

In reply please quote our reference

Your reference : N.A.
Our reference : 2016/21187551724W
Date : 09 June 2016
Writer's direct number : +65 6331 6545

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:

1288610

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

Trade Mark Number : 40201603035W

Class Number(s) : 09, 35, 36, 38, 42 AND 45

4. Name of holder of the International Registration:

BITFLYER INC.

5. Ground(s) of the Provisional Refusal:

5.1 Section 7(1)(b)

The mark is objectionable under section 7(1) of the Trade Marks Act (Cap. 332, 2005 Rev. Ed.) as:

it is devoid of any distinctive character. The word "bitcoin" means "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" or "a system of open source peer-to-peer software for the creation and exchange of (payment in) a certain type of cryptocurrency" (see sources: <http://www.oxforddictionaries.com/definition/english/bitcoin> and <http://www.thefreedictionary.com/bitcoin>). We take the view that the mark does not have the inherent capacity to distinguish the trade origin of the goods and services provided and will not be perceived by the general public as a badge of origin without expending extensive efforts on educating the public that it is one.



INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
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5.2 **Section 7(1)(c)**

it consists exclusively of signs or indications which may serve, in trade, to designate the kind of goods or services claimed. The mark merely sends an obvious and direct message that the goods and services claimed are related to or feature bitcoins for electronic payment and transactions anonymously (see sources: <http://money.cnn.com/infographic/technology/what-is-bitcoin/> and <http://www.coindesk.com/information/what-is-bitcoin/>). We take the view that the relevant consumers are not likely to perceive the mark beyond its descriptive nature and recognize it as a source identifier. In addition, the mark could be used in connection with many different users in similar trade, thus it would be unfair to grant monopolistic rights to any one trader.

5.3 **How to overcome our objection(s) under section 7(1)(b), (c) and/or (d)**

Please file evidence showing that the mark has, before the date of application, in fact acquired a distinctive character as a result of the use made of it. The evidence should relate to at least 5 years of use prior to the date of application of the mark. The evidence of use should be filed by way of a statutory declaration. For guidance as to how the evidence of use should be presented, please refer to the Registry's web site at <http://goo.gl/EcaHSY>.

5.4 **Specification of goods and/or services**

We note that you have applied for protection of the mark for goods and/or services in various classes. However, we have raised objections under rule 19(2)(b)(ii)(A) of the Trade Marks Rules as the following goods and/or services do not follow the guidelines provided under the International Classification of Goods and Services (ICGS):

Class 9

- (a) "electronic machines" in "electronic machines and apparatus" – As "machines" are generally classified in Class 7, please consider rewording to "electronic data processing machines", if applicable, for clarity.

Class 45

- (a) "Providing user authentication services in e-commerce transactions; providing user authentication services in e-commerce transactions via communication lines." – Please clarify whether it is a form of digital security service or physical security services as a digital form of security feature is proper to Class 42.

Please note that no form or fee is required for an amendment to the specification of goods or services of an international registration designating Singapore.

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

This refusal applies to all the goods and services in Class(es) 09, 35, 36, 38, 42, 45 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:



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- (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 **9 October 2016**, the application for the refused goods and/or services indicated in paragraph 6 of this refusal will be treated as withdrawn (reinstatable).

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

If the application 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 <http://www.ipos.gov.sg/Services/FilingandRegistration/FormsandFees/TradeMarks.aspx>

12. Further refusal of protection:

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 Yeo Li Ting



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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

"sign" includes any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, aspect of packaging or any combination thereof.

"trade mark" means any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person.

Section 7 Absolute grounds for refusal of registration

(1) The following shall not be registered:

- (a) signs which do not satisfy the definition of a trade mark in section 2(1);
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; and
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

(2) A trade mark shall not be refused registration by virtue of subsection (1) (b), (c) or (d), if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

TRADE MARKS RULES

Rule 19 Specification

(2) Every application form shall contain, for each class of goods or services to which the application relates

(a) the class number as set out in the Nice Classification as in force on the date of that application; and

(b) a specification of those goods or services which

(i) is appropriate to that class;

(ii) is described in such a manner as to

(A) indicate clearly the nature of those goods or services; and

(B) allow those goods or services to be classified in accordance with the Nice

Classification as in force on the date of that application; and

(iii) complies with any other requirement of the Registrar.



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