



Guidelines for *RIO Search for Trade Marks*

Revision History*

Date	Changes
1 July 2016	Creation of guidelines following the implementation of <i>RIO Search</i>
3 Aug 2016	Minor amendments to wording
21 Sept 2016	Added information in relation to top up searching
6 Oct 2016	Updates following new features of <i>RIO Search</i>
15 Feb 2017	Updates to phase 2 searching
20 June 2017	Updates to the Chinese character searching example
9 October 2017	Updates to reflect clarification on searching principles
22 Feb 2018	Creation of re-use guidelines & record keeping guidelines

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Examination & *RIO Search for Trade Marks*

Searches need to be conducted in an efficient and effective manner, ensuring a high probability of finding relevant prior applications and registrations and/or establishing grounds for rejection or acceptance.

As the Search Report forms an integral part of the decision-making process and the written record, it should demonstrate a logical sequence of searches and extract all relevant trade marks. This not only ensures the quality of the product, but benefits others who view the file at a later date.

Searches using *RIO Search* will have a high probability of finding:

- All conflicting trade marks and relevant precedent
- Trade marks from the same owner
- Relevant regulated signs

Suggestions for an effective and efficient search in *RIO Search for Trade Marks*

Searching in *RIO Search* usually requires significant keystrokes and screen time. The examiner will need to consider how many results they will need to look at conducting an effective search whilst being aware of WHS concerns.

Whilst searching, the results count will be displayed (in bold on the right side of the screen). With the use of the Save button, searches can be saved to the Search List without being viewed. This can be used if the results are 0 or if the results are too large to view, and this will demonstrate that the search was attempted.

As a general guide, it is suggested that in cases where individual searches return results of greater than 200, the examiner should seriously consider whether an alternative search strategy could be used in the next line/s that would achieve a smaller number of hits and still be effective. There will be times when a search will return results of over 200. Some single or two letter trade marks and common words or devices are examples of this. If these types of elements are the only part(s) of the trade mark, the results must still be looked at.

Pre-searching considerations

There are a number of important considerations before you commence searching. These include:

- Checking the classification of goods/services before you start:
 - If the goods and/or services are ambiguous or have been misclassified, your search strategy would need to cover any classes which have the potential to be added to the application at a later stage.
 - If there are potential conflicting goods/services in unassociated classes the search strategy needs to consider the unassociated class(es).
- Knowing what you are looking for:
 - Consider what would constitute a ground for rejection and plan your search before you begin. Your section 44 decision making skills will play a key role in how you formulate your strategy. Focus your search on parts of the trade mark which are of trade mark significance – noting that this does not mean searching on these elements only.
 - Know when to consider prescribed signs and trade marks where use is contrary to law (see [ANNEX 2: Searching Regulated Signs](#))
 - Think about how the trade mark will be perceived in the marketplace or how it could be marketed (e.g. pronunciations or emphasis on different parts of the trade mark), and include searches for such variations where appropriate.
 - Remember to include common phonetic equivalents and/or similar image descriptors (see [ANNEX 1: Searching Tips](#) attachment for examples) where appropriate.
 - Understand how trade marks are indexed and what indexing terms can assist you with your searches (see [Word Constituents](#), [Figurative Constituents](#), [Top Level Terms](#) for more information).
 - Understand which goods/services would be considered of the same/similar description, or to be closely related, and in which classes such goods/services would be correctly classified (see [Cross Class Search List Including Known Unassociated Classes](#)).
 - **Know when to stop!**

Please see [ANNEX 1: Searching Tips](#) for more information on ways to conduct an effective and efficient search.

Record Keeping

Before starting your search please note the following record keeping requirements:

- Searches that have been viewed should be indicated by any of the following means:
 - On the Search Results screen, by completing the tick box at the bottom of the screen of the last page of results
 - On the Search List screen by completing the tick box/es
- *RIO Search* Extract Lists (including top-up searches) must be saved to file.
- TM Headstart requests must never appear on your Extract List (an exception is the TM Headstart being assessed during a TM Headstart assessment). This is because *RIO Search* Extract Lists are Available for Public Inspection (API) and TM Headstart requests are not. If there are any TM Headstart requests on the Extract List besides the TM Headstart being assessed, the system will prevent the examination being finalised. An error will appear on the front page of the dashboard.
- All trade marks on Extract Lists saved to the file must be annotated to indicate the examiner's decision in regard to section 44. A warning message will appear on the front page of the dashboard if none of the trade marks on the Extract List are annotated. This acts as a reminder that all of the trade marks on the Extract List must be annotated.
- All -9 million signs appearing on Extract Lists saved to file must be annotated with the appropriate annotation being **s39 and/or s42 not raised (considered)** or **s39 and/or s42 raised**. When a s39/s42 is annotated as **s39/s42 not raised (considered)**, working notes should be added to indicate the reason for the examiner's decision.

Precedent

Precedent can be a useful tool to assist examination decisions, but it is not the test for determining whether grounds for rejection exist. We can consider precedent for the following reasons:

- To know how a similar trade mark (regardless of its current status) has previously been examined (for example: for s39-s44 and also for formalities matters such as classification).
- In some cases, the precedent for an earlier trade mark may assist in focussing your subsequent s39, 41, 42 and 43 research.
- To maintain familiarity with the "state of the Register" for common trade marks (e.g. SMART trade marks for electronic goods or POWER trade marks for machines).
- To identify and extract conflicting trade marks.

Note that by using the assessment summary criteria we can search across the examination report history.

Search Structure in RIO Search

When performing an examination search in RIO, some of the annotations will be automatic including ***This mark***, ***Status*** and ***Later priority date***.

Searching is split into 3 main phases which must be carried out:

- **Phase 1: Ownership search(es)**
- **Phase 2: Initial Broad Search(es) (including All classes/All status')**
- **Phase 3: Subsequent Searches (relevant class(es)/status)**

Phase 1. Owner search(es)

An owner search must be conducted to ensure registrability, formalities and classification issues are dealt with consistently. It is also useful for finding potential hand-ons.

For those trade marks that have multiple owners, each owner should be searched individually. This is because there may be prior applications that are owned by only one of the owners and this is relevant to the examination of the current application. A red dot will be visible on the owner name text field, indicating that there is more than one owner to search. A risk management approach is applied in this respect, that is if an application has more than 2 owners listed, owner searches will only be required for 2 of the listed owners.

In some instances multiple owners may appear in *RIO Search* in the following ways:

- Example 1: Owner/s: Joe Nathan and Mitch Moreland
- Example 2: Owner/s: J and V Martinez

In situations such as this, both owners must be searched. These owner names can be searched separately, or if the results are small enough to view these can be searched together by adding an 'OR.'

For example:

Example 1:

Owner name:	"Joe Nathan" OR "Mitch Moreland"
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Example 2:

Owner name:	"J Martinez" OR "V Martinez"
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If the initial search results are too large the owner search can be restricted to status group PENDING. Alternatively, the examiner may restrict to a recent number range (eg >1000000). Either method will help ensure applications currently under examination from the same owner will have classification, ownership etc. dealt with consistently.

Refer to [Guidelines for Passing on Files](#) for when to pass a file to another examiner.

