

## 7.4.3 Non-Roman and Chinese Characters - Guidelines for Section 44

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For information in relation to searching Chinese characters see the [Guidelines for RIO Search for Trade Marks](#)

### [Part 26.6.10 of the Trade Marks Manual](#)

The usual tests for comparing word trade marks are applied when deciding whether words rendered in a non-English language are deceptively similar to trade marks already on the Register and whether there is a reason for rejection under section 44. This applies whether the trade marks being compared are both rendered in Roman characters or in the letters or characters of any system of writing, such as Arabic or Chinese.

## Non-Roman characters

Non-Roman characters are typically those trade marks which are, or include, Korean, Cyrillic, Arabic, Japanese (katakana and hiragana) and Greek scripts. Other scripts are also possible.

When searching these trade marks, a transliteration and translation of the script must be provided either at lodgement, or sought from the applicant at examination. When available, the examiner should conduct an additional search of the transliteration to check whether equivalent characters / transliterations may be

deceptively similar under Section 44. In a similar manner to considerations of Chinese pinyin (Roman characters) vs Chinese characters (non-Roman characters), examiners should consider the likely meaning and impact of non-Roman characters and their Roman equivalent, especially on the target customer base.

For example a Korean character trade mark which has a transliteration provided at the time of lodgement. The examiner searches the image indexing of CHARACTER,KOREAN and TWO and the relevant class(es). The examiner should also search the transliteration provided by the applicant in the normal word search fields to confirm whether any trade marks have the same or similar meaning and letters/words.

## Chinese characters

When comparing trade marks that contain Chinese characters, there are 3 groups of people that we must consider:

- Native Chinese speakers
- Non-Chinese speakers
- Chinese and English speakers

## Character vs Character

### Traditional vs Simplified

There are two standard written Chinese types: traditional and simplified.

Below is an example of two different ways of writing the exact same character, the first being in traditional form and the second being in simplified form.



VS



They are the same character but written using different writing systems, similar to a word with multiple spellings, eg. "organize" vs "organise". As they mean the same thing and will be referred to in the same manner, these characters are considered to be deceptively similar and therefore a ground for rejection under section 44 is appropriate.

### Identical characters written in a different font/style

Chinese characters can be written in different fonts and styles. The same Chinese character can look different according to the font or style that it is written in.

For example:



VS



In the above example, the character on the left is the same as the character on the right but in a different style, similar to an English word written in cursive vs print.

In this situation, although the characters are visually different, they sound the same and mean the same thing. Therefore a ground for rejection under section 44 is appropriate.

## Character vs Pinyin (transliteration)

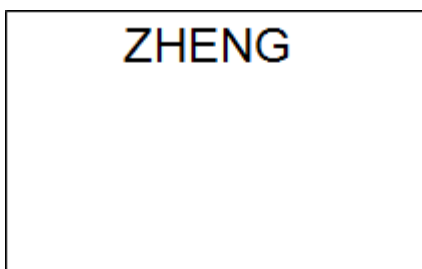
Pinyin is a standardized system of transliteration used for Chinese characters. Each Chinese character is assigned a Pinyin, which is essentially the transliteration of the Chinese character. Pinyin is part of the Chinese language and is recognised by Chinese speakers as well as English/Chinese speakers and English speakers only.

### Single Chinese character vs Pinyin transliteration

For example:



vs



ZHENG is the transliteration of the character 正.

Due to the nature of Pinyin, one-word Pinyin can refer to a multitude of characters (which may have different meanings). Therefore, a section 44 ground for rejection is

not appropriate where considering one Chinese character vs one Pinyin term.

For example, ZHENG can refer to many characters (see sample list below – which is not exhaustive):

Matching Results		
正	zhèng	just (right); main; upright; straight; correct; positive; greater than zero; principle
争	zhēng	to strive for; to vie for; to argue or debate; deficient or lacking (dialect); how or what (literary)
睁	zhēng	to open (one's eyes)
整	zhěng	exactly; in good order; whole; complete; entire; in order; orderly; to repair; to mend; to renovate; (coll.) to fix somebody; to give somebody a hard time; to mess with somebody
蒸	zhēng	to evaporate; (of cooking) to steam; torch made from hemp stalks or bamboo (old); finely chopped firewood (old)
征	zhēng	journey; trip; expedition; to go on long campaign; to attack
征	zhēng	to invite; to recruit; to levy (taxes); to draft (troops); phenomenon; symptom; characteristic sign (used as proof); evidence
挣	zhèng	to struggle to get free; to strive to acquire; to make (money)
挣	zhēng	see 挣扎
症	zhèng	disease; illness
证	zhèng	certificate; proof; to prove; to demonstrate; to confirm; variant of 症
峥	zhēng	excel; lofty
徵	zhēng	Japanese variant of 微
怔	zhēng	to stare blankly; startled
怔	zhèng	stumped for words; to stare blankly

It is only with an additional word that the correlation becomes unmistakable.

