

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)) : if the application Form T2 is used, this is satisfied;
- the name and address of the applicant (section 38(2)(b));
- a statement of the goods or services in relation to which the applicant is seeking to register the trade mark (section 38(2)(c)). “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)(d)).

For example:

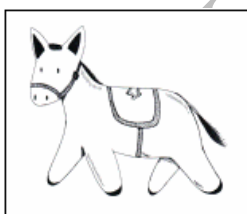
1 June 2003

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).

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 Forms T2 and T2A (if applicable) (section 38(1); rule 6(1))?
- Have the prescribed fees (including any applicable class fees) (Fee Nos. 1, 30 & 32) been paid (section 38(5))?
- 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))?

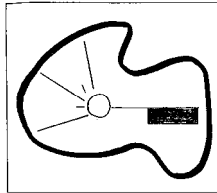
For example, vague additional phrases like “and supporting services” would need to be deleted.

- 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).

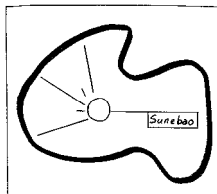
For example :

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 (Box 6 of Form T2; 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. 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 transliteration under rule 120 been met (section 38(4))?

- Has the applicant provided an address for service in Hong Kong (section 38(2)(e); rule 105(1)(a))? This must be a residential or business address in Hong Kong (rule 105(2)). It cannot be a mere P.O. Box or an email address. Only one address for service should be filed for any one application (rule 105(5)). This includes applications filed jointly in the name of two or more 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.

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. 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)* relates to rule 6(1) or 8(1) or section 38(1), 2(e), (3), (4) or (5) (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

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 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

Graphic 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)(d) 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 graphic 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.

A hologram could not be represented by a limited number of photographs, and the application for registration was rejected in *Checkpoint Security Services Ltd's Application* (UK Registry, 7 June 1999).

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

“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)(d).

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

In *John Lewis of Hungerford Ltd's Trade Mark Application* [2001] RPC 575, 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” as unintelligible to people inspecting the Register. The wording “the smell, aroma or essence of cinnamon” 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. It fails to satisfy the requirements of the equivalent of section 38(2)(d).

In *Sieckmann*, it has held that in respect of an olfactory sign, the requirements of graphic representability are not satisfied by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements.

In *Eden SARL v OHIM* (European Court of First Instance, 27 October 2005), the description “the smell of ripe strawberries” was found to be lacking in clarity and precision. 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. A mere sequence of notes (such as E, D#, E, D#, E, B, D, C, A) does not make it possible to determine the pitch and the duration of the notes, which are essential parameters of the melody sought to be represented, and hence fail to meet the requirements of being clear, precise and self-contained. 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. #, b).

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