Today’s workshop on trademark search

Today, we aim to show you:

• How to use our online search services
  http://ipsearch.ipd.gov.hk

• Our search practice for similarities in word elements of trademarks
Search and comparison of marks

• Search for earlier marks with similarities is a preliminary step to comparing the marks and assessing whether they are confusingly similar.

• Similarity is assessed on first impressions of look, sound and idea.

Word elements – Device elements

We search for:

• similarities in words, Chinese characters, letters and numerals (word search)

• similarities in device elements (device search)
Our online search at http://ipsearch.ipd.gov.hk offers you two search interfaces:

- Simple search
- Advanced search
Simple search offers a number of search options:

- ‘Contain word’: finds marks with the identical ‘word(s)’
  e.g. search for ‘Apple’ finds ‘Apple’, ‘blue apple’

- ‘Contain word starting with’: finds marks starting with the
  ‘word(s)’ e.g. search for ‘Apple’ finds ‘Apple’, ‘blue apple’, ‘aplera’

- ‘Contain word ending with’: finds marks ending with the
  ‘word(s)’ e.g. search for ‘Apple’ finds ‘apple’, ‘blue apple’, ‘pineapple’

- ‘Part word’: finds marks containing the ‘word(s)’ e.g.
Advanced search offers wildcard and letter mark methods, to extend your search:

- Wildcard ‘%’ : substitutes one or more or nil characters  
  e.g. Ci%er finds Ice Grape Cider, Citysuper, Cine-R, Me _CIGARETTES Me Lavender, cier

- Wildcard ‘_’ : substitutes a single character e.g. Ci_er  
  finds Ice Grape Cider, Cine-R
Advanced search –
word elements (2)

- Selecting ‘Letter Mark’ confines your search to marks comprising the identical letters e.g. Letter Mark search for ‘abc’ finds marks ABC, abc, abc and device

- Alternatively, ‘Letter Mark’ search for ‘a_c’ extends your search and finds ABC, abc, ade, amc, arc and device

Search system behaviour

- Supports Roman letters and numerals: A-Z, a-z, 0-9
- Supports traditional and simplified Chinese characters
- Punctuation does not affect search (e.g. iou = i.o.u.)
- Space affects search (except ‘Letter Mark’) (e.g. golden sun ≠ goldensun)
Device elements

Coding system

• Vienna Classification: 3-level coding system

• Examples:
  Code 2.5. 21 Children with animals
  Code 2. 5. 8 Children engaging in sport or playing
  Code 26. 3. 1 One triangle
  Code 26. 3.2 Two triangles, one inside the other
  Code 26. 3.3 More than two triangles, inside one another
Search by using device codes directly

Using device description to get the appropriate device code(s)
Device codes for each mark –
Click the thumbnail of the mark to display the device codes

Using device codes to search non-Roman letters or non-Chinese characters

Device code: 28. 3. 0

Inscriptions in stylized (stylised) Chinese, Korean or Japanese characters
Search results – display of records (1)

- Display ‘Live records’ by default
- Option to view ‘Dead records’

Search results – display of records (2)
Search practice for similarities in word elements of trademarks

Visual and phonetic similarities

- Visual and phonetic similarities are taken into account

- Example:  
PELICAN  
PELIKAN  
PELICON
Traditional and simplified Chinese characters

- A search for traditional characters automatically includes the simplified characters and vice versa

- Example: 飛鷹 (traditional)
  飞鹰 (simplified)

Translated words

- Word marks in different languages are not regarded as similar because overall impression of the marks is likely to be different

  Example: 馬
  HORSE
  CHEVAL (French)
Transliterated words (1)

• Marks in Chinese characters are generally not regarded as similar to their transliteration in Roman letters – they give different immediate impression

Example: ‘YONGXIANG’ is not on first impression similar to ‘永祥’ or ‘永香’

Transliterated words (2)

Exception

• If a transliteration obviously stands for particular Chinese characters – we will conduct a search for the characters that the mark represents
  – Meaningful or well-known phrase or term; or the name of a well-known person or place in Pinyin.
    Example: for ‘Dongfang zhi zhu’ we would search ‘東方之珠’
  – Non-standard ‘pinyin’ – some well-known phrases or terms, or the names of well-known persons or places.
    Example: for ‘Kung Hei Fat Choy’, we would search ‘恭喜發財’
Trademark Search Reference (1)

- Click ‘Help’ on our online search system for more information on setting search criteria and ‘live’/‘dead’ trademark records

Trademark Search Reference (2)

- Trademarks Registry Work Manual Chapters on
  - Search
  - Scope of Searches - relative grounds for refusal

(http://www.ipd.gov.hk/eng/intellectual_property/trademarks/registry.htm)
Preliminary search service provided by the registry

Form T1:
- Search of records ($200)
- Preliminary advice on registrability ($200)

Q & A