The owner search criteria can allow for different variations of the owner name at the same time with the use of wildcards and 'OR'. For example, the following search strategy will find results including K Mart, K-Mart and Kmart (but will also find kwikmart, etc.):

Eg

Owner name: "k mart" OR k*mart

An owner name search that is conducted without quotation marks will find trade marks that contain the words in any order. For example a search for *Gold Coast City Council* will find owner names such as *The Council of the City of the Gold Coast*. Quotation marks such as "*Gold Coast City Council*" can be used to make the search more specific by only finding the words in the exact order.

NB: When conducting an owner name search consider company name variations. For example, an exact search for *Calais Pty Limited* will not find slight variations (where the owner may have previously supplied different owner name details – *Calais Limited*, *Calais Pty Ltd*). In this instance an owner name search for *Calais* would be appropriate as it would provide a manageable amount of results to view and find slight variations if applicable.

Phase 2. Initial Broad Search(es) (including All Classes, All Status Groups)

The reasons for conducting initial broad searches are to find the following types of trade marks:

- Relevant Regulated signs (-9000000)
- Substantially identical trade marks including:
 - where the goods/services have been incorrectly classified
 - where similar or closely related goods/services are claimed outside of the associated classes (eg: solar panels for heating in Class 11 vs solar panels for electricity in Class 9)
 - to account for changes in the NICE classification where some goods/services were classified differently in the past (eg: diapers/nappies in Class 5 (NICE 10) vs diapers/nappies in classes 16 & 25 (NICE 9))
- Relevant precedent which will assist you to make examination decisions (including raising conflicting trade marks). **Please note however that legislative changes, relevant case law and changes in office practice must be considered when deciding whether precedent is relevant, and whether it should be followed.**

Searching at Phase 2 attempts to focus on finding identical and substantially identical trade marks (section 44), and Regulated Signs (sections 39 and 42) that the trade mark being examined would so nearly resemble as to be likely to be taken for. These searches are undertaken with all classes and all status groups selected.

NB: There is an expectation that examiners are aware of the relevant parts of the *Trade Marks Act 1995*, *Trade Marks Regulations 1995* and *Trade Marks Manual of Practice and Procedure* to assist in formulating an appropriate search strategy.

Phase 2. - Section 44 of the Act

When considering section 44 it is not usually effective or efficient to search for a range of deceptively similar trade marks during Phase 2 searching. While this can be undertaken if a manageable number of search results can be achieved, the searching process allows for a risk management approach to be considered at this phase (where appropriate) which weighs up the likelihood of finding relevant trade marks against the time that will be spent looking through a large number of results that may have no relevance to the examination at hand.

However, where a trade mark consists of invented and clearly unique words, which also have no known meaning when viewed together, it is expected that these words should be searched individually at Phase 2. For example: QWERTY COBLARK. It would be appropriate to search QWERTY (all classes, all status groups) and a separate search for COBLARK (all classes, all status groups).

This is because the words separately are considered to be memorable (being invented words with no association with the goods and/or services claimed), and major elements of the trade mark under examination.

Likewise, where a trade mark contains non-distinctive elements, care should be taken to ensure that these elements are not searched in combination with distinctive elements. For example: IKEA OTTOMAN (Class 20: seats). It would not be appropriate in this circumstance to combine the two words.

It is important to bear in mind that in instances where results are too large to view at Phase 2 consideration is given to the statement of goods and/or services claimed. This may inform the breadth of your search strategy at Phase 3, bearing in mind misclassified goods and/or services and unassociated classes. See [Cross Class Search list](#) for more information.

Prescribed and Contrary to Law Signs (regulated signs); sections 39 and 42 of the Act
Prescribed signs and signs where use is contrary to law can be identified by a -9000000 number and will always appear at the start of your All Classes All Status Group search results. If it is difficult to complete a Phase 2 search due to high numbers of search results, these signs will still be discoverable in Phase 3.

When considering Phase 2 search strategies that take these signs into account, it is important to remember that any search undertaken should be done so on the basis that the results include signs that the trade mark being examined would so nearly resemble as to be likely to be taken for it. RIO Search strategies should focus on this consideration.

An example of a trade mark that both includes a -9 million sign, and the trade mark is likely to so nearly resemble the sign as to be likely to be taken for it would be WHO HEALTHCARE (Class 44 health care related services). A Phase 2 search should be conducted for WHO (exact word) to find the WHO (World Health Organisation) relevant prescribed sign.

If however the trade mark was WHO KNOWS for class 16: printed matter, a Phase 2 search for WHO (exact word) would not be necessary. This wording, when used together, has a clear and understandable meaning that differs from the meaning of the words *solus*. The trade mark as-a-whole suggests a question, presenting the phrase WHO KNOWS(?). This idea or concept is not likely to resemble a reference to WHO (World Health Organisation) as to be likely to be taken for it. A combination search would be appropriate in this case.

If the trade mark you are examining contains the image indexing terms CROSS,GREEK, *RIO Search* will automatically conduct the following search:

Viewed	Results	Search criteria	Class	Status	Combine	Refine	Remove
1	7	Image cross, geneva (EI) OR flag, switzerland (EI)	All	All	<input type="checkbox"/>	<input checked="" type="checkbox"/>	<input type="checkbox"/>

RIO Search will also extract the relevant -9 million signs (mentioned above). These signs will not be annotated, and the examiner must consider the signs and manually annotate them accordingly. If the signs are not relevant, the examiner can delete them from the Extract List.

NB: The above search will not be required in circumstances where the trade mark contains an emblem that may be taken as a “plus”, “positive” or “in addition to” symbol **instead** of a Red cross. However, a note **MUST** be made on the working notes in the examination dashboard to acknowledge the above consideration rather than a search for these signs.

Examiners may also be required to conduct searches for the relevant -9 million signs as they may not come up automatically (depending on the indexing of the trade mark you are examining).

(See ANNEX 2: Searching Regulated Signs) and parts 30 and 31 of the Manual for further information and assistance on what to look for.

EXAMPLES

Example 1:

KODAK CLAWRIFIC (Class 9 computer software goods)

What are the major elements of the trade mark?

- Kodak (invented word)
- Clawrific (invented word)

Example Phase 2 Search:

KODAK (pw) ALL ALL

LAWRIF (pw) ALL ALL

Example 2:

APPLE BUILDING (Class 37 building services)

What are the major elements of the trade mark?

- Apple (word)

Example Phase 2 Search:

APPLE (pw) ALL ALL

Refine to (ew) APPLE

Example 3:

UNITED TURNSTILES (Class 6 turnstiles of metal)

What are the major elements of the trade mark?

- United (word)

Example Phase 2 Search:

UNITED (ew) ALL ALL; too large

Refine to UNITED (ew) PENDING, REGISTERED AND REFUSED; too large

Refine to UNITED (ew) PENDING

NB:

- Class 6 is not associated with class 42 – searching at phase 3 will not include this class.

- These goods are ones that require searching in an unassociated class (class 9 – see *Conflicting Goods and Services List*). A search for UNITED that includes this class will need to be conducted at Phase 2 or 3.

- It is not appropriate to combine UNITED with TURNSTILES to minimise the results to a manageable number.

