	
<p>1) Class Number Class 09</p> <p>Goods/Services Computers; handheld computers; computer hardware and peripherals; computer peripheral devices; computer operating system programs; computer programs and software; electronic data processing installations; computer network apparatus; parts and fittings for all the aforesaid goods; excluding Universal serial bus (USB) host controller.</p> <p>Class Status Registered</p> <p>Class Expiry Date 1 February 2026</p>	
Current Applicant or Proprietor Details	
<p>1) Name Pepper Technologies Limited</p> <p>UEN/Company Code E16002829T</p> <p>Country of Incorporation United Kingdom</p>	

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State of Incorporation	
Address	Ingles Manor Castle Hill Avenue Folkestone CT20 2RD United Kingdom
Agent/Correspondence Details	
1) Agent Name	BIGFOOT INTERNET VENTURES PTE. LTD.
UEN/Company Code	200411408M
Representative Name	
Address For Service	16 PURVIS STREET Singapore 188595
Action Representing	For all matters relating to the application, registration/grant, except those matters expressly excluded

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