

## Foreign words, letters or characters

A trade mark may consist of words, letters or characters, whether or not they are Roman alphabets or Chinese characters.

### Deficiencies checking

If the trade mark applied for registration includes a word, letter or character which is neither in the Roman alphabet nor in Chinese characters, a translation or transliteration of that word, letter or character has to be included in the application and the language to which that word, letter or character belongs has to be stated (rule 120(4) of the Trade Marks Rules). If either of these two requirements is not met, the examiner will treat it as a deficiency and request the applicant or agent to remedy the deficiency (See chapter on Deficiencies checking).

### Examination on prima facie basis

In examining applications for registration of trade marks which include foreign words, letters or characters on *prima facie* basis, we will generally consider the following factors:

■ *Meaning generally known?*

There are no grounds for refusing registration of trade marks on the basis that they are relevantly descriptive or non-distinctive in a language which is unlikely to be understood by the relevant Hong Kong consumers of the goods or services in question (*Matratzen Concord AG v Hukla Germany SA, C-421/04*). For example, the Dutch word “Verf” which means “paint” in English is registrable in respect of the applied-for goods of “paint” since it is unlikely that the average consumer of such goods in Hong Kong will understand its meaning.

On the contrary, trade marks which include foreign words, letters or characters which are descriptive or indistinctive of the applied-for goods or services and are generally known to the relevant consumers of such goods or services in Hong Kong are

unregistrable. For example, the word “ICHIBAN” meaning “the best” in Japanese is unregistrable in respect of any types of applied-for goods or services since the average consumer in Hong Kong will understand this laudatory meaning.

Where the applied-for goods or services are for particular groups of customers, distinctiveness will be assessed with reference to the targeted consumers of such goods or services. For example, the word “Tumelépano” which means “call on the telephone” in tagalog language will be perceived by the Filipinos in Hong Kong as descriptive and indistinctive of “magnetic cards” for use in telephone calling. Accordingly, if the goods are mainly targeted at this particular sector of the public in Hong Kong, the word is unregistrable in respect of such goods.

■ *Resemblance to the objectionable English or Chinese equivalent*

The more closely the foreign words resemble the objectionable equivalent English words or Chinese characters, the more likely it is that the objectionable meaning will be understood by the consumers. For example, the German word “Kamera”, which means “camera” in English and is very close to “camera”, is unregistrable in respect of “photographic instruments”. On the other hand, the Portuguese word “Portátil”, which means “portable” in English, is registrable in respect of “notebook computers” because it is sufficiently distinguishable from “portable”.

■ *Overall impression*

If the overall impression that the average consumer has of the foreign words or characters forming a trade mark is merely a bunch of codes or a string of unintelligible words or characters, he may not regard the mark as a badge of origin. In such cases, the trade mark is devoid of any distinctive character and objectionable under section 11(1)(b) of the Trade Marks Ordinance. For example, although the average consumer in Hong Kong may not understand the phrase “よりよいプロダクト およびよりよいサービス” which means “better products and better services” in Japanese, it is unlikely that he will regard the whole string of Japanese characters as a badge of origin. Hence, objection under section 11(1)(b) will be taken against this mark in respect of any applied-for goods or services.

■ *Mixture of different languages*

Where the elements of the trade mark are taken from more than one language other

than English or Chinese and the combination of such elements renders the mark distinctive, the mark is registrable. For example, if the mark applied for is “Bon Udon”, and “Bon” and “Udon” mean “good” and “noodles” in French and Japanese respectively, it is registrable in respect of “restaurant services”. However, if the trade mark consists of foreign words or characters and the equivalent descriptive and indistinctive English words or Chinese characters, it is likely that consumers will perceive that the meaning of the foreign words or characters corresponds with that of the English words or Chinese characters. Accordingly, the trade mark as a whole will be perceived by consumers as descriptive or indistinctive of the goods or services in question and is unregistrable. For example, for the mark

  
“”, it is likely that consumers will perceive that the Arabic characters mean “Egyptian American Bank” and thus the trade mark is unregistrable in respect of “banking services”.

### **Acquired distinctiveness through use**

If the objection under section 11(1)(b), (c) or (d) of the Trade Marks Ordinance has been taken against the trade mark which consists of foreign words, letters or characters, the objection may be overcome by filing of evidence of acquired distinctiveness. (See the section “Section 11(2) – acquired distinctiveness through use” of the chapter on Absolute grounds for refusal.)

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