Example 4:

KazaNover (Class 45 dating services)

What are the major elements of the trade mark?

- KazaNover

Example Phase 2 Search:

KA (pw) and NOV (pw) ALL ALL

NB: It may create efficiency (in Phase 3 searching) to search each word (KAZA/ NOVER) individually at Phase 2.

Example 5:

LIFE'S PRETTY STRAIGHT WITHOUT TWISTIES (Class 30 chips)

What are the major elements of the trade mark?

- TWISTIES
- LIFE'S PRETTY STRAIGHT (phrase)

Example Phase 2 Search:

TWISTI (pw) ALL ALL

LIFE (pw) and STRAIGHT (pw) ALL ALL

Example 6:

WHO HEALTHCARE (Class 44 health care related services)

What are the major elements of the trade mark?

- WHO (word)

Example Phase 2 Search:

WHO (pw) ALL ALL

Refine to (ew) WHO

Example 7:

WHO KNOWS (Class 16 printed matter)

What are the major elements of the trade mark?

- WHO KNOWS (phrase – which has a meaning that differs from the words individually)

Example Phase 2 Search:

WHO (pw) and KNOW (pw) ALL ALL

Example 8



(Class 16 plastics material film)

What are the major elements of the trade mark?


- BEAVER (image)
- BEAVER (word)

Example Phase 2 Search:

BEAVER (pi) ALL ALL

NB: Consider the word equivalent BEAVER at Phase 3.

Example 9



CALE THOMAS Class 25 Articles of clothing including boots, shoes and slippers

What are the major elements of the trade mark?

- Cale Thomas (name)
- Stylised Lion (image)

What are the key features of the major elements?

- Cale (word)
- Thomas (word)
- Lion is Rampant or Rearing (image)

Example Phase 2 Search:

Cal (PW) and Thom (PW) ALL ALL

Lion (PI) and Rearing (PI) ALL ALL

- **Please note the guidance for searching descriptive material in phase 3 below**

Phase 3. Subsequent searches (relevant class(es)/status)

This phase of searching will largely depend on the nature of the trade mark you are examining and what has been covered during Phase 2 searching. Consider how best to continue searching with respect to the key features/major elements of the particular trade mark being examined in order to have a high probability of finding deceptively similar trade marks in the relevant classes. [Annex 1: Searching Tips](#) contains information to assist examiners when considering how to continue searching.

NOTE: If you have restricted your Phase 2 searches to exclude possible unassociated classes, status etc, or combined the key features/major elements with other material in the trade mark, make sure you cover them in some part of your Phase 3 searching (where relevant). Make sure you keep in mind the searching tips in ANNEX 1 below. Before continuing you should consider:

- What are the most important parts of the trade mark and what would be considered similar
- Variations of the trade mark and how wide your search strategy will be
- What *RIO Search* tools will best suit the search strategy

For word searching

- Part Word relevant classes, Pending, Registered and Refused status group

If results returned for these searches are too large, consider restricting to Word Prefix/Suffix/Exact Word (where appropriate).

If the trade mark doesn't lend itself to effective Word Prefix/Suffix/Exact Word searching, or the results are still too large, undertake one or more of the following approaches:

- Browse the results to look for irrelevant trade marks which appear in the search results, then either adjust search terms to remove those results or undertake a search for those specific terms and exclude them from the previous search.
 - For example, if the trade mark is EXCEL and search results show multiple trade marks containing EXCELLENT, either adjust the search term (possibly Exact word) or undertake a search for 'EXCEL' And Not 'EXCELLENT'.
- Restrict to single class (try Part Word first, but restrict to Word Prefix/Suffix/Exact Word – if required & possible) – be aware of clear similarities in associated/unassociated classes which will not be included in such searches, noting the [Warnings](#) regarding restricting to single class(es) below.
- Combine your search with other material in the trade mark, noting the [Warnings](#) regarding combining searches with other material below.

Searching non-distinctive terms

Some trade marks with limited capacity to distinguish could be pending or otherwise registered (under provisions of evidence). Therefore, do not discount the non-distinctive/descriptive elements within a trade mark. If it is likely that such marks would be considered deceptively similar to your mark then a search must be conducted.

For example:

- 1) For the trade mark BLACK MARKET for retail services in Class 35 it would not be necessary to search for MARKET solus. The term BLACK MARKET creates the impression of an illegal place to trade in controlled or scarce commodities. The word MARKET is merely an area or place where commercial dealings are conducted. The overall impressions these marks create are different and they would not be considered deceptively similar
- 2) For the mark LOANS APPROVED (with device) in Class 36 it would be necessary to search for LOANS and APPROVED. These words have descriptive connotations however they form a major element of the mark. If identified a similar mark with the prominent words LOANS APPROVED could form a valid and would need to be identified.



On occasions, non-distinctive terms may form a prominent element of a trade mark. In such situations, consideration must be given to whether the existence of *solely* that term would be problematic. In such cases, the non-distinctive term should be searched at Phase 3. In the event that the results are too large to view, a search using the 'Word Phrase' feature may be appropriate. For example: SUPER FINANCIALS (class 36). It may be appropriate to search "super" using the 'Word Phrase' feature using the single criteria. See below For Word phrase searching.

For image/device searching

- Part Image relevant classes, Pending, Registered and Refused status group

If results returned for these searches are too large, undertake one or more of the following approaches:

- Adjust the image search to closer match the trade mark under examination/assessment, if possible (For example, Exact Image search or combining with [qualifying terms](#) or other related material in the trade mark), noting the [Warnings](#) regarding restricting to Exact Image/combination searches below.
- Restrict to single class – be aware of clear similarities in associated/unassociated classes which will not be included in such searches, noting the [Warnings](#) regarding restricting to single class(es) below.

For Goods and services searching

- This search criteria will search across all specifications of goods and/or services. It may be useful for considering relevant precedent in the specification of other trade marks.

For Word phrase searching

- Word phrase searching can be useful in particular scenarios. For example, when the order of the words matter (such as for phrases or slogans) or where word elements are repeated and searching using indexing constituents is impractical or ineffective.
- The Word phrase criteria searches across the trade mark's words and not the indexing constituents.
- When using the standard word search criteria, the system cannot distinguish trade marks with one term or a repeating term. For example, searching for the trade mark GO GO using the standard word search criteria is challenging because these trade marks are often indexed only with GO. Conducting searches with the Word Phrase criteria using inverted commas (ie "GO GO") will allow examiners to find trade marks which contain repeating words. Refer to *RIO Search for Trade marks Functional Reference* for further examples.
- When searching for an exact phrase, inverted commas are required. This is because without the use of inverted commas, each space between the words will default to AND. For example, a search for GO GO (without inverted commas) will find all trade marks that contain the word GO with other elements and will also find all trade marks that are only GO, i.e. returning all results with GO.
- At times it may be more appropriate to use the standard word search criteria to make use of indexing terms such as LTR or OZZ.
- Ticking the 'single' criteria refines the results further. It will only find results of trade marks that contain the word or phrase that has been searched and do not contain any other words, but may contain images.

