

Series of trade marks

Section 51 of the Ordinance and rule 97 of the Rules provide for the registration of a “series of trade marks”.

According to section 51(3), a “series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark”. This definition essentially reflects the old law on series marks (section 26, Cap. 43). Although this definition is a longstanding one, there has been no case law in Hong Kong on what constitutes a series. We are therefore guided by cases decided under similar provisions in the UK Trade Marks Act 1938 on series marks.

Examining applications for registration of a series of trade marks

- Is the application for registration made on the specified form, Form T2? Does the series consist of no more than 4 trade marks? Does the application include a representation of each mark in the series (rule 97(2))?
- Was the specified fee paid when the application was filed (rule 4 and the Schedule to the Rules)? An application for the registration of a series of trade marks in one class requires only one application fee. If the application is for more than one class, class fees for the additional classes are also payable.
- An application for registration of a series of trade marks is allocated a single application number. The application will result in a single registration unless, before registration, the applicant files a request to divide the application (rule 97(4)).

- A series application can be divided into separate applications for one or more trade marks in the series (rule 97(4)). See chapter on Division of applications.
- More than one priority date can be claimed in a series application if priority is claimed on the basis of more than one Convention/WTO application covering the different marks in the series. The different priority dates claimed need to be entered in the application.
- Are the trade marks a series? See *Are the trade marks a series?* below.
- If the marks are not considered to be a series, the applicant can apply to delete any of the marks or to divide the application, so that only those that are a series remain in the application.

Deleting a trade mark in a series

- Is the request to delete a trade mark in a series filed Form T5B (rule 98(1))?
- Is the request to delete a trade mark in a series made by the applicant for the registration of a series or the owner of a registered series of trade marks (rule 98(1))?
- Delete the relevant mark in the series accordingly if the above conditions are satisfied (rule 98(2)). Enter the date the mark is deleted in the historical details of the register entry.

Are the trade marks a series?

- To qualify as a series, the trade marks must:

- resemble each other in their material details;
 - differ only in matters of a non-distinctive nature; and
 - the differences between them must not substantially affect the identity of the trade mark.
- The marks must be considered both visually and phonetically. The overall idea and impression are also important.

Examples of marks forming a series

- The same word in different scripts or fonts may form a series :

Example

TIFFTOFF and *TIFFTOFF*

- The same word represented with or without a simple border, underlined or not underlined :

Examples

TIFFTOFF and TIFFTOFF

TIFFTOFF and TIFFTOFF

- The same Chinese words in traditional and simplified characters :

Example

格爾斯 and 格尔斯

- Differences in upper and lower case and lettering which do not lead to the component words in the marks being perceived or pronounced differently :

Examples

TIFFTOFF and TIFftoff

TIFFTOFF and **TIFFTOFF**

- Differences in punctuation which do not alter the character of the marks :

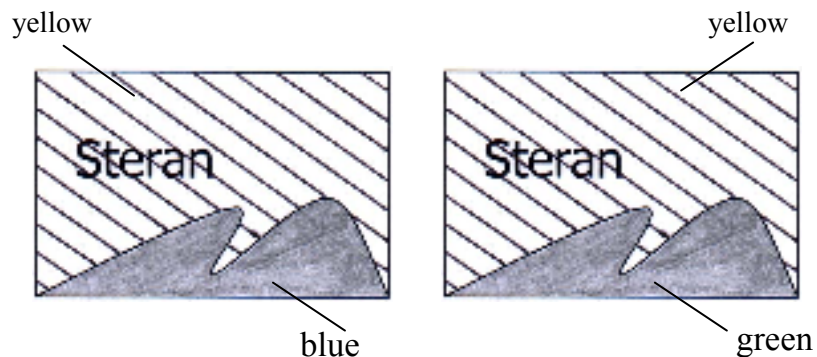
Examples

BORF and B.O.R.F.

BORT-AMT and BORT AMT

- If colour is only a subordinate feature of a mark, variations in colour :

Example



An appropriate colour claim should be made on Form T2A. See chapter on Colour marks.

Examples of marks not forming a series

- In an application to register a shape, any material variation in the shape is likely to substantially affect the distinctive character of the mark and prevent it from forming a series of marks (*Dualit Ltd's Trade Mark Application* [1999] RPC 304)

at 324).

In *Dualit*, the application was for a series of 6 marks each showing the shape of a toaster in 3 dimensions. It was considered that the marks showing toasters with rounded ends and the marks showing toasters with angular ends would not form a series.

- **PEMIO**  **TOU** and **PEMTOU**

The second mark lacks a significant feature of the first.

Examination of word marks (in Chinese) filed in series

- The usual way of reading Chinese characters is from left to right and from top to bottom and this is the way we assess characters in examining them as trade marks for registration (see absolute grounds for refusal).
- In line with the principle above, marks in Chinese characters represented from left to right (mark A) and right to left (mark B) are not a series. The reason is that the public will be likely to read the marks from left to right and, as a result, the identity of the marks will be different.
- However, there are marks containing characters that should obviously be read from right to left. This would happen where it is immediately apparent that the mark is the name of an individual or a company (‘玲美黃’ or ‘司公械器永金’) or the grammatical structure of the mark requires that it should be read from right to left (‘城長里萬’). Marks consisting of identical Chinese characters represented horizontally (one to be read from left to right and the other from right to left) could be considered as forming a series if they fall into this category.

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