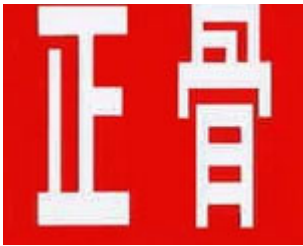
Therefore, when comparing a single Chinese character to the Pinyin a ground for rejection under section 44 is not appropriate. If in doubt, an examiner should consult an SME.

## Multiple Chinese characters vs Pinyin (transliteration)

For example:

ZHENG GU

VS



ZHENG GU is the Pinyin/transliteration of the characters 正骨.

The Pinyin ZHENG GU is only used to refer to those two characters so will be recognised by Chinese speakers as the characters 正骨.

A ground for rejection under section 44 would be appropriate as the trade marks sound the same and mean the same thing.

## How to search Pinyin

1. The need to search Chinese characters should not be routinely required. However, where the examiner requires more information to make a determination, they should input the relevant indexing constituent into a Chinese dictionary prior to contacting the relevant SME.

The following Chinese dictionary is an example of one that can be used:

- <http://www.yellowbridge.com/chinese/chinese-dictionary.php> - See example below

**Note:** If required, clarification may be sought from the relevant SME for the language (see TMDG Subject Matter Experts document for a list of the relevant SMEs).

2. As we can be sure that the transliteration indexing is correct, Examiners can simply put the relevant indexing constituent into the Pinyin to Chinese box. For example:



Search by: [詞 Word](#) [字 Character](#) [部件 Components](#) [Preferences](#)

Chinese to English   [Go](#)

Pinyin to Chinese  No fuzzy match

English to Chinese  [Go](#)

3. A list of search results will then be generated. The search results will show characters, transliterations and translations.

### Mandarin-English Talking Dictionary

[詞 Word](#) [例句 Examples](#) [筆順 Strokes](#) [字 Character](#) [字源 Etymology](#) [Preferences](#)

**Matching Results**

马	mǎ	horse; horse or cavalry piece in Chinese chess; knight in Western chess; (Chinese surname); abbr. for Malaysia 馬來西亞
吗	ma	(question particle for "yes-no" questions)
嘛	ma	modal particle indicating that something is obvious; particle indicating a pause for emphasis
骂	mà	to scold; to abuse; to curse
麻	má	leprosy; numb
麻	má	generic name for hemp, flax etc; hemp or flax fiber for textile materials; sesame; (of materials) rough or coarse; pocked; pitted; to have pins and needles or tingling; to feel numb; (Chinese surname)
吗	mà	variant of 罵
吗	mǎ	see 嗎啡, morphine
妈	mā	ma; mom; mother
嬷	mā	ma; mamma
抹	mǎ	to wipe
杓	mǎ	headboard
馮	mǎ	name of a river
犸	mǎ	mammoth
玛	mǎ	agate; cornelian

Sort by Relevance  Page 1 of 3


New Search   Wildcard: Use \* as placeholder for 0 or more Chinese characters or pinyin syllables [Credits](#)

4. Click on the correct character, which will then bring up the simplified character, as well as the traditional character. In this example, the correct character is 马. This allows the examiner to see that the character 馬 is the traditional form of the same character (simplified) 马.

### Mandarin-English Talking Dictionary

[詞 Word](#) [例句 Examples](#) [筆順 Strokes](#) [字 Character](#) [字源 Etymology](#) [Preferences](#)

**Main**

  
mǎ

**Definition** horse; horse or cavalry piece in Chinese chess; knight in Western chess; (Chinese surname); abbr. for Malaysia 馬來西亞

**Traditional Characters** 馬



5. If the examiner has difficulty with this process or is still unsure, they can then consult the relevant SME.

### Example 1

VS

1. The first trade mark has the indexing constituents T:BAO and T:GUANG. It is important to determine which constituent refers to which character as indexing is entered alphabetically and therefore the order of the characters cannot be accurately determined.
2. Utilising the same procedure outlined above, the examiner can input, for example, the indexing constituent GUANG into the dictionary:



And ascertain that it is actually the second character in the trade mark which is GUANG:

3. The examiner has then confirmed that the first trade mark reads BAO GUANG, whereas the second reads GUANG BAO.
4. The examiner must then consider whether a ground for rejection under section 44 is appropriate when comparing BAO GUANG vs GUANG BAO.
5. In this type of situation, the examiner should consult one of the SME's to determine how the characters will be referred to (read left to right/right to left).

