

## Deficiencies checking

When we receive an application for the registration of a trade mark, certain preliminary checks need to be carried out.

### Requirements affecting the filing date

All applications must include:

- a request for registration of the trade mark (section 38(2)(a)(i) and (b)(i)): if the application Form T2 is used, this is satisfied;
- the name and address of the applicant (section 38(2)(a)(ii) and (b)(ii));
- a statement of the goods or services in relation to which the applicant is seeking to register the trade mark (section 38(2)(a)(iv) and (b)(iii)). “All goods / services in Class [    ]” is not a statement of goods or services for this purpose; and
- a representation of the trade mark (section 38(2)(a)(v) and (b)(iv)).

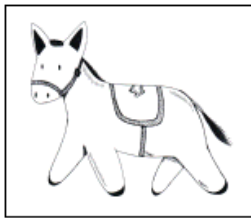
For example:

1 June 2003                      application filed with the following “representation”:



This cannot be treated as a proper representation. A filing date cannot be accorded.

1 September 2003 the following representation is provided:



The application should be accorded a filing date of 1 September 2003 (if the other filing date requirements under section 39 are met).

Also, all applications must be accompanied by the prescribed fees (including any applicable class fees) (Fee Nos. 1, 30 & 32) (section 38(5)).

When all the above criteria have been met, the application receives a filing date (section 39).

## **Other requirements (not affecting the filing date)**

The following items also need to be checked:

- Is the application filed on the specified Form T2 (section 38(1); rule 6(1))?

- Have the correct class numbers for the goods or services been given (rule 7(1))?

If the specification lists goods or services by reference to a class or classes under which the goods or services do not fall, the applicant may file a request to amend the application to correct the class or classes accordingly (see chapter on Amendment of applications).

- Is there a clear and concise description of the goods or services for each class of goods or services being applied for (rule 7(2))?

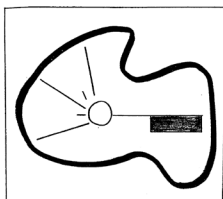
For example, vague additional phrases like “and supporting services” would need to be deleted.

- Is the mark represented clearly and in sufficient detail to permit a proper examination to be made of the mark? Is it of a kind and quality suitable for reproduction and registration (rule 8(1))?

Where an application for registration of a mark satisfies section 39(1) and a filing date has been accorded, a request to replace the representation of the mark with what is purported to be a “clearer” version but which actually includes a significant new feature cannot be acceded to, as an amendment of application has to be in accordance with section 46 (see chapter on Amendment of applications).

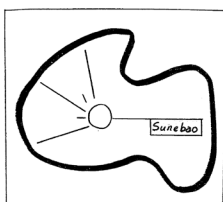
For example:

1 June 2003                      application filed with the following representation:



The application is accorded the filing date of 1 June 2003.

20 June 2003                      request to replace the representation with the following  
“clearer” version:



The amendment cannot be allowed, and a new application would have to be filed.

- Has the applicant indicated that the trade mark is either being used by the applicant or with his consent, or that he has an honest intention that the trade mark will be so used (section 38(3))?
- Is the application filed in one of the official languages, i.e. English or Chinese? An application cannot be filed partly in English and partly in Chinese, but see *Name of Applicant* below. Is the applicant’s name in the Roman alphabet or in Chinese characters? Does the mark contain a word, letter or character that is neither in the

Roman alphabet nor in Chinese characters? If yes, have the requirements for translation ~~and~~or transliteration under rule 120 been met (section 38(4))?

- Has the applicant provided an address for service in Hong Kong (section 38(2)(a)(vi) and (b)(v); rule 105(1)(a))? This must be a residential or business address in Hong Kong (rule 105(2)). It ~~cannot~~must not be an address of a mere P.O. Box or a virtual office, a “care of” address or any other address used solely for forwarding mails, nor an email address. Only one address for service should be filed for any one application (rule 105(5)). This includes ~~applications~~an application filed jointly in the name of two or more persons, i.e. the address for service filed in relation to the application is treated as the address for service of each of those persons (rule 105(4)). If a proper address for service is not filed, a notice to file an address for service under rule 107(1) should be sent.
- If the applicant is a corporation, has the applicant stated the place under the law of which the corporation was formed and registered, incorporated or established (section 38(2)(a)(iii))? If the applicant was incorporated in the United States, the applicant should indicate the state under the law of which it was incorporated.