- For example, a Word Phrase search for “AUSSIE AUSSIE AUSSIE” this can be further refined by ticking the ‘single’ setting. This will only find results with the words AUSSIE AUSSIE AUSSIE and no other words in the trade mark (ie the results would not include AUSSIE AUSSIE AUSSIE OI OI OI)
- Previously, finding trade marks that consisted of only a single word was limited to those manually indexed with a #. The ‘single’ criteria can be used for any word or phrase, not just those “hash words”. Searching for hash words in the word search will still only find trade marks that have been manually indexed with a #.

For Endorsement searching

- This search criteria searches on endorsement fields and convention claim fields in trade marks. It may be useful for considering relevant precedent in the endorsements of other trade marks.

Assessment summary

- This search criteria will find some relevant precedent. It searches across the examination report history. Note that the style of completing the report history (precedent notes or assessment summary) has changed over time and examiners have different ways of entering the history. Therefore to find more accurate results wildcards can be used.
 - E.g. *41* will find history containing section 41, s41 or section41.

Kind

- This search setting defaults to ALL KINDS which includes word, figurative, fancy, colour, scent, shape, sound, movement, feel, hologram, position, taste, tracer or other. To restrict results, you can choose a KIND to search.
 - For example, if you are examining a Shape trade mark, this search criteria will find trade marks which have been classified in *RIO Search* as the KIND Shape.
 - Note that marks with both word and figurative elements will have KIND Figurative only. Marks with non-traditional kinds will not have KIND figurative.

Warnings

When restricting searches be aware of what you are potentially cutting out of your searches, noting the following:

- Searching major features in combination with other material will not find trade marks which contain the same (or similar) major feature(s) without the other material.
 - For example, if the trade mark was the image of an Elephant next to a Tree, a search for ELEPHANT and TREE will not find the exact same Elephant without the Tree.
- When restricting to single classes, be aware that you could be cutting out identical/similar trade marks which:

- have goods/services which are of the same or similar description, or are closely related, in other classes.
- Were lodged under older classification systems or contain misclassified claims with the same/similar specification.
 - For example, changes in NICE classification such as *legal services* which were in class 42 (pre NICE 9) but are now in class 45 (NICE 9 onwards).
 - Be aware that NICE 7 only had 42 classes, so anything which is now correctly classified in classes 43, 44 or 45 should never be searched as a single class without also searching the class which it would have been correctly classified previously.
- If restricting a word search to EXACT WORD, the search will not find trade marks which are pluralised versions of the exact word being searched.
 - For example, an EXACT WORD search for DOG will not find DOGS.
- If restricting an image search to EXACT IMAGE, the search will not find trade marks which contain multiple occurrences of the exact element being searched.
 - For example, an EXACT IMAGE search for DOG will not find a trade mark which contains the exact same dog along with another dog or multiple occurrences of the exact same dog.
- When using the *Owner name, Goods and services, Word phrase, Endorsement, Assessment summary* search criteria:
 - These are exact word searches rather than part word searches, unless wildcards are used. For example, in the owner name search criteria, searching for APPLE will not find APPLES, but APPLE* will find APPLES and APPLETON.
 - The use of quotation marks will determine the order in which words have been placed in the word phrase field by the indexer (e.g. a word phrase search for "PINK SUGAR" will not match "SUGAR PINK".)
- When using the *Goods and services, Word phrase, Endorsement, Precedent* search criteria:
 - These search criteria should not be used in isolation. They are intended to be used in conjunction with other search criteria.
 - It is beneficial to search for results containing a term, rather than excluding a term from the results. This is because relevant trade marks may be missed.
- When using *Word phrase* searching, this criteria should be used carefully as it can exclude relevant results. For example, Word Phrase searches will not find any spelling variations, even if these variations have been indexed (e.g. a search for EASY will not find EZE marks, even if they have been indexed EASY).

- When searching the owner name do not be too specific. For example, an owner search for “Apple Pty Ltd” will not find trade marks with the owner name “Apple Proprietary Limited.”
- Searching on kind “Word” will cut out relevant similar marks that have kind “Figurative” or “Fancy”, e.g. a mark containing the relevant word, but in a fancy font, or next to a graphic. Examiners should not search on kind “Word” .
- Searching on kind “Figurative” will cut out relevant similar marks that have non-traditional kinds, e.g. containing a similar graphic on the surface of a shape mark. Examiners should not search on kind “Figurative”.

Non-traditional trade marks:

These trade marks include trade marks which claim Shapes, Colours, Scents, Sounds, Movement, Taste, Feel, **Hologram, Position, Taste, Tracer, Other** and combinations of these as essential parts of the trade mark.

All non-traditional trade marks should include Image searches for **endorsement-only** and **desc-of-mark**, as some older non-traditional trade marks are captured in this way.

Image:

Shapes

Search shape trade marks using image constituents which describe the shape. For example, BOTTLE in a similar way that you would search a 2D device trade mark. Additionally, search the trade mark using the shape option in the **KIND** search setting.

Kind:

If a shape can only be referred to by one name/idea, search the 2D version and word version of the trade mark as well. For example, for a 3D shape of a BULL you should also search for a 2D representation of a BULL with the shape kind of trade mark option not selected, as well as the word BULL.

Colours

Where a trade mark claims colour(s) as an essential part of the trade mark (not just a coloured representation of an image/device mark) search image constituents which describe the colour. For example, YELLOW. Additionally, search the trade mark using the colour option in the **KIND** search setting.

Kind:

Also search the word version of the colour. For example, if the trade mark is the colour YELLOW, search YELLOW also as a word with the colour option not selected in the **KIND** search setting.

Scents

As there are relatively few scent trade marks, search the trade mark using the Scent option in the **KIND** search setting.

Kind:

Sounds

As there are relatively few sound trade marks, search the trade mark using the Sound option in the **KIND** search setting:

Kind:

If the sound trade mark contains speech, also search the word version. For example, if the trade mark is the sound of someone saying “Ah, McCain, you’ve done it again”, undertake searches to cover the words “Ah, McCain, you’ve done it again” with the sound kind option not selected as well.

Movement, Taste, Feel, Hologram, Position, Taste, Tracer or Other

Where a trade mark claims movement/animation, taste or feel as an essential part of the trade mark, search using the Kinds: Movement, Taste Or Feel, respectively.

Combinations

If a trade mark contains a combination of traditional and/or non-traditional material, all aspects should be searched. For example, if a trade mark claims a shape, a colour and a word, then individual searches must be carried out for the shape, the colour, and the word.

How to annotate a RIO Search extract:

All trade marks/signs included in your *RIO Search* Extract List must be annotated. The trade mark being assessed/examined will be automatically added to the Extract List and annotated as **This Mark** and any subsequent extracts with a **Later priority date** or **Status** will be automatically annotated.

- The trade mark under examination/assessment, and only that trade mark, will be automatically annotated as **This mark**.
- Any trade marks extracted which have a later priority date than the trade mark under examination will be automatically annotated as **Later priority date**. This will consider convention claims, divisional applications, IRDAs (International Registrations Designating Australia), partial assignments and other situations where the priority date may be earlier than expected. Where there is potential ambiguity (e.g. partial convention claims) the system will not automatically annotate. In these situations, the examiner is required to appropriately annotate the trade mark.
- Any trade marks extracted with a status group of Never Registered, Removed, Refused will be automatically annotated as **Status**. An exception to this is where there is a “Revival Pending” flag on a trade mark– these should be treated as though their status is Pending/Registered. These trade marks should appear on the Extract List if they are useful in making a determination on the file. For example, a trade mark may appear on the Extract List to demonstrate that it was considered as precedent.
- Any trade marks extracted with the same ownership as the trade mark under examination/assessment should be annotated as **Same owner**. Please note- this annotation is not automatic.

