

## Common deficiencies and irregularities of trade mark applications

Deficiencies and irregularities of trade mark applications may adversely affect the applications (e.g. their filing dates) and delay our examination of the applications. Hence, it is in the interests of applicants and their agents to ensure the information provided in support of the trade mark applications duly complies with the statutory requirements under the Trade Marks Ordinance, Cap 559 (TMO) and Trade Marks Rules, Cap 559A (TMR).

With a view to helping applicants and agents to avoid deficiencies and/or irregularities in trade mark applications, we set out below a list of common deficiencies and irregularities of trade mark applications, the relevant filing requirements or issues required to be addressed and our suggestions for reference.

Please however note that the deficiencies and irregularities identified below are not meant to be exhaustive. Applicants and agents are advised to exercise their due diligence before filing their trade mark applications.

	<b>Common deficiencies and irregularities</b>	<b>Filing requirements or issues required to be addressed</b>	<b>Suggestions</b>
<b>Language of proceedings</b>			
<b>Use of English or Chinese in completing the application form</b>	<p>Both the English and Chinese languages are used in completing the application form for registration of trade mark (Form T2).</p> <p><b>Example</b></p> <p>The specification of goods and services is provided in English whereas the address for service is given in Chinese.</p>	An application for registration of a trade mark shall be filed in one of the official languages (section 38(4) of TMO).	<p>Choose either English or Chinese as the filing language –</p> <p>(a) (filing in English): complete the English version of Form T2 in English only</p> <p>(b) (filing in Chinese): complete the Chinese version of Form T2 in Chinese only</p>
<b>Name of applicant (Part 01 of Form T2)</b>			
<b>Sole proprietorship or</b>	Only the trading name of a sole	Provision of the trading name of	(a) (where the applicant is

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<b>partnership</b>	<p>proprietorship or partnership is provided.</p> <p>Example ABC restaurant</p>	<p>a sole proprietorship or partnership alone is neither sufficient nor precise enough to support that the applicant is a legal entity capable of holding assets on its own.</p>	<p>a sole proprietorship): provide the name of the sole proprietor followed by the trading name of the sole proprietorship, e.g. <i>Chan Tai Man trading as ABC restaurant</i></p> <p>(b) (where the applicant is a partnership): provide the names of the individual partners followed by the name of the firm, e.g. <i>Chan Siu-ling and Lam Mei-mei trading as Chan &amp; Lam</i></p>
<b>Trade Mark (Part 04 of Form T2)</b>			
<b>Representation of trade mark</b>	<p>The representation of the trade mark filed is unclear.</p> <p><b>Example (a)</b> Some e-filed trade mark applications contain very small images of the trade marks in question which do not clearly indicate all the components of the</p>	<p>The representation of a trade mark should be clear and in sufficient detail to permit a proper examination of the mark (rule 8(1) of TMR).</p>	<p><b>Example (a)</b> Enlarge the electronic image of the trade mark in question in a proper size to</p>

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	marks.  <b>Example (b)</b> In some e-filed trade mark applications for bottle devices consisting of multiple elements including words on the label devices, such words are unclear.		ensure that its individual components are clearly visible  <b>Example (b)</b> Apart from enlarging the electronic image of the trade mark as per the above suggestion, use a higher resolution to enhance the visibility of the individual components of the mark
<b>Series marks</b>	Each of the series marks is not properly indicated or identified  <b>Example</b> abc abc abc abc	Without the proper indications/identifications, the marks cannot be identified as a series of marks.	Provide proper indication for each of the series marks.  <b>Example</b> A. abc B. abc C. abc D. abc
<b>Non-Roman letters and non-Chinese characters (Part 05 of Form T2)</b>			
<b>Non-Roman letters and non-Chinese characters</b>	For a trade mark which consists of or contains a word, letter or character that is neither in Roman letters nor in Chinese characters, neither its transliteration nor translation is	Where a trade mark consists of or contains a word, letter or character that is neither in Roman letters nor in Chinese characters, the application shall	Provide the transliteration or translation of the non-Roman and non-Chinese word, letter or

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	provided.	include the transliteration or translation of the word, letter or character (rule 120(4) of TMR).	character.
<b>Goods and/or services covered by the application (Part 07 of Form T2)</b>			
<b>Repeated items</b>	<p>The same description of goods/services appears more than once in the specification.</p> <p>OR</p> <p>Two or more items of goods/services by reference to the same words in different order, which essentially refer to the same item of goods/services, are stated in the specification.</p> <p><b>Example</b></p> <p>“Engines (Traction -)” and “Traction Engines”</p>	<p>Repeated items make the specification of the goods and/or services tautologous. The specification is required to include for each class of goods or services set out in the specification a <b>clear and concise</b> description in respect of which the trade mark is proposed to be registered (rule 7(2) of TMR).</p>	<p>Avoid repeated items of goods and/or services in the specification.</p> <p><b>Example</b></p> <p>Use “Traction Engines” in the specification</p>
<b>Wrong classification</b>	<p>Adopt an outdated/wrong classification of the goods/services without reference to the latest edition and version of the Nice Classification as applicable at the time of the application (note: Please refer to the section “<a href="#">How to classify my goods and services</a>” at the IPD’s website for the details about the</p>	<p>The goods or services in respect of which a trade mark is registered shall be classified in accordance with the classifications of the Nice Classification in force on the date of registration (rule 5(1) of</p>	<p>Check if the goods and services are properly classified in accordance with the latest edition and version of the Nice Classification as applicable at the time of the</p>

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	<p>current edition and version of the International Classification.)</p> <p><b>Example</b>  “Automatic vending machines” used to be classified in Class 9 is classified in Class 7 instead under the 2013 version of the Tenth Edition of the Nice Classification.</p>	TMR).	<p>application</p> <p><b>Example</b>  “Automatic vending machines” should now be classified in Class 7.</p>
<b>Use of simplified Chinese characters in specification of goods and/or services</b>	<p>The specification contains reference to some simplified Chinese characters</p> <p><b>Example</b>  “干洗劑”</p>	Only traditional Chinese characters should be used in the specification of a trade mark application filed in Chinese.	<p>Ensure that all Chinese characters in the specification of a trade mark application filed in Chinese should only contain traditional Chinese characters</p> <p><b>Example</b>  Use “乾洗劑” instead of “干洗劑” in the specification.</p>

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<b>Wrong punctuation</b>	<p>Improper use of punctuation in the specification may lead to incorrect presentation of the goods/services.</p> <p><b>Example</b> “Retailing of radios; clothing; leather bags; business management; all included in Class 35.”</p>	<p>Commas or semi-colons should be used properly for setting out in the specification the precise goods and/or services.</p>	<p>Use commas or semi-colons properly to set out in the specification the precise goods and/or services.</p> <p><b>Example</b> “Retailing of radios, clothing, leather bags; business management; all included in Class 35.”</p>
<b>Agent’s details (Part 03 of Form T2)</b>			
<b>Agent’s name and address</b>	<p>The person who has signed the Form T2 on behalf of the applicant is the applicant’s agent but the agent’s address has not been provided.</p>	<p>An agent shall notify the Registrar of the address in Hong Kong where he resides or carries on his business activities in the specified form or in writing (rule 103(3) of TMR).</p>	<p>Where an applicant has appointed an agent for filing the trade mark application, the agent’s name and residential or business address in Hong Kong should be provided.</p>