The application form should also be checked to make sure that it is clear and consistent, and that there are no obvious mistakes.

When the filing date for an application is accorded (see *Requirements affecting the filing date* above), the applicant should be notified accordingly.

If any of the matters referred to in *Requirements affecting the filing date* and *Other requirements (not affecting the filing date)* above are not satisfied, the applicant should be informed of these deficiencies and be asked to remedy the situation within two months after the date of the notice. This two-month period is non-extendable (rule 95(1)(a)). If the applicant fails to do so:

- the application will be deemed never to have been made if the deficiencies fall under *Requirements affecting the filing date*; and
- the application will be treated as abandoned if the deficiencies fall under *Other requirements (not affecting the filing date)* which relate to rule 6(1) or 8(1) or section 38(1), 2(a)(iii) or (vi) or (b)(v), (3) or (4) (rule 11(2)(a)). Where the deficiency relates to the description of goods or services or the class(es) in the International Classification required to be specified, and relates only to part of goods or services applied for, the part of the application which is deficient shall be treated as abandoned (rule 11(2)(aa)). (Failure to provide an address for service within 2 months after a rule 107(1) notice will also result in the application being treated as abandoned or withdrawn under rule 107(3)(a)).

## **Name of applicant**

If the name of an applicant in both Chinese and English is recorded in the company register or business register or the equivalent (“official register”) in the place of incorporation of that applicant, the applicant is free to provide such name in both Chinese and English in his application for registration of trade mark provided that such name accords with the record of the official register. Since it is the responsibility of the applicant to ensure accuracy of his name provided in the application, the Registrar generally will not request the applicant to provide a copy of the record of the official register for verification purpose. The name of an applicant given in both Chinese and English in the same application form will not be considered a deficiency unless the Registrar has reason to doubt the accuracy of such name.

Since the applicant named in an application for registration could not be changed once an application is filed (except in the case of an assignment), it is important that the applicant should be correctly named in the first instance.

Where the proposed applicant is a firm owned by one or more persons or other unincorporated associations, care should be taken to ensure that the applicant named has the capacity of owning property and is recorded in an appropriate manner. (See *Sole proprietorships and partnerships* and *Unincorporated associations* in the chapter on Assignment of registered trade marks and applications.)

## Requirement for agent's address in Hong Kong

If the applicant has appointed an agent to act on his behalf in connection with the application, we will check whether the requirement under rule 103(3) for filing agent's address in Hong Kong is met.

If the requirement for agent's address in Hong Kong is not satisfied, we will send a notice to the applicant at his address for service in Hong Kong or at his address (if address for service in Hong Kong is not filed):

- requesting him to file his agent's address in Hong Kong within 2 months after the date of the notice; and
- informing him that the Registrar ~~is unable~~will refuse to recognize as an agent a person having neither a residence nor a place of business in Hong Kong (section 88(3)).

## Representation of the trade mark

### ***Graphical representation***

The definition of “trade mark” in section 3(1) requires that the sign be capable of being represented graphically. Including a representation of the trade mark in the application for

registration is a filing date requirement (sections 38(2)(a)(v) and (b)(iv) and 39). Rule 8(1) requires that the representation “shall depict the trade mark clearly and in sufficient detail to permit a proper examination to be made ... and ... be of a kind and quality that is suitable for reproduction and registration.”

This requirement deals with legal certainty. Any system registering rights, which can be asserted against others, can only function if it is possible to define the scope of the rights in question. The trade mark must therefore be certain and easily viewable.

In particular the representation of a mark must be such that:

- it can be determined from the graphical representation precisely what the sign is without the need for supporting samples;
- the graphical representation can stand in place of the sign because it represents only the sign and no other;
- it is reasonably practical for anyone inspecting the register or viewing the Hong Kong Intellectual Property Journal (in electronic form), to understand from the graphical representation what the trade mark is;
- it is defined with sufficient precision to determine infringement rights; and
- no prior knowledge of how the mark is in fact used is necessary.