When annotating Pending/Registered trade marks, pick the most appropriate reason for the annotation:

- Any trade marks extracted which are considered to be conflicting with the trade mark under examination/assessment should be annotated as **Citation**.
- Any trade marks extracted where the trade mark is considered to be sufficiently different to that of the trade mark under examination/assessment should be annotated as **Marks sufficiently different**.
- Any trade marks extracted where the goods/services are considered to be sufficiently different to those of the trade mark under examination/assessment should be annotated as **Different goods and/or services**.
 - **Caution:** if annotating a trade mark as **Different goods and/or services**, make sure that you fully consider the goods/services specified in both the trade mark being annotated and the trade mark being examined/assessed. Remember that broad claims could include goods/services which are of the same/similar description or are closely related. Also be aware that the classes in which some goods/services are correctly classified may have changed over time, or that some claims may be misclassified.

- Any signs extracted which are to be considered as the basis for raising grounds for rejection under section 39 or 42 should be annotated as “**s39 not raised(considered)/s42 not raised(considered)**” or “**s39 raised/s42 raised**”. When a s39/s42 is annotated as **s39/s42 not raised (considered)**, working notes should be added to indicate the reason for the examiner’s decision such as *9000381 – section 42 not appropriate. When viewed as a whole, the cross element is likely to be seen as a plus symbol .*
- Any trade marks extracted where the above annotations are insufficient/inappropriate and the reason for not citing required complex considerations, or more space than available to annotate, should be annotated as “**See Working Notes**” with further information/explanation provided as working notes. This annotation should be used where the decisions are borderline and rely on a combination of factors e.g. differences in the trade marks as well as the goods/services.
- Working notes can be added next to the annotations available in *RIO Search*. For example if a trade mark has the status Lapsed – Never Registered and it provides relevant precedent for a section 41 decision, you could annotate the trade mark as **Status** and provide working notes as “**s41 precedent.**”

Top up searching

TM Headstart – See Part 66 of the Manual of Practice and Procedure.

Revived trade mark applications

Where an applicant is looking to revive an application, the request for an extension of time will be sent to the examiner to conduct a ‘top up’ search on the lapsed application. In this instance, the aim of the ‘top up’ search is to find any applications that will be affected if the lapsed application was to be revived (i.e. to identify trade marks for which the lapsed trade mark would have been a conflicting trade mark, if it had not lapsed). The examiner should also review any previous search(es) on file.

The ‘top up’ search function in *RIO Search* will not be available for revived trade marks.

To conduct a search strategy without using the ‘top up’ search function in *RIO Search*, the search strategy can be limited to the lapsed trade mark number minus 10,000. For example: if the lapsed TM No. is 1753628 the top up search may be limited to a trade mark number range greater than 1743628.

Trade mark number:

A top up search for revived trade marks should find all potentially substantially identical and deceptively similar trade marks lodged after the revived trade mark’s priority date.

Any trade marks for which the lapsed trade mark would have been a conflicting trade mark (if it had not lapsed) should be annotated as See Examiner’s Worksheet and the relevant TM

number should be noted on the worksheet. For example: TM 1760000 identified during top up search. When adding the comment to the working notes, terms such as cite, citation, conflicting trade mark or gfr should not be used.

When conducting a top up search using the search function in *RIO Search*, you should review all the annotations of the extracted trade mark(s) on the extract list. The trade marks on the extract list retain the annotations from the initial search, and if changes have occurred to these trade marks (such as changes to the goods and services) these annotations may no longer be correct. For example, an extracted trade mark may have been initially annotated as ***Different goods and services***, however the trade mark applicant has added a class, and the good and services are now conflicting. In this situation the annotation will need to be manually changed by the examiner to ***Citation***.

For information about the process of reviving a lapsed trade mark (as opposed to conducting the top up search) see - [Reviving a trade mark application where later conflicting trade marks exist](#).

Foreign furthers/inherited cases

If the search strategy on file is not in accordance with the *Guidelines for ATMOSS searching* or *Guidelines for RIO Search for Trade marks*, the examiner taking over the file must conduct a 'top up' search to address any inadequacies in the search strategy.

Re-using searches

RIO allows examiners to re-use searches conducted on earlier trade marks by using the 'Import' function.

When a RIO search is re-used, the search results are updated to include any marks which have come onto the register since the previous search report was generated. Because of this feature, there are no time limits on when a search can be re-used.

Examiners must ensure that updated search results are viewed and extracted marks re-annotated.

Searches should only ever be re-used for substantially identical trade marks.

It is the responsibility of the Examiner to ensure that the search strategy is appropriate and conforms with the guidelines set out in this document.

Record keeping

Once a search report is sent to file it becomes an important decision making record which should not be deleted.

If a search report has been sent to file containing an error or omission, an updated search report should be sent to file. A note should be attached to the updated search report with a brief description of the changes, i.e. "Annotations corrected".

ANNEX 1 - SEARCHING TIPS

Before you start**Think**

Use your section 44 decision making skills to know what you're looking for. Consider what marks would be deceptively similar or substantially identical. Decide what the prominent element/s of the trade mark are and search accordingly.

Plan

Devise an efficient and effective strategy that will find all relevant trade marks. The indexing of a mark can be of assistance, however it is not always necessary to search each constituent. Conversely, you may need to search terms not included in the indexing constituents.

Search

Consider any precedent you find as you search as this may have the potential to influence your decision. Remember to extract all relevant trade marks that have impacted or give context to your decision. It is not necessary to extract lapsed/never registered marks if they do not form valid precedent. Annotate your extracts and if further explanation is required provide details on the files working notes.

Extracting

Your extract list should form an illustration of the relevant field of art around your trade mark. In some cases your trade mark will be very unique and your extract list may be minimal. In other cases you may need to include a number of extracts to demonstrate the state of the register and to demonstrate relevant precedent. The extract list gives context to your decision and is valuable when reviewed at a later date by other examiners, Hearings Officers or even the courts.

Check

Review your search . Make sure you have ticked the appropriate boxes for the searches you have viewed. Also make sure your extract list is annotated correctly.

Classification:

Remember that if the classification of the goods or services is unclear or incorrect, you must also perform your *RIO Search* Phase 3 searches in all the relevant classes to those in which the goods or services may be correctly classified.

Splitting the trade mark:

Think about where spaces could be added to break up the words and the natural separation of the trade mark.

- The word TWODOG should be searched as TWO and DOG.
- The words TWO and DOG could also be searched as separate words (depending on the situation/context).

Think about how the word can be split up in terms of syllables or significant components.

- INTERACTIVE could be searched as INT and ACTIV to cover hyphenation of words/alternative spellings/double letters etc (see below).
- TELESOFT, a part word search on TELES will not result in TELE SOFT or TELISOFT. A more effective and efficient search would be TEL (pw) and SOF (pw).

