



## 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:**

1639335

**III. Name of the holder:**

KABUSHIKI KAISHA BANDAI(BANDAI Co., Ltd.)

**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 1, 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 37(1)(c) of the *Trademarks Act*, the applicant does not appear to be entitled to registration. Specifically, the entitlement date of October 06, 2021 of the subject Protocol application is later than the entitlement date(s) of May 06, 2021 and August 24, 2021 of co-pending and confusing application Nos. 2105490 and 2131379 the particulars of which are attached.

Please note that the applicant of the instant application is KABUSHIKI KAISHA BANDAI (BANDAI Co., Ltd.) and the applicant of the cited applications is Kabushiki Kaisha BANDAI NAMCO Holdings (Trading as BANDAI NAMCO Holdings Inc.).

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.

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:

(1) retail services or wholesale services for electrical machinery and apparatus; retail services or wholesale services for key holders; retail services or wholesale services for kitchen equipment, cleaning tools and washing utensils; retail services or wholesale services for printed matter; advertising; marketing services; providing commercial information; organizing exhibitions for commercial or advertising purposes; presentation of goods on communications media for retail purposes; (Nice class 35)

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](http://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

Yours truly,

Christine Pappas-Kelly

Examination Section

819-921-1298

fax: 819-953-2476

## VII. Information relating to an earlier mark:

2105490

2131379

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- (i) Filing date and number, and, if any, priority date:  
2021-05-07, **2105490**, 2021-05-06
- (ii) Registration date and number (if available):  
Not applicable
- (iii) Name and address of the owner:  
Kabushiki Kaisha BANDAI NAMCO Holdings (also trading as BANDAI NAMCO Holdings Inc.)  
5-37-8 Shiba  
Minato-ku  
Tokyo, 108-0014  
JAPAN
- (iv) Reproduction of the mark:  
BANDAI NAMCO NEXT
- (v) List of the relevant goods and services (this list may be in the language of the earlier application or registration):  
(Class 35) Retail store services featuring gaming videos and game software; retail store services featuring downloadable audio, video, multimedia, emoticons, badges, images and chat colors; retail store services featuring virtual goods and merchandise for use by members of an online community in connection with a designated website featuring streaming video games and related content; retail store services featuring game enhancement software and computer game software components; Online retail store services featuring gaming videos and game software; Online retail store services featuring downloadable audio, video, multimedia, emoticons, badges, images and chat colors; Online retail store services featuring virtual goods and merchandise for use by members of an online community in connection with a designated

website featuring streaming video games and related content; Online retail store services featuring game enhancement software and computer game software components; administration and coordination of community competitions in the field of e-sports and video games

(Class 41) Entertainment services, namely, providing online games; arranging and conducting multiplayer and collaborative online games; entertainment services, namely, providing online video games via social networks; entertainment services, namely, providing virtual environments in which users can interact through social games for recreational purposes; providing enhancements within online computer and electronic games; publishing of game software; entertainment services, namely, providing online videos featuring games being played by others; arranging and conducting competitions in the field of online computer and electronic games for game players; organizing, conducting and operating game tournaments for video games and e-sports; organizing video gaming leagues for purposes of gaming tournaments; organization of gaming competitions, namely, organizing electronic, computer and video game competitions; organization of software development competitions; arranging of contests; providing online information, news and commentary in the field of games, including electronic, computer and video games; providing news, information and commentary in the field of on-line gaming; arranging of contests and sweepstakes; providing online non-downloadable music; providing non-downloadable online videos featuring music; non-downloadable on-line journals, namely, blogs featuring articles on video games, video game players, gaming and e-sports; providing an Internet website portal featuring content in the field of video games, video game players, gaming and e-sports; providing an online website portal for consumers to play online computer games and electronic games and share game enhancements and game strategies; administration and coordination of team leagues in the field of e-sports and video games, namely, providing a website and online portal for customers to participate in online gaming, operation and coordination of game tournaments, leagues and tours for recreation computer game playing purposes; administration and coordination of recreational opportunities for individuals who wish to participate in team leagues in the field of e-sports and video games, namely, providing a website and online portal for customers to participate in online gaming, operation and coordination of game tournaments, leagues and tours for recreation computer game playing purposes

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

2021-09-02, **2131379**, 2021-08-24

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

Not applicable

(iii) Name and address of the owner:

Kabushiki Kaisha BANDAI NAMCO Holdings (Trading as BANDAI NAMCO Holdings Inc.)  
5-37-8 Shiba  
Minato-ku  
Tokyo, 108-0014  
JAPAN

(iv) Reproduction of the mark:

