



**Notification of ex officio provisional partial refusal of protection (Article 5 of the Madrid Protocol, Rule 17(1) and (2) of the Common Regulations under the Madrid Agreement and Protocol, and to Rule 113 CTMIR)**

Alicante, 01/03/2016

*International registration number:* **1288610**  
*Name of the Holder:* **bitFlyer Inc.**  
*Trade Mark:* **BITCOIN**

The trade mark you have applied for is partially not eligible for registration under Article 7(1)(b) and (c) and Article 7(2) CTMR.

**I. Grounds**

The mark applied for consists of the word 'BITCOIN' and is considered objectionable for:

Class 35 *Advertising and publicity services; marketing research; providing information concerning commercial sales (which includes information provision via the Internet); providing information concerning advertisement and publicity services (which includes information provision via the Internet); intermediary services on sale and purchase contracts for goods in electronic commerce transactions; business operation and management concerning electronic commerce transactions.*

Class 36 *Acceptance of deposits (including substitute bond issuance) and acceptance of fixed interval installment deposits; loans and discount of bills; domestic exchange settlement; liability guarantee and acceptance of bills; securities lending; acquisition and transfer of monetary claims; safekeeping of valuables including securities and precious metals; money exchange services; trusteeship of financial futures contracts; trusteeship of money, securities, monetary claims, personal property, land, rights on land fixtures, surface rights or lease on land; agencies in the field of bonds and other securities; foreign exchange transactions; letter-of-credit related services; brokerage of credit purchase; issue of tokens of value; agencies for collecting gas or electric power utility payments; buying and selling of securities, trading of securities index futures, trading of securities options, and trading of overseas market securities futures; agencies for brokerage of securities, securities index futures, securities options, and overseas market securities futures; agencies or brokerage for entrusting agents with on-commission trading in domestic markets of securities, securities index futures and securities options; agencies or brokerage for entrusting agents with on-commission trading in overseas markets of securities, and securities index futures; securities underwriting; brokerage services relating to securities offering; transaction of securities subscription or offering; providing stock market*

*information; agencies for commodity futures trading; life insurance brokerage; life insurance underwriting; agencies for non-life insurance; claim adjustment for non-life insurance; non-life insurance underwriting; insurance premium rate computing; charitable fund raising.*

Class 38 *Rental of access time to computer databases where users can search and obtain information concerning electronic commerce transactions.*

Class 42 *Providing search engines for electronic commerce transactions; providing computer programs for use in electronic commerce transactions.*

Class 45 *Providing user authentication services in e-commerce transactions; providing user authentication services in e-commerce transactions via communication lines.*

The distinctive character and descriptiveness of a trade mark must be assessed, first, in relation to the goods or services in respect of which registration of the sign is sought and, second, in relation to the perception of the section of the public targeted, which is composed of the consumers of those goods or services (judgment of 27/11/2003, T-348/02, 'Quick', paragraph 29).

The average consumer's level of attention is likely to vary according to the category of goods or services in question (judgment of 22/06/1999, C-342/97, 'Lloyd Schuhfabrik Meyer', paragraph 26).

Furthermore, when assessing the distinctive character of a trade mark consisting of a combination of elements, the mark needs to be considered as a whole. However, that does not preclude prior examination of each of the trade mark's individual features (judgment of 09/07/2003, T-234/01, 'Stihl', paragraph 32).

In the present case, the objectionable services covered by the mark applied for are specialised services and are aimed at both average consumers and a professional public. In view of the nature of the services in question, the awareness of the professional public will be high whereas the average consumer is expected to be reasonably well-informed and reasonably observant and circumspect. Moreover, since the mark 'BITCOIN' consists of an English word, the relevant public with reference to which the absolute ground for refusal must be examined is the English-speaking consumer in the Community (judgment of 22/06/1999, C-342/97, 'Lloyd Schuhfabrik Meyer', paragraph 26; and judgment of 27/11/2003, T-348/02, 'Quick', paragraph 30).

The trade mark consists of the word with the following meaning:

BITCOIN 'a type of digital currency in which encryption techniques are used to regulate the generation of units of currency and verify the transfer of funds, operating independently of a central bank: *bitcoin has become a hot commodity among speculators*' (information extracted from *Oxford Dictionaries online* on 01/03/2016 at [www.oxforddictionaries.com](http://www.oxforddictionaries.com)).

The relevant consumer will understand the word as a meaningful expression: a type of digital currency in which encryption techniques are used to regulate the generation of units of currency and verify the transfer of funds, operating independently of a central bank.

## **1) Descriptiveness**

For the purposes of assessing descriptiveness, it must be determined whether the relevant public will make a sufficiently direct and specific association between the expression and the goods/services for which registration is sought (judgment of 20/07/2004, T-311/02, 'LIMO', paragraph 30).

Taken as a whole, the word 'BITCOIN' immediately informs consumers without further reflection that the services applied for are related to the operations with digital currency including that the consumers can pay for the services using such currency.

Therefore, the mark conveys obvious and direct information regarding the object of the services in question, the expression of value and the means of payment for the services in question.

It follows that the link between the word 'BITCOIN' and the services referred to in the application for registration is sufficiently close for the sign to fall within the scope of the prohibition laid down by Article 7(1)(c) and Article 7(2) CTMR.

## **2) Lack of distinctive character**

According to the case-law of the Court of Justice, the fact that a sign is composed of generic words that inform the public of a characteristic of the goods/services leads to the conclusion that the sign is devoid of distinctive character (judgment of 19/09/2002, C-104/00 P, 'DKV', paragraph 21). This is clearly applicable to the present case.

Given that the mark has a clear descriptive meaning in relation to the services applied for, the impact of the mark on the relevant public will be primarily descriptive in nature, thus eclipsing any impression that the mark could indicate a trade origin.

Consequently, taken as a whole, the mark applied for – 'BITCOIN' – is devoid of any distinctive character and is not capable of distinguishing the services for which registration is sought within the meaning of Article 7(1)(b) and Article 7(2) CTMR.

### **II.**

The holder of the international registration is obliged to be represented before the OHIM by a legal practitioner or professional representative who is entitled to represent third parties before the OHIM (Article 92(2), Article 93(1) CTMR). Protection of the international registration for the European Community will be refused in part if a representative is not appointed within the time limit indicated under III.

### **III.**

The holder of the international registration is hereby given a time limit of two months to overcome the ground for refusing protection indicated and to comply with the requirements indicated above. Failure to do so will mean that after expiry of the time limit, the OHIM will render a decision in which it refuses the protection in whole or in part. Said decision may be appealed. The time limit of two months to reply to the present refusal shall start on the day the present notification was issued by the OHIM (Rule 112(1) CTMR). Any such reply of the holder of the international registration shall be addressed to the OHIM only.

The application is accepted for the remaining goods.

**SIRVINSKIENE Julija**