## Example 2

**1606243**

**Endorsements:** The English translation of the QINGFENG STEAM word QINGFENG in the trade CHINA character/s appearing in the trademark may be transliterated as QINGFENGBAOZI, which DUMPLING SHOP.\*

### Indexing Details – Word Constituents

T:BAO T:FENG

T:QING T:ZI

- The indexing constituents in this trade mark confirm the transliteration provided.

**Note:** In the majority of cases, the endorsement provided will be correct and can therefore be a useful guide.

- The examiner should search the indexing constituents **without** the “T:” to cover Character vs Pinyin trade marks. In this case, the search should pay particular attention to the constituents QING and FENG, as the provided endorsement shows these are the leading two characters (can also be confirmed by the Examiner through a dictionary search). The translation provided (QING-FENG STEAMED DUMPLING SHOP) suggests the last two characters are descriptive.
- A search for QING and FENG will find the following trade mark (a search for T:QING and T:FENG will also find this trade mark:

**1600523**

**Endorsements:** The applicant has advised that the English translation of the Chinese words QI CELEBRATION OF HARVEST.\* The applicant has advised that the CHINESE characters appearing QING FENG which may be translated into English as CELEBRATION OF HARVEST.\*

The Examiner should conduct a dictionary search as per instructions outlined above, which would reveal that the first two characters 庆丰 are simplified forms of the same traditional characters in trade mark 1600523:



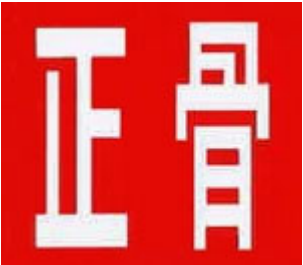



### Considerations in making the section 44 decision:

- The first two characters in TM 1606243 are the same as the characters in 1600523 (just in a different form – simplified v traditional)
- QING FENG is the dominant element in both trade marks
- The additional characters 包子 in TM 1606243 are descriptive
- Both TMs are claiming the same services in class 43
- Therefore, a section 44 ground for rejection is appropriate.

### Summary of general approach to section 44 decision making for trade marks that contain Chinese characters:

- **Character vs character** – YES – s44 ground for rejection where the characters mean the same thing, are referred to in the same way.
- **MULTIPLE characters vs Pinyin (transliteration of the characters)** - YES – s44 ground for rejection because Pinyin is part of the Chinese language. The trade marks would sound the same and mean the same thing.
- **ONE character vs Pinyin** – unlikely to be a s44 ground for rejection as it is only with an additional character(s) that the meaning is clear. The use of one character makes the meaning ambiguous. A risk management approach should be applied in this circumstance. If in doubt, an SME can be consulted.
- **Character vs English translation** – NO – s44 ground for rejection is not appropriate. The trade marks would be aurally and visually different.

Trade Mark 1	Trade Mark 2	Rationale
		<p>Section 44 ground for rejection – <b>YES</b></p> <p>Trade mark 1 is traditional form of the character. Trade mark 2 is the simplified form. Mean the</p>

		same thing, referred to in the same way
		Section 44 ground for rejection – <b>YES</b>  Trade mark 1 is in a different “font” or “style” to Trade mark 2. Although they look different, they are the same character.
	ZHENG GU	Section 44 ground for rejection– <b>YES</b>  Trade mark 2 is the Pinyin (transliteration) of Trade mark 1. They sound the same and mean the same thing.
	ZHENG	Section 44 ground for rejection – <b>NO</b>  Although Trade mark 2 is the Pinyin (transliteration) of Trade mark 1, ZHENG can refer to many different characters. It is only with the addition of another character that gives it a clear meaning.
  The applicant has advised that the Chinese characters appearing in the trade mark may be transliterated as DIAO YU TAI which may be		Section 44 ground for rejection - <b>YES</b>  Trade mark 2 is the Pinyin (transliteration) of Trade mark 1. They sound the same and mean the same thing.

translated into English as NAME OF THE STATE GUESTHOUSE OF CHINA.*		
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