Key components of the trade mark:

- CARE BEER for beer – make sure that you search CARE solus.
- If the trade mark has both word & device elements – make sure you search all key elements by themselves (including in ALL classes/ALL status where appropriate).

Plural words:

Search the singular word rather than the plural word.

WARNING: a search using the plural form will not pick up the word if it is singular.

- MOONS should be searched as MOON.
- STICKMEN should also consider STICKMAN.

Plural Image Constituents:

Images are described by their singular rather than plural. If there is more than one the image constituent may include '+’.

- WAVE for a single wave in the trade mark.
- WAVE+ for more than one wave in the trade mark.
- Search on the singular version as a Part Image search where possible.

Prefix searches:

These take the term and look for it as the start of a word.

WARNING: a prefix search will not pick up the term if it is the second word in a conjoined trade mark. Prefix search on MAX will not pick up POWERMAX.

Use prefix searches **only** if part word search results are too large.

Suffix searches:

These take the term and look for it at the end of a word.

WARNING: a suffix search will not pick up if the term is pluralised or followed by anything else at the end of the word. Suffix search on COW would not pick up COWS.

Use suffix searches **only** if part word search results are too large.

Wildcard searches:

Wildcards can be used to replace characters in words.

- ? is a single letter wildcard. It will replace exactly one single letter.

For example, C?RE will find trade marks such as **CARE, CORE, CURE**

- * is a wildcard which replaces for zero or more characters

For example, P*RE will find trade marks such as **PREMIUM, PORE, PARLORE**

- @ is a wildcard which will replace one or more vowels (being A, E, I, O, U, H and Y). The addition of H and Y is because these are letters that are common silent letters in many words.

For example, S@P AND H@RO will find trade marks such as **SUP, SOUP, SOOP and HERO, HIRO, HIERO**. This would not find trade marks such as STOP AND HYDRO.

Wildcards often produce very large results and **should be used carefully**. Know what you are looking for when using wildcards, as you may get results which are not relevant to the subject trade mark. Wildcards can be useful when searching three or four letter trade marks. They can also be useful when searching one part of an invented word in combination with another, for example:

CIPRAMIL

C@P (pw) **AND** M@L (pw) might be a useful search as this will produce results such as CIPRAMYL or CYPRAMIL or CIPRIMIL all of which should appear on your Extract List.

Note: *Be careful of what can be missed.*

*A wildcard search of CareBeer as car*er would not pick up the trade mark CARE BEER where the words are separated by a space.*

Do not use wildcards as the first character in a suffix search, the last character in a prefix search or the first or last character in a Part Word search.

Word searching using the Exact (non-wildcard):

When word searching the exact (non-wildcard) option is in the dropdown list. Use this option if you are looking for trade marks that contain the characters * ? or @. For example this option may be used when searching for the trade mark BACK@WORK.

Different spellings:

Remember letter substitution, common changes for ends of words and common word substitutions.

C	and	K
Ph	and	F
S	and	Z
Er	and	A
Y	and	I
CK	and	K
AUS	and	OZ
EASY	and	EZ
EE	and	EA

Cool	Kool
Phone	Fone
Laser	Lazer
Power	Powa
Dandy	Dandi
Stix	Sticks
Stuck	Stuk
AUS Cap	OZ Cap
Easy Cap	EZ Cap
Cameese	Camease

Double letters:

Be careful, in some situations the following letters can be represented as a single or double letter without substantially changing the trade mark. There may also be other letters where this could happen, depending on the trade mark, so be aware of them.

B	C	D	F	G	L	M	N	P	S	T	X
---	---	---	---	---	---	---	---	---	---	---	---

Acronyms/Letter-Number combinations:

When searching short combinations of letters/numbers, consider possible letter/number substitutions which may still result in deceptively similar trade marks.

Other substitutions should also be considered depending on how they are represented. Eg



Monograms:

Monograms should be searched in the intended sequence of letters, if known, as well as in their alphabetical order because monograms are also indexed alphabetically. Eg



Should be searched as YSL
as well as LSY

Domain names:

Standard address code material (such as "http://", "www.", "net", "org", "com", "shop" or "au" and punctuation symbols "~", ".", "# or "/") should not generally be searched, as this material is usually non-distinctive. The context of how they appear in the mark must be considered. If they form a major element they must be searched.

For instance, a domain name such as **Biztravel.com** should be searched in the same manner as the trade mark **Biztravel**.

Trade Marks which may convey the same mental picture to a customer:

When searching a word, device, shape, sound or colour which can only be referred to by one name/idea, also search for other ways which the trade mark may be referred, and vice versa.

Search strategies should be limited to the equivalent word or pictorial representation. Before searching for an 'equivalent' make sure it is a clear and obvious reference and a particularly memorable feature of the trade mark.

Trade Mark is	Also search
shape or device of an EAGLE	the word EAGLE
the word EAGLE	part image search for EAGLE
the colour BLUE	the word BLUE
the word BLUE	the colour BLUE
the sound of someone saying "GRUNDA"	the word GRUNDA

Limit searching to only the equivalent word or image constituent(s). Broader search strategies are likely to include results of little relevance to the trade mark under examination.

For example: whilst a device search for the image constituent BIRD,PREY will include 'eagle' representations, the search results will also include other birds that are unlikely to be a clear and obvious reference to an eagle.

Trade marks that include a clear and obvious reference to an eagle will include this term as part of their indexing.

Trade marks containing multiple trade marks:

Sometimes a trader may reuse a specific trade mark to show a connection with all of the trade marks throughout their portfolio. In some cases these specific trade marks are able to stand on their own as a trade mark even though it is an element of another trade mark. It

may be a small part of a complex trade mark but is still a very important part of the trade mark because it indicates the origin of the goods or services.

Be careful to search for such trade marks which may be present in the trade mark under examination/assessment as they may be too similar to trade marks owned by another trader.

Eg: the word STARK with the HEART device in this trade mark



Trade marks with common prefix:

Sometimes a proprietor will have multiple trade marks with the same prefix, therefore you should search the part word on its own (rather than in combination), where possible.

Indexing:

Note that the indexing details for word and image constituents are not a complete list when searching for the same or similar trade marks. What is in one trade mark’s indexing may not be the same in a similar trade mark’s indexing.

Words could be indexed differently:

Phast	versus	Fast
Phuel	versus	Fuel

Devices could be indexed differently:

Triskelion	versus	Impeller three blade
Whirlpool	versus	Tornado

Also be aware of different groups of image constituents which may assist in your searching.

- [Common Groups](#)
- [Arrows and Stripes](#)
- [Bladed Images](#)
- [Types of Circles](#)
- [Other Shapes](#)
- [Heraldic Terms](#)

Image Descriptors:

When searching images, when the first few letters are typed the image descriptors will auto populate. If the image descriptors do not come up as an option, the term typed is not an image descriptor.

[Top Level Terms](#)

- Cover a broad range of sub-terms.
- Are automatically added to the indexing if sub-terms are included.
- The Top Level Term ANIMAL includes: ANTEATER, APE, ARMADILLO, etc.

[Qualifying Terms](#)

- Are used to describe major features of trade marks.