In the words of the ECJ in the *Sieckmann* case (Case C-273/00; 12 Dec 2002) the representation of a mark must be clear, precise, self-contained, easily accessible, intelligible, durable and objective.



Descriptions in words alone are unlikely to be acceptable as a graphical representation of a trade mark. See Swizzels Matlow Ltd's Application for a Three Dimensional Trade Mark [1999] RPC 879, which was not accepted because it was too imprecise, and Ty Nant Spring Water Ltd's Trade Mark Application [1999] RPC 392, which was not accepted because it was too technical.

In Swizzels Matlow Ltd's Trade Mark Application [1998] RPC 244, the description “[T]he trade mark consists of a chewy sweet on a stick” was held to fall far short of the necessary precision.

In Camelot Group Plc's Application (UK Registry, 8 April 1999), the description “[T]he mark consists of a set of forty nine coloured lottery balls, each marked with a number ... nine white balls ... ten blue balls ... ten pink balls” etc was rejected as it gave rise to an infinite variety of marks.

## **Colour marks**

Where the applicant is seeking protection for a mark in a colour or colours (whether the colour(s) relate(s) to the whole or part of the mark), the representation of a mark on the application form (Form T2) must be in such colour or colour(s) and identifies the mark sought to be registered by the applicant.

In cases where a colour or colours are claimed as a trade mark or as element(s) of a trade mark, the application must also contain a description or statement claiming the colour or colours as the trade mark, or as element(s) of the trade mark. For example, “Green” without a sample of the colour is not precise enough to be a representation of the colour for the purpose of section 38(2)(a)(v) and (b)(iv).

In *Ty Nant Spring Water Ltd's Trade Mark Application* [2000] RPC 55, a mark defined as “a blue bottle of optical characteristics such that, if the wall thickness is 3mm, the bottle has, in air, a dominant wavelength of 472 to 474 nanometres, a purity of 44% to 48%, an optical brightness of 28% to 32%” required the use of a spectrophotometer to translate these optical characteristics into the colour known as cobalt blue. Unless and until such steps are taken, the actual identity of the sign put forward for registration would remain veiled by the wording of the representation.

## ***Smell marks***

The major hurdle to registration of a smell mark in practice is the lack of a generally accepted means of representing a smell mark graphically so as to meet the statutory definition of “trade mark” under section 3(1) and also to comply with the filing requirements under section 38(2)(a)(v) and (b)(iv) (see “*Graphical representation*” above).

- It has been held that a written statement/description/chemical formula of a smell mark, a deposit of an odour sample of a smell mark, or a combination of the aforesaid means does not satisfy the requirements on graphical representation of a trade mark (*Sieckmann*).
- In *John Lewis of Hungerford Ltd's Trade Mark Application* [2001] RPC 28, the trade mark was described as “the smell, aroma, or essence of cinnamon”. The Registrar held that a mark was not sufficiently described if it required the assumption of a previous experience on the part of the examiner. On appeal to the Appointed Person, Geoffrey Hobbs Q.C. rejected a pictorial analysis of the smell created by an “electronic nose” on the basis of its inability to provide a graphic representation which could properly be regarded as unique to the applied-for smell. The description of the mark also lacks precision as a result of the degree of subjectivity it allows in the determination of the question whether a fragrance exemplifies “the smell, aroma or essence of cinnamon” and the extent to which the differing perceptions of different individuals can equally well be regarded as benchmarks for the interpretation of the wording in question.

- In *Eden SARL v OHIM* (Court of First Instance of the European Communities (Third Chamber), 27 October 2005), the applied-for mark was represented by the description “the smell of ripe strawberries” and the image of a red strawberry whose variety was not specified. The image which represented the fruit emitting the smell in question did not convey information additional to the description in words. The overall representation of the mark was held to be lacking in clarity and precision. Accordingly, the Court upheld the findings that the mark had not been represented graphically. Besides, the Court noted, “at the present time, there is no generally accepted international classification of smells which would make it possible, as with international colour codes or musical notation, to identify an olfactory sign objectively and precisely through the attribution of a name of a precise code specific to each smell.”