BANDAI NAMCO

(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 game software; Downloadable computer game programs; Downloadable computer game software via a global computer network and wireless devices; Downloadable Video game software; game programs for arcade video game machines; printed

circuit boards for video game machines; video game programs for mobile phones; video game programs for hand-held game machines with liquid crystal displays; video game programs for consumer video game machines; memory cards; encoded magnetic cards; computer memory devices; integrated circuit cards; cell phone straps; digital cameras; camcorders; computers; downloadable computer programs; recorded computer programs; recorded computer game programs; downloadable computer game programs; phonograph records; downloadable music files; downloadable image files; downloadable sound files; additional data for computer games (downloadable); additional data for computer games for mobile phones (downloadable); additional data for computer games for consumer video game machines (downloadable); decorative magnets; downloadable video files; downloadable electronic publications; compact discs; video recordings; controllers for personal computers; computer keyboards; covers for computer keyboards; microphones; mouse; mouse pads; video screens; mobile phone covers; spectacle cases; batteries, electric; headphones; protective helmets; card reading equipment; selfie sticks; exposed slide films; slide film mounts; downloadable educational course materials; exposed cinematographic films; spectacles; sunglasses; simulators for the steering and control of vehicles; electric and electronic effects units for musical instruments; electronic circuits and CD-ROMs recorded with automatic performance programs for electronic musical instruments; humanoid robots with artificial intelligence; smartphones in the shape of a watch; teaching robots; wearable activity trackers.

(Class 16) Stationery; trading collection cards; magazines featuring computer games.

(Class 25) T-shirts; caps and hats; hoodies, neck gaiter.

(Class 28) Action figures; toy scale models; dolls; toys; toy robots; stuffed toys; playing cards; table-top games; video game machines; cabinets for arcade video game machines; amusement game machines; coin-operated or non coin-operated amusement machines; games; controllers for video game machines; game machines and apparatus; conjuring apparatus; balls for games; fishing tackle; scratch cards for playing lottery games; slot machines; gymnastic and sporting articles; hand-held electronic games; card games; toy figures.

(Class 35) Retail store services featuring gaming videos and game software; retail store services featuring downloadable audio, video, multimedia, emoticons, badges, images and chat colors; retail store services featuring virtual goods and merchandise for use by members of an online community in connection with a designated website featuring streaming video games and related content; retail store services featuring game enhancement software and computer game software components; Online retail store services featuring gaming videos and game software; Online retail store services featuring downloadable audio, video, multimedia, emoticons, badges, images and chat colors; Online retail store services featuring virtual goods and merchandise for use by members of an online community in connection with a designated website featuring streaming video games and related content; Online retail store services featuring game enhancement software and computer game software components; administration and coordination of community competitions in the field of e-sports and video games.

(Class 41) Entertainment services, namely, providing online video games; entertainment services, namely, providing a computer game that may be accessed network-wide by network users via mobile phones, mobile devices and computers; providing computer games via network between communications networks and computers; entertainment services, namely, providing online games; arranging and conducting multiplayer and collaborative online games; entertainment services, namely, providing online video games via social networks; entertainment services, namely, providing virtual environments in which users can interact through social games for recreational purposes; providing enhancements within online computer and electronic games; publishing of game software; entertainment services, namely, providing online videos featuring games being played by others; arranging and conducting competitions in the field of online computer and electronic games for game players; organizing, conducting and operating game tournaments for video games and e-sports; organizing video gaming leagues for purposes of gaming tournaments; organization of gaming

competitions, namely, organizing electronic, computer and video game competitions; organization of software development competitions; arranging of contests; providing online information, news and commentary in the field of games, including electronic, computer and video games; providing news, information and commentary in the field of on-line gaming; arranging of contests and sweepstakes; providing online non-downloadable music; providing non-downloadable online videos featuring music; non-downloadable on-line journals, namely, blogs featuring articles on video games, video game players, gaming and e-sports; providing an Internet website portal featuring content in the field of video games, video game players, gaming and e-sports; providing an online website portal for consumers to play online computer games and electronic games and share game enhancements and game strategies; administration and coordination of team leagues in the field of e- sports and video games, namely, providing a website and online portal for customers to participate in online gaming, operation and coordination of game tournaments, leagues and tours for recreation computer game playing purposes; administration and coordination of recreational opportunities for individuals who wish to participate in team leagues in the field of e-sports and video games, namely, providing a website and online portal for customers to participate in online gaming, operation and coordination of game tournaments, leagues and tours for recreation computer game playing purposes.

#### **VIII. Provisions of the applicable law:**

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:  
2023-11-01
- (ii) Calculation of time limit (the time limit runs from):  
2023-05-01
- (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





1 mai/May 2023  
Votre référence Your File

Notre référence Our File  
2161078  
Numéro EI IR Number  
1639335

ROBIC  
630, boul. René-Lévesque Ouest  
20e étage  
Montréal  
QUÉBEC H3B 1S6



RE: Trademark: PREMIUM BANDAI  
Applicant: KABUSHIKI KAISHA  
BANDAI(BANDAI Co., Ltd.)

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Place du Portage I  
50 Victoria Street, room C-114  
Gatineau, QC K1A 0C9

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Yours truly,



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