- Can assist in refining searches, but care must be taken to match correct qualifying terms with major features.
 - For example, SEATED applies to PEOPLE while SITTING applies to ANIMALS.
 - There are special qualifying terms ONLY for animals/creatures in heraldic devices: RAMPANT for *standing on hind legs*, COUCHANT for *lying down*, SEDANT for *sitting*, PASSANT for *walking*.
- INCOMPLETE is used for any unfinished figure.
- IRREGULAR is used for any distorted geometric shape, STYLISTED for any distorted or stylised person, animal, object or scene.
- INTERSECTING is used for stripes, lines, but INTERLOCKING is used for whole figures such as CIRCLES, SQUARES, RECTANGLES or ELLIPSES.
- When qualifying terms are used in searches, ensure they are describing the correct feature(s) in the trade mark (for example, for a trade mark which contains a cat leaping over a moon use LEAPING and CAT not LEAPING and MOON).

Refer to [Types of Terms \(Descriptors\)](#), [Specialised Qualifying Terms](#), [Other Special Descriptors](#), [Heraldic Devices](#), [Geometric Shapes](#), and [Other Specific Devices](#) for more information.

Order of Significance

RIO Search displays constituents in the order of significance as entered by the indexer.



Eg. the Image/Device constituents for this trade mark are shown as:

Displayed order	
1 FARMER	2 MAN
3 OVERALLS	4 CARTOON
5 HAT	6 SUNFLOWER
7 SUNGLASSES	8 CORNCOB
9 PUMPKIN	10 TOMATO
11 SMILING	12 GARDENER
13 BEARDED	14 FLOWER
15 PERSON	16 VEGETABLE

Letter/Number Trade Marks:

Certain constituents are used when trade marks contain significant letter components

- **LTR**
 - Used to identify trade marks where a single letter or group of letters (not a word) make up a part of the trade mark.

- Refer to [Letters](#) for more information on how letters are indexed.
- **#** (Hash Symbol)
 - Where the trade mark is a single letter only, a # is added as well as LTR as word constituents.
- **=** (Equals Symbol)
 - Used for a group of letters (acronym) that do not form a word.
 - Used to differentiate letters from words.
 - eg U.S. from the word US
 - LTR is also added as a word constituent.
- **NUM**
 - Used to identify trade marks which contain numbers (eg Four, 5, Second, 25th, VII, $\frac{3}{4}$, 2.5).
 - Refer to [Numbers](#) for more information on how numbers are indexed.

Hash (#) Words & Images:

- If a trade mark only consists of one of the predetermined HASH images or words, it will be indexed with a HASH (#) constituent in the relevant list of word or image constituents.
- This can be used to restrict your search to trade marks which ONLY contain the term you are searching for with no other corresponding word or image constituents.
 - e.g. a Part Word search for WORLD and a Part Word search for #, returns trade marks that consist **only** of the word WORLD, with or without an image.
 - The search will not return trade marks like BOOKWORLD or JOE'S WORLD OF TOYS.
 - Similarly a Part Image search for CIRCLE and a Part Image search for #, returns trade marks that consist **only** of the image of a CIRCLE, with or without words.
- All letters of the alphabet are hash words.
- Refer to [HASH DEVICES AND WORDS](#) for a full list of hash words & images.
- Care should be taken to not exclude similar trade marks from your overall search strategy which may not be indexed with the HASH constituent.
- The 'single' option in the word phrase searching can achieve the same results for any word or phrase, not just those indexed with a HASH.

Easy, Ozz and Quick Trade Marks

Trade marks containing variations of EASY, QUICK or AUS / AUSSIE (for example, EZY, EZE, QUIC, QWIK, OZ, OZE, OSSIE) are indexed with EASY, QUICK or OZZ for consistency. These indexing terms are added to allow examiners to find all variations of EASY, QUICK or AUS / AUSSIE in searches. Refer to [OZZ, EASY and QUICK phonetics](#) for all variations covered.

Trade marks that contain Non-Roman characters, including Chinese characters

Trade marks that contain non-Roman characters are indexed with image constituents. These include:

- Asian languages

- Cyrillic
- Arabic
- Greek

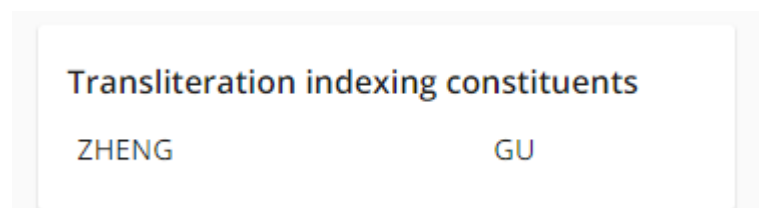
Applications for trade marks that consist of non-Roman characters must also contain a translation and transliteration. These are not indexed.

In addition to searching the image constituents, examiners should also perform a part word search for the transliteration supplied with the application. This is to ensure that they find Roman character trade marks that contain the relevant transliteration. The normal guidelines for conducting word searches should be followed.

If no transliteration has been supplied, the examiner should perform a top up part word search for the transliteration once it has been received.

The *exception* to this is trade marks that contain Chinese characters, which are indexed with both transliteration and image constituents.

Trade marks containing Chinese characters are indexed to include the transliteration (Hanyu Pinyin) of the characters. The transliterated terms will be included within the *transliteration constituents*. For example:



Searches on Word constituent (part, prefix, suffix and exact) search across both word and transliteration constituents. Searches can be limited to Exact (transliteration only) or Exact (word only) to exclude word or transliteration constituents.

If there is a Chinese character(s) but there is no Hanyu Pinyin transliteration there will simply be a transliteration constituent of NONE

When searching trade marks containing Chinese characters, examiners should search for the transliterated terms using a part word search. This is to ensure that they find not only the Chinese characters of interest, but also any trade mark that includes the Pinyin (transliteration).

Examiners should only limit their searches to exact word, or exact word (transliteration only) in cases where the search field is too large to view. In such cases an appropriate search of the Chinese characters may be:

Example: 澳新集 □

Word indexing constituents

AO JI
TUAN XIN

Class 35: Publicity; Organisation of trade fairs for commercial or advertising purposes

Viewed	Results	Search criteria	Class	Status	Combine	Refine	Remove
<input checked="" type="checkbox"/>	180	Word ao (PW) AND xin (PW)	All	All	<input type="checkbox"/>		
<input type="checkbox"/>	1,651	Word ao (PW)	35 (12, 14, 25, 35, 36, 40, 41, 42, 43)	PRR	<input type="checkbox"/>		
<input checked="" type="checkbox"/>	50	Word ao (EW)	35 (12, 14, 25, 35, 36, 40, 41, 42, 43)	PRR	<input type="checkbox"/>		
<input type="checkbox"/>	462	Word xin (PW)	35 (12, 14, 25, 35, 36, 40, 41, 42, 43)	PRR	<input type="checkbox"/>		
<input checked="" type="checkbox"/>	10	Word xin (EW)	35 (12, 14, 25, 35, 36, 40, 41, 42, 43)	PRR	<input type="checkbox"/>		
<input checked="" type="checkbox"/>	58	Word ji (PW) AND tuan (PW)	35 (12, 14, 25, 35, 36, 40, 41, 42, 43)	PRR	<input type="checkbox"/>		

The examiner should exercise reasonable discretion in constructing their search strategy. When identifying key elements in the trade mark to construct their search strategy, the examiner may refer to research results and the Common Descriptors in Chinese document for assistance.

