Scope of searches –

relative grounds for refusal

Search for earlier marks with similarities

Examining an application for registration involves an assessment of whether the applicant's mark is confusingly similar to earlier marks (see chapter on <u>Relative grounds for refusal</u>).

Searching the database for marks with similarities to the applicant's mark is a preliminary step to comparing the marks and assessing whether they are similar. Similarity is assessed on first impressions of look, sound and idea. Each mark is considered as a whole and is compared with another mark successively, allowing for imperfect recollection. The marks are not compared side by side.

An assessment that an applicant's mark is similar to an earlier mark, carries us to the next step which is to assess the likelihood of confusion between the applicant's mark and the earlier trade marks (see Chapter on <u>Relative grounds for refusal</u>).

The preliminary step of searching the database for marks with similarities to the applicant's mark involves two distinct searches: a search for similarities in word elements, Chinese characters and numerals; and a search for similarities in device elements. If the applicant's mark is a word and a device, for example the word CAFEREE and the device of a coffee cup, we make two distinct searches for earlier marks. We make a search for earlier marks that include words with similarities to CAFEREE and a separate search for earlier marks that include devices of coffee cups. The paragraphs below explain the scope of searches for word, characters and number and searches for devices.

Visual and phonetic similarities

A search for words must take into account marks with visual and phonetic similarities:

Example :   PELICAN
                 PELIKAN
                 PELICON

Traditional and simplified Chinese characters

A search for traditional characters automatically takes into account the simplified characters and vice versa.

Example :   飛鷹 *(traditional)*
                 飞鹰 *(simplified)*

Words translated?

Although conceptually similar, word marks that are expressed in different languages are unlikely to be regarded as similar as the overall impression of the marks is likely to be different.

Example :   馬
                 HORSE
                 CHEVAL (French)

However, if the words appear with a device, the device element in the marks may make them similar as a whole. We search separately for devices to take account of this:

Example: 馬 and star device
                 HORSE and star device
                 CHEVAL and star device

Words transliterated?

Despite aural similarities, marks in Chinese characters are unlikely to be regarded as similar to their transliteration in Roman letters because the immediate impression of the marks is likely to be different.

Example: 'WING CHEUNG' is not on first impression similar to '永祥', '榮昌', '穎張' or '泳將'.
'YONGXIANG' is not on first impression similar to '永祥' or '永香'.

However, if the above words or characters appear with a device, the device element in the marks can make them similar. We search separately for devices to take account of this:

Example :   WING CHEUNG and star device
YONGXIANG and star device
永祥 and star device
榮昌 and star device
穎張 and star device
泳將 and star device
永香 and star device

Exceptionally, a transliteration may so obviously stand for particular Chinese characters that we will conduct a search for the characters that the mark represents. A direct connection with the Chinese characters is likely if the transliteration is the standard 'Pinyin' and it immediately evokes a meaningful or well-known phrase or term or the name of a well-known person or place.

Example: In an application to register "Dong fang zhi zhu", we would search '東方之珠'.

Non-standard 'pinyin' is unlikely to evoke an immediate connection with Chinese characters but some well-known phrases or terms or the names of well-known persons or places will be immediately recognised and we will make a search for the equivalent Chinese characters.

Example: In an application to register ' Kung Hei Fat Choy', we would search '恭喜發財'.

Words and numbers

A search for numerals expressed in words should take account of marks that include the numerals in digits and vice versa. Everyday use of digits to stand for words and Chinese characters, indicates that we should:

• search numerals expressed in English words against digits

• search Chinese characters against digits

• search digits against numerals expressed in English words and in Chinese characters

The above searches are limited to English words and Chinese characters as they are most commonly used in Hong Kong.

Example:
When examining applications for the digit marks set out below, we will search "three four" and "三 四" and then assess whether there is a likelihood of confusion.

3・4
3 & 4
3 – 4
3 , 4

Device searches

If a mark has a device element, we search the trade marks database for marks that include similar devices. Composite marks with a similar device could make the marks similar when viewed as a whole although the word element may be different.

Example :   馬 and star device
                HORSE and star device
                CHEVAL and star device

However, it is unlikely that word marks and devices will be regarded as similar because the immediate impression of the marks is likely to be different. For example, the word '馬' is unlikely to be considered as similar to devices of horses.

A device search automatically takes into account three-dimensional marks because 2-D and 3-D marks are coded on the same principles (see the Vienna Classification, above).