

**NOTIFICATION OF PROVISIONAL REFUSAL OF AN INTERNATIONAL REGISTRATION DESIGNATING  
NEW ZEALAND**

1.	<b>Office making the notification:</b> Intellectual Property Office of New Zealand		
2.	<b>Date of the notification of provisional refusal:</b> 8 March 2016		
3.	<b>Number of the international registration:</b> 1288610  <b>Our reference:</b> 1037649		
4.	<b>Representation of the mark:</b> BITCOIN		
5.	<b>Name of the holder:</b> bitFlyer Inc.		
6.	<b>Basis for refusal:</b> Provisional refusal based on an <i>ex officio</i> examination.		
7.	<b>Scope of refusal:</b> Provisional refusal for all the goods and/or services. Total refusal relates to all goods and services specified.		
8.	<p><b>Grounds for refusal:</b></p> <p><u><b>Distinctiveness</b></u></p> <p><b>Section 18(1)(c) and (b) – Mark descriptive and non-distinctive</b></p> <table border="1"> <tr> <td> <p><b>Objection</b></p> </td> <td> <p><b>Descriptiveness</b></p> <p>The Commissioner must not register a mark that describes a characteristic of the goods or services. A mark describes a characteristic of the goods or services if an ordinary person, when seeing the mark in relation to the goods or services, would understand the mark as describing, indicating, or calling to mind their nature or some attribute they possess.</p> <p>The term “bitcoin” is defined as: “<b>Bitcoin</b><sup>[note 5][note 6]</sup> is a digital asset<sup>[16]</sup> and a <u>payment system</u> invented by <u>Satoshi Nakamoto</u>,<sup>[note 7]</sup> <u>who published the invention in 2008</u><sup>[12]</sup> and released it as <u>open-source software</u> in 2009.<sup>[18]</sup> The system is <u>peer-to-peer</u>; users can transact directly without an intermediary.<sup>[19]:4</sup></p> <p>(<a href="https://en.wikipedia.org/wiki/Bitcoin">https://en.wikipedia.org/wiki/Bitcoin</a>)</p> </td> </tr> </table>	<p><b>Objection</b></p>	<p><b>Descriptiveness</b></p> <p>The Commissioner must not register a mark that describes a characteristic of the goods or services. A mark describes a characteristic of the goods or services if an ordinary person, when seeing the mark in relation to the goods or services, would understand the mark as describing, indicating, or calling to mind their nature or some attribute they possess.</p> <p>The term “bitcoin” is defined as: “<b>Bitcoin</b><sup>[note 5][note 6]</sup> is a digital asset<sup>[16]</sup> and a <u>payment system</u> invented by <u>Satoshi Nakamoto</u>,<sup>[note 7]</sup> <u>who published the invention in 2008</u><sup>[12]</sup> and released it as <u>open-source software</u> in 2009.<sup>[18]</sup> The system is <u>peer-to-peer</u>; users can transact directly without an intermediary.<sup>[19]:4</sup></p> <p>(<a href="https://en.wikipedia.org/wiki/Bitcoin">https://en.wikipedia.org/wiki/Bitcoin</a>)</p>
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The term “bitcoin” is also defined as: “Bitcoin is a form of digital currency, created and held electronically. No one controls it. Bitcoins aren’t printed, like dollars or euros – they’re produced by people, and increasingly businesses, running computers all around the world, using software that solves mathematical problems.

It’s the first example of a growing category of money known as cryptocurrency”. (<http://www.coindesk.com/information/what-is-bitcoin/>)

“bitcoin” is also defined as “Bitcoin is *the currency of the Internet*: a distributed, worldwide, decentralized digital money. Unlike traditional currencies such as dollars, bitcoins are issued and managed without any central authority whatsoever: there is no government, company, or bank in charge of Bitcoin. As such, it is more resistant to wild inflation and corrupt banks. With Bitcoin, you can *be your own bank*.”

(<https://www.reddit.com/r/Bitcoin/>)

The mark therefore merely describes the nature of the goods or services for which you seek registration, namely the goods such as computer programs used in the field of electronic commerce transactions that use bitcoin. They are also descriptive in relation to the services identified in that they are likely to utilize bitcoin, feature bitcoin or relate to bitcoin. For example, applicant’s retail services are like to accept digital currency in the form of bitcoin; applicant’s financial services are likely to be rendered utilizing bitcoin; applicant’s telecommunications services are likely to relate to transmitting of bitcoin for transactions; applicants computer programming services are likely to relate to software that processes or utilizes bitcoins; and applicant’s user authentication services are likely to authenticate users who seek to use bitcoin for electronic transactions.

#### **Distinctiveness**

The Commissioner must also not register a trade mark that has no distinctive character. A trade mark has no distinctive character if it cannot serve the essential function of a trade mark which is to distinguish your goods and/or services from those of other traders.

Given your mark’s descriptiveness, we consider that other traders are likely, in the ordinary course of their business and without improper motive, to want to use your mark, or some mark resembling it, in relation to the promotion of their own goods or

	services.
Goods and/or services	Total refusal relates to all goods and services specified.
Relevant law	The relevant provisions of New Zealand law are listed below at 11.

9. **Information relating to subsequent procedure:**

**Responding to this refusal**

The Holder may respond in writing to this refusal. Any response made to the Office must be filed using the Commissioner's website at [www.iponz.govt.nz](http://www.iponz.govt.nz). You will also need to provide an address for service in New Zealand.

**Timeframe for responding**

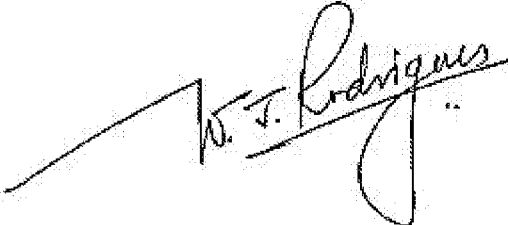
If the Holder does not respond by **18 February 2017**, this refusal becomes final for the specified goods and/or services.

**Refusal still possible following opposition**

If we subsequently accept the designation in New Zealand refusal may still result from an opposition. The opposition period runs for 3 months from the publication of the mark. It is possible that an opposition may be filed more than 18 months from the date we were notified of the International Registration.

10. **Signature by the Office:**

Intellectual Property Office of New Zealand



William Rodriguez  
Trade Mark Examiner  
+64 4 978 3619  
For the Commissioner of Trade Marks

11. **Provisions of relevant law:**

**Trade Marks Act 2002**

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**18 Non-distinctive trade mark not registrable**

(1) The Commissioner must not register—

- (a) a sign that is not a trade mark:
- (b) a trade mark that has no distinctive character:
- (c) a trade mark that consists only of signs or indications that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or of rendering of services, or other characteristics of goods or services:

- (d) a trade mark that consists only of signs or indications that have become customary in the current language or in the bona fide and established practices of trade.
- (2) The Commissioner must not refuse to register a trade mark under subsection (1)(b), (c), or (d) if, before the date of application for registration, as a result of either the use made of it or of any other circumstances, the trade mark has acquired a distinctive character.