

# Search

## Registrar's duty to carry out searches

Section 42 of the Trade Marks Ordinance (Cap. 559) requires us to examine applications for registration to determine whether they satisfy the requirements of the Ordinance, including any requirements imposed by the Trade Marks Rules. In examining applications, we need to conduct searches to consider the grounds for refusal:

- the absolute grounds for refusal which in broad terms concern the distinctiveness of a trade mark (see chapter on Absolute grounds for refusal), and
- the relative grounds for refusal which relate to confusing similarity to earlier trade marks (see chapter on Relative grounds for refusal).

## Search relating to relative grounds for refusal

To consider the relative grounds for refusal of an application for registration we need to search for earlier identical or similar marks for identical or similar goods or services (see chapter on Relative grounds for refusal).

We search for earlier marks by using the trade marks search system available on-line:

[esearch.ipd.gov.hk](http://esearch.ipd.gov.hk)

The registry database contains details of earlier registered trade marks and applications for registration. However, not all earlier marks will be revealed in a search – a mark entitled to protection under the Paris Convention as a well-known mark may not necessarily have been registered in the Hong Kong SAR, or may not have been registered for particular goods or services. Without registration, an owner will need to

protect his mark by opposition.

### ***Searching words and devices***

In searching for earlier identical or similar marks, we check marks that include words, characters, letters or numerals against the database for other marks that include identical or similar words, characters, letters or numerals. Our search not only includes marks likely to be confused visually, it also takes phonetically identical or similar marks into account. Three-dimensional marks, colour, sound and smell marks are also checked against identical or similar [marks](#).

### ***What does a search of earlier marks involve?***

The trade marks search system allows search of details of registrations and applications for registration under the Trade Marks Ordinance (Cap. 559) and under the repealed Trade Marks Ordinance (Cap. 43). The details, kept in electronic form and stored on the register, include information such as the name and address of the owner, the address for service of the owner, the date of registration, any disclaimer, limitation or condition to which the registration is subject, etc (see rule 29 of the Trade Marks Rules). There are also historical records of assignments, licences, security of interests, etc.

The on-line search system has a “Help” function which provides details of search interfaces, methods of inputting search criteria, searchable fields and search result lists.

### ***Searching device marks***

The search system allows search of device marks by code numbers. Device marks are classified under a system based on the Vienna Classification, the international classification of figurative elements of marks administered by the World Intellectual Property Organization (WIPO) (<http://www.wipo.int/classifications/en/index.html>).

The classification consists of a number of categories, divisions and sections in which the figurative elements of a mark are classified. Each category, division and section has a code number that gives access to the marks classified in it.

The appropriate device codes can be obtained from our on-line search system by entering the relevant device description(s) in either English or Chinese.

### ***Searching marks for particular goods and services***

Trade mark registrations for goods and services are classified under class numbers in accordance with the International Classification of Goods and Services under the Nice Agreement (see section 40, rule 2(1) (definition of “Nice Agreement”) and rule 5; see also chapter on Classification).

### ***Cross search***

In searching for earlier identical or similar marks, our on-line search system automatically extends the search to classes identified in our cross-search list (see Cross search list). This automatic extended search helps us to identify earlier marks for identical or similar goods or services.

### **Searches relating to absolute grounds for refusal**

We make dictionary, telephone directory and Internet searches in considering our objections to an application for registration on the absolute grounds for refusal. The following reference books and Internet sites are our main sources but the list is not exhaustive:

## **Chinese**

Lin Yu Tang's Chinese-English Dictionary

<http://humanum.arts.cuhk.edu.hk/Lexis/Lindict/>

## **English**

Collins English Dictionary

<http://www.onelook.com/>

## **Other languages**

Collins Robert French-English/English-French Dictionary

Collins German-English/English-German Dictionary

Collins Sansoni Italian-English/English-Italian Dictionary

Kenkyusha's New Japanese-English Dictionary

## **Abbreviations, Acronyms**

[www.acronymfinder.com](http://www.acronymfinder.com)

## **Financial**

A Dictionary of Finance (Oxford University Press)

[www.investopedia.com](http://www.investopedia.com)

## **General**

Master Dictionary of Food & Wine

## **Geographical**

Merriam Webster's Geographical Dictionary

## **Symbols**

[www.symbols.com](http://www.symbols.com)

## **Technical**

McGraw-Hill Dictionary of Scientific & Technical Terms

<http://techweb.com>

<https://www.webopedia.com/>

Computer Dictionary (Microsoft Press)

Dorland's Illustrated Medical Dictionary

<http://medical-dictionary.com>

Martindale The Extra Pharmacopoeia

Hawley's Condensed Chemical Dictionary

If we base our objection to an application on information from a particular source not

listed above, we should let the applicant know the source of the information by giving him the reference to the relevant website or dictionary.

## **Emblems protected under Article 6ter of the Paris Convention**

Marks consisting of any emblems, abbreviations or names of states and international intergovernmental organizations protected under the Paris Convention shall not in general be registered without the authorization of the competent authorities or organizations (see sections 64 and 65). Therefore, marks must also be searched against the World Intellectual Property Organization (WIPO) notifications of protected emblems etc. of states and international and intergovernmental organizations (see section 66). Details of the protected emblems, abbreviations and names are notified to the Permanent Representation of the Hong Kong Special Administrative Region of China to the World Trade Organization by the International Bureau of the World Intellectual Property Organization. WIPO's Article 6ter database can be searched and viewed at <http://www.wipo.int/ipdl/en/search/6ter/search-struct.jsp>.

## **Geographical designations**

Section 11(1)(c) prohibits the registration of marks consisting exclusively of signs designating geographical origin (see chapter on Geographical origins) and section 11(4)(b) prohibits the registration of marks likely to deceive the public (see chapter on Classification).

But we should note that marks designating geographical origin can be registered as collective or certification marks (see chapter on Certification and collective marks).

Geographical names and devices need to be identified by searches in geographical dictionaries or on the Internet to ensure that a mark does not fall within the prohibitions of the Trade Marks Ordinance, i.e. it is not:

- exclusively a geographical designation for the goods/services, e.g. a name or map outline of a country; or
- likely to deceive the public as to the geographical origin of the goods/services.

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Previous Version