If the examiner chooses to carry out an Other Trade Mark Information search or Assessment Summary search, the guidelines on conducting Other Trade Mark Information search and Assessment Summary search of the trade mark searching system should be followed.

The above searching guidelines in relation to Chinese characters only apply to trade mark applications that have a first adverse/first clear report issued AFTER 20 June 2014. Any response (including clear reports) to an examination report on a trade mark that contains Chinese characters that was issued PRIOR to 20 June 2014 (when new practice was published) DOES NOT require a top up search of the transliteration word constituents.

ANNEX 2
SEARCHING REGULATED SIGNS

Prescribed signs

Section 39(2) grounds for rejection may be taken on a trade mark if it contains or consists of a prescribed sign or if it so nearly resembles the sign as to be likely to be taken for it.

A pre-searching consideration is an understanding of the types of prescribed signs and when section 39 grounds for rejection may be applicable in relation to such signs.

Shields/crests/flags



If a trade mark contains or consists of the above, there is generally a higher likelihood of deception or confusion occurring given the presence of such a sign.

Composite marks

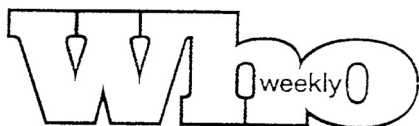


These signs are to be considered as a whole. The mere inclusion of one or more of the words/acronym contained in the sign is unlikely to lead to deception or cause confusion. Should these signs be wholly contained in a trade mark the likelihood of deception or confusion would however be higher.

Plain word/letters

WHO IRENA SHAPE

Whilst the presence of such ordinary English words as a trade mark may be likely to give rise to deception or confusion of the public, limited additional material/stylisation will usually reduce this likelihood considerably, as the trade mark is less likely to be taken for the prescribed sign.



E.g.

The trade mark is not likely to be taken for the World Health Organisation sign and therefore is less likely to deceive or cause confusion in the face of the WHO sign.

Invented words/acronyms

EUREKA

INTELSAT

COMESA

ESO

Given the nature of these invented words/acronyms, minor alterations which do not alter the nature of the invented word (e.g. minor syllabification or additional wording) are unlikely to prevent deception or confusion occurring. With this in mind however given recognition afforded to such invented words, phonetic spelling variations may alter the trade mark sufficiently such that they are no longer likely to be taken for the prescribed sign e.g. EURECA.

Prohibited Signs

Currently as there are no signs specified as prohibited no regulations have yet been made for the purposes of section 18 of the Act (subsection 39(1)).

Use of a trade mark that is contrary to law

Section 42 grounds for rejection must be raised if use of the trade mark would be contrary to law. To be caught by this section of the Act, use of the trade mark should breach some piece of legislation. Similar to prescribed signs, words and signs (the use of which is contrary to law by virtue of other pieces of legislation) are entered on the trade marks database and are indicated by beginning with -9.

The applicable Acts in relation to such signs specify the limitations of use. For example:

- Section 15 of the *Geneva Conventions Act 1957* prohibits the use, without the consent in writing of the Minister or of a person authorised in writing by the Minister to given consent, for any purpose whatsoever of the designations (words): “Red Cross”, “Red Crescent”, “Red Crystal” and “Red Lion and Sun”(and the emblems (signs) used to represent them); heraldic emblem of the Swiss Confederation and a design/wording so nearly resembling any of the emblems or designations specified. In some cases, a condition of registration may be added by the applicant in order to render a trade mark containing the signs acceptable for the purposes of the *Geneva Conventions Act 1957*.
- *The War Precautions Repeal Act 1920* which incorporates protection of the word ANZAC Regulations. The Regulations are quite specific in banning the use of the word ANZAC in trade marks of any kind, unless the applicant can demonstrate Ministerial consent to use the word.

- *The Banking Act 1959* restricts the use of a number of words or expressions in an attempt to assure the public that a financial business that describes itself as a bank, building society, credit union or authorised deposit-taking institution is in fact authorised as such. Further information including a list of relevant terms can be found in Part 30 of the Manual.

Examiner's should refer to Part 30.3 of the Manual which provides information on use contrary to law and lists known signs which if used in a trade mark would be contrary to law. The list provided in the Manual is not exhaustive, however the known signs are included in *RIO Search* as regulated signs and the details of the sign may include the Act applicable or reference to section 42 grounds for rejection.

Generally a ground for rejection for use of a mark contrary to law is applicable when the trade mark applied for contains the sign where use is contrary to law, noting that section 42 grounds for rejection should only be taken in what is clearly a breach of another Act.

Searching and extracting -9 million signs

Search strategies need to include searches that would identify relevant -9 million signs (see Phase 2. Initial Broad Search(es) - including All Classes, All Status'). All relevant -9000000 signs are to be on the *RIO Search* Extract List. This includes (but is not limited to) signs that are specifically mentioned in the TM Examiner's Manual such as the Red cross, the word ANZAC and terms restricted under the *Banking Act 1959* such as BANK.

For example, if the trade mark contained the word ANZAC the search strategy needs to include a search that would find -9000017 ANZAC. This -9 million sign must be included on the *RIO Search* Extract List and annotated as s42 raised or s42 not raised (considered) (see How to annotate an *RIO Search* Extract List).

Where the trade mark contains a Greek cross or representation of a cross which may give rise to Red Cross or Swiss flag considerations, an image search for CROSS, GENEVA or FLAG, SWITZERLAND in Pending status will produce the relevant -9 million signs:

- -9000987 (Red Cross)
- -9001034 (Red Cross)
- -9000371 and -9002582 (Swiss flag)

Your *RIO Search* strategy must include a search that will identify these signs. Depending on the trade mark you are examining, either one of the red cross signs **and both** of the Swiss flag signs must be extracted and properly annotated to demonstrate that the appropriate grounds have been considered. Please note that additional -9 million signs may also need to be searched and extracted depending on the trade mark representation, e.g. where the cross is incorporated as part of another country's flag.

If the trade mark you are examining contains the image indexing terms CROSS, GREEK, CROSS or PLUS, *RIO Search* will automatically the following search:

Viewed	Results	Search criteria	Class	Status	Combine	Refine	Remove
1	7	Image cross, geneva (E) OR flag, switzerland (E)	All	All	<input type="checkbox"/>		

RIO Search will also extract the relevant -9 million signs (mentioned above). These signs will not be annotated, and the examiner must consider the signs and manually annotate them accordingly. If the signs are not relevant, the examiner can delete them from the Extract List.

Examiners may also be required to conduct searches for the relevant -9 million signs as they may not come up automatically (depending on the indexing of the trade mark you are examining).

NB: The above search will not be required in circumstances where the trade mark contains an emblem that may be taken as a “plus”, “positive” or “in addition to” symbol **instead** of a Red cross. However, a note **MUST** be made on the examiners worksheet to acknowledge the above consideration rather than a search for these signs.