### **Sound marks**

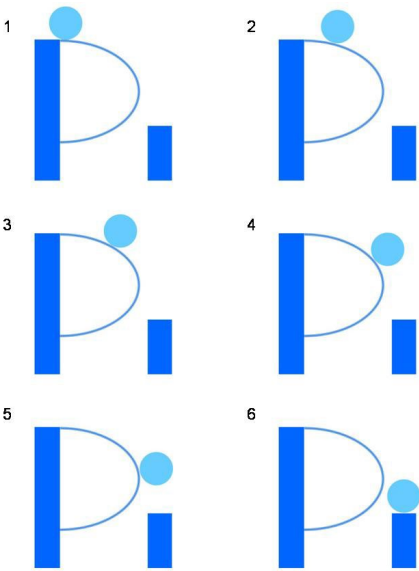
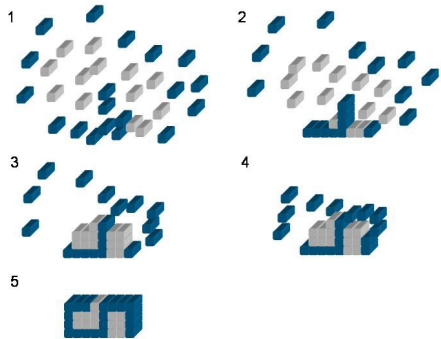
In *Shield Mark BV v Kist* (ECJ) (Case C-283/01), it was held that a written description such as “the first nine notes of Für Elise, or a cockcrow”, lacks precision and clarity and therefore does not make it possible to determine the scope of the protection sought. Similarly, a mere sequence of notes (such as E, D#, E, D#, E, B, D, C, A), which is neither clear, nor precise, nor self-contained, does not make it possible, in particular, to determine the pitch and the duration of the sounds forming the melody in respect of which registration is sought and which are essential parameters of knowing the melody and accordingly, of defining the trade mark itself. The requirement for graphical representation of a sound mark is met where it is represented by a stave divided into bars and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals e.g. sharp (♯), flat(♭) and natural (♮). If the musical instrument used to produce the sound is an element of the mark, this should also be stated in the application.

## ***Movement marks***

The movement mark applied for should be graphically represented by a series of still images in the correct sequence of movement and the movement should be perceivable. The written description of a movement mark should include the following information:

- that the mark is a movement mark which consists of a representation of a sequence of images;
- what the sequence of images depicts, i.e. a precise description of the complete sequence of movement;
- how many images are involved in the complete sequence of movement;
- what the sequential order is of the images; and
- that there is a single (not variable) sequence of movement.

Here are some examples of acceptable and unacceptable representations for movement marks:

Example of acceptable representation for movement mark	
	<p><u>Mark description:</u></p> <p>The mark is a movement mark consisting of a representation of six images in the sequence of movement from 1 to 6, illustrating that the dot device moves downwards to the right from the top of the P-shaped device along the curvature of the device until it falls on the top of the bar forming the letter “i” on the right-hand side.</p>
Example of unacceptable representation for movement mark	
	<p><u>Mark description:</u></p> <p>The mark is a movement mark consisting of a representation of five images in the sequence of movement from 1 to 5. The blocks move towards the centre which are finally consolidated into a block featuring the letters “cn” in blue colour.</p> <p>Remark: This representation is unacceptable since the movement cannot be perceived precisely from the images.</p>

## Holograms

Like movement marks, the graphical representation of a hologram mark has to depict clearly all the material features of the mark including all its various images when viewed from different angles.

A hologram with many features which vary at different viewing angles may not be considered as graphically represented merely by a limited number of photographs or images since it cannot be certain that all the essential features of the mark would be perceived – see Checkpoint Security Services Ltd's Application (UK Registry, 7 June 1999).

The written description of a hologram should indicate that the mark applied for registration is a hologram to be supported by a precise statement for describing the multiple views of the hologram by reference to the essential features of the hologram.

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